

ADMINISTRATIVE PANEL DECISION

IN THE MATTER OF AIAC/D/DNDR-1105-2022
BETWEEN

SEVENTH-DAY ADVENTIST UNION MALAYSIA
(Complainant)

AND

WHITE LABEL DOMAINS SDN BHD
(Respondent)

CASE NO AIAC/D/DNDR-1105-2022

1. The parties:

The complainant Seventh-day Adventist Union Malaysia, is a incorporated Company Limited by Guarantee having its registered address at 3-1, Jalan Indrahana 2, Off Jalan Kuchai Lama 58200 Kuala Lumpur, represented by M/s Messrs Stanley & Co, Unit C-06-10, Block C Southgate Commercial Complex No. 2, Jalan Dua, Chan Sow Lin 55200 Kuala Lumpur, Malaysia.

The respondent WHITE LABEL DOMAINS SDN BHD is a incorporated Company Limited by Shares having its registered address at No. 36B, 2nd Floor, Jalan tun Mohd Fuad 2 Taman Tun Dr. Ismail 60000 Kuala Lumpur, Malaysia.

2. The Domain name and registrar:

The disputed domain name is **<adventist.my>** and the Registrar is the Malaysian Network Information Centre (MYNIC).

3. Procedural history:

3.1 The complainant submitted its complaint with the Asian International Arbitration Centre (AIAC) ("**the Centre**") on 2nd August, 2022 pursuant to 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 MYNIC's (.my)

Supplemental Rules ("**the Supplemental Rules**") in respect of the disputed domain name.

3.2 An examination of the material confirms that all technical requirements for the initiation of this proceeding have been satisfied. Having verified that the complaint satisfies the formal requirement, the proceeding was formally commenced.

3.3 Notification of Commencement of Proceeding (NCP) was sent to respondents by the Centre informing them about the complaint filed against them before AIAC. The Complainant's Form A was served upon the Respondent vide email on 12th August, 2022 followed by postal delivery of the Form A in hard copy on 17th August, 2022. The respondent was directed to file their response on or before September 7th, 2022. But no response has been received from the respondents.

3.4 The Complainant having elected for a single member panel, by email on 8th September, 2022 the Centre appointed Mr.Saravanan Dhandapani as the sole panellist in conformity with the policy and the rules. The panellist has submitted a statement of Declaration of Impartiality and Independence on 12th September, 2022 as required by the Centre.

4. Factual Background:

4.1 The complainant is the regional headquarters of the Seventh-day Adventist Church in Malaysia. The Seventh-day Adventist Church is a global church movement.

4.2 The registered proprietor of the trademark "ADVENTIST" is the General Conference Corporation of Seventh-day Adventists, the global headquarters of the Seventh-day Adventist Church.

4.3 The Complainant is a Licensee of the "ADVENTIST" trademark as evidenced under **Exhibits D & E** which includes the right to exercise any trademark Protection Procedures in the name of the Complainant.

4.4 The Seventh-day Adventist Church is present in more than 200 countries with more than 20 million memberships world wide. As such, the "ADVENTIST" mark is well known around the world as evidenced under the **Screenshot of the webpage showing Seventh-day Adventist World Church Statistics 2021 which is marked as Exhibit F.**

4.5 The Seventh-day Adventist Church has been present in Malaysia for more than 72 years. **The Certificate of Registration of the General Conference Corporation of Seventh-Day Adventists is marked as Exhibit G.**

4..6 The Seventh-day Adventist Church is also commonly known as the Adventist Church and its members are known as Adventists.

4.7 According to Cambridge Dictionary, the word "ADVENTIST" refers to the Seventh-day Adventist religion as evidenced under the **Screenshot of the definition of 'Adventist' in Cambridge Dictionary's website which is marked as Exhibit H.**

4.8 The Seventh-day Adventist Church and the Complainant are both the common law and registered owner (Licensee) of the trademark and service mark "ADVENTIST".

5. The Parties Contentions:

5.1 The Complainant:

5.1 (i) The complainant contends that the registration of the disputed domain name should be transferred to the complainant.

5.1 (ii) The complainant relies on the adduced facts and evidence and contents that it has fulfilled the requisite elements of paragraph 5.2 of the Policy, in particular:

- a. The disputed domain name is identical to and/ or confusingly similar with the complainant's trademarks to which the complainant has rights; and
- b. The respondent has registered and used the disputed domain name in bad faith.

5.2. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

5.2.1 The Seventh-day Adventist Church has been incorporated in Malaysia since 15 August 1949 under the registered company name "General Conference Corporation of Seventh-Day Adventists" as evidenced under **Exhibit G** and has gained significant goodwill and reputation.

5.2.2 It is well established that the relevant test is whether the domain name incorporates the dominant and the distinguishing part of the Complainant's mark as evidenced under **Manchester United Limited v Asia Bureau Com Sdn Bhd, Case No.KLRCA/DNDR-268-2014 which is marked as Exhibit L.**

5.2.3 The Domain Name, Adventist.my, is identical to the Complainant's registered trademark and service mark "ADVENTIST". The addition of the suffix ".my" does not negate the likely confusion and/or deception arising from the use of the Domain Name given that the word "ADVENTIST" is clearly an essential feature of the Domain Name. Hence, the Respondent's incorporation of the Complainant's mark "ADVENTIST" in the Domain Name is highly likely to deceive and/or cause confusion among members of the public as evidenced under **Hugo Boss AG v Eppies Internet, Case No. rca/dndr/2004/02 which is marked as Exhibit M.**

5.2.4 Given that the Seventh-day Adventist Church has been incorporated in Malaysia since 15 August 1949, the Complainant contends that the Respondent should have or ought to have been aware of the Complainant's mark and its

association to the Seventh-day Adventist Church prior to registering the Domain Name.

5.2.5 The Complainant further contends that the Respondent's conduct of using the Domain Name falsely represents to members of the public that the Respondent's website is in some way connected, affiliated and/or associated with the Complainant when it is not, thereby damaging the Complainant's goodwill and reputation.

5.3. Registering and/or using the Domain Name to mainly to sell, rent or transfer the Domain Name for Profit

5.3.1 The Domain Name has been registered in bad faith because the Respondent had registered and/or is using the Domain Name mainly to sell, rent or transfer the Domain Name for profit to the Complainant, its competitor or the owner of the trademark or service mark.

5.3.2 The Respondent is an inactive holder of the Domain Name. This is evident from the fact that the Domain Name does not lead to a functioning website, but instead leads to a parking page that states "Domain Parked with Asia Registry", a website that it is not associated with or related to the Complainant.

5.3.3 Thereafter, internet users will be redirected to a website called "Asia Domains/Asia Registry", a site that sells domains as evidenced under the **Screenshot of the website 'Asia Domains/Asia Registry' via www.adventist.my which is marked as Exhibit I.**

5.3.4 Following the company search conducted on the Respondent, the Respondent's nature of business is "*to engage in the business of domain name branding*" as evidenced under **Exhibit B.**

5.3.5 Further, as per the records of WHOIS-MYNIC, the System Admin of the Domain Name is Instra Corporation Pty Ltd, which is an internet services company that provides global domain names as evidenced under **Exhibit C**.

5.3.6 The sole shareholder of the Respondent is Instra Holdings (UK) Ltd, and its nature of business involves *"Data processing, hosting and related activities – Trading a portfolio of premium domain names."* as evidenced under **Exhibit B and the Screenshot of company search on Instra Holdings (UK) Limited which is marked as Exhibit J**.

5.3.7 The Respondent's act of registering domain names in bulk shows that the Respondent is a domain name squatter, hoping to gain financially from any of its registered domain names.

5.3.8 Following the above, it is obvious that the Respondent has no bona fide intention of using the Domain Name but instead, intends to build traffic by diverting internet users to its website in order to sell, rent or transfer the Domain Name for profit as evidenced under **(1) Mudah.my Sdn Bhd v Scalable Systems, Case No.KLRCA/DNDR-239-2014 which is marked as Exhibit N (2) NEP Holdings (Malaysia) Berhad v Liew Bin Dian, Case No. rca/dndr/2004/04 which is marked as Exhibit O and (3) FlyFirefly Sdn Bhd v Nikabina IT MSC Sdn Bhd, Case No. RCA/DNDR/2007/11 which is marked as Exhibit P**.

5.3.9 The Complainant contends that the Respondent's act of registering the Domain Name yet not making use of the Domain Name for any legitimate purpose other than for the purposes as stated above indicates the Respondent's registration and/or use of the Domain name in bad faith as evidenced under **Manchester United Limited v Asia Bureau Com Sdn Bhd, Case No. KLRCA/DNDR-268-2014 which is marked as Exhibit L**.

5.4. Registering and/or using the Domain Name to prevent the owner of a trademark or service mark owner from using the domain name

5.4.1 Further or alternatively, the Domain Name has been registered in bad faith because the Respondent registered and/or is using the Domain Name to prevent the Complainant, being the owner of a trademark or service mark, from using the Domain Name which is identical to the Complainant's trademark or service mark.

5.4.2 In the present case, it is clear that the Respondent is not carrying on any lawful business using the "ADVENTIST" mark and has not used or prepared to use the Domain Name in relation to a genuine offering of goods and services. As such, the Complainant contends that the Respondent's conduct of registering the Domain Name prevents the Complainant, being the trademark and service mark owner of "ADVENTIST" from using the Domain Name for its organization as evidenced under **FlyFireFly Sdn Bhd v Nikabina IT MSC Sdn Bhd, Case No. RCA/DNDR/2007/11 which is marked as Exhibit P.**

5.5. For the purposes of and with the intention to attract or divert, for commercial gain, Internet users to the Respondent's website

5.5.1 Further or alternatively, the Domain Name has been registered in bad faith because the Respondent registered and/or is using the Domain Name for the purposes of and with the intention to attract or divert internet users to the Respondent's website known as "Asia Domains/Asia Registry" which is operated by Instra Corporation, a company related to the Respondent that is in the business of selling domain names as evidenced under **Exhibit I.**

5.5.2 The Complainant contends that the Respondent's unauthorised use of the Domain Name is to attract or divert internet users to the Respondent's website i.e. "Asia Domains/Asia Registry" by confusing and/or deceiving internet users into thinking that the Domain Name was operated by the Complainant or otherwise connected with the Complainant and/or its trademark or service mark. It was held in

U Mobile Sdn Bhd v Web ID Management (Case ID: AIAC/D-602-2018) **which is marked as Exhibit R** that the Respondent's act of directing the internet traffic to the Respondent's website using a domain name that incorporates the Complainant's mark constitutes bad faith and as evidenced under **NEP Holdings (Malaysia) Berhad v Liew Bin Dian, Case No. Rca/dndr/2004/04 which is marked as Exhibit O.**

5.5.3 Based on the above, it is apparent that the Respondent's use of the Domain Name is to obtain commercial gain by riding on the reputation and goodwill of the Complainant in the "ADVENTIST" mark by attracting and/or diverting internet users to its website in order to promote the sale of its domains as evidenced under **Mudah.my Sdn Bhd v Scalable Systems, Case No. KLRCA/DNDR-239-2014 which is marked as Exhibit N.**

5.6. The Respondent has no rights or legitimate interests in the Domain Name

5.6.1 In light of the grounds stated above and the fact that the Respondent is not commonly known by the Domain Name and is not a licensee of the Complainant or authorised to use the Complainant's mark, it is evident that the Respondent has no rights or legitimate interests in respect of the Domain Name and is not making any legitimate, non-commercial and/or fair use of the Domain Name other than to deceive the public and/or profit from the Complainant's goodwill and reputation.

5.6.2 Further, the Respondent's mere act of registering the Domain Name does not give it a right or legitimate interest in the Domain Name as evidenced under **(1) Manchester United Limited v Asia Bureau Com Sdn Bhd, Case No. KLRCA/DNDR-268-2014 which is marked as Exhibit L; and (2) Volkswagen Group Singapore Pte Ltd v Web motion Design, Case No. rca/dndr/2003/01(int) which is marked as Exhibit Q.**

6. The respondent

The respondent has not submitted its response.

7. Discussions and findings

7.1 Rule 17 contemplates that 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 principles of law which are applied in Malaysia.

7.2 Paragraph 5 of the Policy provides that the complainant must establish both of the following elements in the complaint:

- i. The disputed domain name is identical or confusingly similar to trademark or service mark to which the Complainant has rights; and
- ii. The respondent has registered and/ or used the disputed domain name in bad faith.

The Panel will deal with each of the requirements of the Policy.

8. Identical or confusingly similar:

8.1 The panel finds that the complainant has adduced sufficient evidence to demonstrate that it has rights in the trademark "ADVENTIST" and it has adduced evidence to show that it is a Licensee of the registered trademark ADVENTIST.

8.2 The panel finds that the disputed domain name <adventist.my> is identical to the complainant's trademark ADVENTIST. ADVENTIST is a dictionary word and in the Cambridge Dictionary it refers to the Seventh – Day Adventist religion. Hence, undoubtedly, the disputed domain name is identical to the complainant's trademark.

9. Rights and Legitimate Interests:

9.1 Paragraph 7 of the Policy provides that in order for the respondent to rebut the allegation that the disputed domain name was registered and has been used in bad faith, the respondent may prove that it has rights and legitimate interests in the disputed domain name. Paragraph 7.2 of the Policy identified several types of evidence that could be adduced by the respondent to support its case and they include

- a) Before the date of communication of the complaint, the respondent has used or made preparations to use the disputed domain name in relation to a genuine offering of goods or services; or
- b) The respondent is commonly known by the disputed domain name; or
- c) 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.

9.2 The complainant has established that it has in no way has any connection or link with the respondent. It has also established that it has not authorised or allowed or directed the respondent to use or register the said domain name. The respondent is in no way known by the disputed domain name. It is also seen that respondent has not taken any steps to secure any trademark rights in the domain name.

9.3 The respondent has not proved that prior to being informed of this dispute, they had used or had made demonstrable preparations to use, the domain name in connection with a genuine offering of goods and services. The domain name display website containing commercial banners and spreading malware. Such use of domain name cannot be considered as genuine offering of goods. This view has been supported by many prior panels, few being quoted by the complainant in its complaint.

9.4 The complainant has proved its point that the respondent is not making a legitimate non-commercial or fair use of the domain name without intention for commercial gain by misleading the customers. Hence, it is proved that the respondents have no rights or legitimate interests in the domain name.

10. Bad Faith:

10.1 The complainant has established that its trademark has been in existence since 1969. It is seen from WHOIS report that the disputed domain name was registered in 2011. Hence, the respondents even after being aware of the existence of the trademark registered the domain name in bad faith. The actual or constructive knowledge of the complainant's rights in trademark is also a factor supporting bad faith.

10.2 On perusal of **Exhibit B**, it can be seen that the respondent's nature of business of Domain Name Branding and is in habit of registering many domain names infringing rights of many parties. Hence, it is proved that the respondent registered the domain name in bad faith.

10.3 The complainant has established that the respondent has registered the domain name and also using it only to build traffic by diverting internet users to its website in order to sell, rent or transfer the Domain Name for profit. It can also be seen that the internet users in Malaysia on searching for the complainant's website will be automatically directed to the domain name. Hence, Internet traffic will be diverted to the respondent's domain name. Hence, the respondent will be unduly profited from the goodwill of the complainant.

10.4 Hence, the respondent has registered and is using the domain name in bad faith.

11. Conclusion:

11.1 Based on all the facts and evidence adduced and upon the reasoning provided above, the Panel decides that:

- a) The disputed domain name is identical to the complainant's trademark "ADVENTIST" to which the complainant has Licensed rights; and
- b) The respondent has registered and/ or used the domain name in bad faith

11.2 Accordingly, the Panel directs that the disputed domain name **<adventist.my>** be transferred to the complainant.



SARAVANAN DHANDAPANI
Sole Panelist

24th September, 2022