

**Decision for dispute CAC-UDRP-104398**

Case number **CAC-UDRP-104398**

Time of filing **2022-03-07 09:10:02**

Domain names **golamalaysia.com**

**Case administrator**

Organization **Denisa Bilík (CAC) (Case admin)**

**Complainant**

Organization **D. Jacobson & Sons Limited**

**Complainant representative**

Organization **TLT LLP**

**Respondent**

Name **Leon Bauer**

## OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

## IDENTIFICATION OF RIGHTS

The Complainant has established by evidence which the Panel accepts, that the Complainant is the registered owner of a series of trademarks for GOLA, including the following:

- (a) The United Kingdom trademark for GOLA, registered on June 14, 1978; and
  - (b) The European Union trademark for GOLA, registered on October 4, 2000;
- (collectively “the GOLA trademark”).

## FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT.

These facts are set out under the contentions of the parties

## PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

## PARTIES' CONTENTIONS:

### COMPLAINANT:

The Complainant is the registered owner of several trademarks for GOLA and therefore has standing to bring this Complaint. Included among the trademarks are the following:

- (a) The United Kingdom trademark for GOLA, registered on June 14, 1978; and
  - (b) The European Union trademark for GOLA, registered on October 4, 2000;
- (collectively "the GOLA trademark").

The Respondent registered the disputed domain name on August 11, 2021.

The disputed domain name is confusingly similar to the GOLA trademarks, as it contains the whole of the trademark and the word "malaysia" as a result of which the domain name would be interpreted as invoking the activities of the Complainant in Malaysia.

The Respondent has no rights or legitimate interests in the disputed domain name. That is because the Respondent is not using the domain name for a bona fide purpose but for selling goods under the GOLA brand without the permission of the Complainant, which the Respondent has no right to do and collecting information on potential customers which may lead to perpetrating a fraud on them.

The disputed domain name was registered and is used in bad faith. That is so because the Respondent has been passing itself off as the Complainant, selling goods illegally branded as GOLA and collecting information on customers which may well be used to perpetrate a fraud on them.

Accordingly, the Panel should order that the disputed domain name be transferred to the Complainant.

### RESPONDENT:

The Respondent did not file a Response in this proceeding.

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#### RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

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#### NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

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#### BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

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#### PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

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#### PRINCIPAL REASONS FOR THE DECISION

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform

Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

#### A. Administrative compliance.

By notification dated March 7, 2022 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively compliant and that it was admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed the above process and makes a finding that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

#### B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (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.

The Panel will therefore deal with each of these requirements in turn.

##### A. Identical or Confusingly Similar

The Complainant has adduced evidence which the Panel accepts that the Complainant is the registered owner of the GOLA trademark and that as such has rights in that trademark. In particular, the evidence shows that, among other trademarks, the Complainant is and was at all material times, the registered owner of:

- (a) The United Kingdom trademark for GOLA, registered on June 14, 1978; and
  - (b) The European Union trademark for GOLA, registered on October 4, 2000;
- (collectively “the GOLA trademark”).

The Panel next finds that the disputed domain name <golamalaysia.com> is confusingly similar to the GOLA trademark for the following reasons.

First, the domain name includes the entirety of the GOLA trademark and that word is by far the dominant part of the domain name. Accordingly, the attention of the internet user would naturally be drawn to that part of the domain name and would inculcate in the mind of the user the idea that the domain name was an official domain name of the Complainant. Secondly, the domain name includes the word “malaysia” that has been added to the mark. This must strengthen in the mind of the internet user the notion that the domain name is an official domain name of the Complainant dealing with its products sold under the GOLA brand and distributed in Malaysia.

Internet users would therefore be confused as they would naturally think that the domain name would or might lead to a website where they could buy the Complainant’s GOLA brand products if they were so minded.

It is also now well established that the addition of a generic top-level domain, such as “.com” in the present case, cannot negate confusing similarity that is otherwise present, as it is in the present case.

Accordingly, the domain name is confusingly similar to the Complainant’s GOLA trademark and the Complainant has thus shown the first of the three elements that it must establish.

## B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] of the dispute, your 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) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate non-commercial 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The evidence of the Complainant is that the Respondent is not related in any commercial way to the Complainant or its business. Nevertheless, the Respondent has registered the disputed domain name which falsely implies that it leads to the Complainant's business in Malaysia and to a website where the public may buy genuine GOLA products from the Complainant all of which is false. Providing such misleading and false information on the internet cannot conceivably give rise to any right or legitimate interest in the domain name as it is based on a series of falsehoods.

It is also clear from the evidence that the Respondent is not commonly known by the domain name under Policy paragraph 4(c)(ii).

The disputed domain name points to a website, screenshots of which have been put in evidence. They show that the website brazenly uses the GOLA trademark, which it is not entitled to do, offers goods for sale which are branded GOLA goods, contains a mechanism for internet users to buy the goods which would probably never be delivered and solicits personal information from potential customers probably with the intention of perpetrating a fraud on them.

Indeed, the structure of the website is a mechanism for the sale of what are almost certainly counterfeit goods and other goods which the Complainant has never permitted the Respondent to sell under the GOLA brand.

Moreover, the intention of the Respondent has clearly been to pass itself off as the Complainant and do everything it could to perpetrate the falsehood that the website is genuine when it is not.

Such conduct cannot give rise to a right or legitimate interest in the domain name and the Panel so holds in the present proceeding.

These facts give rise to the prima facie case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default.

Accordingly, the prima facie case has not been rebutted and the Complainant has thus made out the second of the three elements that it must establish.

### C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (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
- (iv) 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 as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b) (iii) and 4 (b)(iv) of the Policy and probably within other provisions of paragraph 4 (b) as well.

That is so for the following reasons.

The Complainant first submits that Respondent must have been aware of Complainant and its well-known trademark at the time of registration of the disputed domain name. The Panel agrees. Because of the fame and reputation of the GOLA trademark acquired over many years, the Respondent must have been aware of the existence of the Complainant and its reputation when it registered the disputed domain name. The Panel accepts the Complainant's submission that it is inconceivable that Respondent did not know of the similarity between the disputed domain name and the GOLA trademark, as they are for all practical purposes identical and the only variation is the discreditable one to mislead the user into thinking that the website deals with the Complainant's business in Malaysia. It is therefore more likely than not that the Respondent chose the wording of the domain name to invoke the name of the Complainant and its activities and deliberately to mislead internet users. Such conduct has been seen by panelists many times to come within paragraph 4(b)(iii) as it must disrupt the Complainant's business.

Secondly, such conduct has also been seen to come within paragraph 4(b) (iv) as it must be taken to have created a likelihood of confusion, with the intention of attracting current and potential customers of the Complainant looking for its services and doing so in this misleading manner. Accordingly, the domain name was registered in bad faith.

Thirdly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name using the GOLA mark and in view of the conduct that Respondent has engaged in when using the domain name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression. The whole *modus operandi* of the Respondent is to give the false impression that it is running an official site for and on behalf of the Complainant, which it is not. On the evidence it is passing itself off as the Complainant, using the Complainant's trademark to make money for itself, defrauding the public and collecting information on them that it is not entitled to collect. In that regard, Annex A, which is in evidence and which is a screenshot of the Respondent's website, shows goods branded GOLA, invites the user to "shop now", has a checkout cart in the usual style, offers "money back guarantee", prices in Malaysian currency and a contact form clearly designed to entice customers to leave their personal information. All of this shows clearly that the

Respondent acted in bad faith both when it registered and when it used the domain name.

There are many prior UDRP decisions to support all of the foregoing conclusions.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

- 1. **GOLAMALAYSIA.COM**: Transferred

PANELLISTS

Name	The Hon. Neil Brown, QC
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DATE OF PANEL DECISION	2022-04-01
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Publish the Decision