

Administrative Panel Decision

In the Matter of Domain Name Dispute

Between

Telekom Malaysia Berhad

And

Andrew Lim/ Tan Li Boon, Innovative Idea Design

Case No: DNDR-8-8-2020

1. The Parties

1.1 The Claimant is Telekom Malaysia Berhad with an address of Menara TM, Jalan Pantai Baharu, 50672, Kuala Lumpur, Malaysia.

1.2 The Respondent is Andrew Lim/Tan Li Boon, Innovative Idea Design with an address of 12A, Seksyen 13, 46200 Petaling Jaya, Selangor, Malaysia.

2. The Domain Name and Registrar

2.1 The Domain Names in issue is <streamyx.com.my> and the Registrar is the Malaysian Network Information Centre (MYNIC).

3. Procedural History

3.1 The Complainant filed its Complaint on 10th January 2020 with the Asian International Arbitration Centre (“the Centre”). Subsequent to this, the Centre transmitted a request to MYNIC for verification of the identity of the domain name holder. MYNIC transmitted its response on 28th January 2020, confirming that the Respondent was listed as the registrant of the domain names and providing its contact details.

3.2 The Centre verified that the Complaint had completed and satisfied the formal requirements of MYNIC’s (.my) Domain Name Dispute Resolution Policy (MYDRP) and Rules, and the Supplemental Rules of the Centre.

3.3 In accordance with the Policy and the Rules, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on 28th January 2020.

3.4 The Centre appointed a single panel consisting of Prof. Dr. Ida Madieha bt. Abdul Ghani Azmi to preside over the Complaint.

4. Factual Background

4.1 The Complainant, Telekom Malaysia Berhad, a public listed company incorporated in Malaysia on 12th October 1984 (Annex 1), is the owner of the trademark STREAMYX and/or marks consisting of STREAMYX in various classes in Malaysia as follows (Annex 4):

Trademark	Class of Goods	Registration Date
Streamyx – TM No. 2012011191	9	02 July 2012
Streamyx – TM No. 2017012771	9	15 Nov 2017
Streamyx – TM No. 07017799	38	11 Sep 2007
Streamyx- TM No. 2012011192	38	02 July 2012
Streamyx- TM No. 2017012772	38	15 Nov 2015
Streamyx – TM No. 2017012773	42	15 Nov 2017

4.2 The disputed domain name <streamyx.com.my> was registered by the Respondent and the results of a WHOIS database search showed that Andrew Lim/Tan Li Boon, Innovative Idea Design was the registrant of the disputed domain name (Annex 3). The Respondent is the proprietor of Innovative Idea Design which was incorporated on 5th March 2019 (Annex 2).

5. Parties' Contentions

The Complainant claims that it is the registered owner of the trade mark STREAMYX and/or marks consisting of STREAMYX in various classes in Malaysia including, but not limited to, Classes 9, 38 and 42 (collectively, the "Marks").

5.1 The Complainant contends that by the registration of the trade marks, it has the exclusive use to the trade marks in Malaysia.

5.2 The Complainant claims that its trademarks are reputable in Malaysia as the Complainant was one of the pioneer companies which facilitated Malaysia's entry into the Internet age with STREAMYX, with its broadband service introduced in 2001. The Complainant has won several awards for the service it has rendered including, among others, the "Reader's Digest Platinum Award" as "The Most Trusted Internet Service Provider", the "Telecom Service Provider of the Year" by Frost & Sullivan Malaysia Excellence Awards, "Malaysia's leading ICT, BPO Provider" in the Gartner Market Guide for the year 2017, "Services Partner and Managed Services Provider of the Year 2017", and the "Industry Excellence Award for Main Board Company in Trading and Services Category". After decades of service, STREAMYX has become a household name in

Malaysia and the awards that TM has received are a testimony to the Complainant's strong international presence (Annex 5, 6 & 7).

5.3 The Complainant contends that the Respondent has registered and/or used the domain name <streamyx.com.my> in bad faith on several grounds. First with the registration, the Respondent intended to mislead the public into believing that the disputed domain name belongs, or is related, to the Complainant and/or associated with the Complainant's corporate group of companies. It is the contention of the Complainant that the choice of the word 'STREAMYX' is calculated to mislead the public and thereafter to take unfair advantage of the Complainant's substantial goodwill in its Marks.

5.4 The disputed domain name <streamyx.com.my> is identical to the Complainant's trade mark STREAMYX with the mere addition of the .COM.MY top-level domain (TLD) suffix. In fact, the disputed domain name incorporates the entirety of the trademark, i.e. STREAMYX, and is therefore likely to confuse consumers as to its connection with the STREAMYX brand name and its associated corporate group of companies.

5.5 At all material times, the Complainant has not authorized and/or consented to the Respondent to use the Marks and/or for the Respondent to use or register the Disputed Domain Name.

5.6 In accordance of Rule 12(1)(i) of the Policy, the Complainant requests that the disputed domain name, <streamyx.com.my> be transferred to the Complainant.

5.7 Respondent

5.8. The Respondent has not submitted a valid Response under Paragraph 6 of the Rules.

6 Discussions and Findings

6.1 Rule 17 of the MYDRP Policy instructs the Panel to decide on the proceeding based upon the documents and evidence submitted by the Parties, the Policy and Rules, as well as any other rules and principles of law which are applicable in Malaysia.

6.2 Rule 5 of the MYDRP Policy provides that the Complainant must establish the following elements in the Complaint:-

- (i) The Domain Name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights, and
- (ii) The Respondent had registered and/or used the Domain Name in bad faith

6.3 It is worth noting that under the MYDRP Policy, there is no need to prove both the registration and usage of the domain name. It is enough that the Complainant proves either one by virtue of the word 'and/or' in paragraph 5(ii) above. This is unlike UDRP that requires a complainant to prove both the element of identical or confusing similarity with registration or usage of such domain name in bad faith (*Hugo Boss AG v Eppies Internet*, Case No:rca/dndr/2004/02; *Google Inc v Digiattack*, Case No rca/dndr/2009/17).

Identical or Confusingly Similar to the Complainant's trademark

6.4 The first determination is whether the Complainant has established its right over the word 'STREAMYX'. From the evidence furnished by the Complainant, it is clear that the Complainant has registered its rights in STREAMYX as trademarks in several classes in Malaysia. The Complainant has also widely used the trade mark STREAMYX in their activities since 2001. Being a pioneer of the broadband services in Malaysia, the Complainant has invested a substantial amount of money in protecting its interest over the trademark 'STREAMYX'. With the trademark registrations, it is abundantly clear that the trademark STREAMYX is associated with the Complainant and therefore the Complainant has rights over the trademark STREAMYX together with the goodwill.

6.5 The Respondent, Andrew Lim/Tan Li Boon, Innovative Idea Design, registered the disputed domain name <streamyx.com.my>. With the countrywide offer of the Complainant's broadband services in Malaysia, it is inconceivable that the defendant would have no knowledge of the Complainant's services such that the registration could be considered an honest or non-deliberate registration and usage.

6.6 Whilst the term streaming refers to the method of sending or receiving data, especially video, over a computer network, the term STREAMYX itself is neither generic nor a dictionary term or a common combination of two words. There is also no possibility that the Respondent might claimed that his usage of the term STREAMYX was in its generic or dictionary sense. This is because the registrability of the mark STREAMYX is never disputed in terms of its distinctiveness, and the mark remains protected under the ambit of trade mark law.

6.7 The second element to be established is that the disputed domain name is identical or confusingly similar to the trade mark of service mark to which the Complainant has rights. On this point, it is to be noted that the disputed domain name is identical to the Complainant's trade mark STREAMYX. In fact, the entire term STREAMYX has been included in the disputed domain name. The inclusion of the.COM.MY suffix does nothing to detract from the identical nature of the disputed domain name with the registered mark owned by the Complainant. (*Malayan Banking Berhad v Beauty, Success & Truth International* (WIPO Case No. D2008-1393)).

6.8 Accordingly, the Panel finds that the Complainant has established its rights over the trade mark STREAMYX and this is well supported by the number of trade mark registrations it has obtained over the mark. The disputed domain name <streamyx.com.my> is exactly identical to the registered trade mark STREAMYX belonging to the Complainant.

7. Registration and/or use of the Domain Name in bad faith

7.1 Rule 6 of the MYDRP Policy lists down four circumstances that constitute bad faith registration as follows:

- (i) you registered and/or are using the Domain Name mainly to sell, rent or transfer the Domain Name for profit to the Complainant, its competitor or the owner of the trade mark or service mark; or

- (ii) you registered and/or are using the Domain Name to prevent the owner of a trade mark or service mark from using the domain name which is identical with its trade mark or service mark; or
- (iii) you registered and/or are using the Domain Name to disrupt the business of the Complainant; or
- (iv) you registered and/or are using the Domain Name for the purposes of and with the intention to attract or divert, for commercial gain, Internet users to:-
 - (a) Your web site;
 - (b) A web site of the Complainant's competitor; or
 - (c) Any other web site and/or online location,

by creating a possibility of confusion or deception that the web site and/or online location is operated or authorized by, or otherwise connected with the Complainant and/or its trade mark or service mark.

7.2 The Complainant alleges among others that the disputed domain name was registered with mala fide intention, for unlawful financial benefit, whether immediately and/or in the near future. There is also an intention to free ride upon and/or take unfair advantage of the Complainant's goodwill and mislead the public. The public may be confused into thinking that the Disputed Domain Name provides goods and/or services originating from and/or associated with the Complainant.

7.3 Any one of the circumstances provided in Rule 6 of the MYDRP Policy as reproduced above, would be enough to constitute bad faith registration. However, it has to be mentioned that the listed circumstances are not exclusive and are merely illustrative.

7.4 The circumstances under Rule 6(ii) may be relevant i.e. to prevent the owner of a trade mark or service mark from using the domain name which is identical with its trade mark or service mark. However, in the present case, the motive of the registration is not clear as the Respondent has not responded to the Complaint. It is not possible to infer the intention of the Respondent for registering the domain name as the disputed domain name can easily be bought in the open market. Nevertheless, with the widespread availability of the Complainant's services in Malaysia, it is inconceivable that the Defendant would not be aware that the domain name that he reserved would cause a problem with the Complainant. As stated earlier, the only plausible explanation is that Respondent sought to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the Complainant's trademark. From here we can draw an inference of bad faith registration which only the Respondent can rebut. However, the Respondent has not done so since he has not responded to the Complaint.

7.5 One decision worth mentioning is *Malayan Banking Berhad v Beauty, Success & Truth International* (WIPO Case No. D2008-1393). In this case, the Complainant, a Malaysian bank and financial group alleged that the Respondent that had registered <maybank.com> had done so in bad faith. The Respondent clearly did not have any rights or legitimate interests in the disputed

domain name, and there was no evidence to suggest that the Respondent was commonly known by the disputed domain name. Moreover, in the case of *Ferrari S.p.A. v. American Entertainment Group, Inc.*, (WIPO Case No. D2004-0673), where a domain name was registered to exploit the fame of the mark, the WIPO Panel ruled that the particular circumstance in question constituted bad faith 'use' under the UDRP Policy. As the MYDRP Policy is to a certain extent based on the WIPO UDRP Policy, the decisions made on the UDRP Policy are of persuasive value in the interpretation of MYDRP Policy.

7.6 Another point that needs to be clarified here is whether the passive holding of the domain name can support a finding of bad faith? On this, many WIPO UDRP decisions have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (*Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. D2000-0003, <telstra.org>, Transfer).

7.7 In light of all the evidence submitted by the Complainant, the Panel finds that the Respondent has registered the disputed domain name in bad faith.

8 Rights and Legitimate Interests in the Domain Name

8.1 The Respondent can evade liability if he can prove that his usage of the disputed domain name is within his right and legitimate interest. Under the Policy, there are three grounds of rights or legitimate interests as outlined under Rule 7.2 as follows:

Evidence of your rights and legitimate interest in the Domain Name may include, among others, the following circumstances: -

- (i) before the date of your being informed of the Complainant's dispute, you had used or made preparations to use the Domain Name or a name corresponding to the Domain name in relation to a genuine offering of goods or services; or
- (ii) You are commonly known by the Domain Name even though you have acquired no trade mark or service mark rights in the same; or
- (iii) You are using the Domain Name for legitimate, non-commercial and/or fair purposes and have no intention of using the same for profits or to deceive the public.

8.2 As the Respondent has not responded to the Complaint, there is no evidence that he is entitled to the registration and use of the disputed domain name. What is clear though is that the Respondent has never been commonly known by the disputed Domain Name. From the little that can be extracted from the *Whois* search, the Respondent Andrew Lim/Tan Li Boon, Innovative Idea Design is commonly known by his personal name and the type of business he deals with has no connection with STREAMYX whatsoever. The Complainant also has no relationship with the Respondent and has never authorized the Respondent to use the domain name <streamyx.com.my> (*Croatia Airlines d.d. v. Modern Empire Internet Ltd.* WIPO Case No. D2003-0455)

8.3 In sum, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

9. Conclusion

9.1 For the foregoing reasons, in accordance with the findings under Rules 5, 6 and 7 of the Policy and Paragraph 17 of the Rules, the Panel directs that the domain name <streamyx.com.my> be transferred to the Complainant.

Prof. Dr. Ida Madieha bt. Abdul Ghani Azmi

Sole Panelist

Date: 9th March 2020.