

In the matter of

**Between**

**Tenaga Nasional Berhad (Co.No.200866-W)**

**(‘the Complainant’)**

**And**

**MOF Solution (Business Registration No.200903041716[CA0145371-V])**

**(‘the Respondent’)**

**Case No. : AIAC/DNDR-891-2020**

**1. The Parties**

The Complainant is Tenaga Nasional Berhad, Malaysia represented by Messrs Christopher & Lee Ong.

The Respondent, MOF Solution, is unrepresented.

**2. The Domain Name and Registrar**

The disputed domain name <[www.e-tnb.com.my](http://www.e-tnb.com.my)> is registered with the Malaysian Network Information Centre (MYNIC) (‘the Disputed Domain Name’).

**3. Procedural History**

The Complaint was filed with the Asian International Arbitration Centre, Kuala Lumpur (‘the Centre’) on 27<sup>th</sup> November 2020. On 1<sup>st</sup> December 2020, the Centre transmitted by e-mail to MYNIC a request for registrar verification in connection with the domain name at issue. On 1<sup>st</sup> December 2020, MYNIC transmitted by email to the Centre its verification response, confirming that the Respondent was listed as the registrant and provided the contact details for the administrative, billing and technical contact.

The Centre verified that the Complaint satisfied the formal requirements of MYNIC’S (.my) Domain Name Dispute Resolution Policy (‘the Policy’), the Rules for MYNIC’S (.my) Domain Name Dispute Resolution Policy (‘the Rules’), and the Supplemental Rules of the Centre (‘the Supplemental Rules’).

In accordance with the Rules, the Centre formally notified the Respondent of the Complaint and the proceedings commenced on 1<sup>st</sup> December 2020. In accordance with the Rules, the due date for Response was 22 December 2020. No response was filed by the Respondent.

The Centre appointed Hemalatha Parasa Ramulu as the sole panelist in this matter on 29<sup>th</sup> December 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 the Rules.

#### 4. Factual background

The Complainant is the largest electricity utility company in Malaysia and a leading utility company in Asia with an international presence in United Kingdom, Kuwait, Turkey, Saudi Arabia, Pakistan, India and Indonesia. The Complainant's core business activities are in the generation, transmission and distribution of electricity. Their other activities include repairing, testing and maintaining power plants, providing engineering, procurement and construction services for power plants related products, assembling and manufacturing high voltage switchgears, coal mining and trading. The Complainant provides products and services and conducts their business under and by reference to the name Tenaga, Tenaga Nasional, Tenaga Nasional Berhad, and TNB (the 'TNB Name').

The Complainant has approximately 9.2 million customers in Peninsular Malaysia, Sabah and Labuan and its customers consist mainly of commercial, industrial and residential customers. Residential customers which represent the majority of Malaysia's 31.7 million population are their largest market.

The Complainant has registered and owns, inter alia, the TNB trade mark in Malaysia ('the TNB Trade mark'). The Complainant has successfully acquired various registrations for the TNB trade mark in various classes on 15 July 2013 in Malaysia.

The Respondent is a sole proprietorship involved in various diverse businesses including the business of management services, insurance agents, training, employment, cleaning of areas and buildings, supplying kits and educational materials, furniture, machines, electrical appliances, food and beverages, souvenirs and clothing. An individual by the name of Che Mohd Fauzi bin Nik Mat, a Malaysian citizen residing and conducting his business in Kuantan, Pahang operates and trades in the name of the Respondent.

The Respondent registered the domain name <[www.e-tnb.com.my](http://www.e-tnb.com.my)> on 15 January 2019.

#### 5. Parties' Contentions

##### A. The Complainant

The Complainant claims that it conceptualized and has used the 'TNB' mark ('the TNB mark') for its goods and services and that they have secured numerous trade mark registrations in Malaysia details of which are set out in Table A as follows ('the TNB Registered Trade Marks'):

Table A

| No. | Mark | Registration No. | Registration date | Status     | Class |
|-----|------|------------------|-------------------|------------|-------|
| 1.  | TNB  | 2013056954       | 15.07.2013        | Registered | 1     |
| 2.  | TNB  | 2013056955       | 15.07.2013        | Registered | 25    |

|    |            |            |            |            |    |
|----|------------|------------|------------|------------|----|
| 3. | <b>TNB</b> | 2013056958 | 15.07.2013 | Registered | 35 |
| 4. | <b>TNB</b> | 2013056959 | 15.07.2013 | Registered | 37 |
| 5. | <b>TNB</b> | 2013056961 | 15.07.2013 | Registered | 39 |
| 6. | <b>TNB</b> | 2013056953 | 15.07.2013 | Registered | 40 |
| 7. | <b>TNB</b> | 201356963  | 15.07.2013 | Registered | 41 |
| 8. | <b>TNB</b> | 2013056967 | 15.07.2013 | Registered | 42 |

In addition, the Complainant also claims that it has used and promoted the TNB Trade mark extensively for its goods and services and thus, has created significant goodwill and reputation in connection thereof. They therefore contend that taking into account the extensive use of the TNB Trade mark in advertising, marketing and promotion thereof has resulted in the TNB Trade mark being associated and identified exclusively with the Complainant and no other.

The Complainant has also registered its domain name <[www.tnb.com.my](http://www.tnb.com.my)> on 17 November 1996 and has since then been operating the website for its business ('the TNB Website').

The Complainant contends that the disputed domain name is identical and confusingly similar to the Complainant's TNB Trade mark in that it incorporates and consists of the Complainant's TNB Trade mark. It is contended that the TNB Trade mark are well-known and pre-date the disputed domain name registration.

The Complainant claims that some time after the Respondent had registered the disputed domain name, the Respondent had offered services to the public for application for amongst others, registration as the Complainant's vendor, renewal as an existing vendor of the Complainant's and for changes of information relating to the Complainant's vendor in the Complainant's vendor database. They claim that the Respondent also further displayed the certificate of registration issued by the Complainant and has used the TNB Trade mark on the Respondent's website as well. This, they contend, shows that the Respondent has registered and used the disputed domain name to create confusion or deception that the website is operated or authorized by or connected with the Complainant when in fact no such connection exists.

The Complainant claims that it received queries from members of public seeking clarifications from the Complainant on whether the disputed domain name was

connected to or belonged to the Complainant and therefore this further supports evidence of confusion.

The Complainant argues that as a result of the Respondent using the TNB Trade mark on its website and offering services in relation to the Complainant as well as the fact that the Complainant is a well-known company in Malaysia, the Respondent was clearly aware of the existence of the Complainant and has therefore registered the disputed domain name in bad faith.

The Complainant further argues that the Respondent's actions of having attracted or diverted internet users to the disputed domain name for commercial gain to its online service of amongst others, registration as the Complainant's vendor, renewal as an existing vendor of the Complainant's and for changes of information relating to the Complainant's vendor in the Complainant's vendor database is evidence of bad faith.

The Complainant finally argues that by using the 'TNB' name in the disputed domain name for the Respondent's business, the Respondent has created a situation whereby users are confused into thinking that the disputed domain name/Respondent's website is connected or associated with the Complainant.

## **B. Respondent**

Although the Complaint was properly notified to the Respondent, as required by the Rules, the Respondent did not file a Response. In the absence of a Response, it is appropriate to accept as true all factual allegations of the Complaint. (*See Ticketmaster Corporation v Bill Hicks, WIPO Case No. D2004-0400, Elan Pharmaceuticals, Inc. v Randy Haag, WIPO Case No. D2001-0755*)

## **6. Discussion and Findings**

Paragraph 5.2 of the Policy requires that the Complainant must prove each of the following:

- (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 Domain Name has been registered and/or is being used in bad faith.

Paragraph 6.1 of the Policy illustrates four circumstances that, if proved constitute evidence of bad faith as required by Paragraph 5.2.

### **A. Identical or Confusingly Similar**

Paragraph 5.2(i) of the Policy requires the Complainant to show that the Disputed Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights.

In this regard, the term 'trademark' under paragraph 5.2(i) of the Policy encompasses both registered and unregistered marks. (*Uniroyal Engineered Products, Inc v Nauga Network Services WIPO Case No. D2000-0503, Thaigem Global Marketing Limited v Sanchai Aree, WIPO Case No. D2002-0358*)

This first limb is satisfied, since the Complainant is the registered proprietor of the TNB Trade mark in Malaysia for many years and certainly at the time of the filing of this complaint. (*Hoffman-La Roche AG v Relish Enterprises, WIPO Case No.D2007-1629, RapidShare AG and Christian Schmid v majeed randi, WIPO Case No.D2010-1089*)

As a result of the longstanding and extensive use of the TNB Trade mark in Malaysia, consumers and the public at large have come to associate this mark with the Complainant's goods and services and none other. The Complainant has set out evidence evincing its registered rights thereof. (*Uitgeverij Crux v W.Frederic Isler, WIPO Case No.D2000-0575, <crux.net>, Skattdirekoratet v Eivind Nag WIPO Case No.D2000-1314, <skatteetaten.com>*)

It is settled that Paragraph 5.2(i) of the Policy functions primarily as a standing requirement and the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trade mark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the disputed domain name. Further, where a domain name incorporates a dominant feature of the relevant mark, the domain name will be considered confusingly similar to that mark for purposes of standing. (*Philip Morris USA Inc. v Steven Scully, J & S Auto Repair, WIPO Case No.D2015-1001, <pmcannabis.com>, Alfred Dunhill, Inc. v Registration Private, Domains By Proxy, LLC/Abdullah Altubayieb, WIPO Case No.D2017-0209*)

For the purposes of determining whether or not there is an identical or confusing similarity it is necessary to exclude from consideration the gTLD ".com" and ccTLD ".my", as they are technical requirements that have no significance in determining similarity (*Volkswagen Group Singapore Pte. Ltd. v. Webmotion Design, Case No. RCA/DNDR/2003/01(INT)*).

The Complainant contends that the Disputed Domain Name [www.e-tnb.com.my](http://www.e-tnb.com.my) is confusingly similar to the TNB Trade mark given that it wholly incorporates "TNB" as a dominant and prominent element to its domain name.

This Panel finds that excluding from consideration the gTLD ".com" and ccTLD ".my", the Complainant's TNB Trade mark and the Disputed Domain Name have substantial visual, aural and conceptual similarities in that both consist of and fully incorporate the same prominent "TNB" name as a dominant feature, which by itself is wholly unique to the Complainant. In *Mudah.my Sdn Bhd v. Scalable Systems, Case No. KLRCA/DNDR-239-2014*, the complainant in that case owned various marks comprising the word "MUDAH" whilst the respondent registered the domain name <mudah2u.com.my>. The Panel in the said Decision held that the mere addition of a non-significant element does not generally differentiate the domain name from the registered trade mark and this applies to the present case too. This Panel finds that the mere addition of the prefix 'e-' to the word 'TNB' does not differentiate the disputed domain name from the registered trade mark.

In view of the above, this Panel finds that the Complainant has satisfied the first element of the Complaint pursuant to Paragraph 5.2(i) of the Policy.

## **B. Bad Faith**

The next element which the Complainant must satisfy the Panel on in terms of Paragraph 5.2 of the Policy is that the Disputed Domain Name has been registered and or is being used in bad faith. For the purposes of satisfying this limb, the Policy

provides a set of non-exclusive as well as merely illustrative situations that the Complainant might use to prove bad faith. Grounds other than those set out, while not codified might be used to establish bad faith as well. (See *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#)). The Complainant in the present complaint contend that they are able to satisfy both registration *as well as* use of the Disputed Domain Name in bad faith.

It must be mentioned that the requirement in Paragraph 5.2 of the Policy is set out disjunctively therefore either registration or use in bad faith is sufficient to meet this criteria.

The Complainant argues that as the Disputed Domain Name was registered well after the Complainant had acquired registered rights in the 'TNB' Trade mark, such conduct by the Respondent in itself is sufficient for a finding of bad faith registration. It is also contended that the Complainant's website i.e. the TNB Website has been in operation prior to even the creation of the Disputed Domain Name. However no evidence has been provided to support the existence of the TNB Website.

The Complainant further argues that as a result of the TNB Trade Mark being well-known this suggests that it is likely that the Respondent was aware of the Complainant and their rights in the TNB Trade mark when it registered the Disputed Domain name which it proposes constitutes bad faith.

As for use in bad faith, the Complainant contends among other things that the Disputed Domain Name resolves to a website which offers services to the public to apply for amongst others, registration as the Complainant's vendor, renewal as an existing vendor of the Complainant's and for changes of information relating to the Complainant's vendor in the Complainant's vendor database. They claim that the Respondent also further displayed the certificate of registration issued by the Complainant and has used the TNB Trade mark on the Respondent's website as well. The Complainant argues that the Respondent's actions of having offered those services have attracted or diverted internet users to the disputed domain name for commercial gain, thereby creating a possibility of confusion or deception that the website and or online location is operated or authorized by, or otherwise connected with the Complainant and or its trade marks. The Complainant has adduced an undated copy of a web page that resolves when the Disputed Domain Name is accessed and it displays, as submitted by the Complainant amongst others a host of services offered by the Respondent presumably as a middle person to assist in amongst others registering with the Complainant as their vendor, and renewing tenure and updating any information as the Complainant's vendor. Fees are charged for providing these services and the pages show that the Respondent normally charges RM690 for assisting a party to register with the Complainant as their vendor, however the Respondent was offering a reduced rate of RM599 at the time the page was accessed. Similarly the Respondent normally charged a fee of RM670 for assisting a party to renew its term as the Complainant's vendor but were at the material time offering their services at a reduced rate of RM599. As for services to update any information as the Complainant's vendor, the normal rate was RM370 but they were offering it at a reduced rate of RM299. The pages showcased a number of testimonials attesting to the reliability of the services offered and a list of staff that were employed to assist prospective customers. On one of the web pages adduced, office details, operational hours and a hotline number are disclosed, and the office address is that of one CIMS Management & Consultancy based in Kuala Terengganu, Terengganu. The Complainant has also disclosed that they have sent a letter to the said CIMS Management & Consultancy on 1 October 2020 to cease and desist from amongst others passing off and or infringing the TNB Registered Trade marks which includes

ceasing the operation of the Disputed Domain Name. This cease and desist letter was sent together with a letter of undertaking for the said company to execute. Presumably CIMS Management & Consultancy refused, failed and or neglected to reply therefore a suit i.e. WA-22IP-75-11/2020 was filed at the Kuala Lumpur High Court. A copy of the Writ and Statement of Claim has been provided to this Panel under Rule 4.2(viii) of the Rules i.e. under cover of other legal proceedings. According to the claim at the High Court, the Complainant started a new Supply Chain Management System ('SCMS') where all tendering processes would be performed through the Complainant's online system. From March 2017, the Complainant also activated an online payment for vendor registration fee via the SCMS. For new registration or renewal of certificate the Complainant's vendors had the option of making online payment or paying manually. It would appear that any individual or company interested in becoming a vendor of the Complainant's would have to submit their applications for registration through 'TNB Online Supplier/Vendor Registration' which can be accessed through the link <https://srm.tnb.com.my/ros#>. The fees payable to the Complainant per submission which covers new registrations, renewals and any updates, amendments or changes made to the Complainant's vendor's information in the Complainant's vendor database is RM50.00 per application. Any inquiry regarding the registration of vendor or amendment of information is solely handled by the Complainant when sent to [e-vendor\\_perolehan@tnb.com.my](mailto:e-vendor_perolehan@tnb.com.my). At no time has the Complainant appointed and or authorized any third party to assist the public with services relating to the said application for vendor registration, renewal and changes to the vendor's information in the Complainant's vendor database. One of the reliefs sought by the Complainant is to have the Disputed Domain Name either deleted or transferred to the Complainant. The Complainant has also adduced a Companies Commission Search result on CIMS Management & Consultancy which shows that it is a partnership made up of two individuals namely Abdul Hadi bin Haji Nik Mat and Che Mohd Fauzi bin Nik Mat, the alter ego of the Respondent. Other than the above the Complainant has also announced to the public at large that the Disputed Domain Name has no affiliation to it whatsoever.

While the Complainant has provided very little documentary evidence to support the prominence of its trade marks, this Panel is prepared to accept its statement that being the largest electricity utility company in Malaysia the Complainant has presence all over the country and with a consumer base of 9.2 million people the TNB Trade mark is associated with the Complainant and no other. The Respondent's site not only refers to the TNB Trade mark but in having advertised services of managing the application and renewal of the Complainant's vendors has, misrepresented to the public at large that it has been authorized by the Complainant to do so. The Complainant has also provided evidence of public enquiry showing that there has been actual confusion as to whether the services offered by the Respondent are those of or authorized by the Complainant. The Respondent has with actual knowledge of the Complainant's rights intentionally attempted to attract users to its website by creating a likelihood of confusion with the TNB Trade Mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

Further with regard to constructive notice, this Panel notes that there a number of Panel decisions which have now addressed the application of paragraph 2 of the Policy and in particular the words under paragraph 2.3 which states that it is the sole responsibility of the Respondent to make sure that their registration and any subsequent renewal of the domain name does not infringe the rights of any third parties. There are cases where a finding of bad faith registration can indeed be confirmed by the specific circumstances of a respondent's so-called "wilful blindness", even if the respondent did not specifically know of the complainant or of its trademark rights when it registered the disputed domain name (see *Media General*

*Communications, Inc. v. Rarenames, WebReg*, [WIPO Case No. D2006-0964](#); *Mobile Communication Service Inc. v. WebReg, RN*, [WIPO Case No. D2005-1304](#); *mVisible Technologies, Inc. v. Navigation Catalyst Systems, Inc.*, [WIPO Case No. D2007-1141](#); *Grundfos A/S v. Texas International Property Associates*, [WIPO Case No. D2007-1448](#); *Balglow Finance S.A., Fortuna Comércio e Franquias Ltda. v. Name Administration Inc. (BVI)*, [WIPO Case No. D2008-1216](#)).

The obligations imposed by paragraph 2 are an integral part of the Policy applicable to all registrants that cannot be ignored. (see *City Views Limited v. Moniker Privacy Services/Xander, Jeduyu, ALGEBRALIVE*, [WIPO Case No. D2009-0643](#)). In this case, it is uncertain whether the Respondent explored the possibility of third-party rights in any way before registering and using the Disputed Domain name. In any event it is incumbent upon a domainer to make reasonable good faith efforts to avoid registering and using domain names that are identical or confusingly similar to marks held by others.

Furthermore, it is not disputed that the Disputed Domain Name registered by the Respondent now resolves to a site being used by CIMS Management & Consultancy, that is providing services that can only be provided by the Complainant or any party authorised by the Complainant to do so. It is clear from the Complainant's pleadings in Court that the Supply Chain Management System ('SCMS') implemented by the Complainant is to allow interested vendors to make an application for registration as a vendor or renewal thereof with the Complainant and the applicant does so themselves by making a payment of RM50. There are no third parties authorized by the Complainant to perform this function. The Respondent, by maintaining the Disputed Domain Name in its name and its alter ego Che Mohd Fauzi bin Nik Mat, having allowed use of it to CIMS Management & Consultancy, a company where he is also a partner has been deriving financial benefit from web traffic diverted through the Disputed Domain Name particularly by charging fees for purportedly managing the application and renewal of the Complainant's vendors. The Respondent's site sets out a fee structure for the various purported applications and renewals in respect of vendor registration and it is markedly higher than the fee collected by the Complainant for such application and renewal. This Panel therefore finds, that the Respondent by registering the Disputed Domain Name did so, with an intention to attract or divert for commercial gain, Internet users to its website by creating confusion or deception that the website is operated or authorised by or otherwise connected with the Complainant and or its trade mark. (See *NBC Universal Media, LLC v. Flying Stingrays Ltd, Jim Macallum*, WIPO Case No. [D2012-1568](#)). This is further supported by the evidence of actual confusion that has been adduced by the Complainant.

It is to be observed further that based on the decisions of earlier Panels, an inference of targeting is made where the complainant's mark is either inherently distinctive, famous, or well known, but that no such inference will normally be appropriate in other cases where there is no evidence of the respondent being aware of the complainant's trademark rights at the time of registration. No such inference would however be made in a case where the domain name is a dictionary word, or a descriptive or generic expression. (See *Grundfos A/S v. Texas International Property Associates*, WIPO Case No. [D2007-1448](#))

The content of the Disputed Domain Name when displayed as a whole shows that the respondent is seeking to target the TNB Trade mark through the Disputed Domain Name. The content displayed on the Disputed Domain Name shows amongst others (i) the display of the TNB Trade mark; and (ii) a certificate of registration issued by the Complainant. Usage of these elements show that the Respondent has deliberately targeted not only the Complainant's TNB Trade mark but that it has intended to create



an association with the Complainants. (See *Schering-Plough Corporation, Schering Corporation v Dan Myers, WIPO Case No.D2008-1641*)

This Panel is prepared to find that the Disputed Domain Name is either inherently distinctive, famous, or well-known and particularly given the findings of wilful-blindness on the part of the Respondent and their further breach under paragraph 6.1(iv)(b) of the Policy, that targeting of the Complainants' TNB Trade mark has been committed.

Accordingly the Panel is able to find that the Complainants have met their burden of proof to establish that it is more likely than not the Respondent had registered and used the Disputed Domain Name in bad faith.

### **C. Rights and legitimate interest**

Unlike the Uniform Domain Name Dispute Resolution Policy ('UDRP') which provides that the complainant has the burden of proof to establish that the respondent has no right or legitimate interest in respect of the domain name, paragraph 7.1 of the Policy shifts the onus on to the respondent, once the complainant has satisfied the requirements of Paragraph 5.2 of the Policy, to lead evidence that the respondent has a right or legitimate interest in respect of that name. Paragraph 7.2 of the Policy offers a number of non-exhaustive defences that the Respondent could advance and avail itself to in resisting an allegation that it had registered and used the Disputed Domain Name in bad faith.

For the completeness of this decision and having regard to the fact that the Respondent is involved in various diverse businesses including the business of management services, insurance agents, training, employment, cleaning of areas and buildings, supplying kits and educational materials, furniture, machines, electrical appliances, food and beverages, souvenirs and clothing this Panel is unable to find that the Respondent would be able to rely on any of the defences under paragraph 7.2 of the Policy. The failure of the Respondent to respond to this Complaint also weighs heavily against the Respondent in this regard.

## **7. Decision**

For all the foregoing reasons, and in accordance with Paragraphs 3.1 of the Policy and 17 of the Rules, the Panel orders that the Disputed Domain Name <[www.e-tnb.com.my](http://www.e-tnb.com.my)> be deleted.



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Hemalatha Parasa Ramulu  
Sole Panellist  
Dated this 26<sup>th</sup> day January 2021