

SINGAPORE DOMAIN NAME DISPUTE RESOLUTION SERVICE

Administrative Panel Decision

Case No. SDRP-2005/0001(F)

McDonald's Corporation v Naturerise, Inc

1. The Parties

1.1 The Complainant, McDonald's Corporation, is a corporation duly organised under the laws of the State of Delaware, USA, whose principal place of business is at One McDonald's Plaza, Oak Brook, Illinois 60523, USA.

1.2 The Respondent, Naturerise, Inc, is a corporation registered in the State of Nevada, USA, whose registered address is at 350 South Center Street, Suite 500, Reno NV 89501, USA.

2. The Domain Name and Registrar

2.1 The domain name in issue is "mcdonalds.com.sg" ("the Domain Name").

2.2 The Registrar of the Domain Name is Pacific Internet Limited of 89B Science Park Drive, #02-05/06 The Rutherford, Singapore 118261, an accredited registrar authorised by Singapore Network Information Centre (SGNIC) Pte Ltd ("SGNIC") of 8 Temasek Boulevard, #14-00 Suntec Tower Three, Singapore 038988.

3. Procedural History

3.1 The Complainant submitted its complaint ("the Complaint") pursuant to the Singapore Domain Name Dispute Resolution Policy ("the Policy"), the Rules of the Singapore Domain Name Dispute Resolution Policy ("the Rules") and the Supplemental Rules of the Singapore Domain Name Dispute Resolution Policy ("the Supplemental Rules").

3.2 The Secretariat for the Singapore Domain Name Dispute Resolution Service ("the Secretariat") received the Complaint dated 11 January 2005 in hard copy on 11 January 2005 and by e-mail on 12 January 2005. After checking the Complaint for compliance with formalities requirements, the Secretariat forwarded the Complaint, together with the prescribed Complaint Notification Instructions to the Respondent in hard copy and electronic form on 18 January 2005.

3.3 The Respondent submitted its response dated 9 February 2005 ("the Response") to the Secretariat by e-mail on 10 February 2005. A copy of the Response was forwarded to the Complainant by the Secretariat by e-mail on 11 February 2005.

3.4 On 11 February 2005, the Secretariat notified both the Complainant and the Respondent (collectively "the Parties") of the appointment of Ms Joyce A. Tan as the sole panellist on the Administrative Panel ("the Panel") to decide the dispute between the Parties over the Domain Name, after the said Ms Joyce A. Tan had signed the

Statement of Acceptance and Declaration of Impartiality and Independence. The Panel received copies of the Complaint and the Response from the Secretariat by e-mail only on 11 February 2005 and a hard copy of the Complaint on 14 February 2005.

- 3.5 The Complainant further submitted to the Secretariat by e-mail and in hard copy (with a copy to the Respondent by e-mail only) its reply to the Response dated 19 February 2005 followed by its amended reply dated 21 February 2005 ("the Reply"). These were received by the Secretariat on 21 February 2005 and were both forwarded to the Panel on 21 February 2005 by e-mail and in hard copy.

4. Factual Background

- 4.1 The Complainant states that it:

4.1.1 is the owner of the registration rights and goodwill in the marks "McDonald's", "Ronald McDonald", "McDonaldLand" and "McDonald's & Corporate Logo", as well as other marks incorporating the word "McDonald's" (collectively the "McDonald's Marks") in respect of a wide range of goods and services in Singapore and throughout the world;

4.1.2 has registered trade marks in Singapore for the McDonald's Marks (both in English and in Chinese) in Classes 14, 16, 25, 28, 29, 30, 31, 32, 36 and 42 and has submitted documentary evidence of such registrations in the Complaint;

4.1.3 is the registrant and owner of the domain name "mcdonalds.com" (registered on 12 July 1994) as well as the equivalent in many other jurisdictions such as "mcdonalds.it" in Italy;

4.1.4 has –

- (1) through extensive usage and advertisements worldwide, including Singapore, caused the McDonald's Marks to become distinctive of various goods and services emanating from and identified solely with the Complainant and no other; and
- (2) further built up substantial goodwill and reputation in the McDonald's Marks, as evinced by the approximate annual amounts of net sales and advertising expenditure associated with the McDonald's Marks and provided in the Complaint as follows –

Year	NET SALES		ADVERTISING EXPENDITURE	
	Worldwide (US\$'000)	Singapore (S\$'000)	Worldwide (US\$'000)	Singapore (S\$'000)
1997	22,928,000	236,177	917,000	9,022
1998	24,513,000	231,021	980,000	10,860
1999	26,309,000	250,951	1,052,000	11,968
2000	28,707,000	263,021	1,148,000	13,102
2001	30,093,000	259,364	1,203,000	12,899
2002	31,108,000	244,645	1,244,000	10,602
2003	17,140,000	238,269	596,700	13,646

- 4.1.5 learnt from its associated company in Singapore, McDonald's Restaurants Pte Ltd ("McDonald's Singapore"), in or around July 2003, that the Domain Name had already been registered in the name of Compulabs Technologies ("Compulabs"), with effect from 5 September 1997.
- 4.2 A search conducted on the Domain Name by the Complainant's solicitors, Messrs Mallal & Namazie ("the Complainant's Solicitors") on 28 October 2003, led to a one-page web-site featuring an advertisement for web/emailing services offered by a company called iLabs Pte Ltd ("iLabs") and a cartoon image of a boy holding a plate of food. A copy of this web-site advertisement was submitted with the Complaint.
- 4.3 The Complainant's Solicitors conducted company searches on Compulabs on 23 July 2003 and on iLabs on 19 November 2003 which revealed that:
- 4.3.1 Compulabs is the sole proprietorship of one Te Kek Chin Allen (Dai Keqin Allen); and
- 4.3.2 the majority shareholder and a director of iLabs is also the said Te Kek Chin Allen (Dai Keqin Allen).
- Copies of the search results revealing the above information were submitted with the Complaint.
- 4.4 The Complainant further states that:
- 4.4.1 on 28 August 2003, Mr Poon Fook Kuan, Vice President – Real Estate and Mr Ng Hock Yam, marketing executive, both of McDonald's Singapore met the said Mr Te Kek Chin Allen of iLabs with a view to procuring the transfer of the Domain Name for the sum of S\$2,000.00;
- 4.4.2 in response, Mr Te Kek Chin Allen did not indicate whether or not the offer was accepted but had instead asked Mr Poon Fook Kuan and Mr Ng Hock Yam to calculate the amount based on -
- (1) the registration, maintenance and hosting costs invested by iLabs since the registration of the Domain Name in 1997;
 - (2) the cost of legal proceedings that the Complainant would have to incur to obtain the said transfer; or
 - (3) a figure which the Complainant feels is a reasonable amount to be paid for the Domain Name.
- 4.4.3 on 10 September 2003, Mr Poon Fook Kuan then offered the amount of S\$5,000.00 for the transfer but this offer was rejected by Mr Te Kek Chin Allen who instead suggested the amount of S\$25,000.00 based on the estimated legal costs that the Complainant would otherwise need to incur to obtain an order for the transfer of the Domain Name;

- 4.4.4 on 7 October 2003, Mr Poon Fook Kuan made a further offer of S\$10,000.00 which was rejected by Mr Te Kek Chin Allen who reiterated his previous amount of S\$25,000.00; and
- 4.4.5 the Complainant did not accept the counter-offer but instead, the Complainant's Solicitors, on behalf of the Complainant, issued a letter of demand on 31 October 2003 to Mr Te Kek Chin Allen trading as Compulabs, a copy of which was included in the Complaint and to which no response was received.
- 4.5 Some time in 2004, the Domain Name was transferred to the Respondent and pursuant to paragraph 8.2.6 of the Registration Policies, Procedures and Guidelines ("RPPG") of SGNIC which requires a foreign company to appoint a locally registered entity as its Administrative Contact, the Respondent nominated Compulabs as such local Administrative Contact.
- 4.6 Subsequently, checks which were conducted on behalf of the Complainant on the use of the Domain Name after its transfer to the Respondent, on 22 May 2004 and more recently on 16 February 2005, led to a webpage that said "You are not authorised to view this page", a printout copy of which has been provided by the Complainant in the Reply.
- 4.7 The Complainant's Solicitors wrote separate letters (copies of which were included in the Complaint) to:
- 4.7.1 Mr Te Kek Chin Allen trading as Compulabs dated 24 May 2004; and
- 4.7.2 the Respondent dated 25 May 2004,
- in both instances seeking information about the said transfer of the Domain Name to the Respondent and information on the Respondent as the transferee of the Domain Name. The Complainant states that no reply was received in response to either of these letters.
- 4.8 Thereafter, the Complainant's solicitors in the United States of America, Messrs Neal, Gerber & Eisenberg LLP ("the US Solicitors") wrote to the Respondent vide a letter dated 9 June 2004 to enquire on the Respondent's intended use of the Domain Name, a copy of which was submitted with the Complaint. In this connection:
- 4.8.1 while the Complainant contends that no response was received from the Respondent to the US Solicitors' said letter;
- 4.8.2 the Respondent contends that it responded to the US Solicitors' said letter –
- (1) by way of an e-mail sent on 20 June 2004 (in support of which the Respondent submitted with the Response, copy of a document setting out the alleged contents of such e-mail presented in traditional letter form, rather than a printout from the "Sent" log of email correspondence),

- (2) stating that its use of the Domain Name constitutes fair use; and

4.8.3 the Complainant –

- (1) continues to maintain its position that no response was received from the Respondent to the US Solicitors' letter and submitted with the Reply, copy of a Statutory Declaration dated 16 February 2005 sworn by the attorney in charge of the matter from the US Solicitors that no such response was received from the Respondent; and
- (2) contends in the Reply that the said e-mail response alleged by the Respondent has been fabricated.

4.9 Corporate information and domain name registration searches conducted on the Respondent by the US Solicitors indicated that the Respondent is or was the registrant of several domain names in the United States of America ("US domain names") in respect of which:

- 4.9.1 the aforesaid Mr Te Kek Chin Allen (of both Compulabs and iLabs) is named as the contact person of the Respondent for at least a couple of the US domain names;
- 4.9.2 the email contact billing@ilabs.com, provided by the Respondent for these couple of US domain names, is the same as that provided for the Domain Name in Singapore; and
- 4.9.3 the name servers "ns1.ilabs.com.sg" and "ns2.ilabs.com.sg" listed for several of the US domain names are the same as those listed for the Domain Name.

Copies of the search results showing the above information have been provided in the Complaint.

- 4.10 The Respondent, who does not provide any background information about itself, generally denies knowledge of the facts surrounding the communication between the Complainant and Compulabs, the previous registrant of the Domain Name, as related by the Complainant and set out at paragraph 4.4 above.

5. The Parties' Contentions

5.1 The Complainant

The Complainant contends as follows:

- 5.1.1 The Domain Name is identical or confusingly similar to the McDonald's Marks in which the Complainant has rights because –
 - (1) "mcdonalds" as used in the Domain Name is virtually identical and/or confusingly similar with the McDonald's Marks owned by the Complainant; and

- (2) the MacDonal'd's Marks are so well known in Singapore that any consumer coming across the Domain Name will naturally assume that it is owned by or affiliated to the Complainant.

5.1.2 The Respondent (like its predecessor registrant of the Domain Name, Compulabs) has no rights or legitimate interests in respect of the Domain Name as it:

- (1) is not authorised or licensed to use the Complainant's name or the McDonald's Marks;
- (2) has not acquired any trade mark or service mark rights over the Domain Name;
- (3) is not commonly known by the Domain Name; and
- (4) has not made any legitimate or fair use of the Domain Name.

5.1.4 The Domain Name has been registered by Compulabs and/or is being used by the Respondent in bad faith for the following reasons:

- (1) the Respondent is related to Compulabs;
- (2) Compulabs registered and the Respondent subsequently took over the Domain Name when it each had actual or constructive knowledge of the McDonald's Marks and the Complainant's name, which are distinctive and well-known in Singapore;
- (3) Compulabs failed to respond to the letter of demand dated 31 October 2003 sent by the Complainant's Solicitors on behalf of the Complainant other than by transferring the Domain Name to the Respondent;
- (4) the Respondent failed to respond to –
 - (a) the Complainant's Solicitors' letter dated 25 May 2004 requesting information about the transfer of the Domain Name and about the Respondent; and
 - (b) the US Solicitors' letter dated 9 June 2004 requesting information on its proposed use of the Domain Name (and further fabricated such a response in its submissions in the Response filed in the present proceedings);
- (5) there has been no legitimate use of the Domain Name since its registration by Compulabs and following its transfer to the Respondent, in particular –
 - (a) when Compulabs as the original registrant allowed use of the Domain Name by its affiliate iLabs in the manner described at paragraph 4.2 above, it was trying to divert customers of the

Complainant to its website for commercial gain in that visitors to that website would have been misled into thinking it was affiliated with the Complainant especially since it featured a cartoon image of a boy bearing a plate of food, which the Complainant is well-known to be in the business of selling (even though the services offered by iLabs were web/emailing services); and

- (b) following transfer of the Domain Name to the Respondent, there has been no legitimate use of the Domain Name as illustrated by the outcome of the checks conducted on the use of the Domain Name and described at paragraph 4.6 above that such checks led to a webpage that said "You are not authorised to view this page"; and
- (6) the Respondent is (as was Compulabs when it was the registrant) a cyber-squatter of the Domain Name which it holds on to purely for the purpose of reserving it for transfer or rent to another for profit.

5.2 The Respondent

The Respondent relies on the following in support of its contention that the Complainant ought to be denied the Domain Name:

5.2.1 The name "McDonalds" is a valid first name and last name in the United States. The Respondent owns a bank of domains across the world with first and last names such as "jane", "peter" and "mcdonalds" so that it may "target paying individuals who want to customize their personal website addresses" and the Respondent's acquisition of the Domain Name –

- (1) was "to make complete as possible" its "portfolio of first and last names"; and
- (2) since it was the only domain name with "mcdonalds" (albeit with the .sg suffix) which the Respondent could afford to acquire from an existing owner.

5.2.2 The Respondent has not used the Domain Name in bad faith and intends to put the Domain Name to fair use –

- (1) in a way that would not infringe the Complainant's rights in the McDonald's Marks in the respective classes for which they are registered; and
- (2) without the intention of selling the Domain Name.

5.2.3 The Respondent's only relationship with Compulabs and/or iLabs is that of customer-supplier and –

- (1) Compulabs was retained as the Administrative Contact for the Domain Name even following its transfer to the Respondent only because of the requirement of SGNIC that a foreign company must appoint a locally registered entity as such Administrative Contact; and
- (2) the email contact billing@ilabs.com and name servers "ns1.ilabs.com.sg" and "ns2.ilabs.com.sg" were retained in the registration particulars in connection with the Domain Name following its transfer to the Respondent, simply as part of the standard services provided to the Respondent when the Domain Name was transferred to the Respondent.

5.2.4 The allegations in the Complaint are directed mainly at Compulabs which the Respondent has no knowledge of and the Complainant has not demonstrated that the Respondent is related to Compulabs.

5.2.5 The three conditions for a finding to transfer the Domain Name to the Complainant have not been met.

6. Discussion and Findings

6.1 Under paragraph 4a of the Policy, the Complainant must establish the following three conditions to be entitled to the remedy under paragraph 4i of the Policy of a transfer of a domain name:

6.1.1 the registrant's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights;

6.1.2 the registrant has no rights or legitimate interests in respect of the domain name; and

6.1.3 the registrant's domain name has been registered or is being used in bad faith.

6.2 Identical/Similar to Name/Mark in Which Complainant Has Rights

6.2.1 With respect to the first condition to be met under paragraph 4a(i) of the Policy, the Complainant must establish both of the following, namely, that:

- (1) the Complainant has rights in the name or mark "McDonald's"; and
- (2) the Domain Name is identical or confusingly similar to the name or mark "McDonald's".

6.2.2 *Complainant's Rights*

- (1) The Complainant has registered the name or mark "McDonald's" in Singapore either as a word mark on its own or together with other components, together forming the stable of McDonald's Marks owned by the Complainant, as stated at paragraphs 4.1.1 and 4.1.2 above. Under Section 26 of the Trade Marks Act (Cap. 332) ("the Act"), trade

mark registration in Singapore confers upon the proprietor the exclusive right to use and authorise other persons to use the registered trade mark, in relation to the goods or services in respect of which the trade mark is registered.

- (2) Further, as a result of the extensive use of the McDonald's Marks and the significant sales generated by such use coupled with the substantial advertising and promotion as disclosed by the Complainant and set out in paragraph 4.1.4 above, the "McDonald's" name has become a well recognised global brand in Singapore and elsewhere and enjoys considerable goodwill and reputation. Such reputation and goodwill constitute a basis on which the common law action of passing off may be founded in the appropriate circumstances.
- (3) Notwithstanding the Respondent's assertion that "Mcdonalds" is a valid first name and last name in the United States, the Respondent has failed to rebut or disprove the Complainant's trade mark rights and reputation and goodwill in the "McDonald's" name.
- (4) With registration of the McDonald's Marks dating back to as early as 1969 and use of the McDonald's Marks having commenced in Singapore since 1979, long before both the registration of the Domain Name and its transfer to the Respondent, the Panel finds that the Complainant has, at the commencement of this Administrative Proceeding, rights in the name or mark "McDonald's".

6.2.3 *Identical or Confusingly Similar*

- (1) Turning now to whether the Domain Name is identical or confusingly similar to such "McDonald's" name (over which the Complainant has rights), the Panel notes that it is generally accepted that the addition of the portion ".com" is to be ignored and the comparison is to be with the characterising part of the domain name (see *VAT Holding AG v VAT.com* (WIPO Case No. D2000-0607) and *Croatia Airlines d.d. v Modern Empire Internet Ltd.* (WIPO Case No. D2003-0455)).
- (2) Accordingly, when the ".com.sg" portion of the Domain Name is discounted, the Panel finds that the Domain Name is identical and/or confusingly similar to the "McDonald's" name or mark over which the Complainant has established rights.

6.2.4 This Panel is therefore of the view that the Complainant has satisfied the requirements of paragraph 4a(i) of the Policy that the Domain Name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights.

6.3 Rights or Legitimate Interests of Respondent

6.3.1 On the second condition under paragraph 4a(ii) of the Policy, the Complainant is required to prove that the Respondent has no rights or legitimate interests in

respect of the Domain Name. Pursuant to paragraph 4c of the Policy, the following in particular but without limitation, which if proved, shall demonstrate the Respondent's rights to or legitimate interests in the Domain Name for purposes of this second condition:

- (1) before any notice to the Respondent 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;
- (2) the Respondent has been commonly known by the Domain Name, even if it has acquired no trade mark or service mark rights; or
- (3) the Respondent is 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 trade mark or service mark at issue.

6.3.2 *Bona Fide Offering of Goods and Services*

- (1) The question is, has the Respondent used or made demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services? The evidence in this regard is as follows:
 - (a) Since the Respondent took over the Domain Name from Computalabs some time in the early part of 2004, the only discernable use of the Domain Name has been for a webpage that says "You are not authorised to view this page". This has been shown to be the case right until following the commencement of this Administrative Proceeding with a copy of the printout from this webpage on 16 February 2005 having been provided by the Complainant in the Reply. Although also raised in the Complaint with respect to a similar finding of this webpage on 22 May 2004, the Respondent has not refuted this in the Response, other than to provide an oblique explanation about this being its "hosting provider's practice to have a standard under construction page which leads before a site goes live".
 - (b) By its own admission, the Respondent owns a bank of domain names such as "jane" and "peter" for the purpose of reselling such names to paying individuals who wish to customise their personal website addresses and the Domain Name was similarly acquired for such purpose. A visit to the website address "www.naturerise.com/draft" as provided by the Respondent in the Response confirms that the Respondent offers a selection of domain names for use as personal website addresses.

- (c) Further, although the Respondent states that "it had already started plans for it", it has not provided any evidence to support this claim.
- (2) In *J. Crew International, Inc. v crew.com* (WIPO Case No. D2000-0054), the complainant owned the trade mark "CREW" and "J.CREW", while the respondent had registered the domain name "crew.com" primarily for the purpose of selling, renting or otherwise transferring the domain name registration. Also, in *Blue Martini Software, Inc. v Entredomains, Inc.* (WIPO Case No. D2000-0917), the complainant had rights in the trade marks "BLUE MARTINI" and "BLUE MARTINI SOFTWARE", while the respondent had registered the domain name "bluemartinissoftware.com" for an alleged unidentified client. In both cases, the respective administrative panels held that the speculation in the sale of domain names corresponding to the marks of others is not a legitimate interest.
- (3) Indeed, the SGNIC RPPG provide under:
- (a) paragraph 9.2 that "*the registrant also represents and warrants ... that the domain name ... is for its own organisational use*"; and
- (b) paragraph 13.1 that "*The registrant has the right to use the domain name but not the right to own it. As such, the registrant does not have the right to sell or transfer the domain name to any party whether for profit or otherwise*".

6.3.3 Commonly Known by Domain Name

The Respondent's name is Naturerise, Inc, which bears no resemblance whatsoever to the Domain Name. Further the Respondent has not asserted that it is commonly or at all known by the Domain Name or any name similar to it and nor does it have any other connection with the Domain Name (besides being the registrant thereof).

6.3.4 Non-Commercial or Fair Use

Is the Respondent 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 trade mark or service mark at issue? The evidence discussed at paragraph 6.3.2 above (in the examination of whether the Respondent has used or is preparing to use the Domain Name in connection with a *bona fide* offering of goods or services) most certainly points to the negative. Insofar as the Respondent intends to reserve the Domain Name (in the Respondent's own words) "to target paying individuals", this cannot be said to be a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain.

6.3.5 The Panel accordingly finds that the condition under paragraph 4a(ii) of the Policy is also satisfied as the Respondent does not have any legitimate right or interest in the Domain Name, taking into account the above considerations discussed in this paragraph 6.3 and in the absence of any other submission made or evidence provided by the Respondent on such right or interest in the Domain Name. On the contrary, the only right and interest in the Domain Name expressed by the Respondent is an illegitimate one contrary to the provisions of the SGNIC RPPG.

6.4 Registration/Use of Domain Name in Bad Faith

6.4.1 The third and final condition to be met under paragraph 4a(iii) of the Policy requires the Complainant to prove that the Domain Name has been registered or is being used in bad faith. The Policy clarifies at paragraph 4b that the following circumstances in particular but without limitation, if found to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (1) circumstances indicating that the registrant 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 bears the name or is the owner of the trade mark or service mark, or to a competitor of that complainant, for valuable consideration in excess of the registrant's out-of-pocket costs directly related to the domain name;
- (2) the registrant has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct;
- (3) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (4) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, internet users to the registrant's website or other on-line location, by creating a likelihood of confusion with the complainant's name or mark as to source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

6.4.2 *Transfer of Domain Name*

It is notable in the present instance that the Respondent did not itself register the Domain Name but is merely the new registrant by way of a transfer between the Respondent and Compulabs, the original registrant.

6.4.3 *Effect of Transfer on Registration*

- (1) To what extent therefore can registration of the Domain Name be said to be that of the Respondent?
 - (a) In *Hebdomag Inc. v Illuminaty Marketing* (WIPO Case No, D2001-0206), the respondent was also the new registrant and was not responsible for registering the domain name in question. Nevertheless, the administrative panel in that case found *inter alia* that this did not mean that the respondent did not "register" the domain name.
 - (b) Further, in *Dixons Group Plc v Mr. Abu Abdullaah* (WIPO Case No. D2000-1406), the administrative panel found that there is basis for saying that "registration" extends beyond the original act of registration and covers subsequent acts of acquisition of the domain name.
- (2) Clearly, a line need not be drawn between the registration of the Domain Name as originally effected by Compulabs and such registration following its transfer to the Respondent.

6.4.4 *Conduct of Previous Registrant*

- (1) Even so, the further question arises as to whether the conduct of Compulabs as the previous registrant may be attributed to the Respondent as the current registrant of the Domain Name. The Respondent itself submits that it has no knowledge of what transpired between the Complainant and the previous registrant, with whom it says it is not related other than in its capacity as customer.
- (2) On this issue, the administrative panel in the above-cited case of *Hebdomag Inc. v Illuminaty Marketing* (WIPO Case No, D2001-0206) decided that when the circumstances of the case tend to indicate that there is, on a balance of probabilities, a likelihood of collusion or duplicity between the current registrant and its predecessor in title, it may be appropriate to take into account the behaviour of the predecessor in title in the determination of bad faith by the respondent.
- (3) Based on the information and documents submitted by both the Complainant and the Respondent, and on a balance of probabilities, the Panel is minded (although it may not be necessary) to find a likelihood of collusion or duplicity between the Respondent and Compulabs, going by several observations which seem to point to a deeper connection between the Respondent and Compulabs as well as iLabs, largely through the *persona* of Te Kek Chin Allen, sole proprietor of Compulabs as well as majority shareholder and director of iLabs. For example:

- (a) Although alleged by the Respondent that it had its first dealing with Compulabs and/or iLabs only when the Domain Name was transferred to it in 2004, the Respondent already held certain US domain names dating back to 2002, in respect of which the said Mr Te Kek Chin Allen was named as the contact person and for which the listed email contact billing@ilabs.com and name servers ns1.ilabs.com.sg and ns2.ilabs.com.sg coincided with those for the Domain Name, as indicated by the search results furnished by the Complainant and referred to at paragraph 4.9 above.
- (b) According to the bare assertion of the Respondent, it obtained the Domain Name from Compulabs without having to pay anything more than "legitimate administrative costs incurred by" Compulabs in registering the Domain Name. In contrast, the Complainant has shown reasonably persuasive evidence that Compulabs was not prepared to take S\$10,000.00 from the Complainant to effect a transfer of the Domain Name to the Complainant.
- (c) Background information submitted on the Respondent in these proceedings has been noticeably scant and one has no sense at all about who the Respondent really is. Despite the commencement of these proceedings following the Complainant's request for information about the Respondent vide the Complainant's Solicitors' letter dated 25 May 2004 to the Respondent as stated in the Complaint, the Respondent has offered no further insight on itself in the Response.

6.4.5 *Conduct of the Respondent*

- (1) However, the Panel does not rely on the conduct of Compulabs and therefore does not delve deeper into such conduct, nor indeed the relationship between the Respondent and Compulabs, in its determination of the third and last condition to be met in these proceedings as to whether the Domain Name has been registered or is being used in bad faith.
- (2) Instead, the Panel places significance on the following with respect to the Respondent itself on this issue of bad faith:
 - (a) The Respondent has stated that its primary purpose of acquiring the Domain Name was to complete its portfolio of first and last names "to target paying individuals" (notwithstanding its other inconsistent assertion that it has no intention of selling the Domain Name, which is not supported by the Respondent's conduct as illustrated by the available evidence). This is clearly within the bad faith provided in paragraph 4b(i) of the Policy where the registrant has "*registered or acquired the domain name primarily for the purpose of selling, renting ...*".

- (b) Notwithstanding the Respondent's assertion that "mcdonalds" is a valid first and last name, the Respondent cannot pretend to be ignorant of the Complainant's widespread reputation, fame and goodwill in the said name and the McDonald's Marks without bad faith. This is supported by *Dixons Group Plc v Mr. Abu Abdullaah* (WIPO Case No. D2000-1406)), which held that where a complainant has a widespread reputation, it would be difficult to believe that the respondent, in taking his transfer of the disputed domain name was unaware of such facts and that such acquisition was made in good faith.
- (c) The Respondent's choice of the Domain Name, bearing and being identical or confusingly similar to the well-known name and mark of the Complainant, is evidence of bad faith as it is contrary to and in breach of the SGNIC RPPG provisions (to which it is bound) under
- paragraph 13.1 that "*The registrant has the right to use the domain name but not the right to own it. As such, the registrant does not have the right to sell or transfer the domain name to any party whether for profit or otherwise*";
 - paragraph 9.1 whereby it represents and warrants that the Domain Name "*(a) does not infringe any registered trade mark nor will it give rise to a cause of action in passing off ... (b) is not identical or confusingly similar with either a registered trade mark, company or business name in Singapore ...*" (which is similarly provided at paragraph 8.1 of the Registrant Agreement to which the Respondent is also bound).
- (d) The administrative panels in *J. Crew International, Inc. v crew.com* (WIPO Case No. D2000-0054) and *Government of Canada v David Bedford a.k.a. DomainBaron.com* (WIPO Case No. D2001-0470) also held that the registration of domain names which are identical or confusingly similar to the trade marks of others may be taken to be evidence of bad faith for the purposes of the Policy.
- (e) The failure to respond to a complainant has been held in past decisions to indicate bad faith (*Samsung Electronics Co., Ltd v Funexpress.com.sg Pte Ltd* (SDRP-2002-0004 (F)) and *Google, Inc. v Googles Entertainment* (SDRP-2002-0003 (F))). In the present instance, the Complainant had (through the Complainant's Solicitors and the US Solicitors) written to the Respondent to enquire about the Respondent's acquisition of the Domain Name and intended use of the Domain Name. The Respondent does not deny that these were received and in fact alleges to have replied to the letter from the US Solicitors in an

e-mail, the only evidence of which provided by the Respondent is a copy of a curiously presented email as described at paragraph 4.8.2(1) above. Such allegation is, in the Panel's view, negated by the sworn Statutory Declaration furnished by the Complainant to the contrary that no reply was in fact received from the Respondent. Not only is the Panel compelled to draw a conclusion of bad faith based on the lack of response but also from the attempt at fabricating the existence of such a response.

6.4.6 For the reasons stated at paragraph 6.4.5 above, the Panel finds that the Domain Name has been registered or is being used in bad faith by the Respondent and that accordingly the condition under paragraph 4a(iii) of the Policy has also been satisfied.

7. **Conclusion**

In the premises, the Panel finds that the Complainant has established the three elements under paragraph 4a of the Policy and is therefore entitled to the remedy of a transfer of the Domain Name as provided under paragraph 4i of the Policy.

Joyce A. Tan
Sole Panellist
25 February 2005