



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Binariang Satellite Systems Sdn. Bhd. v. Adanet Sdn. Bhd.

Case No. D2000-1122

1. The Parties

The Complainant in this proceeding is Binariang Satellite Systems Sdn. Bhd., a company duly incorporated under the Laws of Malaysia having its principal place of business at Level 37, Menara Maxis, Kuala Lumpur City Centre, 50088 Kuala Lumpur, Malaysia.

The Respondent in this proceeding is Adanet Sdn. Bhd. The address of Respondent as contained in the domain name registration is 8 Jalan Tun Mohd. Fuad, TTDI Kuala Lumpur, Kuala Lumpur 60000, Malaysia. The Administrative and billing contact provided for the domain name registration is Kenn, Tan (TK4210) Adanet Sdn. Bhd., 8 Jalan Tun Mohd. Fuad, TTDI Kuala Lumpur, Kuala Lumpur 60000, Malaysia. The Technical, Zonal contact is ReserveMe.com 134-16 Booth Memorial Ave. Suite 1D Flushing, NY 11355, United States.

2. The Domain Name and Registrar

The domain name at issue is "measat.com", which is registered with Network Solutions, Inc., 505, Huntmar Park Drive, Herndon, Virginia 20170, United States of America.

3. Procedural History

The WIPO Arbitration and Mediation Center (the "Center") received the Complaint of the Complainant Binariang Satellite Systems Sdn. Bhd, on August 25, 2000, by e-mail and on August 31, 2000, in hardcopy.

On August 29, 2000, the Center sent an acknowledgement of the receipt of the Complaint to the Complainant. On the same date, the Center sent to the Registrar Network Solutions, Inc. a request for verification of registration data. On August 31, 2000, the Registrar confirmed, interaila, that it is the Registrar of the domain name in dispute and that "measat.com" is currently registered in the name of the Respondent.

Having verified that the complaint satisfies the formal requirements of the ICANN Uniform Domain Name Dispute Resolution Policy ("the Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ("the Supplemental Rules"), the Center on September 19, 2000, sent to the Respondent in accordance with paragraph 2(a) of the Rules a notification of the administrative proceedings together with a copy of the Complaint. The Administrative panel finds that the WIPO Center has satisfied its notification obligation under paragraph 2(a) of the Rules. Respondent was given an opportunity to submit its Response. The last date for sending response by the Respondent was October 8, 2000.

The Center did not receive any response from the Respondent. Consequently, the Center, on October 18, 2000, notified the Respondent of its default and informed the Respondent that the Center would appoint an Administrative Panel as per the Rules and inform the Panel of the Respondent's default in responding to the Complaint.

On October 24, 2000, the Center appointed the Administrative Panel consisting of a single member. The date for the decision was fixed as November 6, 2000.

Till this date, no response has been received from the Respondent. The Panel therefore rules that the Respondent has forfeited its right to file a response.

The Respondent is proceeded Ex-parte. Rule 5 (e) governs this situation which reads as under:

"5(e) If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based on the Complaint".

The Panel finds that in the present case there are no exceptional circumstances that exist and therefore the present dispute is being decided on the basis of the Complaint and documents on record of the Panel.

4. Factual Background

Binariang Berhad (No. 158400- v) was formally known as Binariang Sdn. Bhd. Binariang Berhad Vide Deed of Assignment dated July 22, 1998 had assigned and transferred all rights including all common law intellectual property rights, title and interests in respect of applications for registration as proprietor of the trademark in

favour of Binariang Satellite Systems Sdn. Bhd. i.e. the Complainant. A copy of Deed of Assignment dated July 22, 1998 and the Recordal of Assignment filed with each of the relevant Trade Mark office are attached as Annexure 'D' with the Complaint. The applications for registration of the Trademark are pending in Malaysia and Singapore. As on the date of the Complaint, the trademark 'MEASAT' has been registered in Brunei in favour of Binariang Sdn. Bhd. The Complainant has provided evidence of the applications made for the registration of trademarks and the certificate of registration of the trademark 'MEASAT' in the Braunei, filed as Annexure "E" to the complaint.

Respondent is the current registrant of the domain name "measat.com" E-mail dated August 31, 2000, from Network Solution, Inc. to the Center confirms that Respondent is the Registrant of the domain name at issue. The record in relation to the said domain name was created on August 7, 1998.

5. Parties' Contentions

A. Complainant

The Complainant asserts:

- that the Complainant is the owner and operator of Malaysia's first fleet of telecommunications satellites known as the MEASAT Satellite System. The Complainant launched its MEASAT-1 and MEASAT-2 satellites in January and November 1996, respectively. Prior to and since then, the 'MEASAT' mark is prominently shown on and widely used in, amongst other things, the Complainants letter head, announcement cards and other forms of stationary, its marketing brochures, promotional materials and advertisements, not only in Malaysia but also in the Asian region. The Complainant is expanding its business worldwide and uses the trademark to promote and market its global business.

- that the trademark is also extensively used under license by the Complainant's authorised affiliated companies in their corporate names and in respect of their goods and services, including, but not limited to, the provision of Malaysia's first and currently, the only multi-channel, multi-lingual, Direct-To-User services by MEASAT Broadcast Network Systems Sdn. Bhd., a company affiliated with the Complainant. The extensive use and promotion of the trademark by the Complainant and its authorised affiliated companies have not only made the trademark well known but also symbolizes, identifies and distinguishes the goods and services marketed under the trademark by the Complainant and its authorised affiliated companies.

- that the Disputed Domain Name registered by the Respondent on August 7, 1998, is identical to the trademark, since the Disputed Domain Name fully incorporate the 'MEASAT' name.

- that the Respondent is not identified by the name "MEASAT" and does not conduct or operate any business marketed or known as "MEASAT" nor does the Respondent offer any goods or service under the "MEASAT" name or trademark.

- that the Disputed Domain Name is not being utilised by the Respondent in connection with a bona fide offering of goods or services. Instead, an Internet user logging on to the Disputed Domain Name would be redirected to other third party websites which previously had been a website offering pornographic materials and which is the "Yahoo.com" website.

- that the representatives of the Complainant and Respondent eventually met on April 13,2000, and in the said meeting the Respondent had acknowledged that when it registered the Disputed Domain Name in August, 1998, it was fully aware that the trademark belonged to the Complainant and is closely associated with and is widely used by the Complainant and its authorised affiliated companies.

- that the respondent had indicated that it would relinquish the Disputed Domain Name to the Complainant if he agrees to pay the right price. The Complainant had offered to reimburse the Respondent its out of pocket expenses in relation to the registration of the Disputed Domain Name. However the Respondent had rejected the offer and indicated that it would not be interested in an offer of nominal amount.

- that by registering the Disputed Domain Name, Respondent is preventing the complainant from legitimately registering a generic Top Level Domain under its trademark so as facilitate the global marketing of its business and services.

- that the use of the Disputed Domain Name by the Respondent, is diluting the unique and distinctive significance of the trademark and would cause serious and irreparable injury and damage to the Complainant as well as its authorised affiliated companies whose goods and services are marketed under the trademark. In addition, the use of the Disputed Domain Name by the Respondent, will create a likelihood confusion with the trademark, as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location, to which the users are redirected upon logging on to the Disputed Domain Name.

B. Respondent

The Respondent has not contested the allegations of the Complainant and is in default.

6. Discussions and Findings

Paragraph 15(a) of the Rules instructs this Panelist as to the principles the Panelist is to use in rendering its decision: "A panelist shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Applied to this case, Paragraph 4 (a) of the Policy directs that the complainant must prove each of the following:

(i) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) that the Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) that the domain name has been registered and used in bad faith.

A. Identity or confusing similarity

The complainant has produced copies of applications for registration of the trademark 'MEASAT' in Malaysia and Singapore, certificate of registration for the trademark 'MEASAT' in Brunei (Annexure E to the Complaint) and the Deed of Assignment dated July 22, 1998 in its favour by Binariang Berhad (Annexure D to the Complaint). The application for the registration of the trademark 'MEASAT' are pending in Malaysia and Singapore. The Trademark 'MEASAT' has been registered in Brunei. The domain name "measat.com" registered by Respondent is identical to Complainant's trademark MEASAT. The registrar Network Solution, Inc. has already confirmed vide its e-mail dated August 31, 2000, that the Respondent is the current registrant of the domain name at issue. The Administrative Panel finds that the domain name "measat.com" is identical to the trademark 'MEASAT'.

B. Rights or legitimate interests

The trademark 'MEASAT' has been used by the Complainant since 1998 and before 1998 it was used by the Binariang Berhad (formally known as Binariang Sdn. Bhd.), who has transferred all their rights in the favour of the Complainant vide Deed of Assignment dated July 22, 1998. A copy of Deed of Assignment dated July 22, 1998 and the Recordal of Assignment filed with each of the relevant Trade Mark office are attached as Annexure 'D' with the Complaint. The applications for registration of the Trademark are pending in Malaysia and Singapore. The trademark has been already registered in Brunei in favour of Binariang Sdn. Bhd. The Complainant has provided evidence of the applications made for the registration of trademarks and the certificate of registration of the trademark 'MEASAT' in the Braunei, filed as Annexure "E" to the complaint.

The Complainant is the owner and operator of telecommunications satellite known as the MEASAT satellite systems. The trademark MEASAT is also being used under license by the Complainant's authorised affiliated companies in their corporate names and in respect of their goods and services.

The Complainant has not given or agreed to give to the Respondent any authority, permission, license, consent or right to use the trademark 'MEASAT'. The Respondent has not contested this assertion. In the absence of any license from the Complainant to use the mark MEASAT or use any domain name incorporating the said trademark, no actual or bona fide use of the domain name could be made by the Respondent.

From particulars given in the Complaint, it seems that the Respondent is not commonly known by the domain name "measat.com".

The Respondent has failed to present any defense or evidence that would tend to establish that Respondent has legitimate interest in respect of the domain name. Accepting the assertions made in the Complaint to be correct, the Administrative Panel

finds that the Respondent has no rights or legitimate interests in the Domain name "measat.com".

C. Bad faith

The Respondent has failed to respond to the allegations made in the Complaint, and the panel is permitted to draw such inference therefrom as it consider appropriate, under paragraph 14(b) of the Rules.

The Respondent's failure to present any evidence must be considered on the issue of bad faith. Failure of a party to submit evidence on facts in its control permits me to draw an adverse inference regarding those facts. Here, the potential evidence of good faith registration and use was in Respondent's control. Respondent's failure to present any such evidence or to deny Complainant's allegations leads to the inference that the evidence would not have been favorable to Respondent or the Respondent accepts the allegations of the Complainant.

The requirement in Paragraph 4 (a) (iii) of the Policy is that the domain name "has been registered and is being used in bad faith" would be satisfied if the complainant proves that the registration was undertaken in bad faith and the circumstances of the case are such that the Respondent is continuing to act in bad faith.

Paragraph 4(b) of the Policy provides that for the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or he has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of his documented out-of-pocket costs directly related to the domain name; or

(ii) the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website or location or of a product or service on his website or location.

Network Solution, Inc. WHOIS search made on October 24, 2000, Annexure 'A' to the Complaint shows that the record in respect of the domain name "measat.com" was created on August 7, 1998. The Domain Name is not being actively utilized by the Respondent except that an Internet user logging on the Domain Name would be redirected to other website. A printout of the page appearing upon logging on at "http:\

www.measat.com" has been filed as Annexure F with the Complaint. The Complainant in the Complaint has stated that the Complainant offered to reimburse the Respondent its out of pocket expenses in relation to the registration of the Disputed Domain Name. The Respondent rejected the offer and indicated that it would not be interested in an offer of nominal amount. In the absence of any response from the Respondent and circumstances of the case, the panel accepts allegations of the Complainant and is of the opinion that Respondent wants to take the benefit of the goodwill of the Complainant and has registered the domain name for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark for valuable consideration in excess of his documented out of pocket cost, directly related to the domain name.

The Administrative Panel has considered whether, in the circumstances of this particular Complaint, the holding of the domain name by the Respondent amounts to the Respondent acting in bad faith. It concludes that it does. The particular circumstances of this case which lead to this conclusion are:

(i) the Complainant has substantially used the name and mark MEASAT since long and is the owner of the trademark MEASAT, covering various goods and services as given in the Complaint;

(ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name;

(iii) the Respondent is not commonly known by the domain name registered by it. The domain name at issue is not a registered business name of the Respondent;

(iv) Respondent has not been licensed to use the mark 'MEASAT' by the Complainant.

Therefore, the panel finds that the Respondent's holding of the domain name at issue amounts to an instance of bad faith under paragraph 4 (a) of the policy. The Respondents has registered and used the domain name in bad faith. The panel further finds that the complainant has proved the relevant elements of paragraph 4 (a) of the policy.

7. Decision

This Panel concludes that the Respondent owns a domain name "measat.com" identical to the Complainant's trademark MEASAT, has no rights or legitimate interests in respect of the domain name, and registered and used the domain name in bad faith. These facts entitle the Complainant to an order transferring the domain name from the Respondent. Panel allows the Complaint and directs that the Respondent's domain name "measat.com" be transferred in favour of the Complainant.

Ashwanie Kumar Bansal
Sole Panelist

Dated: November 6, 2000