

## ADMINISTRATIVE PANEL ORDER

In the matter of a Domain Name Dispute

BETWEEN

**BTC INTERNATIONAL LIMITD**  
[Complainant]

AND

**1. NXC CORPORATION**  
[Respondent]

**Case ID: KLRCA/ADNDRC-266 -2014**

### **1. The Parties**

The Complainant is BTC International Limited of 4<sup>th</sup> Floor Ellen Skelton Building, 3076 Drake's Highway, P.O.Box 3444, Road Town, Tortola British Virgin Islands with its place of incorporation in British Virgin Island and its principal place of business at BritishIndia (Asia) Sdn Bhd, No. 1 Jalan Teknologi 3/1, Taman Sains Selangor, Kota Damansara, 47810 Petaling Jaya, Selangor, Malaysia an agency under the Malaysian (BTC).

The Respondent is NXC Corporation with its principal place of business at 86, Nohyeong-dong, Jeju-si, Jeju-do, 690802 Jeju, Korea with its place of incorporation in Korea.

### **2. The Domain Name**

The domain name in dispute is www.britishindia.com ("the disputed Domain Name") and is registered with Gabia, Inc. and the Registrant is the Respondent. It was registered on 27 May 1999.

### **3. Procedural History**

The Complaint was filed in English with the Kuala Lumpur office of the Asian Domain Name Dispute Resolution Centre ("ADNDRC-KL") pursuant to the Uniform Domain Name Dispute Resolution Policy ("the Policy") and elected to have the case in

question be dealt with by a single member panel. ADNDRC-KL transmitted by email on 23<sup>rd</sup> October 2013 to Gabia, Inc. (Registrar of the Domain Name) requesting for the registrar verification in connection with the disputed Domain Name.

On 24<sup>th</sup> October 2014, Gabia, Inc. through Chang-ki Jang, the Internet Business team transmitted by e-mail to ADNDRC-KL its verification response, confirming that the Respondent is listed as the Registrant or holder of the disputed Domain name. The Registrar confirmed that the language of the registration agreement was Korean.

ADNDRC-KL verified that the Complaint satisfied the formal requirements of the Policy, the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and ADNDRC Supplementary Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplementary Rules”).

On 29 October 2014, the ADNDRC-KL sent a Written Notice of Complaint (“the Notice”) to the Respondent. The Notice gave the Respondent 20 calendar days to submit a Response (i.e. on or before 20 November 2014).

Since the Complaint was filed in English, the Claimant’s authorized representative wrote to ADNDRC-KL on 31<sup>st</sup> October 2014 requesting the panel to exercise her discretion to determine the language of the proceeding to be in English. Prior to appointing the panel on 3<sup>rd</sup> November 2014, ADNDRC-KL transmitted by email to the Respondent the Claimant’s request, which the Respondent replied in affirmative, agreeing to this proceeding to be conducted in English.

The Respondent submitted a response on 19 November 2014.

On 21 November 2014, the ADNDRC-KL sent an email to Samrith Kaur enquiring from her whether she could act and if so whether she could act independently and impartially in the matter in question.

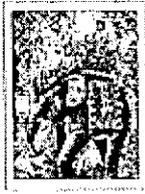
On the same day, Samrith Kaur confirmed that she was willing to act and if appointed would act independently and impartially and thereupon ADNDRC-KL notified the parties that Samrith Kaur had been appointed as a sole panellist by the ADNDRC-KL.

The deadline for rendering the decision has been set for 6 December 2014.

#### 4. **Factual Background**

Complainant is the registered and common law proprietor of the BritishIndia mark (as shown below) (“**BI Mark**”) since 1994 and owns numerous BI Marks on a worldwide basis, namely in China, India Indonesia, Myanmar, Singapore, Malaysia,

Thailand, Philippines, United Arab Emirates, Vietnam, Australia and Hong Kong (collectively known as “BI Marks”).



BRITISHINDIA

The Complainant is in the business of clothing and home furniture with over 40 outlets across Malaysia, Singapore, Thailand and Philippines. The Complainant has and also through its associated company in Malaysia, BTC Clothier Sdn Bhd and BritishIndia (Asia) Sdn Bhd and Singapore, BTC Clothier (S) Pte Ltd, been using the BI Marks extensively in Malaysia, Singapore and worldwide since 1994.

The Respondent registered the disputed Domain Name on 27 May 1999 and to date there has not been evidence of any use by the Respondent of the Domain Name.

The Respondent is a global game company, developing a number of online games and providing its services to about 110 countries. The Respondent is not only registering and using a number of domain names in connection with its current business, but also securing the domain names that it might use in the future business by registering and holding them.

## 5. Parties' Contentions

### a. For the Complainant

The Complainant's contentions may be summarised as follows:

#### i. The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Respondent registered the disputed Domain Name on 27 May 1999, 5 years after the Complainant began using the BI Mark in 1994. Further, the search on GoDaddy WHOIS database lists shows that the Respondent is the Registrant of the disputed Domain Name causing the general public to be confused that the Respondent is the owner of the BI Mark or associated to the Complainant or authorized by the Complainant to use the BI Marks.

Hence the disputed Domain Name is identical and/or confusingly similar to a trade mark in which the Complainant has rights.

ii. **The Respondent has no rights or legitimate interests in respect of the Domain Name**

The Respondent has no rights or legitimate interest in the Domain Name as no permission has been granted to the Respondent to use the BI Marks or the disputed Domain Name. The Respondent is not commonly known by the disputed Domain Name and is not making legitimate non-commercial or fair use of the disputed Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the BI Marks.

There is no evidence that the disputed Domain Name has been used by the Respondent since it was registered 15 years ago.

iii. **The Domain Name was registered and is being used in bad faith**

**Primary for purpose of selling, renting or otherwise transferring the domain name**

The Respondent registered the disputed Domain Name primary for the purpose of selling, renting or otherwise transferring the disputed Domain Name registration to the Complainant who is the owner of the BI Mark, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name.

On 16 June 2014, the Complainant sent cease and desist letter to the Respondent to *inter alia*, assign and transfer the disputed Domain Name to the Complainant.

On 27 June 2014, the Respondent stated that it has maintained the disputed Domain Name for 15 years and offered to grant licence to the Complainant to use the disputed Domain Name.

On 3 July 2014, the Complainant wrote requesting for details of the terms and conditions of the proposed license and whether the Respondent would be amenable to assign the disputed Domain Name to the Complainant.

On 7 July 2014, the Respondent replied by stated that it is willing to licence the disputed Domain Name to the Complainant for 3 year period for a licence fee of USD 3,000.00 per annum.

On 22 July 2014, the Complainant wrote to the Respondent demanding the disputed Domain Name be assigned to it for a consideration of USD 200.00 as the amount is sufficient to cover the cost of registration and maintenance of the Domain Name for the past 15 years. The Registrar's fees for registration and renewal of the Domain Name are USD 9.99 each per year, which is approximately USD 200 only.

On 25 July 2014, the Respondent wrote refusing to accede to the Complainant's demand. The Complainant deems this as evincing that the Respondent is cybersquatting on the disputed Domain Name.

The disputed Domain Name was being used in bad faith by the Respondent merely holding it and not using it since its registration. Based on the DomainTools database Whois Search, it is revealed that the Respondent has registered 161 domain names and 127 of them are not in use (see Exhibit 13)

#### Bad faith inferred based on fame of Complainant's BI Marks

Bad faith ought to be inferred based on the fame of the Complainant's BI Marks, such that the Respondent was aware or should have been aware of the Complainant's mark and claims of rights thereto.

Without prejudice to the Complainant's averment that there is no use of the Domain Name by the respondent, use of the Domain Name in relation to the Respondent's business is likely to cause confusion and/ or deception in that members of the trade and public would erroneously suppose or mistake the business of the Respondent to be associated with that of the Complainant. Such registration if allowed to continue, would damage the Complainant's reputation for highly quality goods as the Respondent's services would not have been subjected to the Complainant's strict quality control.

The Complainant states that if the Domain Name is not assigned to the Complainant, use of it by the Respondent would result in dilution and /or depreciation of the value, goodwill and reputation in the Complainant's mark in that, the trade and public would be misled or deceived into believing that the BI Marks are (a) available for use by the trade; and /or (b) generic; and/or (c) not distinctive of the Complainant's business and goods.

iv. **Without Prejudice” rule is not applicable in the present case**

Even though the Complainant’s correspondence were written on the “Without Prejudice” basis, it does not preclude the evidence indication bad faith on the part of the Respondent. (refer to J.E. Boris SA v Jonathan Obadia, WIPO Case No. D2007-0445; Advance Magazine Publishers Inc v Marcellod Russo, WIPO Case No. D2001-1049).

b. *For the Respondent*

The Respondent’s contentions may be summarised as follows:

**The Respondent, as a holding company of Nexon, the global game company, is securing in advance the domain names that it might use in the future, by registering and holding them in an attempt to prepare for the initiation of various new businesses. The subject Domain Name is one of them.**

The Respondent is not only registering and using a number of domain names in connection with current business, but also securing in advance the domain names that it might use in the future for various future businesses by registering and holding them. Therefore the respondent’s 161 domain names, including the subject Domain Name, as indicated in the list submitted by the Complainant as Exhibit 13 are all registered and held by the Respondent for the foregoing reason.

The Respondent states that it is using 34 domain names out of 161 domain names indicates that the Respondent is not registering or holding domain names in bad faith of interfering with the business or selling them to a lawful right holder, but is using some domain names appropriate for the currently ongoing business first and continues to hold the other domain names for any possible use in the future even though they are not currently in use.

**At the time of the registration of the Subject Domain Name, the Respondent was never aware of the existence of the Complainant’s BRITISHINDIA related trademarks.**

According to the Respondent, the Complainant being a clothing company operated its business mainly in countries such as Malaysia, Singapore, the Philippines, etc. since 1994 and had never been well known in Korea. Therefore, the Respondent could never been aware of the existence of the Complainant

and the BI Marks. The Respondent further states that the Complainant has not submitted materials evidencing the well know status of the BI Marks in 1999 in or outside Korea and the Complainant has not even initiated its business in Korea yet. The mark was only registered in 2010 in Korea, a decade after the registration of the disputed Domain Name, that the Complainant registered the trademark in Korea.

**“BRITISHINDIA” literally refers to “British India” and does not constitute a coined word mark. Therefore, a coin incidence of the identicalness/ similarity to the BI Marks is not enough to be a presumptive ground for the Respondent’s bad-faith intent.**

“BRITISHINDIA” refers to former 17 Indian provinces under the British rule. The Respondent registered the Domain Name since no one had registered a domain name that incorporated the word “BRITISHINDIA”. Further, since the BI Mark does not constitute a coined word mark it is hard to presume that the Respondent had bad faith intention to register the Domain Name based on the fact that it is identical or similar to BI Mark.

**It is difficult to deem that the fact that the Respondent proposed to the Complainant the payment of royalties for the use of the Domain Name, to which the Respondent has lawfully owned property rights over 15 years since its registration, indicates the Respondent’s bad faith.**

The Respondents states that since the Complainant filed an objection to the Respondent’s registration and possession of the Domain Name to which it owns the property rights, although it has no legal obligation, the Respondent proposed that the Complainant pay moderate royalties in the amount of USD 3,000.00 for 3 years (USD 1,000.00 for each year) for the use of the Domain Name in order to respond to the Complainant’s request amicably. Therefore, the Respondent’s proposal was part of a fair transaction or a means to exercise the Respondent’s lawful property rights, and the Respondent had no bad faith and should not be presumed to have had any bad faith.

## **6. Findings**

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

- (1) Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) Respondent's domain name been registered and is used in bad faith.

### **Identical or Confusingly Similar**

The Panel finds that the Complainant has established that it is the owner of the trademarks comprising "BRITISHINDIA". It is clear that the Complainant registered the trademark BI in 1994 prior to the Respondent registering the disputed Domain Name (www.britishindia.com) which is identical to the trademark name "BRITISHINDIA". Although both the parties are well known in their own industries and that the Respondent claims that it registered the disputed Domain Name in advance for future businesses, it does not emend the fact or reality that the Complainant is only known by the Domain Name and no other name, unlike the Respondent who has never used or been referred to as by the disputed Domain Name.

Based on BI Marks being the Complainant's registered trademark, and that the Complainant only known by the disputed Domain Name, the Panel finds that the disputed Domain Name is identical or confusingly similar to the Complainant's registered trademark.

Therefore the Panel finds that the disputed Domain Name is identical to the Complainant's mark pursuant to the Policy, paragraph 4(a)(i).

### **Rights or Legitimate Interest**

The Complainant asserted that it had not granted any permission to the Respondent to use the BI marks or disputed Domain Name. The Panel notes that there is nothing to indicate or suggest that the Respondent has been commonly known by the disputed Domain Name. In fact, the disputed Domain Name has not been used by the Respondent since it was registered in 1999. The Respondent respond by stating that it was never aware of the existence of the Complainant's mark does not negate

the fact that it has no rights or legitimate interest in the disputed Domain Name as it is not known by the Domain Name unlike the Complainant.

The Panel further notes that no evidence has been produced to show that the Respondent has been commonly referred to as the disputed Domain Name (unlike in the case of the Complainant), and there is no reason why Respondent might reasonably be said to have any rights or legitimate interests in registering or using the disputed domain.

The Respondent has also not satisfied the burden of proof under paragraph 4(c) of the Policy, in that the Respondent failed to demonstrate: *(i) the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) it has been commonly known by the domain name, even if it had acquired no trademark or service mark rights; or (iii) the 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.*

Accordingly, the Panel finds that the Complainant has rights to or legitimate interest in respect of the Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

#### **Registered and used in Bad Faith**

The Claimant asserted that the Respondent registered the Domain Name primarily for the purpose of selling, renting or otherwise transferring the Domain Name registration for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name.

This was evident in the Respondent letter dated 7 July 2014 (Exhibit 9), offering the Complainant *'a three year period in exchange for an annual licence fee of USD3,000.00'*, which does not tally with the Respondent's Response dated 19 November 2014, whereby it stated that the Respondent proposed that the Complainant pay "moderate royalties in the amount of about USD 3,000.00 for three years (i.e. about USD 1,000.00 per year)". Reading the letter, it is clear that the Respondent was offering USD 3,000.00 per year.

Hence, as far as use of the disputed Domain Name in bad faith is concerned, the Panel concludes that the Respondent's holding of the disputed Domain Name in this case satisfies the requirement of Paragraph 4(a)(iii) of the Policy in that the domain name was "being used in bad faith" by the Respondent by merely holding it and not using it from 27 May 1999 to 16 June 2014 (i.e. when the Respondent received the Complainant's notice of dispute).

The Panel notes that the Complainant's trademarks have a strong reputation and are widely known, as evidenced by its substantial use and registration in various countries (Annexure B), and the evidence filed by Respondent could not prove any actual or contemplated good faith use by it of the domain name from 1999 until June 2014, which is an unreasonably long period of time for considering use of the domain name.

For above reasons, the Panel finds that paragraph 4(a)(iii) is satisfied in this case and that the registration and use of the disputed Domain Name has been made in bad faith.

## 7. Conclusion

For the foregoing reasons, the Panel is satisfied that the Complainant has sufficiently proved the existence of all the three element pursuant to Paragraph 4(a) of the Policy. In accordance to paragraph 4(a) of the Policy and Article 15 of the Rules, this Panel orders that the *disputed Domain Name, www.britishindia.com be transferred to the Complainant.*



.....  
Samrith Kaur  
Sole Panellist

Date: 5<sup>th</sup> December 2014