

ADMINISTRATIVE PANEL DECISION**IN THE MATTER OF CASE NO./ AIAC/DNDR- 1212 -2023**

BETWEEN

HLX SDN BHD (previously known as GuoLine eMarketing Sdn Bhd)
(Complainant)

AND

GOLDLINKS SDN BHD
(Respondent)**The parties:**

a) The complainant is HLX Sdn Bhd (Previously known as GuoLine eMarketing Sdn Bhd), Malaysia, an incorporated company having its registered address at Level 32, Menara Hong Leong, No.6, Jalan Damanlela, Bukit Damansara, 50490 Kuala Lumpur. The complainant is represented by Messrs. LAW Partnership, Unit 12-01, Tower 8, Avenue 5, The horizon Phase 2, Bangsar South, No.8, Jalan Kerinchi, 59200 Kuala Lumpur.

b) The Respondent is Goldlinks Sdn Bhd having address at F-SG-48, Sunway Geo Avenue, Jalan Lagoon Selatan Sunway South Quay, Subang Jaya, 47500 Selangor and/or at Unit No. 203, TKT 2, BLK C, Damansara Intan, No.1, Jalan SS 20/27, Petaling Jaya, 47400 Selangor and/or at 2803, Lorong 6A/91, Taman Shamelin Perkasa, off Jalan Cheras, 56100 Kuala Lumpur.

The Domain Name and Registrar:

The dispute domain name is <<https://www.gemfive.com.my/>>.
The Registrar is the Malaysian Network Information Centre (MYNIC).

Procedural History:

a) The complainant submitted the complaint dated 18th July, 2023 with the Asian International Arbitration centre (AIAC) ("**the Centre**") 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 MYNIC's (.my) Supplemental Rules of the Centre ("**the Supplemental Rules**") in respect of the disputed domain name.

b) The 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 proceedings were formally commenced.

c) Notification of Commencement of Proceeding (NCP) was sent to the Respondent 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 21st July, 2023 followed by postal delivery of the Form A in hard copy on 21st July, 2023. The respondent was directed to file their response on or before 11th August, 2023. But no response has been received from the respondent.

d) The complainant having elected for a single member panel, by email on 16th August, 2023 the centre appointed Mr. Saravanan Dhandapani as the sole panelist in conformity with the policy and the rules. The panelist has submitted a Statement of Declaration of Impartiality and Independence on 15th August, 2023 as required by the Centre.

Factual Background:

1. The complainant is a part of Hong Leong Group of Companies and has its registered office in Malaysia.
2. The complainant, previously known as GuoLine eMarketing Sdn Bhd, is the registered and common law proprietor of various trademarks bearing the trade/service name and mark **"GEMFIVE"**. The GEMFIVE marks were used on e-commerce marketplace owned by the complainant.
3. The complainant claims that its domain name has developed considerable reputation and goodwill in both services and brands and that its trademark **"GEMFIVE"** is among most famous online trademarks in the world.
4. The complainant states that its domain name consisting of **"GEMFIVE"** trademark is not only heart of the business but also the main way for millions of users to avail themselves of its services.
5. The complainant claims that it has registered its trademark **"GEMFIVE"** in various countries such as Malaysia, Brunei, Singapore, Japan, Korea, China, Thailand, and Vietnam. The registrations quoted by the complainant are Trademark No. 2015002547 registered on 9th March 2015 in Malaysia, Trademark No. 46563 registered on 30th April 2015 in Brunei, Trademark No. 40201504055T registered on 10th March 2015 in Singapore, Trademark No. 982899 registered on 21st April 2015 in Thailand, Trademark No. 40288175 registered on 19th September 2017 in

Vietnam, Trademark No. 5899369 registered on 25th November 2016 in Japan, Trademark No. 410357228 registered on 26th April 2016 in Korea and Trademark No. 16732935 registered on 7th June 2016 in China for goods and services. These registrations are also evident from the copies of trademark registration certificates are attached by the complainant in **Exhibit 5**.

6. The Complainant states that the disputed domain name **<<https://www.gemfive.com.my>>** incorporates entirely the complainant's GEMFIVE marks and only differs by containing the country code top level domain (ccLTD).

7. The complainant had no access to identify the owner or controller of the disputed domain name and required the assistance of the AIAC, through their liaison with MYNIC to identify the respondent.

8. It is also pertinent to note that the disputed domain name is not available for purchase including the complainant. The complainant has initiated this complaint with a hope to retrieve and protect their rights over the disputed domain name.

9. The complainant's e-commerce platform has gained attention and recognition from reputable news platform by reporting on the activities and offerings of GEMFIVE and by highlighting its significance in the e-commerce industry. GEMFIVE advertising campaigns undertaken for launching the platform is evidenced in **Exhibit 7**.

10. The Complainant has further expanded their e-commerce platform through the creation of GEMFIVE App which is available for free on Google. The GEMFIVE App is evidenced in **Exhibit 8**.

11. The complainant states that they have spent large amount of money in marketing and promoting its e-commerce platform through YouTube, Facebook, Spotify and other local online portals.

12. The complainant's e-commerce platform has gained online media coverage by Vulcan Post on 19th May, 2015 where the launch of GEMFIVE as a new e-commerce platform was featured, by The Edge Malaysia on 3rd June, 2015 that reported that GEMFIVE is operated by GuoLine eMarketing which is owned by private arm of the Hong Leong Group and by New Straits Times on 18th May, 2015 that reported GEMFIVE has over 100 merchants and carries over 300 international brands from United States, South Korea, Sweden, Australia and Thailand. The printout of the online media coverage is evidenced in **Exhibit 10**.

The Parties Contentions:

1. The Complainant:

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

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

- a.** The disputed domain is identical to and/ or confusingly similar with complainant's trademarks or service marks to which the complainant has rights; and
 - b.** The respondent has registered and/or used the disputed domain name in bad faith;
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1(iii) In support of these contentions, the complainant asserts and maintains various points which includes the following:

1(iv) The Domain Name **<https://www.gemfive.com.my/>** is identical to the Complainant's registered trademark and service mark **"GEMFIVE"**. The addition of the suffix "com.my" does not negate the likely confusion and/or deception arising from the use of the Domain Name given that the word "GEMFIVE" is clearly an essential feature of the Domain Name. Hence, the Respondent's incorporation of the Complainant's mark "GEMFIVE" in the Domain Name is highly likely to deceive and/or cause confusion among members of the public and take advantage of the Complainant's reputation to exploit their brand recognition.

1(v) The complainant stresses that the addition of (ccTLD), such as .com or .my or .com.my is immaterial in determining the identically or similarity between the "GEMFIVE" mark and the disputed domain name.

1(vi) The complainant states that the respondent has owned the similar e-commerce platform to take advantage of complainant's reputation and exploit their brand recognition to confuse the public who wanted to visit the complainant's website. The printout of the

Complainant's website (obtained from web.archive.org) is attached in **Exhibit 14(i)** and the Respondent's website is attached in **Exhibit 14(ii)**.

1(vii) The Complainant states that the website under the disputed domain name use infringing marks which are virtually, phonetically and conceptually identical to "**GEMFIVE**" marks as it wholly incorporates the use of the word "**GEMFIVE**". The printout of the website that has the infringing marks is attached in **Exhibit 12**.

1(viii) In addition to that the website under the disputed domain name displays unauthorized use of the name, company registration number and business and registered addresses belonging to the complainant. The printout of the website that containing unauthorized use of the complainant's information is attached in **Exhibit 13**.

1(ix) The Complainant also states that the Respondent is utilizing the disputed domain name and has designed their website as an e-commerce market place which is the same business as that of the complainant's "**GEMFIVE**" platform. Therefore, any public visiting the disputed domain name would be confused or deceived into the mistaken belief.

1(x) The Complainant further contends that the Respondent's conduct of using the Domain Name with the use of infringed mark and unauthorized use of Complainant's information 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.

1(xi) The complainant claims that the respondent intend to divert the internet users and also create confusion. According to the complainant, the internet users would find the complainant's official website dedicated to both Malaysia and international users as the domain name identically reproducing the complainant's trademark "**GEMFIVE**" under .com.my and .my country code extensions. Clearly, the respondent intend to derive the goodwill and reputation attached to the complainant's trademark.

1(xii) it is also pertinent to note that the complainant registered the GEMFIVE marks between the year 2015-2017 under **Exhibit 5** and the respondent registered the disputed domain name on 31st July, 2019 which is much later to the Complainant's registration.

1(xiii) The complainant submits that the respondent is neither the licensee of the complainant nor has it been authorized by the complainant to use the trademark. It has also been found that the respondent has not taken any steps to secure or register any trademark rights in the disputed domain name. 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. Further, the Respondent's mere act of registering the

Domain Name does not give the right or legitimate interest in the Domain Name.

1(xiv) The complainant states that they have been using the "**GEMFIVE**" marks for number years and have gained good reputation and attention from the public. The respondent could not have coincidentally registered or used the "**GEMFIVE**" marks under the disputed domain name with infringing marks and unauthorized information of the complainant. This shows that the respondent had the knowledge of the Complainant's business and reputation.

1(xv) The complainant has established that it is no way connected or linked with the respondent. It has also established that it has not authorized or allowed or directed the respondent to use or register the domain name. And the respondent has not sought any approval or consent to use the GEMFIVE marks.

1(xvi) The complainant further states that they have issued a notice on 30th June, 2023 under **Exhibit 15** to the respondent to cease and desist the disputed domain name and it came to light that the email addresses were invalid and notice was unsuccessfully delivered to all the three email addresses. And it also contains the complainant's business address without any authority. The cease and desist notice was extended to its reseller, Qinetics Solutions Sdn Bhd.

1(xvii) Hence, the complainant asserts that the domain name is identical to the complainant's trademark, the respondent has registered and/or using the domain in bad faith and the respondent has no right to use the same.

2. The Respondent:

The respondent has not submitted their response.

Discussions and Findings:

- 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 is applied in Malaysia.
- 2.** Paragraph 5 of the Policy provides that the complainant must establish both of the following elements of the complaint:
 - a.** The disputed domain is identical to and/ or confusingly similar with complainant's trademarks or service marks to which the complainant has rights; and
 - b.** 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.

Identical and confusingly similar:

- 3.** GEMFIVE is derived from the amalgamation of two components namely GEM and FIVE. The acronym 'GEM' represents the complainant's previous name 'GuoLine eMarking' while FIVE was made by the founding members. The panel finds that the complainant

has adduced sufficient evidence to demonstrate that it has common law proprietor of various trademarks bearing the trade/service name and mark **"GEMFIVE"** in various countries including Malaysia. It has adduced evidence to show that it has registered the trademark **"GEMFIVE"** all over the world.

4. Therefore, the panel finds that the disputed domain name **<gemfive.com.my>** is identical to the complainant's trademark **"GEMFIVE"**.

Rights and Legitimate Interests:

5. 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 disputed domain name in relation to a genuine offering of goods and 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 fair purposes and has no intention of using the same for profits or to receive the public.

6. The complainant has established that it is no way connected or linked with the respondent. It has also established that it has not authorized or allowed or directed the respondent to use or register the domain name. The respondent is in no way known by the disputed domain name. It is also seen that the respondent has not taken any steps to secure any trademark rights in domain name.

7. The complainant has proved its point that the respondent is not utilizing the disputed domain name for legitimate, non-commercial or fair purpose but for misleading the customers. Hence, it is proved that the respondent has no rights or legitimate interests in domain name.

Bad Faith:

8. The complainant states that the Respondent has full knowledge of the complainant's reputation, its nature of goods and services.

9. It is evident that the complainant has been operating the **"GEMFIVE"** marks for a number of years and has gained reputable attention from the public. The complainant registered the **"GEMFIVE"** marks between the year 2015-2017 and the respondent registered the disputed domain name on 31st July, 2019 which is much later to the Complainant's registration.

10. The complainant states that disputed domain name has not coincidentally registered or used or incorporated as it uses the infringing marks, unauthorized use of complainant's information and provides identical services as the complainant.

11. The complainant states that they have not authorized the respondent or the respondent is not related to the complainant or the respondent did not get any approval or consent to use the **"GEMFIVE"** marks.

12. The Respondent's use of the disputed domain name is neither in legitimate nor in good faith rather to misappropriate the complainant's goodwill and reputation.

13. The complainant further states that they have issued a notice on 30th June 2023 to the respondent to cease and desist the disputed domain name and it came to light that the email addresses were invalid and notice was not successfully delivered. And it also contains the complainant's business address without any authority. The cease and desist notice was extended to its reseller, Qinetics Solutions Sdn Bhd.

14. Hence, this panel finds that the respondent has registered and are using the domain name in bad faith.

Conclusion:

15. 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 "**GEMFIVE**" to which the complainant has right; and

b. The respondent has registered and used the domain in bad faith.

16. Accordingly, the Panel directs that the domain name **<gemfive.com.my>** be transferred to the complainant.



SARAVANAN DHANDAPANI

Sole Panelist
24th August, 2023