

Asian Domain Name Dispute Resolution Centre (Kuala Lumpur Office)

ADMINISTRATIVE PANEL DECISION

Case No.	AIAC/ADNDRC-779-2019
Complainant:	Genting Americas, Inc.
Respondent:	Michael Shaya
Disputed Domain Name:	<www.gentingamericas.com>

1. The Parties and Contested Domain Name

The Complainant is Genting Americas, Inc., of 1501 Biscayne Blvd Suite 500 Miami, Florida 33132, United States. The Complainant is represented in these administrative proceedings by Lim Zhi Jian, whose address is Level 6, Menara 1 Dutamas, Solaris Dutamas, No. 1, Jalan Dutamas 1, 50480 Kuala Lumpur, Malaysia.

The Respondent is Michael Shaya, of 1321 NW 14th Street, Suite 605 Miami, Florida 33125, United States.

The domain name at issue is <www.gentingamericas.com>, registered by the Respondent with GoDaddy.com, LLC, of contact email at abuse@godaddy.com.

2. Procedural History

On 19 September 2019, the Complainant submitted a complaint to the Kuala Lumpur Office of the Asian Domain Name Dispute Resolution Centre (“the ADNDRC-KL”) and elected this case to be dealt with by a single-member panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (“the Policy”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“the ADNDRC Supplemental Rules”).

Upon receipt of the complaint, the ADNDRC-KL sent to the Complainant by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules.

On 3 December 2019, the ADNDRC-KL notified the Complainant and Respondent about the commencement of the proceedings. On the same day, ADNDRC-KL was also inviting response from the Respondent to be given on or before 23 December 2019.

On 30 December 2019, the ADNDRC-KL sent out notice noting that no response had been received and the complaint was to be proceeded to a decision by the Panel to be appointed. Having received a declaration of impartiality and independence and a statement of

acceptance, the ADNDRC-KL notified the parties on 30 December 2019 that the Panel in this case had been appointed, with Mr. Gary Soo acting as the sole panelist.

Again, on 30 December 2019, the Panel received the file by email from the ADNDRC-KL and was requested to render the Decision on or before 13 January 2020.

3. Factual background

The Complainant

The Complainant in this case is Genting Americas, Inc.. The registration address is 1501 Biscayne Blvd Suite 500 Miami, Florida 33132, United States. The Complainant appointed Lim Zhi Jian, the address of which being at Level 6, Menara 1 Dutamas, Solaris Dutamas, No. 1, Jalan Dutamas 1, 50480 Kuala Lumpur, Malaysia, as its authorized representative in this matter.

The Respondent

The Respondent, Michael Shaya, is the current registrant of the disputed domain name <www.gentingamericas.com> according to the GoDaddy.com, LLC. The address of the Respondent from the registration information is 1321 NW 14th Street, Suite 605 Miami, Florida 33125, United States. The Respondent's email is stated to be michaelshaya@gmail.com.

4. Parties' Contentions

A. Complainant

The Complainant was initially incorporated as Genting East Coast USA Inc. on 15 June 2010 before changing its name to Genting Americas Inc. on 25 October 2011. The disputed domain name was bearing the Complainant's name in its entirety.

The Complainant provided a copy of the Certificate of Incorporation of Genting East Coast USA Inc., the Secretary's Certificate for Genting Americas Inc., enclosing various exhibits including, among others, the Certificate of Amendment reflecting the change of name from Genting East Coast USA Inc. to Genting Americas Inc., and showed / annexed the certification that Genting Americas Inc. was duly incorporated and the application by Genting Americas Inc. for authorization to transact business in the state of Florida, United States, with the corresponding authorization letter.

According to the Complainant, the Complainant was a subsidiary of Genting Berhad. Along with Genting International Management Limited ("Genting International"), they formed part of the Genting group of companies (hereinafter collectively referred to as the "Genting Group"). Genting International was the registered and/or beneficial and/or common law owner of the mark, "GENTING" and/or marks consisting of "GENTING", "GENTING DREAM", "GENTING REWARDS", "GENTING PALACE", in various classes all over the world including but not limited to the United States.

As regards the registrations in the United States, these, as per the annexures, included the following:-

1. Trademark Registration No. 3683708
Specifications of goods and/or services in Classes 16, 41 and 43
2. Trademark Registration No. 5198070
Specifications of goods and/or services in Classes 16, 25, 28, 39, 41, 43 and 44
3. Trademark Registration No. 5464874
Specifications of goods and/or services in Class 35
4. Trademark Registration No. 4365100
Specifications of goods and/or services in Class 35
5. Trademark Registration No. 4112727
Specifications of goods and/or services in Class 35
6. Trademark Registration No. 4112726
Specifications of goods and/or services in Class 35
7. Trademark Registration No. 4578508
Specifications of goods and/or services in Class 43

A list of Genting International's marks, bearing the word "GENTING" registered all over the world was also enclosed with annexures.

In addition to the above, The Complainant's contentions were summarized as follows:-

- i. The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant was a subsidiary of Genting Berhad. Along with Genting International and various other companies, they formed part of the Genting Group.

The Genting Group's members, including Genting International, consisted of the registered proprietor and/or owner and/or beneficial owner of the mark "GENTING" (the "Mark") and/or marks consisting of "GENTING" in various classes all over the world including but not limited to the United States as abovementioned.

The core businesses of the Genting Group were leisure hospitality and casino business. The businesses of the Genting Group had later diversified to include global investments in oil palm plantations, power generation, oil & gas, property development, cruise, biotechnology and other industries. All the products and/or services bearing the Mark involving the businesses above had been provided extensively by the Genting Group.

The Genting Group and/or its members had won numerous awards in the course of their worldwide trade. It was a five-time winner of the World's Leading Casino Resort (2005-2010) awarded by World Travel Awards and had been voted as Asia's leading casino resort for six consecutive years (2005-2010). It could not be disputed that the Genting Group and/or its members had acquired substantial reputation and goodwill in the Mark for various goods and services. The reputation and goodwill acquired were proprietary rights accorded by

statutory and common law rights, which the law permitted to guard against all manners of misappropriation and infringement. The Mark “GENTING” owned by the Genting Group and/or its members was clearly a well-known mark worldwide.

In the Americas, the Genting Group had been owning and operating and/or had been planning the opening of the following hotels, resorts and/or casinos;

- 1) Resorts World Casino New York City;
- 2) Resorts World Bimini Bahamas;
- 3) Resorts World Catskills;
- 4) Resorts World Las Vegas; and
- 5) Resorts World Miami.

Screenshots of news articles and/or websites of the websites of the abovementioned hotels, resorts and/or casinos are enclosed as annexures.

Based on the above, the Complainant contented that Genting Group’s members were the registered proprietor and/or owner and/or beneficial owner of the Mark and the Genting Group and/or its individual members had acquired substantial goodwill and reputation throughout the years over the Mark, which was the trading name of the Complainant in this regard.

In addition, the disputed domain name, which consists of “GENTING” and “AMERICAS”, amounted to a misrepresentation that the disputed domain belonged to and/or was associating with the Genting Group as a whole. This exacerbated and amplified the misrepresentation or erroneous claim on the disputed domain name which damaged the Genting Group’s business, goodwill and reputation and also amounted to the false designation of origin and/or false description and/or dilution. The Respondent’s wrongful usage of the disputed domain name would lead members of the trade and public into believing that the disputed domain name was connected with the Genting Group, when this being not the case.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name(s).

The Genting Group and/or its members have been using the Mark since as early as 1965. The earliest registration belonging to the Genting Group and/or its members would be Trade Mark No: 10197 registered in Brunei on 3 March 1981, as evidenced by the copy of the certificate of registration enclosed. The Genting Group and/or its members have been using this Mark since its inception and the Mark had acquired substantial and extensive reputation worldwide including but not limited to the United States. The Genting Group clearly had prior rights in the Mark (since 1965) which preceded the registration of the Disputed Domain on 26 October 2011.

The Genting Group and/or the mark “GENTING” was known worldwide, including in the United States where the Genting Group had presence, goodwill, reputation and recognition;

The Respondent ought not to be allowed, in fact and in law, to register the disputed domain name. The Complainant highlighted that the mere registration of the disputed domain name by the Respondent was not sufficient to establish its rights or legitimate interests in it. In *Educational Testing Service v. TOEFL* (Case No. D2000-0044), the learned Panel held that: “*if mere registration of the domain name were sufficient to establish rights or legitimate interests...then all registrants would have such rights or interest, and no Complainant could succeed on a claim of abusive registration.*”

At all material times, the Genting Group and/or its members had not authorized and/or consented to the Respondent to use the Mark and/or for the Respondent to use or register the dispute domain name. The use of the Mark and the purported registration of the disputed domain name were unlawful, illegal and/or *mala fide* on the part of the Respondent. Thus, the disputed domain name had deceived and confused and/or was likely to deceive and confuse members of trade and public into believing that the disputed domain name was in some way affiliated and/or associated and/or connected to the Genting Group and/or its members when that was contrary to reality. Such misrepresentation or erroneous claim via the disputed domain name damaged the Genting Group’s business, goodwill and reputation and also amounts to false designation of origin and/or false description and/or dilution of the Mark.

- iii. The disputed domain name(s) has/have been registered and is/are being used in bad faith.

The acts of the Respondent in registering, and/or preventing the Genting Group and/or its members from using the disputed domain name were clearly tainted with *mala fide* intention, knowing very well (due to its extensive and substantial use) that the Genting Group and/or its members (all of which incorporate the Mark “Genting”) owned the Mark.

Further, the Respondent’s attempted to sell the disputed domain name to the Complainant highlighted that the disputed domain name had been registered and was being used in bad faith. This was highlighted in the Complainant’s cease and desist letter vide their American solicitors dated 22 July 2019, in which the Complainant had requested for the transfer of the disputed domain name to the Complainant, which was enclosed and annexed to the Complaint.

The Respondent’s acts were clearly to not only gain unlawful financial benefits, whether immediately and/or in the future but to also dispute the business, goodwill and reputation of the Genting Group and/or its members.

As the Respondent had registered the disputed domain name which clearly incorporated the Mark and had disrupted Genting Group and/or its members’ business, goodwill and reputation, the *mala fide* intention and lack of good faith of the Respondent could clearly be inferred as the Respondent would have been aware of the Genting Group’s Marks. This was clear evidence of bad faith.

Also, the Complainant pointed out that the domain name dispute proceedings had been initiated to preemptively prevent further damages suffered by the Genting Group and/or the public from being deceived into believing that the disputed

domain name provided goods and/or services originating from and/or associated with the Genting Group and/or its members when this was clearly not the case.

B. Respondent

As said, the Respondent, Michael Shaya, is the current registrant of the Disputed Domain Name <www.gentingamericas.com> according to the GoDaddy.com, LLC. The Respondent registered the Disputed Domain Name on 26 October 2011.

The Respondent has not submitted a response within the stipulated time.

5. Findings

Paragraph 14 of the Rules provides that, in the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by the Rules or the Panel, the Panel shall proceed to a decision on the complaint; and that, if a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

Paragraph 15(a) of the Rules instructs the Panel as to the principles that the Panel is to use in determining the dispute, stating that the Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

According to the Complainant, as a member of the Genting Group, was and is with rights over the "GENTING" mark and/or marks consisting of "GENTING", "GENTING DREAM", "GENTING REWARDS", "GENTING PALACE" ("the GENTING Marks"). From the documents and evidence supplied, the Complainant was operating on a worldwide scale the Marks and trading in its name including the word "GENTING" as the featured part. To all these, the Respondent had filed no contrary evidence nor indicated any objection thereto. The Panel hence accepts and finds that the Complainant has the necessary legal rights and interests over the Marks and/or its name "Genting Americans" for the purpose of the Complaint.

The Panel finds it clear that the domain name in issue the domain name in dispute <gentingamericas.com> incorporates the "gentingamericas" part as its key part for distinctive identification purposes and the part ".com", as top level domain name, does not feature out to likewise extent. The Panel also believes that, particularly to some internet

users in the United States, they will take “gendingamericas” to mean “gending” of “americas”, which can be taken as the place where the Respondent was residing. The Panel observes to note that the dispute domain name indeed incorporated the Marks and/or the name of the Complainant, i.e. “Gending Americas”. Accordingly, the Panel finds that the Complainant has succeeded in proving the element in Paragraph 4(a)(i) of the Policy as regards <www.gendingamericas.com>.

B) Rights and Legitimate Interests

In the present case the Complainant alleges that Respondent has no rights or legitimate interests in respect of the disputed domain name. Also, the Complainant submits that the Complainant and the Respondent have no prior connection, and the latter has not been authorized by the former to use the Mark and/or the Marks in relation to the disputed domain name. As per the above, the Marks and/or the trade name of the Complainant have acquired significant recognition worldwide, prior to the registration of the disputed domain name in issue. The Panel finds that, from the name of the Respondent, there is nothing to indicate that the Respondent has any rights or interests or connection to the “gendingamericas” name or mark. Also, the Respondent has not filed a response to the Complaint and has not addressed this point.

Furthermore, the Panel agrees that the part “gendingamericas” is not a term commonly used in the English language and there is also no evidence that the Respondent has been commonly known by the disputed domain name.

To all theses, the Respondent does not respond to disagree or to submit contrary evidence.

Thus, the Panel finds that the Complainant has succeeded in proving the element in Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Under Paragraph 4(b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

- (i) Circumstances indicating that the Respondent has registered or 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 Complainant, for valuable consideration in excess of the Respondent’s 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

The Complainant contends that it is clear that the disputed domain name has been registered and/or was being used in bad faith. The Complainant highlights that these were

evidenced, *inter alia*, by the attempts of the Respondent to sell the disputed domain name to the Complainant and/or the Genting Group, which tends to show that the Respondent had been aware of the rights of the Complainant and/or the Genting Group over the Marks and/or the trade name of the Complainant. The Complainant submits that the Respondent was tainted with *mala fide* intention, knowing very well (due to its extensive and substantial use) that the Genting Group and/or its members (all of which incorporate the Mark “Genting”) owned the Mark.

To all theses, the Respondent does not respond to disagree or to submit contrary evidence. The Panel accepts these as factual findings and agrees with the Complainant that the Respondent registers the domain name in issue knowing the rights and interests of the Complainant over the Marks and/or the trade name of the Complainant. The Panel finds that all these do constitute bad faith on the part of the Respondent.

Therefore, the Panel also finds that the Complainant has succeeded in proving the elements in Paragraph 4(a)(iii) of the Policy as regards <www.gentingamericas.com>.

6. Decision

Having established all three elements required under the Policy in respect of the disputed domain name <www.gentingamericas.com>, the Panel concludes that relief shall be granted in favour of the Complainant. Accordingly, the Panel decides and orders that the disputed domain name <www.gentingamericas.com> shall be transferred from the Respondent to the Complainant.



Gary Soo
Sole Panelist

6 January 2020