



# Asian Domain Name Dispute Resolution Centre

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**(KUALA LUMPUR OFFICE)**

## **ADMINISTRATIVE PANEL DECISION**

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**Case No.** AIAC/ADNDRC-1211-2023  
**Complainant:** Bandar Utama City Centre Sdn Bhd  
**Respondent:** Choi Han  
**Disputed Domain Name(s):** <[1utama.net](http://1utama.net)>

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### **1. The Parties and Contested Domain Name**

The Complainant is **Bandar Utama City Centre Sdn Bhd**, of 1 Dataran Bandar Utama, Bandar Utama, PJU 6, Petaling Jaya, 47800 Selangor, Malaysia. The Complainant is a Company incorporated in Malaysia with its place of business in Selangor, Malaysia. The Complainant is represented by **LindaWang Su & Boo**, of Level 7, Menara Milenium, Jalan Damanlela, Pusat Bandar Damansara, 50490 Kuala Lumpur, Malaysia.

The Respondent is **Choi Han**, of No. 393-1, Jalan Pudu, 55100 Kuala Lumpur, Malaysia. The Respondent is not represented.

### **2. Domain Name and Registrar**

The domain name at issue is <[1utama.net](http://1utama.net)>; (the “**Domain Name**”), registered by the Respondent with **Namecheap.com, Inc, (the “Registrar”)**, of 4600 East Washington Street, Suite 305, Phoenix, AZ 85034, USA.

### **3. Procedural History**

3.1 The Complaint dated 3 July 2023 was filed with the Kuala Lumpur Office of Asian Domain Name Dispute Resolution Centre (“**ADNDRC**” the “**Centre**”) on 6 July 2023.

3.2 On 17 July 2023, the Centre sent an email requesting the Registrar to provide information related to the Domain Name registration verification within two (2) days, by 19 July 2023.

- 3.3 On 20 July 2023, the Centre sent a follow-up email requesting the Registrar to provide the Domain Name registration verification.
- 3.4 On 20 July 2023, the Registrar replied by email to the Centre its verification response with details of the information, which was withheld under the Privacy Service of the Domain Name. The information included the Contact ID, Administrative, Technical, and Billing Contact details of the Named Registrant. The Registrar confirmed that the language of the Registration Agreement was English.
- 3.5 The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “**Policy**” or “**UDRP**”), the Rules for UDRP, and the ADNDRC Supplemental Rules for UDRP (the “**Supplemental Rules**”). Accordingly, the Centre fixed 18 July 2023 as the date of the commencement of the administrative proceedings.
- 3.6 On 20 July 2023, the Centre, in accordance with the Rules, Paragraphs 2 and 4, notified the Respondent of the Complaint and the date of the commencement of the proceedings as 18 July 2023. In accordance with the Rules Paragraph 5, the Centre fixed the due date for the response as on or before 7 August 2023. The Respondent did not submit any reply.
- 3.7 On 9 August 2023, the Centre invited Jayems, Dhingra Jag Mohan, to confirm availability to be the Sole Panellist for this matter. The Panellist confirmed availability and submitted the Statement of Acceptance, Declaration of Impartiality, and Independence, as required by the Centre, to ensure compliance with Paragraph 7 of the Rules.
- 3.8 On 10 August 2023, the Centre confirmed the appointment of the Sole Panellist and notified the Parties. Therefore, the Panel finds that it was properly constituted.

#### 4. Factual background

- 4.1 The Complainant is a Company incorporated in Malaysia with its place of business and address in Malaysia. The Complainant is in the business of owning and managing shopping centers in Malaysia. The Complainant and its related entities under the Bandar Utama City Corporation Group in Malaysia, including Bandar Utama City Corporation Sdn. Bhd. and 1 Utama Shopping Centre Sdn. Bhd. (collectively referred to as “**BUCC Group**”) operate under the “1 UTAMA” mark in Malaysia.
- 4.2 The Complainant is the registered owner of the Trademark “1UTAMA,” as evidenced by the list of the Trademark Certificates provided by the Complainant and issued by the Trademark Registry, *Perbadanan Harta Intelekt Malaysia, Intellectual Property Corporation of Malaysia* (“**MyIPO**”) summarized in Table–1.

**Table-1: Summarized List of Trademarks Registered with MyIPO and Current Status****Applicant: Bandar Utama City Centre Sdn Bhd (BUCC)**

#	Trademark No.	Nature of Trademark	Class	Application Filed Date	Current Status
1	TM2019012559	Word & Figurative	35	5 Apr 2019	Registered
2	TM2019012560	Word & Figurative	36	5 Apr 2019	Registered
3	TM2019012561	Word & Figurative	41	5 Apr 2019	Registered
4	TM2019012562	Word & Figurative	43	5 Apr 2019	Registered
5	TM2022005977	Word (1 UTAMA)	9, 16, 25, 35, 36, 39, 41, 43	9 Mar 2022	Provisional Refusal (Objection)- Hearing
6	TM2022010175	Stylized Word Mark	9, 16, 35, 36, 41, 43	21 Apr 2022	Provisional Refusal (Objection) - Hearing
7	TM2022010178	Word & Figurative	9, 16, 35, 36, 41, 43	21 Apr 2022	Registered
8	TM2022010179	Word & Figurative	9, 16, 35, 36, 41, 43	21 Apr 2022	Provisional Refusal (Objection) - Hearing
9	TM2022010181	Word & Figurative	9, 16, 35, 36, 41, 43	21 Apr 2022	Registered
10	TM2023012936	Word (ONE UTAMA)	43, 44	10 May 2023	Under Formality Validation
11	TM2023012937	Word (1 UTAMA)	43, 44	10 May 2023	Under Formality Validation
12	TM2013007332	Word & Figurative	36	27 May 2013	Registered
13	TM2013007331	Word & Figurative	43	27 May 2013	Registered
14	TM2016008769	Word & Figurative	41	16 Aug 2016	Registered
15	TM99003051	Word & Figurative	35	12 Apr 1999	Registered

4.3 The Respondent did not submit a response, and its factual background is not known. However, it is confirmed by the Registrar that the Respondent is the registrant of the Domain Name <1utama.net>, and the registration expires on 27 October 2023. The Respondent's address is No.393-1 Jalan Pudu, 55100, Kuala Lumpur, Malaysia. The Domain resolves to an active website.

## 5. Parties' Contentions

### A. Complainant

5.1 The Complainant seeks that the Domain Name be transferred to the Complainant. The Complainant's contentions and the Complaint are made on the following factual and legal grounds, emphasized in detail in the UDRP Complaint Form and Annexures:

5.1.1 The Domain Name is identical or confusingly similar to its well-known trademarks under which various Classes of goods and services are offered for commerce in Malaysia.

5.1.2 The Complainant contended that pursuant to Regulation 5 of the *Trademarks Regulations 2019* ("TMR"), the Complainant's marks meet the criteria of a well-known mark in Malaysia.<sup>1</sup> Therefore, extensive use and promotion of the 1 UTAMA Marks in Malaysia are well-known and exclusively synonymous with the Complainant's and BUCC Group's business, goods, and services. The Complainant contended that the 1 UTAMA Marks are highly valued and recognised, which the Complainant strives to protect.

5.1.3 The Complainant has registered ten (10) trademarks, and five (5) trademark applications are under review in Malaysia. The BUCC Group has been operating the 1Utama Shopping Centre since 1995, housing more than 700 shops.

5.1.4 The Complainant submitted that the earliest 1UTAMA Marks were registered as of 12 April 1999, long before the disputed Domain Name was registered on 27 October 2022. So, the Respondent would be fully aware of the significant reputation of the Complainant and its trademark, 1UTAMA.

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<sup>1</sup> See Regulation 5 of the TMR 2019, Criteria of well-known trademarks:

5. In determining whether a trademark is well-known in Malaysia, the Registrar or the Court shall have regard to the following criteria:
  - a) the extent of knowledge or recognition of the trademark in the relevant sector of the public;
  - b) the duration and extent, and geographical area of any use of the trademark;
  - c) the duration and extent of any promotion of the goods or services where the trademark applies and the geographical area where the promotion is carried out;
  - d) the duration and place of registration, or duration and place of application for registration, of the trademark, to the extent that they reflect use or recognition of the trademark;
  - e) the record of successful enforcement of rights in the trademark, in particular, the extent to which the trademark was recognized as well-known by competent authorities; and
  - f) the value associated with the trademark.

- 5.1.5 The Complainant stressed that the dominant and consistent feature of 1UTAMA Marks is used in the infringing and disputed Domain Name, as was in the case of *Telekom Malaysia Berhad & Anor v CA Multimedia Sdn Bhd & Ors* [2019] 1 LNS 2005.<sup>2</sup>
- 5.1.6 The Complainant submitted that the Respondent has no rights or legitimate interests in the Domain Name. The Complainant relies on the case of *Educational Testing Service v. TOEFL*, WIPO Case No. D2000-0044 contended that mere domain name registration is insufficient to establish rights or legitimate interests.<sup>3</sup>
- 5.1.7 The Complainant contends that the Respondent has registered and used the Domain Name in bad faith. In light of the well-known character of the Complainant's Trademarks, it is inconceivable that the Respondent was not aware of the Complainant's Trademarks when it registered the Domain Name and used the building façade of the 1UTAMA Business on its website.
- 5.1.8 The Complainant submitted further arguments to support the issue of bad faith by relying on the cases of *Petróleo Brasileiro S.A. - Petrobras v. Lirong Shi* WIPO Case No. D2013-2077 and on the issue of Passing Off relying on the Malaysian High Court case of *Petroliam Nasional Bhd (Petronas) & Ors v Khoo Nee Kiong* [2003] 4 MLJ 216, pg. 246.
- 5.1.9 The Complainant submitted the screenshots of the Respondent's website using the disputed Domain Name bearing the trademarks of the Complainant to show that the Domain Name is registered and being used in bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Findings**

- 6.1 The Complainant initiated the proceedings in English. The Respondent did not provide any response. The language of the Disputed Domain Registration Agreement is also English. Therefore, the Panel finds that in accordance with Paragraph 11(a) of the Rules, the language of this administrative proceeding shall be English.
- 6.2 In view of the lack of a response filed by the Respondent as required under Paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual submissions.

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<sup>2</sup> See UDRP Complaint Form Annexure-F at [72].

<sup>3</sup> See UDRP Complaint Form Annexure-G.

For the Complainant to succeed, the Complainant must prove as per Paragraph 4(a) of the ICANN Uniform Domain Name Dispute Resolution Policy (“**UDRP**”) that each of three findings must be made in order for the Complainant to prevail:

- i. Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent’s domain name has been registered and is being used in bad faith.

Therefore, only if all three elements above have been fulfilled can the Panel grant the remedies requested by the Complainant. The Panel deals with each of the requirements in turn hereafter.

### **A) Identical or Confusingly Similar**

6.3 Pursuant to Paragraph 4(a)(i) of the Policy, the Complainant must show that the Domain Name is (1) identical or confusingly similar to a trademark or service mark, (2) in which the Complainant has rights. Concerning having rights, the Complainant has submitted Trademark Registration Certificates from *MyIPO*, per the details above in Table – 1. It is noted from the review of the Trademarks Certificates that the Complainant is the registered owner of the Trademarks.

6.4 The Complainant submitted that the BUCC Group also has the registration of the domain names “1utama.com.my” and “1utama.my.”

6.5 Pursuant to section 1.2.1 of the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”)*, where the Complainant holds a nationally or regionally registered trademark or service mark this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.

6.6 The Complainant has provided factual and legal submissions to show that its Marks are well-known marks. The rights of a well-known mark owner are established under Regulation 5 of the TMR, and also the legal jurisprudence, as in the case of *Telekom Malaysia v CA Multimedia*, to show that the effect of *.net* should be disregarded.

6.7 Accordingly, the Panel finds that the Complainant has proved its rights to the Trademarks used in the disputed Domain Name.

6.8 On the first element part (1) for assessment of identical or confusing similarity of the Domain Name with the Trademarks, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Complainant’s Trademarks and the disputed Domain Name. In cases where a domain name incorporates the entirety of a trademark, the domain name will

normally be considered confusingly similar to that mark.<sup>4</sup> Further, “Where the relevant trademark is recognisable within the disputed domain name, adding other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”<sup>5</sup>

6.9 In the present case, the Complainant’s Trademark is incorporated in its entirety in the disputed Domain Name with Top Level Domain (“TLD”) “.net” and making it “1utama.net.” It is well established that the addition of the generic Top-Level Domain (“gTLD”) “.com,” “.net,” and any other letters before or after the Complainant’s Trademark does not prevent a finding of confusing similarity with the Trademarks.<sup>6</sup>

6.10 The disputed Domain Name is confusingly similar to the Complainant’s trademarks 1UTAMA and . Since “.net” is not taken into account in the comparison, “1utama” is the main part of the disputed Domain Name, of which “1utama” is identical to the Complainant’s well-known and reputed 1UTAMA trademarks. This is the central and distinguishing element of the disputed Domain Name, as it will give the impression to the relevant public of being the same as the Complainant’s website.

6.11 Therefore, having considered the above reasons, the Panel finds that the requirement under paragraph 4(a)(i) of the Policy has been satisfied.

## **B) Rights or Legitimate Interests**

6.12 Pursuant to paragraph 4(c) of the Policy, any of the following circumstances, in particular, but without limitation, if found by the Panel to be proved based on the evidence, shall demonstrate a respondent’s rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organisation) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial or fair use of the domain name without intent for commercial gain to divert consumers misleadingly or to tarnish the trademark or service mark at issue.

6.13 The Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name. It is usually sufficient for a complainant to make

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<sup>4</sup> See Section 1.7 of the WIPO Overview 3.0.

<sup>5</sup> See Section 1.8 of the WIPO Overview 3.0.

<sup>6</sup> See section 1.11 of the WIPO Overview 3.0.

out a prima facie case that a respondent lacks rights or legitimate interests. If a complainant does establish a prima facie case, the burden of production of evidence shifts to the respondent (section 2.1 of WIPO Overview 3.0).

- 6.14 The Complainant's contentions and the evidence on file shows that the Respondent has not been linked or commonly known by the Domain Name. The Complainant also contends, and the Respondent did not submit any response to deny, that the Complainant did not authorize the Respondent's use of the Complainant's trademark in the Domain Name or has any relationship with the Complainant. Based on the evidence of the Respondent's use of the Domain Name, it does not satisfy the requirements of a bona fide offering of goods and services. The Respondent has used the Domain Name to point to a website showing a static picture substantially similar to the Complainant's 1UTAMA trademarks and a login page without any details on the nature of goods or services being offered.
- 6.15 Based on the use of the Complainant's trademark in the Domain Name and substantial similarity between the Complainant's website and trademarks, the Panel concludes that the Domain Name suggested affiliation between the Complainant and the Respondent, which did not amount to bona fide offering of services or legitimate fair use. Once a complainant makes a *prima facie* case, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name.
- 6.16 The Complainant contended that the Google search leads to only the website and services of the Complainant's businesses, and no results were found leading to the disputed Domain Name.
- 6.17 However, by defaulting, the Respondent has failed to rebut the Complainant's prima facie case and demonstrate its rights or legitimate interests in the Domain Name. The Panel finds that the Complainant has satisfied the second element of the UDRP.
- 6.18 Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name, and the requirement of Paragraph 4(a)(ii) is fulfilled.

### **C) Registered and being Used in Bad Faith**

- 6.19 Under paragraph 4(a)(iii) of the Policy, a complainant must show that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy lists four non-exhaustive circumstances which may be considered evidence of registration and use of a domain name in bad faith.
- 6.20 In the Complaint, the Complainant has provided screenshots of a Google Search of its Trademark. The search results all point to the Complainant's website and the website linked to services or places of public interest near the

Complainant's shopping centre. The disputed Domain Name by which the Respondent impersonates the Complainant by mimicking its Trademark appears to show a relationship or resemblance for agents of the Complainant, which would amount to bad faith. Paragraph 4(b)(iv) of the Policy gives an example of similar circumstances of bad faith:

- (iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

- 6.21 In view of the substantial similarity of pictures and names on the Complainant's website linked to the disputed Domain Name and the registration date (27 October 2022) of the disputed Domain Name, the Panel is persuaded by the Complainant's contention that "it can be reasonably inferred that the Respondent was aware of the Complainant's prior trademarks on 1UTAMA and its websites besides nationwide popularity of its trademarks well before registering the Disputed Domain Name."<sup>7</sup>
- 6.22 The Complainant relies on the WIPO case of *Petrobras v Lirong Shi* and the Malaysian High Court case of *Petronas v Khoo Knee Kiong*, submitted that the Respondent's actions are an apparent infringement of its trademarks and an act of passing off, which tantamount to bad faith.
- 6.23 Having considered the evidence presented and submissions made, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith. Thus, the Complainant has proved the third element of Paragraph 4(a)(iii) of the Policy.

## 7. Decision

For the foregoing reasons, and in accordance with Paragraphs 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the Domain Name <1utama.net> be transferred to the Complainant, forthwith.



**Jayems, Dhingra Jag Mohan**

Sole Panellist

*LL.M. (IP Laws), WIPO Neutral*

Dated: 16 August 2023

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<sup>7</sup> See Complaint Form Annexure – A and Annexure – I.