

ADMINISTRATIVE PANEL ORDER

In the matter of a Domain Name Dispute

BETWEEN

FLUKE CORPORATION

[Complainant]

AND

**CHENG WONG NG /
KK INSTRUMENTS & TOOLS**

[Respondent]

Case ID: AIAC/DNDR-1090-2022

1. THE PARTIES

- 1.1 The Complainant is Fluke Corporation, a Washington corporation duly organized on 7 October 1953, having its principal office street address at 6920 Seaway Boulevard, Everett, Washington 98206, USA. The Complainant is represented by Jason Chan and Christine Saw of Amica Law LLC, 77 Robinson Road, #22-01, Singapore 068896.
- 1.2 The Respondent is Cheng Woon Ng, KK Instrumentals & Tools, of Suite 3, 9th Floor, Wisma Sing Long, 9 Jalan Zabadah, 83000 Batu Pahat, Johor, Malaysia. The Respondent is not represented.

2. THE DOMAIN NAME

- 2.1 The domain name in dispute is fluke.com.my ("the Disputed Domain Name") and the registrar of the domain name in dispute listed on WHOIS record, is **Exabytes Network Sdn Bhd**, with its registered address at Lintang Mayang Pasir 3, Pulau Pinang, Malaysia.

3. PROCEDURAL HISTORY

- 3.1 The Complaint was filed in English with Asian International Arbitration Centre ("AIAC") under MYDRP. The Complainant filed Form A with supporting documents on

28 June 2022 in accordance with MYNIC's (.my) Domain Name Dispute Resolution Policy (the Policy), the Rules of the MYNIC's (.my) Domain Name Dispute Resolution Policy (the Rules) and the Supplemental Rules of the AIAC (the Supplemental Rules) and elected to have the case in question be dealt with by a single member panel (**Rule 4.2(iii) of the Rules**).

- 3.2 AIAC received the requisite payment of fees on 1 July 2022. and proceeded to transmit the Complainant's Form A to the Respondent on 4 July 2022, officially commencing the matter.
- 3.3 On 4 July 2020, the Provider transmitted the Complainant's Form A to the Respondent ("the Notice") to the Respondent via email and followed by postal delivery of the hard copy of Form A which was delivered on 12 July 2022.
- 3.4 The Respondent did not submit a response by the Submission date, i.e. 26 July 2022. On 29 July 2022, the AIAC emailed Samrith Kaur enquiring whether she could act and if so whether she could act independently and impartially in the matter in question. On 2 August 2022, the undersigned confirmed that she is willing to act and if appointed would act independently and impartially and thereupon AIAC notified the parties that Samrith Kaur had been appointed under **Rule 8.2** of the Rules as a sole panellist by the AIAC. The Panel then submit the Declaration of Impartiality and Independence, as required by the AIAC to ensure compliance with Rule 9.3 of the Rules.
- 3.5 Barring any exceptional circumstances, the deadline for rendering the decision in accordance with Rule 17 of the Rules of MYNIC's (.my) Domain Name Dispute Resolution Policy has been set for 23 August 2022.

4. **FACTUAL BACKGROUND**

- 4.1 The Complainant is based on:
 - i. The Complainant's trademark rights in its famous **FLUKE** brand of electronic test and measuring instruments and devices and electronic test tools; and
 - ii. Its ownership of numerous worldwide registrations for the **FLUKE** trademark, including in the U.S. and Malaysia. These **FLUKE** registrations serve as evidence of the Complainant's ownership of the marks and exclusive right to use the marks in connection with numerous goods.

- 4.2 The Complainant's marks include, but not limited to, the following registered marks in Malaysia (refer to the table below), all of which carry application and/or registration dates predating the Respondent's registration of the Disputed Domain Name:

Mark/Name	Status/Dates	Brief Goods/Services	Owner Information	App. No./Reg. No.
FLUKE	Registered: 30 November 1987	Class 9: Electrical apparatus, electronic test and measuring devices and instruments, and parts and accessories therefor; all included in Class 9	Fluke Corporation (Washington Corp.) 6920 Seaway Blvd. Everett Washington 98203	87005715
FLUKE FLUKE	Registered: 29 May 2015	Class 9: E.g., electronic test and measuring instruments and devices and electronic test tools...	Fluke Corporation (Washington Corp.) 6920 Seaway Boulevard Everett Washington 98203	2015058222

- 4.3 The Complainant also have the following trademark registrations in the U.S:

Mark/Name	Status/Key Dates	Brief Goods/Services	Owner Information	App. No./Reg. No.
FLUKE	Registered 8 & 15 March 31,	(Int'l Class: 09) E.g., scientific,	Fluke Corporation (Washington	RN: 3818870 SN: 77386872

Mark/Name	Status/Key Dates	Brief Goods/Services	Owner Information	App. No./Reg. No.
	2016 Int'l Class: 09 First Use: May 4, 2010 Filed: February 1, 2008 Registered: July 13, 2010	surveying, optical, weighing, measuring, signaling, and checking apparatus and instruments...	Corp.) 6920 Seaway Blvd. Everett Washington 98203	
FLUKE	Renewed January 27, 2018 Int'l Class: 09 First Use: October 5, 1992 Filed: September 25, 1995 Registered: January 27, 1998	(Int'l Class: 09) E.g., electronic test and measuring instruments and devices and electronic test tools...	Fluke Corporation (Washington Corp.) 6920 Seaway Boulevard Everett Washington 98203	RN: 2131631 SN: 74733847
FLUKE	Renewed September 26, 2019 Int'l Class: 09 First Use: June 23, 1961 Filed: November 25, 1987 Registered: September 26, 1989	(Int'l Class: 09) E.g., electronic test and measuring instruments and devices and electronic test tools...	Fluke Corporation (Washington Corp.) 6920 Seaway Boulevard Everett Washington 98203	RN: 1557670 SN: 73697611
FLUKE (Stylized) FLUKE	Renewed April 7, 2018 Int'l Class: 09 First Use: March 3, 1961 Filed: July 24, 1996 Registered: April 7, 1998	(Int'l Class: 09) E.g., electronic test and measuring instruments and devices and electronic test tools...	Fluke Corporation (Washington Corp.) 6920 Seaway Boulevard Everett Washington 98203	RN: 2148673 SN: 75138828

- 4.4 The Complainant is an international manufacturer of industrial test, measurement, and diagnostic instruments, including electronic test equipment, all marketed and sold under the well-known **FLUKE** brand and trademark.
- 4.5 As early as March 3, 1961, the Complainant has used its **FLUKE Marks** in connection with the sale of electronic test and measuring instruments and devices and electronic test tools.
- 4.6 The **FLUKE Marks** have long been used in Malaysia and globally to designate the Complainant's unique brand of industrial test, measurement, and diagnostic equipment. Through the Complainant's significant promotion and sale of instruments and devices bearing the **FLUKE Marks**, consumers have come to recognize the **FLUKE Marks** as the identifying indicia of the Complainant's electronic test and measuring instruments and electronic test devices/tools.
- 4.7 The Respondent registered the Disputed Domain Name on or about 18 June 2009 (**Annex 2**) and the Complainant states that:
- i. The Respondent has no statutory or common law trademark rights or any other right or legitimate interest in or to the Complainant's **FLUKE Marks** nor the Disputed Domain Name.
 - ii. The Complainant has not authorized or licensed the Respondent to use the **FLUKE Marks** or any derivative mark for any purpose.
 - iii. The Complainant registered its **FLUKE Marks** in the U.S. and Malaysia long before the Respondent registered the Disputed Domain Name. Hence, the Complainant has superior and obvious priority over the Respondent with respect to the **FLUKE Marks**.
 - iv. The Respondent has been engaged in a pattern of bad-faith conduct through the registration and use of the Disputed Domain Name to unfairly use and take advantage of the goodwill associated with the **FLUKE Marks** and to profit thereof. This contention is supported by the fact that the Complainant is seeking for the third time the transfer of the domain name from the same Respondent in respect of the **FLUKE Marks** (See **Annex 4 - Fluke Corporation v. Cheng Woon Ng**, Case No. D2016-2442 (WIPO Feb. 8, 2017); **Fluke Corporation v. Cheng Woon Ng**, FA2010001916074 (NAF Nov. 9, 2020)).
- 4.8 The Panel notes that pursuant to **Paragraph 5.1 of the Policy**, if the Complainant disputes registration or use of the Domain Name, the Complainant may file a

Complaint with a Provider, and the Complainant must establish BOTH of the following elements in the Complaint (**Paragraph 5.2**) : -

- (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 have registered and/or used the Domain Name in bad faith.

4.9 The Respondent on the other hand, must establish that the registration and/or use of the Domain Name was not in bad faith and among others, that the Respondent have rights and legitimate interests in the Domain Name, pursuant to **Paragraph 7 of the Policy**.

5. PARTIES' CONTENTIONS

5.1 a) The Complainant

5.1.1 The Complainant's contentions are summarised as follows:

i. The Disputed Domain Name is Confusingly Similar to the FLUKE Marks (Policy Para 5.2(i))

The Disputed Domain Name (fluke.com.my) contains the single distinctive element of the **FLUKE Marks** in its entirety i.e., the unique **FLUKE** element. Save for the additional "my", which is merely a country identifier, the Respondent reproduces entirely the Complainant's legitimate domain name (fluke.com).

Following from the above and based on *Celcom Planet Sdn Bhd v. O C Tech, KLRCA/DNDR-373-2016* at 6.4, it was held that the disputed domain name was confusingly similar to the mark "SHOCKING DEALS" in that it wholly incorporated the mark. Similarly, in this present case, the Disputed Domain Name is identical or at least confusingly similar to the **FLUKE Marks**.

The Complainant avers that the Respondent's addition of the top-level domain ".com" or ".my" is said to be immaterial when determining identity or similarity between trademarks and domain names as stated in *Volkswagen Group Singapore Pte Ltd v Webmotion Design Case No. RCA/DNDR/2003/01 (INT)*. The addition of ".my" reinforces the confusion,

as online users may assume that the Disputed Domain Name is the local authorized Malaysian site of the Complainant.

Further, the Disputed Domain Name being linked to a site located at flukemalaysiasupplier.com, is itself suggestive of a perverse intent as the inclusion of the words “malaysia” and “supplier” describe the geographic origins of the goods offered/sold by the Respondent in connection with the **FLUKE Marks**, thereby compounding the deception or confusion of the Disputed Domain Name and the **FLUKE Marks**.

The Complainant states that recently in another similar matter, the Complainant successfully sought the transfer of the flukemalaysiasupplier.com in an UDRP decision *Fluke Corporation v. Timothy Saravaan FA2205001997653 (NAF June 23, 2022)*, where it was found that the disputed domain name was confusingly similar to the Complainant’s **FLUKE Marks** as it incorporated the mark in its entirety, only adding geographic and generic words and the “.com” gTLD (refer to Annex 4).

The Complainant therefore submits that the Disputed Domain Name being confusingly similar to the **FLUKE Marks** will likely deceive the public into thinking that the Disputed Domain Name owner/operator of the website(s) are sponsored by or affiliated with the Complainant. Further, the goods listed on the website are identical to the goods offered by the Complainant under the **FLUKE Marks** and the Complainant states that the Respondent had deliberately used a similar black and yellow colour scheme **FLUKE Marks** on its website causing consumers to mistakenly believe that the websites are related (Refer to Annex 5 and Annex 6).

ii. **The Disputed Domain Name has been registered and is being used in Bad Faith Policy Para 5.2(ii)**

The Complainant contend that the unauthorised registration of the Disputed Domain Name shows that the registration was made in bad faith. The Complainant avers the followings:

- a. Firstly, the Respondent registered the Disputed Domain Name having actual prior knowledge of the Complainant’s trademark rights in the **FLUKE Marks** in order to prevent the Complainant from using it, is demonstrative of bad faith pursuant to **Paragraph 6.1(ii) of the Policy**. The Complainant supports its contention by the fact that:

- i. The Disputed Domain Name was registered well after the **FLUKE Marks** had been used by the Complainant in Malaysia and elsewhere around the world.
 - ii. The Respondent used the Disputed Domain Name to offer **FLUKE** goods (which authenticity is disputed) on a website that copies the hallmark indicia and other materials copied from the Complainant's authentic fluke.com website (Refer to **Annex 5**).
 - iii. The Complainant's counsel notified the Respondent of the Complainant's ownership of the **FLUKE Marks** and that, the Disputed Domain Name is being unlawful use (Refer to **Annex 7**).
 - iv. The Respondent is the owner of the websites previously located at flukemalaysia.com and flukedistributormalaysia.com, which domain names were successfully transferred to the Complainant based on the same matters stated in this Complaint. Refer to **Fluke Corporation v. Cheng Woon Ng, Case No. D2016-2442 (WIPO Feb. 8, 2017); Fluke Corporation v. Cheng Woon Ng, FA2010001916074 (NAF Nov. 9, 2020)** (Refer to **Annex 4**).
- b. Secondly, pursuant to **Paragraph 6.1(iii)**, the Complainant avers that the Respondent acted in bad faith by diverting **FLUKE's** customers to its website. This is supported by the findings in *Puckett, Individually v. Miller, D2000-0297 (WIPO June 12, 2000)* where it was stated that the respondent by diverting business from the complainant to a competitor's website is in violation of UDRP Policy paragraph 4(b)(iii)¹.
- c. Thirdly, by using a name that is identical to or confusingly similar to the **FLUKE Marks**, the Respondent's intentional attempt to attract or divert internet users to its website for commercial gain violating **Paragraph 6.1(iv) of the Policy**.

5.1.2 The Complainant states that bad faith intent can be inferred from the Respondent's choice to adopt and use a designation that it knows to be identical or similar to another's registered trademark in order to attract or divert consumers to its website. Refer to *AltaVista Co. v. Krotov, D2000-1091*

¹ UERP Policy Paragraph 4(b)(iii)- you have registered the domain name primarily for the purpose of disrupting the business of a competitor;

(*WIPO Oct. 25, 2000*), which found bad faith under UDRP Policy paragraph 4(b)(iv) where the respondent's domain name resolved to a website that offered links to third-party websites offering services similar to the complainant's services and merely took advantage of Internet users' mistakes.

5.1.3 The Complainant further states that bad faith can also be established because the Respondent registered the Disputed Domain Name in order to capitalize on the Complainant's goodwill residing in its **FLUKE Marks**, by creating a likelihood of confusion as to the source/origin of the website causing consumers to incorrectly believe that the goods offered by the Respondent are authentic **FLUKE** goods where else, in actuality the goods are offered by an unrelated third-party, or other non-**FLUKE** goods offered.

5.1.4 The Complainant avers that the Disputed Domain Name, which contains the Complainant's **FLUKE Marks**, is solely used to forward to another of its websites, flukemalaysiasupplier.com, which prominently displays the Complainant's **FLUKE Marks**, suggesting that the Respondent was well aware that consumers would see the Disputed Domain Name and associate it with the Complainant. Based on *Amundi S.A. v Privacy Protect, LLC (PrivacyProtect.org) v Yong Woon Chin (WIPO Case No. DCO2020-0095)*, using a domain name to redirect to a website reproducing a logo that is similar to the logo used by the Complainant on its website supports a finding of bad faith. In another case of *Saquon Barkley, SRQB, LLC v Ari Armani, Ari Armani & Co. (WIPO Case No. D2019-0269)*, the Respondent's use of the disputed domain name which consists of the Complainant's mark to attract and redirect consumers to the Respondent's website was found to be done opportunistically and in bad faith).

The Respondent does not have any rights or legitimate interests in the Disputed Domain Name (Policy Para 7)

5.1.5 The Complainant avers that the Respondent has no right or legitimate interest in the Disputed Domain Name as the registration of the domain name was not a genuine offering of goods (**Paragraph 7.2 (i) of the Policy**). The Respondent was not commonly known by the Domain Name and no permission has been granted to the Respondent to use the **FLUKE Marks** or the Disputed Domain Name (**Paragraph 7.2(ii) of the Policy**). Further, the Respondent did not use the Domain Name for legitimate, non-commercial and/or fair purposes but with intention of using the same for profits or to deceive the public into believing its website offers legitimate electronic test

and measuring instruments and devices and electronic test tools under the **FLUKE Marks (Paragraph 7.2(iii) of the Policy)**.

5.1.6 Remedy

The Complainant requests that the **Disputed Domain name be transferred to the Complainant** or in the alternative, in the event it is not possible to on the account the Complainant is not a locally incorporated company, then **the Complainant seeks cancellation of the Disputed Domain Name**.

5.2 *b) For the Respondent*

5.2.1 I take note that prior to the Complainant filing this Dispute with the Centre, the Complainant Solicitor, Messrs Amica Law LLC wrote to the Respondent on 13 April 2022 via Courier & email, giving the Respondent notice of the Trademark Infringement and Unauthorised used of Domain Name, and seeking the cancellation of the Unauthorised Website or procure the transfer of its registration of the Disputed Domain Name.

5.2.2 However, the Respondent submitted no response under **Rule 6 of the MYDRP Rules** in this matter. Pursuant to **Rule 6.7** *"unless there are exceptional circumstances; if the Respondent does not submit a Response, the Panel will decide the Proceeding based on the Complaint"*.

6. Findings

6.1 Pursuant to **Rule 17.1 of the Rules**, *"the Panel will decide a Proceeding based on the documents and evidence submitted by the Parties, the Policy and Rules as well as any other rules and principles of law which are applied in Malaysia"*.

6.2 For convenience, **Paragraph 5.2 of the Policy** is reproduced here again, which 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 trade mark or service mark to which the Complainant has rights; and
- (ii) the Respondent has registered and/or used the Domain Name in bad faith.

- 6.3 The Panel also take cognisance of **Paragraph 7 of the Policy**, where it states that the Respondent must establish the registration and/or use of the Domain Name was not in bad faith and among others, that the Respondent have rights and legitimate interests in the Domain Name. To this, there was no response by the Respondent.

Is the Disputed Domain Name Identical or Confusingly Similar to the FLUKE Marks?

- 6.4 The Panel finds that the Complainant has established that it is the legal owner of the **"FLUKE Marks"**. It is clear that the Complainant had used the FLUKE Marks as early as 1961 and registered the **FLUKE** trademark since 1987 prior to the Respondent registering the Disputed Domain Name in 2009, which is identical to the **FLUKE Marks**. (Refer to **Annex 3**). From the documents and evidence before me, it is undeniable that the Complainant is a well-known international manufacturer of industrial test, measurement, and diagnostic instruments including electronic test equipment, has registered the its products under the well-known **FLUKE** brand and trademark.
- 6.5 The Panel is in agreement with the Complainant that a consumer visiting the Respondent's website would assume that the Disputed Domain Name is the local authorised Malaysian site of the Complainant. Based on the findings in *Celcom Planet Sdn Bhd v. O C Tech, KLRCA/DNDR-373-2016*, the Panel is convinced and agree with the Complainant that the Disputed Domain Name is identical or confusingly similar to the Complainant's registered **FLUKE** trademarks.
- 6.6 Therefore, the Panel finds that the disputed Domain Name is identical to the Complainant's mark pursuant to the **Paragraph 5.2(i) of the Policy**.

Does the Respondent have Rights or Legitimate Interest in the Disputed Domain Name?

- 6.7 The Complainant asserted that it had not granted any permission to the Respondent to use the FLUKE marks or disputed Domain Name. The Panel notes that there is nothing to suggest that the Respondent has been commonly known by the Disputed Domain Name.
- 6.8 Since the Respondent failed to submit its Response to the Complainant, the Respondent failed to satisfy the burden of proof under Paragraph 7.2 of the Policy, in that the Respondent failed to demonstrate: *(i) before the date of being informed 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; or (ii) the Respondent is commonly known by the*

Domain Name even though it has acquired no trade mark or service mark rights in the same; or (iii) the Respondent is 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.

- 6.9 Based on the case of *Malayan Banking Berhad v Beauty, Success & Truth International (WIPO Case No. D2008-1393*, where it was found that the respondent 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; and *Compagnie de Saint Gobain v. Com-Union Corp., D2000-0020 (WIPO Mar. 14, 2000)* which found no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademark, since the Respondent did not receive the Complainant's permission to use the **FLUKE Marks** and is not commonly known by the **FLUKE** name, the Panel finds that the Respondent has no legitimate right to register or use the Disputed Domain Name. Accordingly, the Panel finds that the Respondent has no rights to or legitimate interest in respect of the Disputed Domain Name.

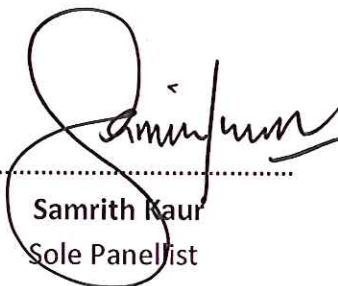
Is the Disputed Domain Name Registered and used in Bad Faith?

- 6.10 Based on the above facts and evidence provided, the Panel finds that the Complainant has discharge its burden of prove pursuant to **Paragraph 6 of the Policy**. The Panel is also satisfied with the evidence that shows the Respondent had actual notice or knowledge of the Complainant's trademark rights in **FLUKE Marks** at the time the Disputed Domain Name was registered, which demonstrates bad faith.
- 6.11 The Panel also take note that there seems to be a pattern of abuse as can be seen in the previous registration of the domain names flukemalaysia.com on 4 May 2007 and flukedistributormalaysia.com on 3 December 2017, both of which were transferred to the Complainant, and the present matter where the Respondent continue to use the Disputed Domain Name without permission. The Panel is convinced that this is sufficient to show a pattern of bad faith on the part of the Respondent in using the Disputed Domain Name.
- 6.12 The Panel also agrees with the Complainant that through a website operating under the Disputed Domain Name, by the Respondent offering for sale goods that are nearly identical to those under **FLUKE Marks**, the Respondent was and continues to *disrupt the Complainant's business* directly competing for website traffic with the Complainant or diverting traffic intended for the benefit of the Complainant, for its own commercial benefit, thereby acting in bad faith.

- 6.13 Hence, as far as use of the Disputed Domain Name in bad faith is concerned, the Panel concludes that the Respondent's holding of the Disputed Domain Name in this case satisfies the requirement of **Paragraph 5.2(ii) of the Policy** in that the domain name was "being used in bad faith" by the Respondent by creating a likelihood of confusion as to the source or origin of the website.
- 6.14 The Panel notes that the Complainant's trademarks have a strong reputation and are widely known, as evidenced by its substantial use and registration in various countries (**Annex 3**), and since the Respondent did not respond to the Complainant, the Respondent failed to discharge its burden to show any actual or contemplated good faith use by the Respondent of the Disputed Domain Name.
- 6.15 For above reasons, the Panel finds that **Paragraph 5.2(iii) of the Policy** is satisfied in this case and that the registration and use of the Disputed Domain Name has been made in bad faith.

7. Conclusion

- 7.1 For the foregoing reasons, in accordance to **Paragraph 12(i) of the Policy** and **Rule 17.2 of the Rules**, the Panel orders that the Disputed Domain Name, fluke.com.my be transferred to the Complainant.



Samrith Kaur
Sole Panelist

Date: 22nd August 2022