

**KUALA LUMPUR REGIONAL CENTRE
FOR ARBITRATION**



REGIONAL RESOLUTION, GLOBAL SOLUTION

FORM H

**NOTIFICATION OF DECISION BY THE PANEL TO THE KUALA
LUMPUR REGIONAL CENTRE FOR ARBITRATION**

1. DETAILS OF THE CASE: AllProperty Media Pte Ltd v Think Media Sdn. Bhd.

CASE NUMBER: KLRCA/DNDR/2011/27

DISPUTED DOMAIN NAME(S): propertyguru.com.my

CASE ADMINISTRATOR: Usharani Balasingam

PARTIES NAME:

- a) Complainant: AllProperty Media Pte Ltd.
- b) Respondent: Think Media Sdn. Bhd.

2. NAME OF PANELLIST(S):

Ms. Chew Kherk Ying

Mr. Khoo Guan Huat

Mr. Deepak Pillai

Pursuant to Rule 17.3, the Panel hereby forwards its decision for the above-referenced case.

Signature : sgd.

Name of Panellist(s) : Ms. Chew Kherk Ying, Mr. Khoo Guan Huat, Mr. Deepak Pillai

Date : 20th July 2011

Administrative Panel Decision**In the matter of****Between****ALLPROPERTY MEDIA PTE LTD.****And****THINK MEDIA SDN. BHD.****Case No: RCA/DNDR/2011/27****1. The Parties**

The Complainant is AllProperty Media Pte Ltd (Company No. 200615063H), a company incorporated under the laws of Singapore on October 10, 2006 and having a registered office address at 51 Goldhill Plaza #11-03/05, Singapore 308900.

The Respondent is Think Media Sdn. Bhd. (Company No. 801817P), a company incorporated under the laws of Malaysia on January 7, 2008 and having a registered office address at Block B-5-7 (Level 7), Menara Uncang Emas, 85 Jalan Loke Yew, 55200 Kuala Lumpur.

2. The Domain Name and Registrar

The domain name in dispute is <propertyguru.com.my> ("the Disputed Domain Name"). It was registered in the name of the Respondent since July 22, 2010 vide Registration No. D1A141126. The Registrar is Malaysian Network Information Centre (MYNIC) ("the Registrar").

3. Procedural History

The Panel has sighted only some of the documents relating to the procedural history of this matter but the Case Administrator has provided the following table:-

CASE-FILE-CHRONOLOGY

SUBMISSION DATE	DESCRIPTION
Documents submitted by Parties (date received by Centre)	
Documents communicated by Centre (date issued)	
May 11, 2011	1. CTC & Form A-Complaint (Email/Hardcopy)
May 19, 2011	2. Acknowledgement of Receipt of Complaint
May 19, 2011	3. Centre's Request for MYNIC's Verification of identity of domain name(s) holder
May 19, 2011	4. Complaint Notification Instructions and Commencement of Proceedings
June 9, 2011	5. Form B Response (Email/Hardcopy)
June 10, 2011	6. Acknowledgement of Receipt of Response
June 20, 2011	7. Reply (Email/Hardcopy)
June 23, 2011	8. Statement of Acceptance and Independence of the Panel (Ms. Chew Kherk Ying)
June 23, 2011 (Received on June 24, 2011)	9. Statement of Acceptance and Independence of the Panel (Mr. Khoo Guan Huat)
June 23, 2011 (Received on June 24, 2011)	10. Statement of Acceptance and Independence of the Panel (Mr. Deepak Pillai)
June 27, 2011	11. Notification of Appointment of the Panel and Projected Decision Date
June 27, 2011	12. Communications of Notification on Panel Appointment to the Parties

4. Factual Background

The Complainant is in the business of providing information and resources over the internet on property markets in Singapore and other jurisdictions including Malaysia ("the Services").

The mark "PropertyGuru.com.sg" was registered by the Complainant since April 16, 2008 in class 36 in Singapore under Trade Mark No. T0804863E. Trade mark registration applications for "PropertyGuru" and "PropertyGuru.com.my" were then filed by the Complainant in Singapore and Malaysia in Classes 35, 36 and 38 between July 2010 to April 2011.

The Complainant has also secured registration of the domain name <propertyguru.com.sg> since September 24, 2007, whilst <propertyguru.com> was registered in June 3, 1999 and subsequently acquired by the Complainant on January 12, 2009. The Complainant has also shown use of the mark "PropertyGuru.com.sg" and/or "PropertyGuru" in Malaysia since early to mid-2008 through Malaysian visitors to its website, Malaysian developers advertising their properties on the <propertyguru.com.sg> website and advertisements for the <propertyguru.com.sg> website in Malaysian publications.

The Respondent is a company wholly owned by iProperty Group Asia Pte Ltd ("iProperty Singapore") since July 30, 2010. iProperty Singapore also owns iProperty.com Malaysia Sdn Bhd ("iProperty Malaysia"), and together with the Respondent, they are all part of an online real property group which owns and operates real property online portals in various countries (collectively "iProperty Group").

The Disputed Domain Name was originally registered on May 20, 2008 by Lestari Cemerlang Sdn Bhd, which subsequently changed its name to AIQ Global Sdn Bhd ("AIQ"). By a Declaration of Trust dated September 25, 2009, AIQ then held the Disputed Domain Name on trust for the Respondent with effect from September 25, 2009. The Disputed Domain Name was subsequently registered in the Respondent's name on July 22, 2010. iProperty acquired the rights to the Disputed Domain Name following its acquisition of the Respondent on July 30, 2010.

5. Parties Contentions

Complainant's Contentions

In the Complaint, the Complainant contends that the Disputed Domain Name is identical or confusingly similar to the Complainant's trade mark. By reason of the long, continuous, prior and extensive use of the "PropertyGuru" and "PropertyGuru.com.sg" marks and promotion of the Services, the Complainant has established valuable goodwill and reputation in the "PropertyGuru" mark in relation to the Services it offers and in particular, in Singapore and Malaysia. The Disputed Domain Name is also identical or confusingly similar to the Complainant's "PropertyGuru" mark, as it has been wholly adopted and incorporated in the Disputed Domain. It is also closely and confusingly similar to the Complainant's "PropertyGuru.com.sg" and "PropertyGuru.com.my" trade marks. Due to the distinctiveness of the Complainant's "PropertyGuru" mark to the Complainant and its

Services, the Complainant claims that use and registration of the Disputed Domain Name by the Respondent which wholly adopts the Complainant's "Property Guru" mark in its entirety will inevitably be perceived by the public and relevant trade as being used by or one which is endorsed by the Complainant.

The Complainant also asserts that the Respondent had registered the Disputed Domain Name in bad faith as the Respondent is a company within the iProperty Group, being a major competitor of the Complainant. The Respondent, being part of the iProperty Group and a competitor of the Complainant therefore had actual knowledge of the Complainant's rights and interests in and to the "PropertyGuru" trade mark and also the fact that the Complainant owns the domain name <propertyguru.com.sg>.

The Complainant contends that the iProperty Group is maintaining the Disputed Domain Name with the aim of preventing the Complainant from registering and using the Disputed Domain Name which incorporates its own trade mark "PropertyGuru", in Malaysia. The Complainant believes that the iProperty Group has no valid reason to maintain another new website which does not add value to its existing iProperty website, offers the same functions and services in its existing iProperty websites, and incorporates the use of a competitor's trade mark, other than to unfairly stifle competition and to prevent the Complainant from operating a website and registering a domain name which incorporates the Complainant's trade mark "PropertyGuru".

The Complainant further supports the contention of bad faith on the part of the Respondent by the fact that iProperty Group had through iProperty.com Malaysia, taken steps to register and use a domain name which is confusingly similar to another of the Complainant's domain name, <homeguru.com.my> ("HomeGuru Domain Name"), of which trade mark applications to register "Home Guru" and "HomeGuru.com.my" have been filed by the Complainant on December 12, 2010 under application numbers 2010023769 and 20100023770. The marks have been assigned to the Complainant's Malaysian company, HomeGuru Sdn Bhd ("HomeGuru Malaysia"), a company incorporated by the Complainant to offer its Services in Malaysia. The Complainant had also taken steps to register the HomeGuru Domain Name through Instra Corporation Pty Ltd ("Instra") on August 4, 2010 in the name of White Label Domains Sdn Bhd pending incorporation of HomeGuru Malaysia. The HomeGuru Domain Name was subsequently transferred to HomeGuru Malaysia sometime in April 2011. However, iProperty Group had also registered an almost identical domain name <home-guru.com.my> through iProperty.com Malaysia on December 2, 2010. iProperty Group then launched its www.home-guru.com.my website ("Home-Guru Website") on January 21, 2011, which was just before the Complainant through HomeGuru Malaysia had officially allowed property agents to subscribe for its services and pay for the listing of properties on its website on January 26, 2011. The Complainant asserts that this exhibits a consistent pattern by iProperty Group in disrupting the Complainant's business.

Respondent's Contentions

The Respondent denies the Complainant's contentions and asserts that the Complainant has no right in the Disputed Domain Name as it consists of the English words "property" and "guru", which are highly generic or descriptive in nature. The Respondent also contends to the contrary that the Respondent and the iProperty Group are in fact, the first users of the "PropertyGuru" mark and the Disputed Domain Name in Malaysia. As such, all goodwill generated in Malaysia in relation to the same are associated entirely and solely with the Respondent and the iProperty Group. Moreover, the Complainant cannot claim to be the owner of the "PropertyGuru" mark in Malaysia as trade mark rights are territorial in nature and the registration applications of the mark in other countries do not assist the Complainant in Malaysia. As there was no use of the mark "PropertyGuru" by the Complainant in Malaysia prior to the registration of the Disputed Domain Name on 20 May 2008, the Complainant has not acquired any common law or registered trade mark rights for the mark in Malaysia.

The Respondent also asserts that it has used the Disputed Domain Name in good faith. It was not out of ordinary for the Respondent to register or use the Disputed Domain Name given the nature of the Respondent's and the iProperty Group's business. The Respondent claims that it has been making legitimate fair use of the Disputed Domain without any intent for commercial gain by misleadingly diverting consumers or tarnishing the Complainant's business and/or to associate the Disputed Domain Name with the Complainant. The Respondent also states that the Complainant has not adduced any evidence of confusion, nor is there any likelihood of the Malaysian public of being confused into thinking that the Disputed Domain Name is operated or associated with the Complainant. Additionally, the Complainant's reliance on iProperty's registration and use of the HomeGuru Website is misconceived because the Complainant had not acquired any proprietary rights in the "HomeGuru" or "Home Guru" marks when the Home-Guru Website was launched by iProperty.

The Respondent further contends that the Complainant had abused the Mynic (.my) Domain Name Dispute Resolution Policy and Rules ("the Policy and Rules") proceeding as this Complaint was brought as a retaliatory measure against iProperty for the Civil Suit S-22IP-15-2011 commenced by iProperty.com Malaysia against HomeGuru Malaysia. The Complainant had come to this tribunal knowing full well that it cannot prove any of the elements required to succeed. As this was not a case where it cannot be concluded that the Respondent has no rights or legitimate interest nor is it a simple case of cyber-squatting, the Respondent submitted that this Complaint is not within the scope of this tribunal's decision. The Respondent then requested that a finding of reverse domain name hijacking be made against the Complainant.

Complainant's Contentions in Reply

In its reply, the Complainant denies the Respondent's contentions and asserts that the relevant date of registration of the Disputed Domain Name in the name of the Respondent should be July 22, 2010, which is when the transfer of the domain name from AIQ to the Respondent was made, and not the earlier registration date of May 20, 2008, when it was originally registered by AIQ. The Complainant reiterates that it has extensively and continuously used the "PropertyGuru" and "PropertyGuru.com.sg" marks in Malaysia since 2008, which predates the registration of the Disputed Domain Name by the Defendant on July 22, 2010; these marks have already become distinctive of the Complainant in Malaysia. There is also no requirement under the Policy and Rules that the Complainant's marks must first be registered in Malaysia to succeed in a domain name complaint filed against the Respondent, and the registration of the Complainant's "PropertyGuru.com.sg" mark in Singapore predates the registration of the Disputed Domain Name by the Respondent.

The Complainant asserts that "PropertyGuru" is not descriptive or generic and is distinctive of the Complainant's services and business by virtue of the extensive and continuous use and promotion in Singapore and Malaysia since 2008. Therefore, the use and registration of the Disputed Domain Name by the Respondent which wholly adopts the Complainant's "Property Guru" mark in its entirety will cause confusion by the public and relevant trade. There is also no abuse of proceeding as the Complaint was filed within a reasonable time frame and as it was filed based on the scope set out in the Rules and the Policy, this Complaint is within the scope of this Panel's jurisdiction.

6. Discussions and Findings

Rule 17 of the Rules of the MYNIC's (.my) Domain Name Dispute Resolution Policy ("MYDRP Rules") instructs the Panel to decide the proceedings based on the documents and evidence submitted by the Parties, the Policy and Rules as well as any other rules and principle of law which are applied in Malaysia.

Paragraph 5 of MYNIC's (.my) Domain Name Dispute Resolution Policy ("MYDRP") provides that the Complainant must establish BOTH of the following elements in the Complaint:-

- (i) The Disputed Domain Name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights; and
- (ii) The Respondent has registered and/or used the Disputed Domain Name in bad faith.

The Respondent on its part may prove that the Disputed Domain Name is not identical or confusingly similar to the Complainant's trade mark or service mark and/or that he

has rights and legitimate interests in the Disputed Domain Name which should remove a finding of bad faith (Paragraph 7, MYDRP).

Identical or Confusingly Similar

The Panel finds that the Disputed Domain Name <propertyguru.com.my> is identical to the Complainant's "PropertyGuru" mark. It is also closely and confusingly similar to the Complainant's "PropertyGuru.com.sg" and "PropertyGuru.com.my" marks.

Based on the evidence presented by the Complainant, the Panel agrees that the Complainant had acquired goodwill and reputation in the "PropertyGuru" mark in Malaysia through its website, www.propertyguru.com.sg ("PropertyGuru.com.sg Website"), which was shown to have been visited by Malaysians, used as an advertising platform for Malaysian developers and promoted/advertised in Malaysian publications since early to mid 2008.

The Panel does not agree with the view of the Respondent that the words "Property Guru" are descriptive, generic terms which should be free for use by all. This argument is inconsistent with the Respondent's application to register the "PropertyGuru.com.my" mark in Malaysia under trade mark application no. 2010022725 in respect of services generally relating to "*on-line advertising and marketing of property; on-line business directories featuring listings of real estate and related businesses*".

The Panel, therefore, concludes that the Complainant has established that the Disputed Domain Name is identical and/or confusingly similar to the Complainant's trade marks to which the Complainant has rights.

Bad Faith

The Complainant must also establish that the Respondent had registered and/or used the Disputed Domain Name in bad faith. Paragraph 6 of the MYDRP provides that bad faith may be inferred *inter alia* in circumstances where:-

- (i) the Respondent registered and/or is using the Disputed Domain Name mainly to sell, rent or transfer the Disputed Domain Name for profit to the Complainant or its competitor;
- (ii) the Respondent registered and/or is using the Disputed Domain Name to prevent the owner of a trade mark or service mark from using the Disputed Domain Name which is identical with its trade mark or service mark;
- (iii) the Respondent registered and/or is using the Disputed Domain Name to disrupt the business of the Complainant; or
- (iv) the Respondent registered and/or is using the Disputed Domain Name for the purposes of and with the intention to attract or divert, for commercial gain,

Internet users to the Respondent's website, a website of the Complainant's competitor and/or any other website, by creating a possibility of confusion or deception that the website is operated or authorised by, or otherwise connected with the Complainant and/or its trade mark or service mark.

The Complainant has asserted that the date of registration of the Disputed Domain Name by the Respondent should be July 22, 2010 in accordance with the panel's decision in *William R. Hague Inc. dba Hague Quality Water International v Water N Boss Marketing S/B* (Case No. rca/dndr/2006/09). The Panel agrees that this is the general position also taken by the panels appointed under the Arbitration and Mediation Center of the World Intellectual Property Organisation ("WIPO"). However, the Panel notes that the Disputed Domain Name was held on trust for the Respondent by AIQ under a Declaration of Trust with effect from September 25, 2009.

Yet, even if the Panel takes September 25, 2009 as the date of registration of the Disputed Domain Name by the Respondent for the purposes of this complaint, the Complainant has demonstrated prior use, goodwill and reputation in the "PropertyGuru" mark and the PropertyGuru.com.sg Website in Malaysia since early to mid 2008. Notwithstanding that the Respondent had yet to become a member of the iProperty Group as of September 25, 2009, it was engaged in providing services akin to the Services provided by the Complainant. The Panel thus infers that the parties were competitors at the material time. The existence of competition between the parties supported a finding of bad faith in *Teresa Christie, d/b/a The Mackinac Island Florist v. James Porcaro, d/b/a Weber's Mackinac Island Florist* (Case No. D2001-0653). Further, in *537397 Ontario Inc. operating as Tech Sales Co. v. EXAIR Corporation* (Case No. D2009-0567), the panel held that parties do not register the trade marks of their competitors for no reason at all and on that basis, the panel inferred that the respondent's intentions were abusive and therefore in bad faith.

Accordingly, the Panel takes the view that as of September 25, 2009, the Respondent appears to have registered the Disputed Domain Name in bad faith with the intention of preventing the Complainant from using the "PropertyGuru" mark and/or disrupting the business of the Complainant. Further, by reason of the subsequent acquisition of the Respondent by the iProperty Group, being the Complainant's major competitor, the Panel also infers that the Respondent had registered the Disputed Domain Name to sell or transfer the same to a competitor of the Complainant.

The Panel also notes that the Respondent made no use of the Disputed Domain Name as a legitimate website until after it was acquired by the iProperty Group, a major competitor of the Complainant. Paragraph 5 of the MYDRP provides that it should be considered whether not only the registration, but also the use of the Disputed Domain Name was in bad faith. The Panel finds that the Respondent is using the Disputed Domain Name in bad faith as the website for the Disputed Domain Name was only launched after the Respondent was acquired by the iProperty Group, and the Complainant has presented evidence to show that the iProperty Group were fully aware of the Complainant's prior use, goodwill and reputation in the "PropertyGuru" mark in Malaysia. The Complainant also presented evidence of confusion by

members of the public arising from the Respondent's website using the Disputed Domain Name, which appeared to suggest some form of partnership between the Complainant and the Respondent. All of the circumstances set out above under Paragraph 6 of the MYDRP could be established by virtue of such use by the Respondent.

While a pattern of conduct of preventing a trade mark holder from reflecting the mark in a corresponding domain name could also support evidence of bad faith, a pattern normally requires more than one relevant example. However, considering all of the surrounding circumstances, the Panel is inclined to perceive the registration and use of the <home-guru.com.my> domain name by the iProperty Group as evidenced by the Complainant as further supporting an inference of bad faith on the part of the iProperty Group, and likewise the Respondent with respect to the registration and/or use of the Disputed Domain Name.

Based on the foregoing, the Panel finds that the Complainant has established that the Disputed Domain Name was registered and/or is being used by the Respondent in bad faith.

Rights and Legitimate Interests

The Respondent states that it is the first user of the "PropertyGuru" mark in Malaysia by virtue of its launch of the website using the Disputed Domain Name in Malaysia, and that it is making a genuine offering of services. Yet, the inferences drawn above under the assessment of bad faith, together with the actual knowledge of the iProperty Group of the Complainant's prior rights in the "PropertyGuru" mark as of the first use of the Disputed Domain Name by the Respondent, do not support such legitimate rights and interests.

The Panel finds that it is too coincidental that the Respondent as a competitor of the Complainant (whether before or after its acquisition by the iProperty Group) had registered the Disputed Domain Name comprising of a mark identical to the Complainant's "PropertyGuru" mark for the same services. Accordingly, the Panel concludes that the Respondent has failed to demonstrate any rights and legitimate interests in the Disputed Domain Name sufficient to negate the finding of bad faith in the preceding section.

For the same reasons, the Panel does not find any instance of reverse domain name hijacking by the Complainant.

7. Conclusion

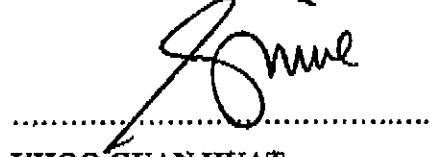
In accordance with the principles under paragraphs 5, 6 and 7 of the MYDRP and Rule 17 of the Rules, the Panel directs that the Disputed Domain Name be transferred to the Complainant.

Dated July 19, 2011



CHEW KHERK YING

Presiding Panellist


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KHOO GUAN HUAT

Panellist


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DEEPAK PILLAI

Panellist