



ADMINISTRATIVE PANEL DECISION

Evite, Inc. v. Hays Synergy Sdn Bhd
Case No. AIC / DNDR – 820 - 2020

1. The Parties

The Complainant is Evite, Inc., of Los Angeles, California, United States of America represented by Shearn Delamore of Kuala Lumpur, Malaysia

The Respondent is Hays Synergy Sdn Bhd of Kajang, Selangor, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <evite.my> is registered with MYNIC Berhad (the “**Registrar**”).

3. Procedural History

The Complaint was filed with the Asian International Arbitration Centre (the “**Centre**”) on February 11, 2020.

The Centre verified that the Complaint satisfied the formal requirements of MYNIC’s (.my) Domain Name Dispute Resolution Policy (the “**Policy**” or “**myDRP**”), the Rules of the MYNIC’s (.my) Domain Name Dispute Resolution Policy (the “**Rules**”), and the Supplemental Rules of the Centre (the “**Supplemental Rules**”).

In accordance with the Rule 5.6 of the Rules and Paragraphs 5 of the Supplemental Rules, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on February, 18 2020. In accordance with Rule 6 of the Rules and Paragraph 6 of the Supplemental Rules, the due date for Response was March 10, 2020. The Respondent did not submit any response. Accordingly, the Centre notified the Respondent’s default on March 16, 2020.

The Centre appointed Syed Naqiz Shahabuddin as the sole panelist in this matter on March 17, 2020. The Panel finds that it was properly constituted. The Panel has submitted the Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with Rule 9.3 of the Rules.

4. Factual Background

The following summary sets out the uncontested factual submissions made by the Complainant:

- 4.1 The Complainant is a company incorporated on or about June 4, 2007 under the laws of the State of Delaware and is headquartered in Los Angeles, California, United States of America. The Company owns a digital platform for creating, sending and managing online invitations.
- 4.2 The Complainant owns the following registered trademarks for the EVITE mark in respect of digital invitation services in various classes worldwide including but not limited to the United States of America:

| Country | Title | Local Classes | Application Date | Registration / Application No. | Registration Date | Status |
|-----------------|-------|------------------------|------------------|--------------------------------|-------------------|------------|
| USA | EVITE | 38, 41, 42 | 13.4.1999 | 2,650,957 | 11/19/2002 | Registered |
| USA | EVITE | 35 | 13.4.1999 | 2,655,403 | 12/3/2002 | Registered |
| USA | EVITE | 42 | 24.7.2007 | 3,500.825 | 9/16/2009 | Registered |
| USA | EVITE | 09 | 17.5.2018 | 5,842,272 | 8/27/2019 | Registered |
| Australia | EVITE | 35, 38, 41, 42 | 12.10.1999 | 810093 | 11/1/2001 | Registered |
| Benelux | EVITE | 35, 38, 42 | 28.7.1999 | 0656334 | 7/28/1999 | Registered |
| Canada | EVITE | - | 13.10.1999 | TMA568707 | 10/8/2002 | Registered |
| European Union | EVITE | 35, 38, 42 | 11.10.1999 | 001339506 | 7/31/2003 | Registered |
| Japan | EVITE | 35, 38, 42 | 13.10.1999 | 4552560 | 3/15/2002 | Registered |
| Australia | EVITE | 38, 39, 40, 41, 43 | 26.7.2007 | 1189357 | 3/10/2009 | Registered |
| Canada | EVITE | - | 25.7.2007 | TMA740454 | 5/21/2009 | Registered |
| China | EVITE | 39 | 27.8.2007 | 6245089 | 9/14/2010 | Registered |
| China | EVITE | 40 | 27.8.2007 | 6245088 | 3/28/2010 | Registered |
| China | EVITE | 43 | 27.8.2007 | 6245087 | 3/28/2010 | Registered |
| European Union | EVITE | 38, 39, 40, 41, 43 | 27.7.2007 | 006174056 | 2/29/2008 | Registered |
| Japan | EVITE | 38, 39, 40, 41, 42, 43 | 30.7.2007 | 5226342 | 4/24/2009 | Registered |
| China | EVITE | 35 | 27.8.2007 | 6245086 | 11/14/2011 | Registered |
| China | EVITE | 38 | 27.8.2007 | 6245085 | 3/28/2010 | Registered |
| China | EVITE | 41 | 27.8.2007 | 6245084 | 11/14/2011 | Registered |
| China | EVITE | 42 | 27.8.2007 | 6245083 | 9/21/2011 | Registered |
| Madrid Protocol | EVITE | 09 | 14.11.2018 | IR1441545 | 11/14/2018 | Registered |
| Australia | EVITE | 09 | 14.11.2018 | IR1441545 | 11/14/2018 | Registered |
| Benelux | EVITE | 09 | 14.11.2018 | IR1441545 | 11/14/2018 | Registered |
| European Union | EVITE | 09 | 14.11.2018 | IR1441545 | 11/14/2018 | Registered |
| United Kingdom | EVITE | 09 | 14.11.2018 | IR1441545 | 11/14/2018 | Registered |

- 4.3 In Malaysia, the Complainant has filed a trademark application for the EVITE mark in class 42 under Trade Mark Application No. TM2019045053 in respect of "*preparation of electronic invitations; providing party and events planning and invitation information provided by users via an electronics communications network; computer services, namely, providing a web site that automates party and entertainment events management that consists of guest lists, guest information, restaurant*

information, and invitation creation and delivery providing a website for users to upload and share digital photography with others”.

- 4.4 The Complainant offers its services through its website www.evite.com and its mobile app. These services include free and premium customizable digital and text invitations. The Complainant has since recorded over 160 million annual users and, through its predecessors in interest, has sent over 3 billion invitations since the launch of its website in 1998. The Complainant’s services are available worldwide, including Malaysia, where over 16,000 events in Malaysia have been planned through Evite and over 28,000 individuals in Malaysia have been recorded as users (based on data collected since the Complainant began tracking its international users in 2015).
- 4.5 The Complainant advertises its services extensively which has been the subject of numerous press articles and commentary. The services have also been featured or mentioned in several television shows, including but not limited to, *The Office*, *Orange is the New Black*, *The Big Bang Theory*, *The Late Show with Stephen Colbert*, *Family Guy* and *Keeping Up With The Kardashians*. These television shows were and are aired to the Malaysian public via various platforms such as Astro, Netflix, UnifiTV and YouTube.
- 4.6 The disputed domain name was registered on April 11, 2019 by the Respondent whose nature of business is reflected in the official company search results as “*to carry on the business of printer and stationers*”.
- 4.7 As of the date of the decision, the disputed domain name appears to resolve to a website, specifically the following URL: <https://www.ekad.my>, which provides online invitation services and which uses the EVITE mark in its description of services.

5. Parties’ Contentions

A. Complainant

- 5.1 The Complainant contends that it has rights in the trademarks listed in section 4 above and has produced the relevant trademark certificates and proof of use.
- 5.2 The Complainant contends that the disputed domain name is identical to the Complainant’s EVITE mark as it is constituted entirely of the word EVITE.
- 5.3 The Complainant further contends that the Respondent has registered and/or used the disputed domain name in bad faith. The Complainant submits that the EVITE mark was and is intended to be the source identifier of the Complainant’s services, and refers to the Complainant’s services.
- 5.4 The Complainant submits further that the choice of the EVITE mark by the Respondent cannot be incidental especially since it offers the same services as the Complainant. Allegedly, the Respondent was and is therefore, clearly aware of the Complainant and the Complainant’s EVITE mark and was intentionally registered to prevent the Complainant from using a domain name in Malaysia which is identical to the Complainant’s EVITE mark. In addition, the Complainant contends that the registration and use of the disputed domain name is nothing more than an attempt to misappropriate and usurp the Complainant’s goodwill and commercial reputation which the Complainant has already enjoyed in Malaysia and continue to enjoy.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

Paragraph 5 of the Policy provides that in order to succeed, the Complainant must establish BOTH of the following elements in the Complaint:

- (a) The domain name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights; and
- (b) The Respondent has registered and/or used the domain name in bad faith.

A. Identical or Confusingly Similar

The Panel is satisfied with the evidence adduced by the Complainant to establish its rights to the EVITE mark through its abovementioned registrations in various countries and the extent and long use thereof.

The disputed domain name comprises the EVITE mark in its entirety and only differs by the ccTLD “.my”. This Panel agrees that a ccTLD indicator such as “.my” cannot be taken into consideration when determining confusing similarity. This Panel is guided by the *WIPO Jurisprudential Overview 3.0* relating to country code top level domain names which states that such top level domain names should be disregarded when comparing domain names with trademarks.

The panel in *Volkswagen Group Singapore Pte Ltd v Webmotion Design* [Case No RCA/DNDR/2003/01 (INT)] also held that the addition of a ccTLD “.my” to a domain name is inconsequential when determining where a disputed domain name is identical or confusingly similar to the trademark.

As such, the Panel finds that the Complainant has proved that the disputed domain name is identical to the EVITE mark in which the Complainant has established rights according to paragraph 5.2(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 7 of the Policy allows the Respondent to prove its rights and legitimate interest in the disputed domain name by substantiating with evidence that:

- (a) before the date of the Respondent being informed of the Complainant’s dispute, the Respondent had used or made preparations to use the disputed domain name or a name corresponding to the disputed domain name in relation to a genuine offering of goods or services; or
- (b) the Respondent is commonly known by the disputed domain name even though it has acquired no trademark or service mark rights in the same name; or
- (c) the Respondent is using the disputed domain name for legitimate, non-commercial and/or fair purposes and has no intention of using the same for profits or to deceive the public.

Based on the absence of a response and the absence of any nexus between the disputed domain name and the Respondent’s name, the Panel could not find any justification, rights, or legitimate interests on the part of the Respondent to the disputed domain name. The notoriety of the Complainant’s EVITE mark would present a significant hurdle for the Respondent to justify any rights or legitimate interests to the mark without submitting compelling reasons to this Panel to conclude otherwise.

The disputed domain name also appears to redirect users to a website with the domain name www.ekad.my which provides similar services as the Complainant and which then applies the EVITE mark generously throughout its content page. This does not suggest a genuine offering of goods and services. Rather, it appears to be an attempt to usurp and ride on the Complainant’s reputation and goodwill.

C. Registered and Used in Bad Faith

The Panel agrees with the Complainant's contention that the Respondent had or should have had knowledge of the Complainant's EVITE marks when it registered the disputed domain name. The factors that were taken into account to arrive at this conclusion include the date of registration of the disputed domain name which was much later than the date the Complainant registered the Complainant's EVITE marks, the widespread use of the Complainant's EVITE marks and services at a global level and the extent of promotion and publicity of the Complainant's mark and services.

Paragraph 6.1(iv) of the Policy identifies the following circumstances as one of bad faith registration and/or use of a domain name:

"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."

The Panel takes cognizance that the Complainant first used the EVITE mark since at least 1998 and registered the EVITE mark as early as 2002. The Panel is satisfied that the Respondent had or should have had knowledge of the reputation and goodwill of the EVITE mark when it sought to register the disputed domain name. A simple Internet search by the Respondent would have disclosed this given that the Complainant's domain name ranks highly, if not first, in that search category. By using the mark in its entirety, the Respondent appears to attempt to misrepresent a connection with the Complainant when in fact no such connection exists.

Bad faith registration can also be confirmed where a respondent has acted in willful blindness even if the respondent did not know of the complainant or its trademark rights during the registration of the disputed domain name. See *Millenium & Copthorne Hotels Plc and Millenium & Copthorne International Limited v Everise Sales Sdn Bhd* [Case No. KLRCA/DNDR-557-2018].

In light of the above, the Panel finds that bad faith has been demonstrated under paragraph 5.2(ii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with Paragraph 12.1 of the Policy and Rule 17 of the Rules, the Panel orders that the disputed domain name, <evite.my> be transferred to the Complainant.

Syed Naqiz Shahabuddin
Sole Panelist

Date: March, 24 2020