

ADMINISTRATIVE PANEL DECISION

Case No: AIAC/ADNDRC-1066-2022
Complainant: Premier Saveguard Sdn. Bhd.
Respondent: Muhammad Fazir Bin Abdul Munir

1. The Parties and Contested Domain Name

The Complainant is Premier Saveguard Sdn. Bhd. (Company No. 201601025216 (1196155-D)), a company incorporated in Malaysia and having a principal place of business at D4-3-1, Solaris Dutamas, No. 1, Jalan Dutamas 1, 58400 Wilayah Persekutuan Kuala Lumpur.

The Respondent is Muhammad Fazir Bin Abdul Munir, whose address is at 2-13, Capital 4, Oasis Square, 47301 Petaling Jaya, Selangor.

The domain name in dispute is <premiersaveguard.com> (“**the Domain Name**”). It was registered on 15 January 2020.

The Registrar of the Domain Name is Google LLC (“**the Registrar**”).

2. Procedural History

The Complainant filed a complaint dated 25 February 2022 (“**the Complaint**”) with the Kuala Lumpur Office of the Asian Domain Name Dispute Resolution Centre (“**ADNDRC**”), through its counsel, Messrs. Rosli Dahlan Saravana Partnership, seeking transfer to the Complainant of the Domain Name. According to the Complaint, the Respondent was identified by the Complainant from an undated email purportedly from the Registrar. In its Complaint, the Complainant opted for a sole panellist but did not nominate one, thereby leaving the selection to ADNDRC.

In its Complaint, the Complainant confirmed that no legal proceedings have been commenced by the parties in conjunction with or relating to the domain name which is the subject of this dispute.

On 1 April 2022, ADNDRC forwarded the Complaint to the Respondent, with a copy to the Registrar, and requested that it file its Response within 20 days therefrom. No response was filed by the Respondent within such time limit and, to the knowledge of this Panel, no such response such been filed to date.

On 21 April 2022, the Respondent informed the ADNDRC, by way of email, that the parties have purportedly reached a settlement pursuant to Rule 19.1 of the Rules of the MYNIC’s (.my) Domain Name Dispute Resolution Policy. A document containing the purported settlement agreement, evidencing the full and final settlement of the domain name dispute, was attached to this email. This email was forwarded to the Complainant by the ADNDRC on the same day, as the Complainant was not copied to the email.

The Complainant responded to the ADNDRC by way of letter, dated 21 April 2022, that it was not aware of the existence of the purported settlement agreement. It sought to put a hold on the proceedings, to allow counsel to seek further instructions from the Complainant.

On the same day, the ADNDRC responded by way of email, acknowledging receipt of the Complainant's request to place the proceedings on hold. It further informed the parties that in light of the suspended proceedings, it will not be proceeding with the appointment of a panellist for the proceedings, and pursuant to Paragraph 17(a)(ii) of Rules for Uniform Domain Dispute Resolution Policy ("**the Rules**") the ADNDRC will inform the Registrar of the same.

Further, on the same day, the Respondent requested, by way of email, for a Standard Settlement Form pursuant to Paragraph 17(a)(iii) of the Rules for the parties' execution.

On 25 April 2022, the ADNDRC informed the Registrar, by way of email dated 25 April 2022, that parties were in the midst of discussing a settlement.

On the same day, the Respondent by way of 2 emails dated 25 April 2022 to ADNDRC submitted the Standard Settlement Form. These emails were forwarded to the Complainant by ADNDRC, as the Complainant was not copied to the emails.

In response, the Complainant, by way of email dated 25 April 2022, stated that parties have not concluded any settlement agreement as of 25 April 2022, and did not recognise the said settlement agreements to be valid and binding on the Complainant. Nevertheless, the Complainant maintained its request to put the proceedings on hold as parties were still in the midst of settlement talks.

On 9 May 2022, the Complainant informed the ADNDRC, by way of letter, that parties have failed to reach an amicable settlement, and requested for proceedings to be continued and a panel be appointed to decide on the matter.

On 10 May 2022, ADNDRC requested, by email, the undersigned to indicate his ability to act independently and impartially between the parties as the sole panellist. On the same date, the undersigned replied by email to confirm the same.

On 12 May 2022, ADNDRC issued the Notice of Appointment of the undersigned as Sole Panellist to the parties and copied the undersigned.

3. Factual Background

The Complainant engages in business security services under the business name "Premier Saveguard Sdn. Bhd.", to which the words "Premier" and "Saveguard" are found in the Domain Name.

The Domain Name was registered by the Respondent with the Registrar on 15 January 2020.

The Respondent was given the authority to register the Domain Name on 15 January 2020, and to manage the administrative affairs vis-à-vis the Domain Name on behalf of the Complainant.

On or around August 2021, the Complainant claims that it revoked its consent and/or authority in respect of the registration, maintenance and/or use of the Domain Name, and through verbal requests had requested the Respondent to handover all access and/or information in the Respondent's possession vis-à-vis the Domain Name to the Complainant. The Respondent has refused and continues to do so.

On 15 January 2022, the Respondent renewed the Domain Name and withheld access to the Domain Name from the Complainant.

4. Parties' Contentions

A. Complainant's Contentions

The Complainant clarifies in its Complaint that the complaint is not in relation to the initial registration of the Domain Name. It contends that the maintenance and/or renewal of the Domain Name on 15 January 2022 by the Respondent was:

- (a) infringing and violating the rights of the Complainant, including infringing the Complainant's trademark of "premiersaveguard";
- (b) for an unlawful purpose; and
- (c) amounting to, amongst others, tort of deceit and/or passing off of the Complainant's goodwill and/or business.

The Complainant submits that the Domain Name is identical, if not, confusingly similar to the Complainant's trademark for the following reasons:

- (a) the registered company name of the Complainant is "Premier Saveguard Sdn Bhd";
- (b) the Domain Name incorporated the whole of the Complainant's company name "Premier Saveguard" by excluding "Sdn Bhd". In this regard, "Sdn Bhd" merely means private limited company, and bears no other distinctive function in respect of the Complainant's trademark;
- (c) the Domain Name is therefore synonymous to the Complainant's registered company name; and
- (d) the Domain Name was designed and/or crafted in the aforesaid manner because it was initially registered for the Complainant's use.

The Complainant submits that the Respondent has no ownership rights in respect of the Domain Name, for the following reasons:

- (a) the Complainant's initial authority given to the Respondent did not extend to:
 - (i) personal and/or other use of the Domain Name without the consent of the Complainant;
 - (ii) withholding the access to the Domain Name as if the Respondent is the legitimate owner of the Domain;
 - (iii) renewal of the Domain Name notwithstanding that the authority had ceased since around August 2021; and
- (b) the Respondent is in no way associated with the Domain Name in its personal capacity and/or other capacity (if any), especially after the cessation of the authority.

The Complainant submits that the Domain Name was maintained, used and/or renewed in bad faith by the Respondent. The Complainant relies on Paragraph 4(b)(iii) of the Uniform Domain Name Dispute Resolution Policy, that the Respondent had maintained and/or renewed the Domain for the purpose of disrupting the business of the Complainant, claiming that:

- (a) several existing contracts of the Complainant were wrongfully terminated without the consent of the Complainant by using one of the e-mail addresses created/hosted under the Domain Name as a medium to facilitate the wrongful conduct; and
- (b) the maintenance and/or the renewal of the Domain Name prevents the Complainant from registering, accessing, using, making changes, and/or taking over the control of the Domain Name, including e-mail addresses created under the Domain Name.

B. Respondent's Contentions

The Respondent failed to submit his Response to the Complaint.

5. Deliberation and Findings

This Panel is governed by the Rules for Uniform Domain Name Dispute Resolution Policy (“**the Rules**”) as well as the Uniform Domain Name Dispute Resolution Policy (“**the Policy**”).

Under Rule 15(a), the Panel shall decide a complaint on the basis of the statement and documents submitted and in accordance with the Policy, Rules and any other rules and principles of law that it deems applicable.

Under Rule 5(f), if a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint. The Panel does not find any exceptional circumstances preventing the Panel from proceeding to decide the dispute based on the Complaint.

Under Paragraph 4(a) of the Policy, the Complainant must establish and prove the following:

- (i) The 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 domain name; and
- (iii) The Domain Name has been registered and is being used in bad faith.

All three criteria must be established before this Panel can order a transfer of the disputed Domain Name.

A. Is the Domain Name identical or confusingly similar?

It is generally accepted that a trade mark can be both a registered or unregistered trade mark. In this case, the Complainant does not have any registered trademark. However, the Complainant’s corporate or trade name is Premier Saveguard Sdn Bhd and it is evident that the Complainant is an ongoing business. The Complainant was incorporated on 28 July 2016 and can therefore be said to be using its trade name Premier Saveguard as an identifier of the source of the services it is providing to its clients. The name Premier Saveguard is therefore being used as a service mark by the Complainant from its date of incorporation.

The Panel accepts the Complainant’s evidence which is unchallenged, that it is the proprietor of and has rights to the trade name Premier Saveguard, which is also a trade mark or service mark in used by the Complainant.

The domain name in dispute is <premiersaveguard.com>. The Panel finds that the Domain Name is identical to a trade mark or service mark in which the Complainant has rights. As such, the Panel is satisfied that Paragraph 4(a)(i) of the Policy has been established by the Complainant.

B. Does the Respondent have rights or legitimate interests?

The Complainant’s case is that the Respondent was initially given authorisation to register the Domain Name and that the authorisation was revoked on or around August 2021. The Respondent’s employment with the Complainant was also terminated around October 2021. The Panel notes that no evidence of the revocation of the authorisation was submitted by the Complainant save for the allegation. However, since the Respondent has not filed any response or challenged the allegation, the Panel accepts that the authorisation given to the Respondent was revoked on or around August 2021.

There is also no evidence before the Panel that the Respondent has any prior rights or interests in the Domain Name prior to registration save for the initial authorisation given by Complainant to the Respondent to register the domain name on 15 January 2020.

The Complainant contends that:

- (a) The authority given to the Respondent limits only to (i) the initial registration of the Domain Name; and (ii) the subsequent management of administrative affairs vis-à-vis the Domain Name, strictly on behalf of the Complainant. Due to the given authority, the access to the Domain Name (including access to any email addresses created under the Domain Name) remained with the Respondent at all material times;
- (b) The Respondent does not have ownership; legitimate interests and/or rights over the Domain Name; and
- (c) The Domain Name will not be used and/is not registered for uses other the use of the Complainant in its business affairs.

This being the case, it would appear that the Respondent does not have any rights or legitimate interests in the domain name <premiersaveguard.com> prior to registration or at any time during the registration. The Respondent was merely acting as an agent for the Complainant in registering the Domain Name.

As such the Panel is satisfied that Paragraph 4(a)(ii) of the Policy has been established by the Complainant.

C. Is there bad faith?

The main thrust of the Complaint is that the Respondent's conduct amounts to bad faith. However, in order to establish bad faith, the Complainant must satisfy Paragraph 4(a)(iii) of the Policy which states: "*the domain name has been registered and is being used in bad faith*". To satisfy this condition, the Complainant must establish that the registration and the use of the Domain Name is in bad faith.

However, in the present case, the Complainant admits that the registration of the Domain Name by the Respondent was with the Complainant's consent in that the Complainant had given authorisation to the Respondent to register the Domain Name. The authorisation was subsequently revoked, but Paragraph 4(a)(iii) of the Policy concerns the circumstances at the time of registration and not subsequent conduct.

A mere renewal of a domain name has not generally been treated as a new registration for the purposes of assessing bad faith. There is no justification for straying from the plain wording of the Policy and allowing bad faith renewal to satisfy the bad faith registration requirement (Russell Specialities Corporation v. Media Image Inc, et al, D2002-0322).

Registration in bad faith must occur at the time of the initial registration. Also, as Paragraph 4(a)(iii) mentions only registration and not renewal, any unauthorised renewal of the Domain Name would not assist the Complainant.

The requirement in Paragraph 4(a)(iii) is stated in the conjunctive. Registration in bad faith is insufficient if the respondent does not use the domain name in bad faith, and conversely, use in bad faith is insufficient if the respondent registered the domain name for a permissible purpose (Shirmax Retail Ltd v. CES Marketing Group Inc, eResolution Domain Dispute Case AF-0104).

Furthermore, if the domain name was registered in good faith, it cannot, by changed circumstances, the passage of years, or intervening events, later be deemed to have been registered in bad faith

(Substance Abuse Management Inc v. Screen Actors Models International, Inc (SAMI), D2001-0782; see also Russell Specialities Corporation v. Media Image Inc. et al, D2002-0322).

Since the registration of the Domain Name was with the consent or authorisation of the Complainant, it cannot be said that the registration was in bad faith. The Panel therefore finds that the registration of the domain name was not done in bad faith.

Paragraph 4(b) of the Policy sets out the circumstances upon which if found present by the Panel shall be evidence of the registration and use of a domain name in bad faith. The Panel proceeded to review the evidence to determine if Paragraph 4(b) would assist the Complainant.

Paragraph 4(b)(i) of the Policy is not relevant as this is not a case of cyber-squatting, nor is there any evidence of such circumstances.

Paragraph 4(b)(ii) of the Policy is also not applicable as this is not a case of the Respondent registering the Domain Name to prevent the trade mark owner from reflecting the mark in a corresponding domain name. The initial registration of the Domain Name was with the consent of the Complainant who is the trade mark owner. It would also appear that the Domain Name was used by the Complainant as there is no allegation that the Complainant was denied used of the Domain Name post registration.

Paragraph 4(b)(iii) of the Policy is also not applicable since the Domain Name was legitimately registered with the consent of the Complainant and there was no disruption of any business. As indicated above, Paragraph 4(b)(iii) deals with the registration of the domain name and not its subsequent renewal.

The Panel notes that the Complainant is currently using a different domain name, namely <www.premiersaveguards.com>, and that there does not appear to be any business disruption using this website.

The Panel also considered whether the circumstances leading to the Complaint satisfied Paragraph 4(b)(iv) of the Policy, that *“by using the domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent’s] website or other on-line location, by creating a likelihood of confusion with the complainant’s mark”*. This is not a case of the Respondent using his website to cause confusion or to divert business or attract for commercial gain. The complaint is that the someone else connected with the Respondent, one Ranjit Singh, had on 1 August 2021 and again on 14 October 2021 used the Domain Name as an email address, namely <admin@premiersaveguard.com>, to send notices to terminate on-going business contracts with the Complainant’s customers. However, there is no evidence that Respondent consented or allowed the use of the Domain Name by Ranjit Singh as an email address. It is also not entirely clear to the Panel if this email address, <admin@premiersaveguard.com>, is an existing email address that was created or in used prior to the termination of the Respondent’s authorisation or employment by the Complainant.

The Panel notes that the Complainant’s letter dated 25 October 2021 addressed to itself states that the Board of Directors have decided to terminate the services of 3 individuals including the Respondent. It is not clear if the termination of employment was before or after the date of the letter. It is also not clear if the termination was before 1 August 2021 when the said email using the Domain Name was used. There is no other evidence to confirm the date of termination of employment of the Respondent.

While the circumstances surrounding the use of the email address comprising the Domain Name is suspicious in the light of the follow up correspondence from Kawalan Pertiwi Sdn Bhd to one Ridge View Residence which was sent shortly after Ranjit Singh had sent the termination notice, there is

again no evidence to connect the Respondent to Kawalan Pertiwi Sdn Bhd which uses a completely different domain name. The Panel is of the view that Paragraph 4(b)(iv) of the Policy has also not been satisfied.

Even though Paragraph 4(b) of the Policy is without limitation, and that other circumstances can also constitute bad faith, such as the unauthorised use of any email address containing the domain name, there is insufficient conclusive evidence before the Panel to establish that the email address <admin@premiersaveguard.com> was created after the Respondent's termination of employment with the Complainant. Even if the use of the email address is indicative of bad faith, as discussed above, Paragraph 4(a)(iii) of the Policy requires both registration and use in bad faith. In this case, the initial registration of the Domain Name was not in bad faith.

As such the Panel is of the view that Paragraph 4(a)(iii) of the Policy has not been established by the Complainant.

6. Decision

In order to direct the transfer of the domain name, all three criteria of Paragraph 4(a) of the Policy must be established by the Complainant. Based on the Policy, the Complaint and the above analysis, the Panel finds only the first two criteria have been met but not the third criteria. The registration of the domain name was not in bad faith. As such, the Panel is unable to direct that the disputed Domain Name, <premiersaveguard.com>, be transferred from the Respondent to the Complainant.

The Panel notes that the Complainant is currently using a different domain name, <www.premiersaveguards.com>, and that there does not appear to be any business disruption using this domain name. Also, the disputed Domain Name does not appear to be accessible at the time of writing this decision. There are also civil remedies available to the Complainant, including injunctive relief, which the Complainant can avail itself in order to effect a transfer of the disputed Domain Name.

The application for transfer of registration is denied, without prejudice, and with hope that the parties can resolve the dispute amicably.



Alban Kang

Sole Panellist

Date: 25 May 2022