

Case Number - AIAC/DNDR-1035-2021

The **COMPLAINANT** is *ASSICURAZIONI GENERALI S.P.A*

The **RESPONDENT** is *GAN TONGHUAT* (in his personal capacity, and in his capacity as the Sole Proprietor of SC Concept Marketing)

1.0 THE DOMAIN NAME AND THE REGISTRAR:

The Domain names at issue are <general~~i~~.my> and <general~~i~~.com.my>

The Registrar is MYNIC

2.0 PROCEDURAL HISTORY:

The AIAC (Asian International Arbitration Centre) received a Complainant from ASSICURAZIONI GENERALI S.P.A on 26.11.2021. On 13.12.2021, copies of the Complainant along with the additional Documents were sent to the Respondent and the matter was officially commenced. On 03.01.2022, the Respondent informed the AIAC that he is willing to transfer the Domain Name to the Complainant. On 4th Jan 2022, the AIAC informed the Complainant regarding the Respondent's email dated 3rd January 2022 and sought confirmation from the Complainant if it would like to withdraw the proceedings, in light of the Respondent's email and communication regarding the transfer of domains. On 7th Jan 2022, the Complainant emailed its response to AIAC confirming that it intends to proceed with the DNDR Proceeding.

3.0 FACTUAL BACKGROUND OF THE CASE:

3.1 Complainant:

The Name and Trademark:

The Complainant is one of the largest global insurance and asset management providers based in Trieste, Italy. It is among the top ten largest insurance companies with a global presence in 50 countries. The Complainant is the registrant of the domain name <general~~i~~.com> which was created on 11-03-1995. The Complainant and its various affiliated companies around the world own and/ or control more than 60 domain names, including but not limited to <general~~i~~.it>, <general~~i~~.com.hk>, <general~~i~~asia.com>, <general~~i~~.com.ph>, <general~~i~~.de>, <general~~i~~.fr>

The Complainant is the registered and common law proprietor of various trademarks bearing the trade name and mark "GENERALI" throughout the world, including in Malaysia (collectively referred to as the "GENERALI Marks"). The Complainant also owns various domain names, among which is <generali.com> and other variations incorporating the word "generali". The use of the GENERALI Marks throughout the decades in various countries in the world including Malaysia, the Complainant has generated and garnered substantial goodwill and reputation in the GENERALI Marks.

3.2 Respondent:

According to the Who is Database, the Respondent is the registrant of the domain name <generali.my> SC Concept Marketing, a sole proprietorship, is the registrant of the domain name<generali.com.my>. Respondent's business license of SC Concept Marketing had expired on 29-11-2008. The Respondent is the sole proprietor of SC Concept Marketing, and the Respondent shares the same residential address SC Concept Marketing's principal place of business. The Respondent is also stated on the Who is Database to be the administrative contact and the billing contact for the domain name <generali.com.my>. This dispute concerns the Disputed Domain Name <generali.com> and <generali.com.my> both registered on 30-04-2015

Therefore, the Respondent is the registrant, owner and/or controller of the Domain Names, through himself as the individual registrant of the disputed Domain name <generali.my> and through the sole proprietorship of Concept Marketing, as the company business registrant of the Disputed Domain Name <generali.com.my>

4.0 Parties Contentions:

Complainant:

4.1 The Complainant has garnered substantial goodwill and reputation in the business in relation to the Complainant's GENERALI Marks, thereby acquiring proprietary rights therein. Therefore, the Complainant is entitled to exclusive use of the GENERALI Marks to the exclusion of others. In view of the goodwill and reputation acquired by the Complainant in respect of the GENERALI Marks, any members of the public visiting the Disputed Domain Names would be confused and deceived into the mistaken belief that:

- A. The Complainant and/ or a Malaysian Affiliate and/ or any of the affiliates has endorsed, sanctioned and /or allowed the participation of the Respondent in the creation of the website or

- B. The Disputed Domain Names were created and/or are associated with the Complainant and/or its Malaysian Affiliate and/or any of the affiliates and/or the GENERALI Marks, or
- C. The Disputed Domain Names are a variation or extension of the GENERALI Marks; or
- D. The Complainant and/or its Malaysian Affiliate and/ or any of the affiliates are responsible for the creation of the disputed domain name.

4.1.1 Respondent is Cybersquatting:

Upon visiting the Disputed Domain Names, the members of the public will be flagged with a notice that "attackers may try to steal information due to the fact that the security on the website has expired. Therefore, the Complainant asserts that the Respondent is cybersquatting.

4.1.2 Causing disruption to the business:

It is to be noted that the Respondent was an employee of the Complainant's Malaysian Affiliates. The Respondent was an employee in MPI Generali Insurance Berhad for almost 17 years where he commenced his employment with the Malaysian Affiliates around 2002 and held a senior position (Regional Manager) as recently as 2019. He had then resigned in 2019.

Therefore, in view of the Respondent's employment history with the Complainant's Malaysian Affiliate, the Respondent has and / or would have actual knowledge of the GENERALI Marks and the various domain names owned by the Complainant and for the Malaysian Affiliate and/or other affiliates of the Complainant.

The Respondent's choice of name for the Disputed Domain Names cannot bona fide given the Respondent has or would have actual knowledge of the GENERALI Marks and the various domain names owned by the Complainant and/ or the Malaysian Affiliate and/or the affiliates of the Complainant. Therefore, the registration of the Disputed Domain Name was intended to cause disruption to the business and goodwill of the Complainant and / or the Complainant's Malaysian Affiliate and/ or the affiliates.

4.1.3 Used the Domain Name for the Commercial purposes:

Based on the foregoing, the Complainant contends that the Disputed Domains Names are used and/or were registered mainly to sell, rent or transfer the Disputed Domain Names for a profit to the Complainant or to the Complainant's affiliates or third party, or otherwise with a view to obtain a commercial advantage, profit and/or to disrupt the well-

established business of the Complainant and/or its Malaysian Affiliates and/ or the Complainant's affiliates in other parts of the world.

Respondent:

4.2 The Respondent states that he is ready to transfer the Domain Name to the Complainant. The Respondent adds that he has also informed MYNIC regarding the transfer of the Domain Name. It was also stated that the account of the Respondent was blocked by MYNIC on receiving the complaint due to which he couldn't transfer or delete the Domain Name.

5.0 REASONS (DISCUSSION AND FINDINGS):

5.1 Identical or Confusingly Similar:

5.1.1 It is well established that the GENERALI Marks are associated by the members of the trade and public with the product and services of the Complainant exclusively Hence, any domain name associated and bearing the GENERALI Marks would instantly cause members of the trade and public to associate the GENERALI Marks with the Complainant and its affiliates accordingly.

5.1.2 The Disputed Domain Names have caused or will inevitably cause confusion, deception and mislead members of the trade and public due to the identical nature of the Disputed Domain Names with the GENERALI Marks. . The Respondent is not utilizing the Disputed Domain Names for legitimate, non-commercial and/or fair purposes.

5.1.3 The Panel concludes that both the domain names in issue are confusingly similar to the Complainant's GENERALI Marks.

5.2 Rights or Legitimate Interests:

5.2.1 The use of a domain name by the respondent is identical to the Complainant's GENERALI Marks. The Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name.

5.2.2 The Respondent is not commonly known or associated with the Disputed Domain Names registered and acquired by him. Moreover, the respondent has not acquired the trademark or the GENERALI Marks. The Complainant had not licensed the use and for in any way authorized the registration of the Disputed Domain Names and / or authorized the use of the GENERALI Marks by the Respondent.

5.2.3 The Panel Concludes that the Respondent is well aware of the Generali Marks since he was an employee of the MPI Generali Insurance Berhad for almost 17 years and has not licensed for the use of the GENERALI Marks, which clearly indicates that , the Respondent has no legitimate rights or legitimate interest over the GENERALI Marks.

5.3 Registered and Used in Bad Faith:

5.3.1 The Disputed Domain Names were registered and for being used in bad faith by the Respondent. The Respondent is not making any legitimate fair use of the Disputed Domain Names as the Respondent is an inactive holder of the Deputed Domain Names.It is also to be noted that the Respondents sole proprietorship. SC Concept Marketing has an expired business license. No further available information can be found regarding SC Concept Marketing which suggests that the company may not be actively engaging in any business activities therefore the respondent used the domain name with bad faith to spoil the reputation of the Complainant.

5.3.2 The Panel finds that the Respondent was aware of the Complainant and its reputation at the time of registration of the domain Name. The Respondent has not given any explanation on, why a similar/ identical Domain name was used when there was an existing Domain name which was registered by the Complainant, which shows that the Respondent used the Domain Name in Bad Faith

6.0 DECISION:

6.1 In the light of the foregoing, the panel decides that the Domain name registered by the Respondent is identical and/or confusingly similar to the corresponding trademarks and common law trademark of the Complainant, that the Respondent has no legitimate interests in respect of this Domain name and that the Domain name in issue has been registered and is being used in bad faith by the Respondent.

6.2 The panel accordingly requires that the registration of the domain name be transferred to the Complainant.



Date: 28th January 2022

Name & Signature: Mr.INBAVIJAYAN VEERARAGHAVAN