

ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

(KUALA LUMPUR OFFICE)

Administrative Panel Decision (“Award”)

Case No. AIAC/ADNDRC-795-2019

Complainant: Genting International Management Limited

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British Isles IM2 4RB

Represented by Lim Zhi Jian
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Malaysia

Respondent: Posa Honaa

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Thailand

Disputed Domain Name: gentingprincess168.com

Panelist: Dr. Daniel Dimov

Procedural History

The complainant submitted a Uniform Domain Name Dispute Resolution Policy (“UDRP”) complaint dated the 23rd of October 2019 to the Asian Domain Name Dispute Resolution Centre – Kuala Lumpur Office (“ADNDRC”). On the 11th of December 2019, the ADNDRC sent a Notification of Commencement of Proceedings to the respondent. The respondent did not respond within the prescribed time period of 20 days. Therefore, this panelist has been able to consider only information submitted by the complainant.

In its complaint, the complainant confirmed that no legal proceedings have been commenced or terminated by the parties in connection with or relating to the domain name gentingprincess168.com (the “Disputed Domain Name”).

Factual background

According to the submission of the complainant:

1. Along with Genting Intellectual Property Pte Ltd and other companies, the complainant forms part of Genting Group of companies (hereinafter, collectively referred to as “Genting Group”).

2. Genting Group owns (i) trademarks covering the word “GENTING” only, (ii) trademarks including the word “GENTING” amongst other elements, and (iii) trademarks covering the figurative trademark “G”. Those trademarks are registered in various classes in Thailand, the EU, and, according to the complainant, other jurisdictions.

3. The complainant presented evidence indicating that it owns the following trademarks registered in Thailand:

- (i) Trademark App. No. 788838 for GENTING REWARDS;
- (ii) Trademark App. No. 788837 for GENTING REWARDS;
- (iii) Trademark App. No. 887848 for eGENTING;
- (iv) Trademark App. No. 491838 for GENTING WORLD OF ENTERTAINMENT;
- (v) Trademark App. No. 517563 for eGENTING;
- (vi) Trademark App. No. 464534 for the figurative trademark “G”;
- (vii) Trademark App. No. 817035 for the figurative trademark “G”;
- (viii) Trademark App. No. 722367 for GENTING;
- (ix) Trademark App. No. 722368 for GENTING;
- (x) Trademark App. No. 722369 for GENTING;
- (xi) Trademark App. No. 722371 for the figurative trademark “G”;
- (xii) Trademark App. No. 722372 for the figurative trademark “G”; and
- (xiii) Trademark App. No. 722370 for the figurative trademark “G”.

4. The complainant has presented evidence indicating that it owns the following trademarks registered in the European Union:

- (i) EU Trademark Fil. No. 006350359 for GENTING;
- (ii) EU Trademark Fil. No. 015023245 for GENTING DREAM;
- (iii) EU Trademark Fil. No.014292882 for GENTING HOTEL;
- (iv) EU Trademark Fil. No.014292874 for GENTING HOTEL;

- (v) EU Trademark Fil. No. 009534942 for GENTING REWARDS;
- (vi) EU Trademark Fil. No. 009534934 for GENTING REWARDS;
- (vii) EU Trademark Fil. No. 009534926 for GENTING REWARDS;
- (viii) EU Trademark Fil. No. 009534918 for GENTING REWARDS;
- (ix) EU Trademark Fil. No. 014292924 for GENTING CASINO INTERNATIONAL; and
- (x) EU Trademark Fil. No. 014292916 for GENTING INTERNATIONAL CASINO.

5. Since some of the trademark evidence presented by the complainant was outdated, the panel conducted a trademark search in the WIPO's Global Brand Database in relation to the trademarks supported by outdated evidence in order to verify and confirm that those trademarks are still registered. According to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), the panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reach a decision. WIPO Overview 3.0 also states that such a research may include accessing trademark registration databases.

6. The complainant provided an annual business report for 2018 covering the activities of Genting Berhad, one of the companies of Genting Group. According to the provided information, Genting Group was founded in 1965 and is involved in leisure and hospitality, oil palm plantations, power generation, oil and gas, property development, life sciences and biotechnology activities, with operations spanning across the globe, including Malaysia, Singapore, Indonesia, India, China, the United States of America, Bahamas, the United Kingdom, and Egypt. The revenue of Genting Group for 2018 exceeded RM 20,9 billion (about USD 5,12 billion), whereas its net profits for the same year were RM 2,4 billion (more than half a billion USD).

7. Gaming constitutes an important part of the business of Genting Group. For example, Genting Malaysia operates Resorts World Casino New York City, the first and only video gaming machine facility in New York City at the side of the Aqueduct Racetrack. Genting Group owns casinos in the United Kingdom (e.g., Genting International Casino in Resorts World Birmingham) and Egypt (e.g., Crockfords Cairo operating inside the Nile Ritz-Carlton in Cairo, Egypt). According to the provided annual business report for 2018, Genting Group engaged in construction works for the project Resorts World Las Vegas which will include two hotel towers with about 3,400 rooms and suites, a main casino podium, and other facilities. The revenue of Genting Group from gaming operations in 2018 alone exceeded RM 12 billion (roughly USD 2,94 billion).

8. The Genting Group won many awards in the course of their commercial activities. For example, it won World's Leading Casino Resort (2005-2010) awarded by World Travel Awards and was regarded as Asia's leading casino resort for six consecutive years (2005-2010).

For the respondent

1. The respondent has not submitted any response to the complainant's complaint within the prescribed time period of 20 days.
2. Taking into account the lack of response, the panel will render a decision that is based only upon the information and materials submitted by the complainant.
3. The panelist opened the website associated with the Disputed Domain Name (the "Website") on the 13th of January 2020 and noted that the Website includes photos and other materials related to an online casino called "Genting Princess". The language of the Website is Thai.

Parties' Contentions

A. Complainant

The complainant's contentions may be summarized as follows:

1. The Disputed Domain Name contains the complainant's registered, common law, and well-known trademark GENTING and, therefore, it is confusingly similar to it.
2. The respondent has no rights or legitimate interest in the Disputed Domain Name and the complainant has not authorized the respondent to use complainant's trademarks and/or to use or register the Disputed Domain Name. The complainant supports its arguments by stating that, according to *Educational Testing Service v. TOEFL* (WIPO Case No. D2000-0044), the mere registration of a Disputed Domain Name is not sufficient to establish rights or legitimate interests in it.
3. The complainant argues that the respondent registered the Disputed Domain Name with *mala fide* intention because it can clearly be interfered that "the Respondent would have been aware of" the trademarks of the complainant. The complainant also argues that the respondent registered the Disputed Domain Name with *mala fide* intention because, by registering it, the respondent attempted not only to gain unlawful financial benefits, but also to disrupt the business, goodwill, and reputation of Genting Group.

B. Respondent

The respondent did not reply to complainant's complaint within the prescribed time period of 20 days.

Findings of the Panel

Pursuant to Article 4(a) of the UDRP, each of the following three elements must be met for the complainant to prevail:

Element 1: The Disputed Domain Name must be identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

Element 2: The respondent has no rights or legitimate interests with respect to the Disputed Domain Name; and

Element 3: The Disputed Domain Name has been registered and is being used in bad faith.

Based upon the information and evidence presented to the panel, the panel finds as follows.

Element 1: Is the Disputed Domain Name identical or confusingly similar to a trademark or service mark in which the complainant has rights?

Prior UDRP panels have consistently held that “[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.” See WIPO Overview 3.0. The complainant has established that it owns registered trademarks for the trademark GENTING. See the following trademarks registered in Thailand: (i) Trademark App. No. 722367 for GENTING; (ii) Trademark App. No. 722368 for GENTING; and (iii) Trademark App. No. 722369 for GENTING. See also EU Trademark Fil. No. 006350359 for GENTING. Hence, the complainant has met the threshold requirement of having trademark rights for the purposes of standing to file a UDRP case.

The next step is to analyse whether the Disputed Domain Name is identical or confusingly similar to the trademark GENTING. The Disputed Domain Name consists of four elements, namely, (i) “GENTING”, (ii) “PRINCESS”, (iii) “168”, and (iv) “.com”. The gTLD “.com” is a standard registration requirement, and may be disregarded when determining identity or confusing similarity under the Element 1.

According to the WIPO Overview 3.0, “*While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.*” In this case, the Disputed Domain Name not only incorporates the entire trademark GENTING, but also the trademark GENTING constitutes the first part of the Disputed Domain Name. Consumers normally pay more attention to the beginning of a trademark than to the end because the first part has a greater impact (See the judgment in the European Court of Justice case T-411/15 *PP Gappol Marzena Porczyńska vs European Union Intellectual Property Office*).

Taking into account that (i) the Disputed Domain Name includes the complainant's trademark GENTING in its entirety and (ii) that the complainant's trademark GENTING constitutes the first part of the Disputed Domain Name, the panel concludes that the Disputed Domain Name is confusingly similar to the complainant's trademark GENTING.

Element 2: Does the respondent have rights or legitimate interests with respect to the Disputed Domain Name?

To demonstrate rights or legitimate interests in a domain name, non-exclusive respondent defenses under UDRP paragraph 4(c) include the following:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The respondent has failed to answer the allegations of the complainant and, therefore, has not attempted to demonstrate any rights or legitimate interests in the Disputed Domain Name. The Website contains information on how users can access respondent's online casino "Genting Princess". In this regard, it includes three links to the online casino "Genting Princess", namely, (i) www.arunbet.com, (ii) <http://ax9988.com>, and (iii) www.borderbet.com. Each of those links refers to a webpage requiring the user to enter a User ID and password in order to access the respondent's online casino "Genting Princess".

The respondent's current use of the Website cannot be regarded as a *bona fide* offering of goods or services because, according to the WIPO Domain Name Registration Data Lookup, the respondent registered the Disputed Domain Name on the 3rd of October 2018. The complainant has presented sufficient evidence to prove that, at the time when the Disputed Domain Name was registered by the respondent, the complainant had at least three valid registrations for the trademark GENTING in Thailand, i.e., Trademark App. No. 722367 for GENTING, Trademark App. No. 722368 for GENTING, and Trademark App. No. 722369 for GENTING. The EU Trademark Fil. No. 006350359 for GENTING was also valid at that time.

After considering (i) the existence of complainant's registered trademarks in Thailand at the time when the Disputed Domain Name was registered, (ii) the fact that the trademark GENTING is widely known internationally, (iii) the fact that the respondent's address is in Thailand, and (iv) the fact that the respondent used the Disputed Domain Name to launch a website operating in the same field (gaming) in which the complainant operates, the panel finds that the respondent was

likely aware of complainant's trademarks, but, nevertheless, registered and used the Disputed Domain Name with the aim to benefit from the goodwill and the reputation of the complainant by attracting Internet users to respondent's online casino "Genting Princess". Such a use cannot constitute a *bona fide* offering of goods or services or making a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish complainant's trademarks at issue. Furthermore, there is no evidence that the respondent has been commonly known by the Disputed Domain Name.

Since there is no evidence proving the respondent's rights or legitimate interest with respect to the Disputed Domain Name, the panel concludes that the respondent has no rights or legitimate interests with respect to the Disputed Domain Name. According to the WIPO Overview 3.0, if the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Element 3: Has the Disputed Domain Name been registered and used in bad faith?

The panel finds that the respondent was likely aware of complainant's trademarks, but, nevertheless, registered and used the Disputed Domain Name with the aim to benefit from the goodwill and the reputation of the complainant by attracting Internet users to the Website. To attract such users, the respondent created a likelihood of confusion with the complainant's trademark GENTING as to the source, sponsorship, affiliation, or endorsement of the Website. The panel came to this conclusion on the basis of (i) the existence of complainant's registered trademarks in Thailand at the time when the Disputed Domain Name was registered, (ii) the fact that the trademark GENTING is widely known internationally, (iii) the fact that the respondent's address is in Thailand, and (iv) the fact that the respondent used the Disputed Domain Name to launch a website operating in the same field (gaming) in which the complainant operates.

Pursuant to Section 4(b)(iv) of the UDRP the following circumstances shall be regarded as an evidence of bad faith:

By using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location.

Therefore, the panel concludes that the Disputed Domain Name been registered and used in bad faith.

The panelist notes that the respondent's use of the Disputed Domain Name and the Website may also fall within the scope of Section 4(b)(iii) of the policy, but the examination of whether this is the case is not necessary as the presence of the circumstances in Section 4(b)(iv) of the UDRP is sufficient to establish that the Disputed Domain Name been registered and used in bad faith.

Award

Based upon the UDPR, the information presented to the panel, and the aforementioned analysis, the panel finds that: (i) the Disputed Domain Name is confusingly similar to trademarks in which the complainant has rights; (ii) the respondent does not have any legitimate right or interest with respect to the Disputed Domain Name; and (iii) the Disputed Domain Name was registered and is being used in bad faith.

Therefore, the panelist hereby orders the Disputed Domain Name to be transferred to the complainant.



Dr. Daniel Dimov

Sole Panelist

13 January 2020