



IN THE MATTER OF A DOMAIN NAME DISPUTE

Between

PACKET ONE NETWORKS (MALAYSIA) SDN BHD [Complainant]

And

WARTOG ID [Respondent]

Case ID: KLRCA/ADNDRC-2-2012

1. The Parties

- 1.1. The Complainant is Packet One Networks (Malaysia) Sdn Bhd, with an address at Packet Hub, Level G, Lot 159, Jalan Templer, 46050, Petaling Jaya, Selangor, Malaysia.
- 1.2. The Respondent is Wartog id, with its address at No. 1 Jalan Setiakasih 9, Bukit Damansara, Damansara, 60000 Kuala Lumpur, Malaysia. At the present time the Respondent is the registrant of the domain "www.p1wimax.net".

2. The Domain Name and Registrar

- 2.1. The Domain Name in issue is "www.p1wimax.net", and the Registrar of this domain is GODADDY.COM, LLC ("the Registrar").

3. Procedural History

- 3.1. The Complaint was filed on 20 June 2012 with the Asian Domain Name Dispute Resolution Centre (Kuala Lumpur Office) ("the Centre"). On 3 July 2012, the Centre transmitted a request to the Registrar for verification regarding the identity of the domain name holder of www.p1wimax.net. The Registrar, on 4 July 2012 transmitted its response confirming that the Respondent is listed as the registrant of the domain name, and provided its contact details.
- 3.2. I am satisfied that the Complaint is complete and satisfies the formal requirements of the Uniform Domain Name Dispute Resolution Policy

(UDRP) and the Uniform Domain Name Dispute Resolution Policy Rules (UDRP Rules) approved for implementation by ICANN on 26 August, 1999 and 24 October, 1999 as well as the ADNDRC Domain Name Dispute Supplemental Rules adopted by the ADNDRC. The Centre, by a letter of 6 August 2012, provided me with the following documents:

- 3.2.1. Complaint Transmittal Coversheet and Form C;
 - 3.2.2. New Case Notification to Registrar dated 3 July 2012;
 - 3.2.3. Email dated 4 July 2012 from the Registrar;
 - 3.2.4. Notification of Commencement of Proceedings dated 12 July 2012.
- 3.3. The Respondent did not submit any Response to the Complaint.
- 3.4. The Centre appointed me as the sole panelist in this matter. I have submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with the Rules.
- 3.5. The Complainant seeks the remedy of having the domain "www.p1wimax.net" transferred to it.

4. Parties' Contentions

- 4.1. The Complainant contends, among others, that:
- a) its legal status to maintain this complaint is from its ownership of the trademarks "P1" and "P1 Wimax", among others. It is to be noted that these and some other marks bearing "P1" or its likeness have yet to be registered, although the applications seeking registrations thereof had been filed. For the present purposes, and for brevity, I shall refer to them collectively as the "Trademarks". The Complainant has said that it is also known as "P1", a matter only asserted and not specifically proven in the documents submitted. I draw no conclusions with respect to how the Complainant is known, but accept that "P1" is a mark for which registration as a trademark is being sought by the Complainant.

- b) The history of the Complainant dates back to 2002. The Complainant claims that in 2008, it pioneered the 4G WiMAX service in Malaysia. This 4G WiMAX deployment is claimed to be the first large scale commercial deployment in Southeast Asia. In 2007, the Complainant was one of the four companies awarded the 2.3 GHz spectrum licence by the Government of Malaysia to deploy WiMAX services throughout Malaysia.
- c) The Complainant asserts that since its entry into the Malaysian market, it has received a number of recognitions for its achievements. I do not propose to list them out, but will say that they have been set out paragraph 8(a) of Form C.
- d) The Complainant claims to have also secured the domain name "p1.com.my" as set out in Exhibit 3 to Form C. I have perused this Exhibit 3, and notice that the registrant for this domain is Packet One Network (Malaysia) Sdn Bhd (Co. 534942-H). The Complainant's name comes with an "s" in "Networks", and the email contact given uses the domain "packet-1.com", and not "p1.com.my". I will add however that the administrative contact person (of "p1.com.my") has an address that is the same as that of the Complainant's i.e. at 159 Jalan Templer, albeit located on a different floor from that of the Complainant. The Complainant has not provided its company registration number, and I am thus unable to verify if the Registrant of "p1.com.my" is indeed the Complainant itself. I therefore am unable to place any weight on Exhibit 3.
- e) Additionally, the Complainant has exhibited a number of promotional literature and materials to show that it has extensively used "P1 WiMAX". These are exhibited collectively as exhibit 4 to Form C. I have carefully perused the documents in Exhibit 4, and find that they relate to materials which used the following marks: "P1", "P1 W1MAX", "P1 w1max". The numeral "1" is used in place of the alphabet "I" in WiMAX. Based on these documents, I find that the Complainant has not proved its use of P1 WiMAX.

- f) The Complainant alleges that on or about 25 February 2012, it discovered that the Respondent had registered the domain name "p1wimax.net". The Complainant also exhibited the screenshots of some pages in this domain that the Complainant alleges to be offensive, and calculated to disparage the Complainant's products and services. The Complainant further alleges that this website is used mainly to tarnish the Complainant's goodwill and reputation in the P1 and P1 WIMAX trademarks. The Complainant considers that the *"Respondent has published many slanderous statements (sic) and unfounded allegations about the business and services of the Complainant"*. The Complainant also says that the website adopts a trademark identical to the *"Applicant's"* (sic). In addition, the Complainant alleges that *"due to the similarity between www.p1.com.my and www.p1wimax.net" the offending name is likely to cause confusion, mistake and to deceive as to affiliation or association of the Respondent with the Complainant"*.
- g) With respect to the domain "www.p1wimax.net", I do not find that it uses a mark identical to P1W1MAX used by the Complainant. From the postings in the allegedly offending website "www.p1wimax.net", however, I find that substantially these postings refer to the P1 Wimax services, and these they (the posters) consider to be that offered by the Complainant under the mark P1 W1MAX.
- h) Further, I am unable to conclude that there is similarity between the two domain names, "www.p1.com.my" and "www.p1wimax.net". There may be similarity between "P1W1MAX" and "p1wimax", but I cannot consider "p1.com" to be of the same genus.

5. 1st Requirement - Whether the domain name is identical to or confusingly similar to a trademark or service mark in which the Complainant has rights

- 5.1. To satisfy this requirement, two elements need to be present. The Complainant must show that it has rights to a trademark or service mark, and that the domain name is identical or confusingly similar to this trademark or service mark.
- 5.2. In the Complaint, the Complainant asserted that its legal status to maintain the Complaint is by virtue of it being the Owner of the Trademarks.
- 5.3. One of the Trademarks is "P1 Wimax". Ownership of a trademark is not proved by a pending application for registration of the trademark. "WIMAX" or "Wimax" in any event is an acronym for "Worldwide Interoperability for Microwave Access". I therefore have grave reservations as to whether or not the Complainant can claim exclusive rights to the use of "WIMAX" or "Wimax". However, as I have alluded to above, this "Wimax" or "WIMAX" mark is not used in the Complainant's marketing literature. The Complainant used "P1 W1MAX" and "P1 w1max".
- 5.4. In the circumstances, based on available evidence, I find that the Complainant has not proved rights to the trademark "P1 Wimax" .
- 5.5. However, considering the Complainant's marketing literature which used "P1 W1MAX" as trademark, I find that the Complainant has rights to a mark (P1 W1MAX) that is similar to "P1wimax".
- 5.6. As I mentioned earlier, the postings in the website www.p1wimax.net refer to the WIMAX services offered by the Complainant using the mark "P1 W1MAX".
- 5.7. For these reasons, I find that the Complainant has satisfied to first requirement that is the Complainant has rights to the trademark "P1 W1MAX", and that the domain "www.p1wimax.net" is confusingly similar to the "P1 W1MAX" mark.

6. 2nd Requirement – that the Respondent has no rights or legitimate interests in respect of the domain name

- 6.1. The Respondent has not submitted any response or reply to the Complaint. In the absence of any response, I am unable to find that the Respondent has rights to or in respect of the domain name.

- 6.2. Whether or not the Respondent has any legitimate interests in respect of the domain name can be examined by looking at purpose(s) for which the domain was set up. I accept the Complainant's contention that the domain was set up to be used as a forum to criticise the Complainant's alleged poor service.
- 6.3. The Complainant has referred to a number of decisions of administrative panels. These decisions effectively suggest the following:
- 6.3.1. That it is legitimate to set up a domain for the purposes of lawful criticism of a trademark owner;
 - 6.3.2. That this right (to criticise) does not extend to occupying a domain name identical to a sign identifying a trademark owner;
 - 6.3.3. That the right to express one's views is not the same as the right to use another's name to identify one's self as the source of those views;
 - 6.3.4. That a right to express (or a legitimate interest in expressing) critical views is different from a right or legitimate interest in respect of a domain name;
 - 6.3.5. That to fully exercise free speech rights, one does not need to be dispensed with using someone else's identical or confusingly similar trademark.
- 6.4. The above are collectively distilled from the decisions in *1066 Housing Association Ltd v Mr D Morgan Case No. D2007-1461*; *Skattedirektoratet v Eivind Nag, WIPO Case No. D2000-1314*; *Monty & Pat Roberts Inc v J Bartell, WIPO Case No. D2000-0300*; *Tridos Bank NV v Ashley Dobbs, WIPO Case No. D2002-0776*; *The Royal Bank of Scotland Group plc, National Westminster Bank plc aka NatWest Bank v Personal and Pedro Lopez, WIPO Case No. D2003-0166*. I accept the principles elucidated in these decisions, and find that the Respondent has no legitimate rights or interests in respect of the domain name www.p1wimax.net.

7. 3rd Requirement - Whether the Respondent's domain name has been registered or used in bad faith

- 7.1. The decision in *Generale des Matieres Nucleaires v Greenpeace International*, WIPO Case No. D2001-0376, cited by the Complainant is instructive. I agree and adopt this decision in my findings here. This decision sets out the following observations:
- 7.1.1. That in assessing bad faith, the motive of the Respondent is paramount;
 - 7.1.2. That a selection of a Domain Name, a name which is not the Respondent's own, which it knew at the time of registration to be the name and trademark of the Complainant, and the use of the domain is to campaign against the Respondent is intended to catch by surprise visitors intending to reach the Complainant's website;
 - 7.1.3. That registering a domain name comprising the name and trademark of another and specifically with a view to causing damage and disruption to that other cannot be right.
- 7.2. I have perused Exhibit 5 to Form C. It is clear to me that the purpose of setting up the domain was to allow the Registrant/Respondent and visitors to the domain to, among others, ventilate their grievances and dissatisfaction over the services offered by the "P1 Wimax" and the Complainant. The website also allows visitors to post ways that can allegedly circumvent payment requirements for broadband connections offered by the Respondent.
- 7.3. I find as follows:
- 7.3.1. That it is evident that at the time the domain "www.p1wimax.net" was created (25 February 2012), the Respondent already knew of Complainant's Trademarks;
 - 7.3.2. That the website was set up to cause damage and disruption to the Complainant and to the goodwill and reputation in the Complainant's Trademarks.

7.4. I therefore find that the Respondent's domain name "www.p1wimax.net" has been registered or used in bad faith

8. Order

a) In view of the fact that:

- i. "WIMAX" is an acronym for "Worldwide Interoperability for Microwave Access",
- ii. I have grave reservations as to whether or not the Complainant can claim exclusive rights to the use of "WIMAX" or "Wimax",
- iii. The Complainant had used "P1 W1MAX" and "P1 w1max" and not "P1 Wimax" or "P1 WIMAX" in its marketing activities;
- iv. The mark "P1 Wimax" has been applied for, but not yet registered in favour of the Complainant;

I would **not** order the domain name "p1wimax.net" to be transferred to the Complainant.

b) I would however order that the registration in the Respondent's name of the domain name www.p1wimax.net be cancelled.



Khoo Guan Huat

Sole Panellist

17 August 2012