

**Asian Domain Name Dispute Resolution Centre
Kuala Lumpur Regional Centre for Arbitration**

Case ID: KLRCA/ADNDRC-368-2016

In the Matter of a Domain Name Dispute
And in the Matter of the Uniform Domain Name Dispute Resolution Policy

Between

Genting International Management Limited

Complainant

And

Francois Potvin

Respondent

The Parties

The Complainant is Genting International Management Limited, (“the Complainant”) a registered company having its registered office at Douglas, Isle of Man represented by Bahari Yeow Tien Hong of Kuala Lumpur, Malaysia.

The Respondent is Francois Potvin (“the Respondent”) of Quebec Canada.

Domain Names in Dispute

The domain names in dispute are <gentingbirmingham.com>, <gentingglasgow.com>, <gentingleeds.com>, <gentingmanchester.com> and <gentingnovomatic.com>.

The Registrar

The Registrar of the disputed domain names is NameSilo, LLC (“the Registrar”).

Procedure

On January 29, 2016 the Complainant filed a Complaint with the Kuala Lumpur Office of the Asian Domain Name Dispute Resolution Centre (“the Centre”) pursuant to the Uniform Domain Name Dispute Resolution Policy (“the UDRP”), 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”) and the Centre acknowledged receipt of the Complaint by email.

On January 31, 2016, the Centre advised the Respondent that it had reviewed the Complaint for administrative compliance in accordance with Paragraph 4(c) of the Rules and Article 7 of the Supplemental Rules and further advised that the Registrar had confirmed that the disputed domain names are registered by Respondent.

On February 4, 2016 the Complainant submitted a timely revised Complaint.

On February 5, 2016 the Centre notified the Respondent that the Complaint had been submitted on January 29, 2016; that the UDRP applied to the registrations of the disputed domain names; that in accordance with the UDRP the Respondent is required to submit to mandatory proceedings; that the administrative proceeding commenced on February 5, 2016; that the Respondent was required to submit a Response by February 25, 2016. The notice provided links to the UDRP, the Rules and the Supplemental Rules.

On February 26, 2016 the Centre advised the Parties by email that no Response had been submitted by the Respondent within the required period of time and that the Centre would proceed to appoint a Panelist.

On February 29, 2016 the Centre appointed James Bridgeman ("the Panel") as sole panelist and advised the Parties accordingly. The Centre further advised in accordance with paragraph 6(f) of the Rules that absent exceptional circumstances, a decision will be rendered by the Panel on or before March 14, 2016.

Subsequent to his appointment, the Panel received communications from both the Respondent, on February 29, 2016 and March 8, 2016 and the Complainant, on March 7, 2016. Said communications had been sent to the Centre by email and copied ("cc") to the Panel.

This Panelist certifies that proper procedures have been followed by the Centre. He confirms that in accordance with paragraph 7 of the Rules that he is impartial and independent and that prior to accepting this appointment he has confirmed to the Centre that there are no circumstances giving rise to justifiable doubt as to his impartiality or independence. He further confirms that since his appointment no new circumstances arise that could give rise to justifiable doubt as to his impartiality or independence.

Factual Background

The Complainant is an investment holding and management company and is part of a group of companies engaged in the leisure, hospitality, gambling and other businesses in a number of jurisdictions across the world. The Complainant is the owner of the GENTING trademark for which it holds the following trademark registrations:

- Malaysia trade mark GENTING, registration number 07018137, registered on September 28, 2007 in respect of services on class 41;
- Singapore trade mark GENTING, registration number T0719741F, registered on October 2, 2007 in respect of services in class 41.
- U.K. trade mark GENTING, registration number 2360561, registered on April 8, 2004 for goods and services in classes 16, 28, 41 and 43;
- U.S.A. trademark GENTING, registration number 3,683,708 registered on September 15, 2009 for goods and services in international classes 16, 41 and 43.

In the absence of a Response there is no information available about the Respondent, except that which has been provided on the Registrar's Whois and in the Complaint.

The disputed domain names were all created on December 14, 2015.

Parties' Submissions

Complaint

The Complainant relies on its above-listed registrations for the GENTING mark which it states are used by its group of companies in its core leisure, hospitality and casino businesses and other diversified investments including oil palm plantations, power generation, oil and gas, property development, cruise shipping, biotechnology in the United States of America, the United Kingdom, China, Singapore, Malaysia and other jurisdictions.

The Complainant argues that it has acquired a substantial goodwill and reputation in the GENTING mark through such use and has provided its group annual report for the year 2014 as evidence of its extensive business operations.

The Complainant submits that it has an established Internet presence, and points in particular to its website at <www.gentingcasinos.co.uk> which provides information about its casino chain in the United Kingdom, <www.resortsworldbirmingham.co.uk> which promotes its activities in Birmingham and other locations across the United Kingdom including casinos, hotels, cinemas, bars and restaurants, and <www.gentinghotel.co.uk> which also promotes its business in the United Kingdom.

The Complainant submits that it has won numerous industry awards and since January 2015 has sponsored the GENTING Arena in Birmingham, which is the second largest sporting arena in the United Kingdom.

The Complainant submits that the disputed domain names are confusingly similar to the GENTING trademark as they each consist of the GENTING mark in combination with the names of cities in the United Kingdom and in one instance the word "novomatic".

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain names arguing that the Complainant has used the GENTING mark since as early as 1965; that the Complainant did not authorise or consent to the Respondent's use of the GENTING mark or the registration of the disputed domain names which incorporate the GENTING mark.

The Complainant submits that such unauthorised use of its trademark is unlawful and deceptive in that any use of the disputed domain names are likely to deceive Internet users into believing that the disputed domain names belong to the Complainant or are in some way associated with the Complainant's business with consequent damage to the Complainant's goodwill, and reputation and the dilution of the Complainant's mark.

The Complainant submits that the disputed domain names were registered in bad faith, arguing that because of its extensive reputation and goodwill the registrant must have had actual knowledge of the Complainant's rights in the GENTING mark when the disputed domain names were registered. The Complainant further submits that the Respondent acted in bad faith by hiding his details behind a privacy shield.

Response

There was no Response submitted.

Preliminary Issue – Communications and Request for Extension of Time

Subsequent to the appointment of the Panel, the Respondent sent an email communication to the Centre on February 29, 2016 to which the Complainant responded on March 7, 2016 and there was a rejoinder by the Respondent on March 8, 2016. These communications were uninvited, sent by the Parties to the Centre and copied *inter alia* to the Panel. In said communications the Respondent requested an extension of time to file a Response for medical reasons. The Complainant objected and submitted that the Panel should not consider the Respondents late application.

This Panel has considered these communications, in the interest of fair procedures and decides that they should not be admitted for consideration because:

1. Said communications are in breach of paragraph 8 of the Rules which states: *“No Party or anyone acting on its behalf may have any unilateral communication with the Panel. All communications between a Party and the Panel or the Provider shall be made to a case administrator appointed by the Provider in the manner prescribed in the Provider’s Supplemental Rules.”* and paragraph 4 of the Supplemental Rules which provides: *“Where a Party intends to send any communications to the Panelist(s), it shall be addressed through the Office of the Centre which the Complainant has selected to administer the proceedings.”*
2. The Parties could have, and should have, communicated directly with the Centre without copying the Panel;
3. As they do not comply with the Rules and the Supplemental Rules, it would be inappropriate to admit such communications absent exceptional circumstances;
4. On February 5, 2016, the Respondent was notified of the requirement to provide a Response on or before February 25, 2016 and delayed making his request for an extension of time until February 29, 2016, after the deadline had expired, after he had been notified that the Centre was proceeding to appoint a panel and only when he was notified of the appointment of the Panel.
5. The Respondent has not provided any evidence supporting his assertions relating to his illness nor has he indicated that he has any substantive defence to the Complaint.
6. To consider the application in such circumstances would prejudice both this administrative procedure and the Complainant.

Discussion and Reasoning

Paragraph 4 of the UDRP requires the Complainant to establish in respect of each disputed domain name that:

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

Identity or Confusing Similarity

The Complainant has provided evidence to prove its ownership of the GENTING trademark through the above-listed registrations and the goodwill it has acquired in the mark through its extensive use

by the Complainant and its associated companies within its group in the leisure, hotels, gambling and other businesses.

Having compared each, this Panel finds that the disputed domain names are confusingly similar to the Complainant's GENTING mark.

The domain names <gentingbirmingham.com>, <gentingglasgow.com>, <gentingleeds.com> and <gentingmanchester.com> consist of a combination of the Complainant's mark in its entirety together with the name of a city in the UK. The Complainant's mark is the dominant element in these combinations, because of its distinctive character. The addition of the city names do not serve to distinguish the domain names in any way and because the Complainant has established businesses in many cities in the UK, they merely serve to add to the likelihood of confusion in the minds of Internet users.

The <gentingnovomatic.com> domain name consists of the Complainant's mark in its entirety in combination with the word "novomatic". On the balance of probabilities Internet users would be confused into believing that there is an association between the Complainant's mark and the domain name because the GENTING mark is both the first and a distinctive element element of the domain name.

In these circumstances, this Panel finds that each of the disputed domain names is confusingly similar to the GENTING mark in which the Complainant has rights and the Complainant is entitled to succeed in the first element of the test in paragraph 4(a) (i) of the UDRP.

Rights and Legitimate Interest

The Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interest in the disputed domain names, arguing that the disputed domain names are confusingly similar to its GENTING mark; that the Complainant has used the GENTING mark since 1965 which predates the registration of the disputed domain names; that the Complainant did not authorise or consent to the Respondent's use of the GENTING mark in either a domain name or a trademark; and that the Respondent must have had actual knowledge of the Complainant's rights in the GENTING mark.

It is well established under the Policy that where, as in the present case, a Complainant makes out a *prima facie* case that the Respondent has no rights or legitimate interest in the disputed domain names the burden of production shifts to the Respondent to show that he has such rights or legitimate interest.

In the absence of a Response, there is no information about the Respondent except for that provided in the Whois and the Complaint. Having considered the file, this Panel finds on the balance of probabilities that the Respondent, who has no association with the Complainant which is the owner of the GENTING mark, has not used the disputed domain names in connection with any *bona fide* offering of goods or services nor has he been commonly known by the domain names or any of them. Furthermore there is no evidence that the Respondent has made any legitimate non-commercial or fair use of the disputed domain names.

The Respondent has failed to discharge the burden of production and so this Panel finds that the Complainant is entitled to succeed in the second element of the test in paragraph 4(a) (ii) of the UDRP as the Respondent has no rights or legitimate interest in the disputed domain names.

Bad Faith Registration and Use

The Complainant has proven that it has acquired a substantial reputation in the use of the GENTING mark in a number of jurisdictions across the globe. The Complainant's profile in the UK in particular has been strengthened since January 2015 by its sponsorship of the GENTING Arena sporting venue in Birmingham.

Given the similarity of the disputed domain names and the Complainant's GENTING mark, and the distinctive character of the GENTING mark, this Panel finds that on the balance of probabilities the registrant of the disputed domain names was aware of the Complainant's GENTING mark when the disputed domain names were chosen and registered and in fact the disputed domain names were chosen and registered because of their inherent reference to, and potential for association with the Complainant and its GENTING marks.

The disputed domain names were registered on December 14, 2015, many years after the Complainant established its international reputation. There is no evidence that the disputed domain names have at any time resolved to an active website and they appear to be passively held by the Respondent. When this passive holding is considered in combination with other factors in this case and in particular the international reputation of the GENTING mark, the fact that one of the domain names specifically combines the GENTING mark with the name of the city of Birmingham where the Complainant sponsors a famous arena, the fact that the Respondent has failed to submit a Response within the time set by the Rules and the fact that the Respondent sought to conceal his identity through a privacy shield, it leads to the inevitable conclusion that the disputed domain names have been registered and are being passively used in bad faith in order to take predatory advantage of the Complainant's goodwill and reputation in the GENTING mark.

The Complainant has therefore satisfied the third and final element of the test in paragraph 4(a) (iii) of the UDRP and is entitled to succeed in the Complaint.

Decision and Order

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, this Panel orders that the disputed domain names <gentingbirmingham.com>, <gentingglasgow.com>, <gentingleeds.com> <gentingmanchester.com> and <gentingnovomatic.com> be transferred to the Complainant.



Signed:

James Bridgeman
Panel

Date:

March 9, 2015

Place:

Dublin, Ireland