

# Asian Domain Name Dispute Resolution Centre

(Kuala Lumpur Office)

## ADMINISTRATIVE PANEL DECISION

AIAC/ADNDRC-584-2018

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<b>Complainant:</b>	<b>PT Pulau Bawah</b>
<b>Respondent:</b>	<b>DomainMarket.com LLC</b>
<b>Domain Name:</b>	<b>&lt;bawah.com&gt;</b>
<b>Registrar:</b>	<b>ENOM.COM</b>

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### 1. Procedural History

The Complainant in this case is PT Pulau Bawah a corporation organized under the laws of Indonesia, whose address is Desa Kiabu Kecamatan Siatan Selatan, Kabupaten Kepulauan Anambas (“Complainant”). Their authorized representative in these proceedings is Tom Blachere.

The respondent is DomainMarket.com LLC., whose address is 9812 Falls Road, Suite 114-331 Potomac, MD 20854 USA (“Respondent”). Their authorized representative in these proceeding is Brian H. Leventhal, Attorney at Law.

The domain name in dispute is <bawah.com>. The Registrar of the domain name is ENOM.COM, whose address is 5808 Lake Washington Blvd. NE, Suite 201, Kirkland, WA 98033, USA .

On 30 April 2018, pursuant to the Uniform Domain Name Dispute Resolution Policy (“the Policy”), the Rules for the Uniform Domain Name Dispute Resolution Policy (“the Rules”) and Asian Domain Name Dispute Resolution Centre (ADNDRC) Supplemental Rules for Uniform Domain Name Dispute

Resolution Policy (“the Supplemental Rules”), the Complainant submitted a Complaint to the Kuala Lumpur Office of the ADNDRC (“the KL office of the Centre”) and elected this case to be dealt with by a single-member panel.

On 3 May 2018, the KL Office of the Centre notified the Registrar of the Complaint and requested for verification of the registration information of the Disputed Domain Name. On the same day, the KL Office of the Centre received the reply from the Registrar.

On 8 May 2018 the KL Office of the Centre notified the Respondent of the commencement of the proceedings and the deadline for filing a response, which is 28 May 2018.

On 30 May 2018, the KL Office of the Centre received a response from the Respondent with a request that the Response should be admitted and considered by the Panel of this case according to Article 5(b) of the Rules.

On 1 June 2018, the KL Office of the Centre notified the parties that the Panel in this case had been selected, with Dennis CAI acting as the sole panelist, and the deadline for rendering the decision is 15 June 2018. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

## **2. Factual Background**

### *For the Complainant*

The Complainant engaged an agency to conduct trademark search and apply for trademark registration for “BAWAH” and “EXPLORESWANTED” under Class 43 of the Classification of Goods in Indonesia in 2015.

### *For the Respondent*

The Respondent registered the Disputed Domain Name on 14 May 2012.

## **3. Parties’ Contention**

### *The Complainant*

The Complainant asserts that the domain name at issue is identical or confusingly similar to Complainant's "BAWAH" mark.

The Complainant further alleges that Respondent has no rights or legitimate interests in respect of the domain name, and that Respondent's domain name has been registered in bad faith and is being used in bad faith.

#### *The Respondent*

The Respondent requests the denial of the Complaint on the following grounds: (i) the Complaint failed to establish that it has trademark rights in "BAWAH"; (ii) the Respondent has a legitimate interest in the Disputed Domain name; (iii) the Respondent did not register nor has it used the Disputed Domain Name in bad faith.

The Respondent further requests for finding of reverse domain hijacking according to Paragraph 15 of the Rules.

## **4. Findings**

### **Consideration of the Response**

The Panel notes that the Respondent submitted its Response with a request for extension of time for response under Paragraph 5(b) of the Rules on 30 May, two days after the lapse of the initial time for response. In practice, applications for extension of time for submission of pleadings in dispute resolution procedures should normally be submitted no later than the initial deadline, and late application for extension of time may not be considered.

Noting the automatic nature of granting extension of 4 calendar days under Paragraph 5(b) of the Rules, the Panel considers that it is not necessary for a respondent to submit a request for extension before initial deadline under the provision, regardless of the fact that a respondent may have 20 calendar days to communicate such a request to the provider within the initial time frame. Respondent's conduct of submitting its Response within 4 calendar days after the initial deadline itself could be regarded as an implied request for such an extension and trigger the automatic granting of the extension of time under Paragraph 5(b) of the Rules. Hence, the Panel concludes that the Response submitted by the Respondent on 30 May 2018 is admissible.

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

Paragraph 4(a) of the Policy directs that the Complainant must prove **each of** the following:

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

***A) Identical or Confusing Similarity***

For the reasons set forth in 4(c), the Panel is not required to make any findings for this element. See *Creative Curb v. Edgetec Int’l Pty. Ltd.*, NAF Claim No. 116765 (finding that because the complainant must prove all three elements under the Policy, the complainant’s failure to prove one of the elements makes further inquiry into the remaining element unnecessary); see also *Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, FA 836538 (Nat. Arb. Forum Dec. 28, 2006), and *Convoy (Trademarks) Limited, Convoy Financial Services Limited v. Rainforest Consulting*, HK-100318 <convoy.com> (*ADNDRC, 23 December 2010*).

***B) Rights or Legitimate Interests of the Respondent***

For the reasons given under 5(C), the Panel is not required to make any findings for this element.

***C) Bad Faith***

Paragraph 4(a) of the Policy requires the Complaint to prove both registration and use in bad faith. Nonetheless, Paragraph 4(b) of the Policy sets out particular scenarios, which shall be evidence of the registration and use of a domain name in bad faith. They are:

- (i) circumstances indicating that you have registered or you have 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 your documented out of pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

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

The Respondent notes that Respondent's registration of the Disputed Domain Name predates Complainant's alleged trademark rights and contends that it could not possibly have registered it for any purpose related to those alleged rights.

According to the Whois information, the Disputed Domain Name was registered on 14 May 2012, while the Complainant submitted two Invoice Statements respectively dated 19 January 2015 and 16 February 2015 which appear to prove that the Complainant's engagement with an agency for conducting trademark search of "BAWAH" and "EXPLORES WANTED" and applying for trademark registration of these two names under Class 43 in Indonesia. The Complaint alleges in its Complaint that "[d]isputed domain contains the word 'bawah' which is identical to the Complainant's registered trademark", but no evidence has been provided before the Panel that the Complainant has acquired trademark rights either through registration or use of the marks in its commercial activities. Submission of the above-mentioned Invoice Statements as evidence is insufficient for the Panel to find that the Complainant has trademark rights in "BAWAH" mark.

The Complaint also stated in its Complaint that "BAWAH" is the name of the island (Pulau Bawah), a geographic location for which our business operates.

For the reason that Respondent's registration of the disputed domain name predates the Complainant's alleged trademark rights and "BAWAH", and that the major part of the disputed domain name is a name of a geographic location, it would be difficult to ascribe bad faith intentions to the Respondent at the time of registration of the disputed domain name. There is no evidence on which the Panel could conclude that the Complainant has common law rights in respect of the name "BAWAH", and that the Respondent targeted the Complainant's mark when registering the Disputed Domain Name.

Hence, the Panel finds the Complainant does not satisfy the requirement of Paragraph 4(a)(iii).

#### ***D. Reverse Domain Name Hijacking***

The Respondent requests for findings of Reverse Domain Name Hijacking which is defined in Paragraph 1 of the Rules, meaning using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.

Paragraph 15(e) of the Rules provides that: "[i]f after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding."

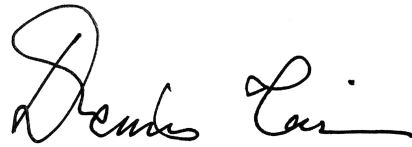
In light of the facts of this case, the Panel declares that the Complaint was brought in an attempt at Reverse Domain Name Hijacking and constitutes an abuse of the administrative proceeding, as the Complainant should have known that the Complaint could not be supported based on the fact that the Disputed Domain Name was registered several years prior to the time that the Complainant could acquire trademark rights.

Moreover, the fact that the Complainant based its Complaint mainly on allegations without providing supporting evidence suggests that Complainant appears to have actually known it could not succeed as to the third element of Paragraph 4(a) of the Policy. See *Color Image Apparel, Inc. v. Whois Privacy Services by DOMAINCA / unitedeuropa consulting*, Case No. D2017-0650 (WIPO, 19 June 2017).

## 5. Decision

For the foregoing reasons, the Complaint is denied.

The Panel also finds that the Complainant attempted to engage in Reverse Domain Name Hijacking.

A handwritten signature in black ink, appearing to read "Dennis Cai". The signature is fluid and cursive, with the first name "Dennis" being larger and more prominent than the last name "Cai".

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Dennis Cai  
Sole Panelist  
DATED: 15 June 2016