



ASIAN INTERNATIONAL ARBITRATION CENTRE

ADMINISTRATIVE PANEL DECISION

In the matter of Domain Name Dispute AIAC/DNDR-1088-2022

Between

The Liverpool Football Club and Athletic Grounds Limited
(Complainant)

And

Asia Bureau.com Sdn. Bhd.
(Respondent)

1. The Parties

The Complainant is The Liverpool Football Club and Athletic Grounds Limited, of Anfield Road, Anfield, L40TH, Merseyside, Liverpool, United Kingdom.

The Respondent is Asia Bureau.com Sdn. Bhd., of 11th Flr, MCB Plaza No.6, Changkat Raja Chulan, 50200 Kuala Lumpur, Wilayah Persekutuan, Malaysia.

2. The Disputed Domain Name, Registrar and Registry

The Disputed Domain Names are <liverpoolfc.my> and <liverpoolfc.com.my>, registered by Respondent with MYNIC Berhad (“Registrar” and “Registry”), of Level 3, Tower 2, Menara Cyber Axis, Jalan Impact, 63000 Cyberjaya, Selangor Darul Ehsan, Malaysia.

3. Procedural History

A Complaint by the Complainant to the Asian International Arbitration Centre (formerly known as the Kuala Lumpur Regional Centre for Arbitration (KLRCA), “Centre” or “AIAC”) under the MYNIC’s (.my) Domain Name Dispute Resolution Policy (“Policy”) was received by the Centre electronically on 24th June 2022; the Centre further confirmed the receipt of the hardcopy of the Complaint on 18th July 2022.

The Centre has verified that the Complaint satisfies the formal requirements of the Policy, the Rules for MYNIC'S (.my) Domain Name Dispute Resolution Policy ("Rules"), and the Supplemental Rules of the Centre ("Supplemental Rules").

On 20th July 2022, the Centre served the Complaint and all Annexes, including Complaint Notification Instruction, setting a deadline of 10th August 2022 by which Respondent could file a Response to the Complaint, via e-mail.

On 16th August 2022, the Centre confirmed no Response was received within the required period of time. On the same day, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Centre serve a panelist appointment notice to Mr. Paddy Tam. Having declared no conflict of interests between the parties, Mr. Paddy Tam is appointed as the Panelist. The Panelist shall render a decision on or before 6th September 2022.

4. Factual background

A. Complainant

The Complainant is a professional football club based in Liverpool, United Kingdom. The club had established itself as a major force in English and European football in the 1970s and 1980s. During these years, it secured eleven League titles and four European Cups. The club won two further European Cups in 2005 and 2019, the latter leading the club to a nineteenth League title in 2020, the club's first during the Premier League era.

To date, the club has won nineteen League titles, eight FA Cups, a record nine League Cups and fifteen FA Community Shields. In international club competitions, the club has secured six European Cups, more than any other English football club, three UEFA Cups, four UEFA Super Cups and one FIFA Club World Cup.

The domain name <liverpoolfc.tv> had been used for the purposes of a website at www.liverpoolfc.tv since as early as 2000, serving as the official website for the Complainant at the time, and which provides news, statistics and other information on the club, as well as selling match tickets and club merchandise.

In 2002, the Complainant began to utilise the domain name <liverpoolfc.com> as its primary website for the club, initially as a redirect to www.liverpoolfc.tv, and then as a website at www.liverpoolfc.com in its own right. Based on website traffic analysis made available for period March 2022 – September 2022, www.liverpoolfc.com generates an average 7.5 million visitors every month, from various locations worldwide, and almost half of all visits originating from United Kingdom based internet users.

Aside from <liverpoolfc.tv> and <liverpoolfc.com>, the Complainant owns various other domain names comprising of the LIVERPOOL FC term, which stem back to as early as 1996. The Complainant's impressive internet

presence can thus be traced back over 20 years, the <liverpoolfc.co.uk> domain having been registered within less than a decade of the inception of the domain name infrastructure of the late 1980s.

B. Respondent

The Respondent is a company in Kuala Lumpur, Malaysia.

5. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Disputed Domain Names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights:

The Complainant registered the composite trade marks containing LIVERPOOL FOOTBALL CLUB at the Intellectual Property Corporation of Malaysia on 28 August 1996, covering classes 18, 25 and 28. The Respondent registered the Disputed Domain Names on 9 August 2004 and 18 February 2008, respectively.

The Complainant's use of LIVERPOOL FOOTBALL CLUB predates the registration of the Disputed Domain Names by the Respondent. Aside from this, the Complainant has used and continues to use other names comprising of "LIVERPOOL" as a key part, such as LIVERPOOL FC, having built up substantial recognition in the public domain, under these names, alongside a portfolio of registered trade marks.

The Disputed Domain Names incorporate the first word "LIVERPOOL" of the composite mark in its entirety. The words "FOOTBALL CLUB" are commonly abbreviated to "FC" in relation to football clubs. The common abbreviation is featured as a suffix within the Disputed Domain Names, forming "liverpoolfc".

Based on the above, in consideration of the Complainant's registered trade mark rights in the sign LIVERPOOL FOOTBALL CLUB dating back to 1996, the Complainant requests that the Panel agrees that the Disputed Domain Names are identical to the Complainant's LIVERPOOL FC brand, or at the very least, confusingly similar to the Complainant's registered rights in the LIVERPOOL FOOTBALL CLUB trade mark.

- ii. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names:

The Complainant submits that the Respondent does not have any rights or legitimate interests in the Disputed Domain Names under Policy, Paragraph 7.2.

The Complainant submits that to the best of their knowledge, the Respondent has never been known as "LIVERPOOL FC" at any point in time.

The Disputed Domain Names were created on 9th August 2004 and 18th February 2008 respectively. By this point, the Complainant already had extensive registered rights in the LIVERPOOL FOOTBALL CLUB brand dating back to 1996 and undisputed worldwide reputation, as a result of not only its successes and achievements as a professional football club, but also various commercial activities carried out under the LIVERPOOL FC and LIVERPOOL FOOTBALL CLUB brand names.

The Respondent's has not used the Disputed Domain Names or a name corresponding to the Disputed Domain Names in connection with a bona fide offering of goods or services

The Disputed Domain Names do not resolve to a live website. As far as the Complainant is aware, the Disputed Domain Names do not have active mail exchange servers. The Complainant understands the purpose of the Disputed Domain Names are to deprive ownership from our client and tarnish the reputation and commercial activity it has established both within Malaysia and online. This substantiates the fact that the Respondent has not made any bona fide offering of goods and services under Policy, Paragraph 7.2(i).

The Respondent has not made a legitimate non-commercial or fair use of the Disputed Domain Names, without intent of or commercial gain to misleadingly divert consumers.

- iii. The Disputed Domain Names were registered and/or are being used in bad faith:

The Respondent registered and/or is using the Disputed Domain Names to prevent the owner of a trade mark or service mark from using the Disputed Domain Names which are identical with its trade mark or service mark.

At the date of this Complaint and as far as the Complainant is aware, the Disputed Domain Names do not resolve to any live content, nor do they have a mail exchange server enabled. The Disputed Domain Names have not resolved to any live content since their registration in 2008. Since the Complainant's entry into the Malaysian trade mark register in 1996, evidenced by the trade mark registrations, the Complainant's success within its industry has significantly increased. The Complainant submits the continued registration is to prevent them from using the Disputed Domain Names, a doctrine otherwise known as "passive holding".

The Complaint submits the Respondent has engaged in a pattern of bad faith conduct, evident through previous domain name disputes against Premier League football clubs.

B. Respondent

The Respondent has not filed an official response within the required period.

6. Discussion and Findings

Paragraph 17.1 of the Rules provide that the Panel is to decide the proceedings based on the documents and evidence submitted by the Parties, the Policy and the Rules as well as any other rules or principles of law which are applied in Malaysia.

Paragraph 5.2 of the Policy provides that the Complainant must establish each of the following elements in the Complaint:

A) Identical or Confusingly Similar

To satisfy the first element under Paragraph 5.2 of the Policy, a Complainant needs to prove its rights in a trademark and the Disputed Domain Names are identical or confusingly similar to the trade mark.

First, the Complainant claims rights in the LIVERPOOL FOOTBALL CLUB mark through its registrations of the trade marks in multiple jurisdictions including Malaysia covering classes 18, 25 and 28 since 1978. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under Paragraph 5 of the Policy. See *Manchester United Limited v Asia Bureau.com SDN BHD*, Case No. KLRCA/DNDR-268-2014 (KLRCA/AIAC 23rd December 2014) (*"The Complainant has provided evidence of trade mark registration in Malaysia and given that MAN UTD is a well-known trade mark, the registration of the MAN UTD marks in the classes of goods and services in paragraph 4.5 above further reaffirm the Complainant's undisputed right in the trade marks"*) Accordingly, the Panel accepts that the Complainant has the registered Trademark rights in the LIVERPOOL FOOTBALL CLUB mark.

Second, the Complainant claims that "FC" is a common abbreviation of words "FOOTBALL CLUB" and "LIVERPOOLFC" has been used in most if not all of Complainant's Internet presence including the primary domain names <liverpoolfc.com> and <liverpoolfc.tv> and for the official website. The Complainant further states that the country code top level domain ("ccTLD") ".my" and ".com.my" should be disregarded in the comparison between Complainant's trade mark and the Disputed Domain Names. The Panel accepts that "FC" is a common acronym of "FOOTBALL CLUB" which is also closely linked to the Complainant in the football industry and the prominent part of the Disputed Domain Names are confusingly similar to Complainant's LIVERPOOL FOOTBALL CLUB trade mark. In addition, the Panel also agrees that the ".my" and ".com.my" ccTLDs are irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of Paragraph 5.2(i). See *TENCENT HOLDINGS LIMITED v. HAPPY CLICK SDN. BHD.*, Case No. KLRCA/DNDR-

502-2017 (KLRCA/AIAC 9th October 2017) (*“Disregarding the “.com.my” and “.my” elements of the Disputed Domain Names, it is immediately apparent to the Panel that the Disputed Domain Names clearly incorporate the trade mark WECHAT in its entirety.”*).

For the foregoing reasons, the Panel finds that the Disputed Domain Names are identical or confusingly similar to Complainant’s trade mark or service mark under Paragraph 5.2(i) of the Policy.

B) Rights and Legitimate Interests in the Disputed Domain Names

To satisfy Rights and Legitimate Interests in the Disputed Domain Names under Paragraph 7 of the Policy, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See ASSICURAZIONI GENERALI S.P.A v. GAN TONGHUAT, AIAC/DNDR-1035-2021 (AIAC 28th January 2022).

Complainant reiterates the reputation and history of its business in the football sector which makes no sense for the Respondent to register or use the Disputed Domain Names other than to take advantage of Complainant’s trade mark rights.

The Complainant also argues that the Respondent has not been commonly known by the Disputed Domain Names and passively holding the Disputed Domain Names does not contribute to any bona fide offering of goods and services under Paragraph 7.2 of the Policy.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the Disputed Domain Names and the burden of proof has been shifted to the Respondents to prove that it has rights or legitimate interests to the Disputed Domain Names. However, the Respondents have not submitted an official response to rebut the assertion within the required period of time.

For the foregoing reasons, the Panel finds the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names under Paragraph 7 of the Policy.

C) Registration and/or use of the Domain Name in bad faith

To satisfy the second element under Paragraph 5.2 of the Policy, the Complainant must prove the registration and/or use of the Disputed Domain Names is/are in bad faith.

Despite successfully proving either the registration or use of the Disputed Domain Names in bad faith has already satisfied the requirements set forth under Paragraph 5.2 of the Policy, the Panel will rule on the registration and the use of

the Disputed Domain Names separately in the present case for the sake of completeness.

First, the Complainant submits that Respondent's registration and/or use of the Disputed Domain Names prevent the Complainant from using the Disputed Domain Names which are identical with its trade mark or service mark. The Complainant further highlights that in the view of the widespread fame and extensive use of Complainant's LIVERPOOL FC mark, it would be implausible for the Respondent to have no knowledge of the Complainant and its rights in the LIVERPOOL FC brand. Considering the 130 years of history, the success of the brand in the football industry and prior trademark registration, the Panel is of the view that it is impossible for the Respondent to register the Disputed Domain Names in good faith. The Panel also notes that the Respondent had registered <manutd.my> in the past which infringed the rights of another football team in the English Premier League, not only demonstrating the actual knowledge of the LIVERPOOL FC mark but also engaging in a bad faith cybersquatting pattern. The present Panel agrees with the Panel decision of the case MANCHESTER UNITED LIMITED v. ASIA BUREAU.COM SDN BHD (Respondent of the present case), KLRCA/DNDR-268-2014 (KLRCA/AIAC 23rd December 2014). On this basis, the Panel agrees the registration of the Disputed Domain Names was in bad faith.

Second, the Complainant contends that the Disputed Domain Names do not resolve to any active content, nor have any active mail exchange service record. Since the registration of the Disputed Domain Names in 2008, the Disputed Domain Names have not resolved to any live content. Further to the prevention of use of the Disputed Domain Names, the passive holding of the Disputed Domain Names constitutes to the use of the Disputed Domain Names in bad faith. See MANCHESTER UNITED LIMITED v. ASIA BUREAU.COM SDN BHD (Respondent of the present case), KLRCA/DNDR-268-2014 (KLRCA/AIAC 23rd December 2014) (*"Given the circumstances, the Panel finds it difficult to agree with the Respondent that the Respondent could not possibly misappropriate and usurp the Complainant's goodwill, reputation and commercial advantage in the use of the MAN UTD just because it is alleged that the Respondent did not use or was using the domain name commercially. Inactive holding of domain name can amount to bad faith use...The Panel is persuaded to follow the decision in Google Inc. v Googles Entertainment, Case No SDRP-2002-0003(F) that bad faith use is not limited to positive action, but such use could be inferred from a respondent's passive holding of the domain name."*). See also Google Inc v. Digiattack, RCA/DNDR/2009/17 (KLRCA/AICA 24th April 2009)(*"Apart from the scenario of classic cybersquatters who cunningly register multiple domain names for commercial gain, inactive holding domain names also amounts to bad faith use."*) Without receiving any response from the Respondent, there is no plausible explanation for the Respondent to hold the Disputed Domain Names passively for 14 years in good faith without resolving any meaningful content from the Disputed Domain Names. The Panel agrees with the Complainant and finds that the Respondent's use of the Disputed Domain Names is in bad faith.

For the foregoing reasons, the Panel finds that the Respondent has registered and/or used the Disputed Domain Names in bad faith under Paragraph 5.2(ii) of the Policy.

7. Decision

Having established all three elements required under the MYNIC Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the Disputed Domain Names <liverpoolfc.my> and <liverpoolfc.com.my> be **TRANSFERRED** to the Complainant.



Paddy Tam
Panelist

Dated: 25th August 2022