

**ADMINISTRATIVE PANEL DECISION**

**In the matter of**

**LuLu Group International [Complainant]**

**And**

**Muhammad Ismadi Bin Yusoff trading as Lulu Hypermarket [Respondent]**

**Case no.: AIAC/DNDR-1015-2021**

**1. The Parties**

- 1.1. The Complainant is LuLu Group International represented by Mona Adel Hussein / United Trademark & Patent Services.
- 1.2. The Respondent is Muhammad Ismadi Bin Yusoff trading as Lulu Hypermarket.

**2. The Domain Name and Registrar**

- 2.1. The disputed domain name is <[www.luluhypermarket.com.my](http://www.luluhypermarket.com.my)> and the Registrar is Malaysian Network Information Centre ("**MYNIC**").

**3. Procedural History**

- 3.1. The Complaint was lodged by the Complainant to the Asian International Arbitration Centre (the "**Centre**") on 22 September 2021.
- 3.2. In accordance with Rule 5.3 of MYNIC's Rules (the "**Rules**"), the Centre formally notified the Respondent of the Complaint, on 4 October 2021.
- 3.3. The proceedings formally commenced on 4 October 2021, pursuant to Rule 5.6 of the Rules and paragraph 5 of AIAC Supplemental Rules (the "**Supplemental Rules**").
- 3.4. The last date for submission of response is 9 November 2021. The Respondent submitted a Response on 8 November 2021.
- 3.5. The Complainant replied to the Respondent's Response on 15 November 2021.
- 3.6. The Complainant having elected for a single member Panel, the Centre appointed Ms. Celia Cheah Chiew Lan as the sole panellist in this matter on 19 November 2021. The Panel finds that it was properly constituted. The Panel submitted the Declaration of Impartiality and Independence on 19 November 2021 as required by the Centre for compliance with Rule 9.3 of the Rules.


#### **4. Factual background**

- 4.1. The Complainant is a multinational conglomerate that operates a chain of hypermarkets and retails companies including "Lulu Hypermarket" with business entities worldwide. The Complainant's core business activities range from hypermarket operations to shopping mall development, manufacturing and trading of goods, hospitality assets and real estate. The Complainant has an international presence in 22 countries located across Middle East, Asia, US and Europe.
- 4.2. The Complainant's retail chain, "LULU HYPERMARKET" was first established in the early nineties and is the fastest growing retail chain in the Middle East and Asia.
- 4.3. The Complainant is currently operating in 214 LuLu stores and 23 shopping malls across the GCC, Egypt, India and the Far East including Malaysia with approximately more than 1,100,000 shoppers daily.
- 4.4. The Respondent is a sole proprietor in Malaysia registered under the business name of "Lulu Hypermarket" on 5 July 2013.
- 4.5. The disputed domain name <[www.luluhypermarket.com.my](http://www.luluhypermarket.com.my)> was registered on 9 July 2013.

#### **5. Parties Contentions**

##### The Complainant

- 5.1. The Complainant contends that the disputed domain name is identical to the trade mark or service mark in which the Complainant has rights to. In establishing the Complainant's rights to the trademark and service mark, the Complainant has provided evidence of the following:-
  - 5.1.1. The Complainant claims to be the owner of the trademark "LuLu HYPERMARKET" along with other "LULU HYPERMARKET" trademarks in other countries such as India, Kuwait and Qatar as seen in **Annex 3**.
  - 5.1.2. The Complainant also claims to be the legal and beneficial owner of the trademark "LuLu" in various jurisdictions around the world including Malaysia in various

classes, in particular, Trademark No. 2013002685 for " " in class 35 for "Advertising, business, administration, office function, hypermarket retailing, supermarket retailing, department store retailing" since 20 February 2013 as evidenced in **Annex 4**.

5.1.3. The Complainant claims that they have registered the "LULU" word mark as well as various logos consisting "LULU" in various countries around the world as shown in **Annex 5**.

5.1.4. The Complainant claims to own copyright to several marks consisting of "Lulu Hypermarket" and "Lulu" in English and Arabic as seen in **Annex 7**.

5.2. The Complainant further claims that "LULU HYPERMARKET" and "LuLu" trademarks are well-known to be associated with the Complainant. The Complainant's trade name "LULU HYPERMARKET (L.L.C)" is registered as its company name in the headquarter of the Complainant's business in United Arab Emirates since June 5, 2000.

5.3. The Complainant also claims to have many businesses in Malaysia including operating a LuLu Mall with LuLu HYPERMARKET of 250,000 sq. ft. which was inaugurated by the then Malaysian Prime Minister Dato' Sri Haji Mohammad Najib bin Tun Haji Abdul Razak, in the presence of the then Ambassadors of UAE and the High Commission of India and other dignitaries.

5.4. The Complainant further asserts that the Respondent has registered and used the disputed domain name in bad faith for the following reasons:

5.4.1. The Complainant contends that the Respondent does not have any rights or legitimate interest in the disputed domain name as it is not affiliated with the Complainant in any way nor authorised by the Complainant to use the trademark or seek registration of any domain name incorporating the trademark "LuLu HYPERMARKET".

5.4.2. The Complainant claims that the registrations of the trademarks "LuLu

Hypermarket" in 2012 in India and " " in February 2013 in Malaysia

precede the Respondent's registration of the disputed domain name and business in July 2013.

- 5.4.3. The Complainant also claims to have used the trademark/trade name "LuLu HYPERMARKET" since 2000, 13 years prior to the Respondent's registration of the disputed domain name and business.
- 5.4.4. The Complainant contends that the Respondent has not registered the disputed domain name with *bona fide* intent as the Respondent is using the Complainant's trademark, trade name and copyrighted terms/phrases on the same activity while not being a licensee of the Complainant to mislead the public to believe that it is the same/authorised business of the Complainant with the intention for commercial gain and to take unfair advantage of the Complainant's protected rights.
- 5.4.5. The Complainant claims that the above causes financial loss and disrupts the Complainant's reputation which proves the Respondent's bad faith.
- 5.4.6. The Complainant contends that it would be implausible for the Respondent to be unaware of the Complainant's marks, "LuLu HYPERMARKET" which is well known globally, including in Malaysia and it is entirely included in the disputed domain name and the Complainant is operating a hypermarket website at the domain name, "www.luluhypermarket.com" as shown in Annex 10.
- 5.4.7. The Complainant also contends that the Respondent's website at the disputed domain name "www.luluhypermarket.com.my" as shown in Annex 11 imitated the Complainant's trademark and offers similar categories of products.
- 5.4.8. The Complainant further contends that the Respondent's website of the alleged hypermarket is reflecting a Facebook, Twitter and Instagram icons which are fake and a market investigation conducted revealed that the address reflected in the Respondent's website is also fake as there is no physical hypermarket at such address.
- 5.4.9. The Complainant in reply to the Respondent's Response further alleges that the Respondent's choice of the word "LuLu HYPERMARKET" cannot be incidental in view of the goodwill and reputation of the Complainant.

5.4.10. The Complainant alleges that the Respondent has registered and used the disputed domain name to disrupt the business of the Complainant and for the purpose of and with the intention to attract or divert, for commercial gain, internet users to its website by creating a possibility of confusion or deception that the website is operated or authorised by or otherwise connected with the Complainant and / or its trademark or service mark. Such registration and use of the disputed domain name for the same business is nothing more than an attempt to misappropriate and usurp the Complainant's goodwill and reputation which has accrued to the Complainant's business which the Complainant has enjoyed in Malaysia and continue to enjoy.

#### The Respondent

5.5. The Respondent denies that the Respondent has purportedly used the disputed domain name in bad faith.

5.6. The Respondent further states that in his Response that the Respondent has registered and used the disputed domain name in good faith because:

- 5.6.1. the Respondent has been in business since 5 July 2013 and sold goods online like any other hypermarket and supported this with an email by MYNIC;
- 5.6.2. The word "LULU" is the nickname of the Respondent's wife;
- 5.6.3. The Respondent's business was registered before the incorporation of the Complainant's business in Malaysia;
- 5.6.4. The Respondent has no knowledge of the Complainant's trademarks in Malaysia and other countries as claimed by the Complainant;
- 5.6.5. The Respondent has never advertised nor made any representation to any party that the Respondent was affiliated with the Complainant;
- 5.6.6. The Respondent has never used the Complainant's trademark/logo on the Respondent's website;
- 5.6.7. The public at large shall not be confused in distinguishing the Respondent's website from the Complainant's website as the Respondent has included a disclaimer in the Respondent's website which states that it is a registered entity with the Companies Commission of Malaysia and it has no linkage with any other local or international entities or business to; and
- 5.6.8. The Respondent has no knowledge of the Complainant and/or its affiliate when the Respondent's business was set-up in 2013.

5.7. The Respondent also claims that it has not committed the following:

- 5.7.1. Misrepresentation to the public that the Respondent has any affiliation or is an agent of the Complainant and / or authorised to act on behalf of the Complainant;
- 5.7.2. Injure the business or goodwill of the Complainant; and
- 5.7.3. Cause actual damage to the business or goodwill of the Complainant.

## **6. Discussion and Findings**

- 6.1. Pursuant to Rule 17 of the MYDRP Policy (the "**Policy**"), the Panel is to decide the proceeding based on the documents and evidence submitted by the Parties, the Policy and Rules as well as any other rules and principle of law which are applied in Malaysia.
- 6.2. The Panel may also undertake limited factual research into matters of public record if it deems this necessary to reach the right decision, including visiting the websites linked to the disputed domain name in order to obtain more information about the Respondent and the use of the disputed domain name (***Transplace Texas, L.P. v Transplace Logistics Sdn Bhd, AIAC Case No. KLRCA/DNDR-278-2014 (<transplace.com.my>)***).
- 6.3. Paragraph 5 of the Policy provides that the Complainant must establish both of the following elements in the Complaint:-
  - (i) The domain name is identical or confusingly similar to a trademark or service mark to which the Complainant has rights; and
  - (ii) The Respondent has registered and/or used the domain name in bad faith.

### **Identical or confusingly similar to a mark the Complainant has rights**

- 6.4. The first element to be determined is whether the Complainant has established its right over a trade/service mark. Secondly, the Complainant must show that the disputed domain name is identical with or confusingly similar to such trade/service mark.

- 6.5. The Panel is satisfied with the evidence adduced by the Complainant claiming its rights to the marks, "LuLu HYPERMARKET" and "LULU".
- 6.6. Although the mark, "LuLu HYPERMARKET" is not registered in Malaysia, the Panel takes the view that to establish the Complainant's rights, *"the country where a Complainant's trademark is registered does not have to be the country of residence or incorporation of the Respondent"* (**William R. Hague Inc. dba Hague Quality Water International v Water N Boss Marketing Sdn. Bhd Case No. rca/dndr/2006/09, <waterboss.com.my>** ).
- 6.7. The Panel is also satisfied with the evidence adduced by the Complainant that the Complainant has rights in the "LULU" marks registered in Malaysia (**TRS Quality Inc v Alpha Constant Sdn Bhd, Case No. KLCRA/DNDR/2012/30 <radioshack.com.my>** )
- 6.8. In view of the above, the Panel finds that the Complainant has established its rights in the "LULU" and "LuLu HYPERMARKET" marks.
- 6.9. In determining whether the disputed domain name is identical or confusingly similar to the marks to which the Complainant has rights, the Panel is merely required to look at the disputed domain name and the Complainant's mark(s) on their own to determine whether the essential element of the Complainant's mark has been adopted or incorporated into the disputed domain name. (**Transplace Texas, L.P. v Transplace Logistics Sdn Bhd, AIAC Case No. KLRCA/DNDR-278-2014, (<transplace.com.my> )**).
- 6.10. The Panel finds that "LuLuHYPERMARKET" is identical with the disputed domain name notwithstanding the presence of gTLD and ccTLD, com.my which is the technical requirement of registration (**Volkswagen Group Singapore Pte Ltd v Webmotion Design Case No. RCA/DNDR/2003/01 (INT), <volkswagen .com.my>** ).
- 6.11. The Panel also finds that the disputed domain name is confusingly similar to the Complainant's marks, "LU LU" as the essential element of the disputed domain name is "lulu" and the word "hypermarket" merely describe the services of interest. (**Transplace Texas, L.P. v Transplace Logistics Sdn Bhd, AIAC Case No. KLRCA/DNDR-278-2014, (<transplace.com.my> )**).

6.12. Accordingly, the Panel is convinced that the Complainant has satisfied the requirement under paragraph 5(i) of the Policy and has established that the disputed domain name is identical with and confusingly similar to the Complainant's marks, "LuLu HYPERMARKET" and "LuLu".

### **Rights and Legitimate Interests**

6.13. Paragraph 7 of the Policy provides that in order for the Respondent to rebut the allegation of registration and/or use of the disputed domain name in bad faith, the Respondent shall prove amongst others that, the Respondent's right or legitimate interests in the disputed domain name. Several circumstances are provided under Paragraph 7.2 of the Policy, including:

- (i) Before any notice of the Complainant's dispute, the Respondent 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.
- (ii) The Respondent is commonly known by the domain name even though no trademark or service mark rights in the same has been acquired.
- (iii) The domain name is used for legitimate, non-commercial and fair purposes with no intention of using the same for profits or to deceive the public.

6.14. The Respondent contends that it has been using the disputed domain name to sell the Respondent's goods online (the "**Respondent's website**"). However, the Respondent did not produce any evidence such as invoice to prove that the Respondent has indeed sold the Respondent's goods online. The Respondent merely provides an email from MYNIC dated 9 July 2013 relating to the updated domain name records of the disputed domain name.

6.15. The Complainant on the other hand contends that the Respondent's website of the alleged hypermarket is reflecting a Facebook, Twitter and Instagram icons which are fake and a market investigation conducted revealed that the address reflected in the Respondent's website is fake and there is no physical hypermarket at such address.

6.16. The Respondent did not reply to the Complainant's contention that the social media icons and address stated in the Respondent's website are fake.



6.17. In view of the lack of explanation, the Panel has taken the liberty to access the Respondent's website and clicked on the social media icons. The contention of the Complainant is proven as when the icons were clicked, one is redirected to the same webpage of the Respondent's website.

6.18. Further, the Respondent explained that the choice of the word "Lulu" derived from the nickname of his wife. However, no evidence is provided to support this explanation.

6.19. The Respondent also contends that the public at large shall not be confused between the Respondent's website ([www.luluhypermarket.com.my](http://www.luluhypermarket.com.my)) and the Complainant's website ([www.luluhypermarket.com](http://www.luluhypermarket.com)) as a disclaimer has been included in the Respondent's website but there is no evidence provided to substantiate the inclusion of disclaimer.

6.20. The Panel can only decide such matters on the balance of probabilities and on the material put before it.

6.21. The Panel concludes that the Respondent did not provide sufficient evidence and explanation that the Respondent has legitimate rights and interest in the disputed domain name for the following reasons:

6.21.1. There is no evidence to show there is a genuine offering of goods and services.

6.21.2. There is no evidence to support that the Respondent is commonly known by the name of "lulu" nor "lulu hypermarket."

6.21.3. There is lack of explanation and evidence to support the choosing of 'hypermarket' as part of the disputed domain name for selling goods online as "Hypermarket" is defined to mean "a very large self-service store with a wide range of goods and a large car park, typically situated outside a town" (Cambridge English Dictionary) or "A hypermarket is a retail store that combines a department store and a grocery supermarket. Often a very large establishment, hypermarkets offer a wide variety of products such as appliances, clothing, and groceries" (Investopedia).

6.21.4. On the other hand, the Complainant has successfully established evidence of registration and use of the Complainant's marks and trade name before the

registration of the Respondent's business and disputed domain name. The Panel is of the view that the disputed domain name is associated with the Complainant and not the Respondent.

### **Bad Faith**

6.22. The Complainant need not prove that both the registration and usage of the domain name has been done in bad faith. It is sufficient if the Complainant proved that either the registration OR the use of the disputed domain name is in bad faith. (Paragraph 5(ii) and 6 of the Policy).

6.23. Several circumstances showing registration and/or use of the disputed domain name in bad faith are provided in the paragraph 6.1 of the Policy reproduced as follows:

- (i) The domain name is used or registered mainly to sell, rent, transfer the domain name for profit to the Complainant, its competitor or the owner of the trademark or service mark; or
- (ii) The domain name is used or registered to prevent the owner of a trademark or service mark from using the domain name which is identical with its trademark or service mark; or
- (iii) The domain name is used or registered to disrupt the business of the Complainant; or
- (iv) The domain name is used or registered for the purposes of and with the intention to attract or divert, for commercial gain, internet users to:-
  - (a) Website of the Complainant
  - (b) A website of the Complainant's Competitor
  - (c) Any other website and or online location

6.24. The Respondent claims to have never heard of the Complainant. Following ***William R. Hague Inc. dba Hague Quality Water International v Water N Boss Marketing Sdn. Bhd Case No.: rca/dndr/2006/09 <waterboss.com.my>***, the Panel cannot make any finding on this point without a proper hearing involving witnesses even if the Panel is sceptical on the matter.

6.25. Nonetheless, the Panel agrees with the Complainant's contention that "*it is implausible that the Respondent was unaware of the Complainant's trademark*" given that it is well known throughout the world including Malaysia (***Playboy Enterprises International Inc. v. BEG Service KB, WIPO Case No. D2001-0494***). The Panel

further refers to the Complainant's reply to the Respondent which provides a screenshot of the list of hypermarkets in Malaysia which includes the Complainant's business and the lack of explanation by the Respondent in choosing the word "HYPERMARKET" for merely selling goods online.

6.26. The trademark in question must necessarily predate the domain name for there to be infringement of the mark by the Respondent (*John ode d/ba ODE and ODE-Optimim Digital Enterprises v Intership Limited WIPO Case No. D2001-0074*). The Panel finds that the Complainant's trademarks for "LuLu Hypermarket" was registered in 2012 (before the Respondent's registration of the disputed domain name in 9 July 2013) as seen in **Annex 3** and "LULU" in Malaysia was registered on 20 February 2013 which was also before the Respondent's registration of the disputed domain name as seen in **Annex 4**.

6.27. The Complainant, in alleging bad faith, has pointed to the fact that the Respondent's disputed domain name offers online shopping of "*Groceries, Electronic, Apparels and more*" which is imitating the Complainant's trademark and business for commercial gain and causing confusion to the consumers. Upon viewing the Respondent's disputed domain at **Annex 11**, the Panel agrees that the goods sold on the disputed domain is similar to the Complainant's website and the mark "Luluhypermarket" is displayed on the Respondent's website. In view of the similarities, there is a possibility of confusion or association with the Complainant's business. The Panel holds the view that such possible confusion would affect the Complainant's goodwill and commercial reputation as internet users would be mistakenly believe the disputed domain website belongs to the Complainant or is affiliated to the Complainant.

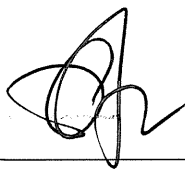
6.28. The Respondent has indicated in his Response of the addition of a disclaimer in the disputed domain name but no evidence was provided to support this contention. The Panel takes the view that even if the disclaimer were indeed provided in the Respondent's website, unless it is prominently displayed, the public at large (as alleged by the Respondent) would unlikely pay attention to such detail. On balance of probabilities, the Panel is inclined to believe that the wording of the said disclaimer would indicate that the Respondent has knowledge of the Complainant and has intentionally word the disclaimer that it has "*no linkage with any other local or international entities or business*" but no evidence showing the display of disclaimer on the disputed domain name is provided.

6.29. The failure of the Respondent in responding to the allegation that the information on the Respondent's website is fake support the Complainant's contention that that the Respondent intended to divert internet users to the disputed domain name through deception.

6.30. in view of the above, the Panel is not convinced that the disputed domain name is being registered and/or used in good faith by the Respondent and finds that the Respondent has registered and used the disputed domain name to disrupt the business of the Complainant and for the purpose of and with the intention to attract or divert, for commercial gain, internet users to its website by creating a possibility of confusion or deception that the Respondent's website is operated or authorised by or otherwise connected with the Complainant and/or its trademark or service mark. Such registration and use of the disputed domain name for the same business is nothing more than an attempt to misappropriate and usurp the Complainant's goodwill and reputation which has accrued to the Complainant's business.

## **7. Conclusion**

For the reasons stated above, the Panel orders that the disputed domain name [www.luluhypermarket.com.my](http://www.luluhypermarket.com.my) be transferred to the Complainant.



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Celia Cheah Chiew Lan  
Sole Panellist

Date: 9 December 2021