MYDRP
Background & Provider, Parties involved
Cases and Decisions since 2003
Case Studies

Comparison with UDRP
(Uniform Domain Name Dispute Resolution Policy)

MYNIC’s Regulated Names Policy
Case study
Mynic’s MYDRP
MYDRP

MYNIC’s Domain Name Dispute Resolution Policy (MYDRP)
• Asian International Arbitration Centre (formerly known as Kuala Lumpur Regional Centre for Arbitration) was appointed by MYNIC to administer trademark-related complaints over .my domain names
• Complainant: Trademark or Servicemark owner
• Respondent: Registrant of .my, com.my domain name
• Panelists (Single or 3 member): Appointed by the Director of KLRCA/AIAC

MYDRP is modeled on ICANN’s UDRP with modifications made to fit local context
• applicable Malaysian laws
• KLRCA/AIAC Supplemental Rules (fees in Ringgit Malaysia) since the Centre is based in Kuala Lumpur
• Cases and Decisions since 2003 until August 2019
  • 48 Cases filed with KLRCA/AIAC
  • 38 Panel Decisions made in favour of Complainant
    • 33 transfers of .my domain names, and
    • 5 in favour of Respondent (Registration remains as is)
MYDRP – Case Study

Two-prong test

a) Domain Name is identical or confusingly similar to a trademark or service mark to which Complainant has rights; and

b) registered and/or use of Domain Name in bad faith
MYDRP – Case Study

- First case filed in 2003 by Volkswagen Group Singapore against Webmotion Design over Volkswagen.com.my
  - Volkswagen Group’s trademark was identical to domain name and there was bad faith registration e.g. evidence of cybersquatting
  - Decision in favour of Volkswagen
  - their website is still being maintained as at 2019, under this domain
Complaint was filed by Lego Juris A/S against Natah Media in 2009 over **Legoland.my** and **Legoland.com.my**
  - Decision in favour of this brandowner which has continued to maintain their website under both these domain names
  - Other brand names e.g. **Facebook** under Facebook Inc (2016), **Taobao** under Alibaba Group Holding Ltd (2012), **Paypal** under Paypal Inc (2011)
    - Panel Decisions in their favour
MYDRP – Case Study

Complaints denied where Registrant can establish legitimate rights & interests in the domain name

**Ledtronics.com.my**
Ledtronics Inc vs Ledtronics Sdn Bhd
- Longer use and presence in Malaysian market by Registrant

**Nikon.my**
Nikon (M) Sdn Bhd vs First Web Enterprise
- No trademark rights established by the Complainant (e.g. Trademark under name of HQ office in Japan and no assignment made to Malaysian subsidiary)

**Waterboss.com.my**
William R. Hague Inc against Water N Boss Marketing Sdn Bhd
- Two separate trademark applications filed for same trademark
- Trademark rights issue to be decided by Trademark Office or Malaysian Courts
Comparison with UDRP
## UDRP by comparison

<table>
<thead>
<tr>
<th>MYDRP</th>
<th>UDRP</th>
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<td><strong>Two-prong test</strong></td>
<td><strong>Three-prong test</strong></td>
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<tr>
<td>a) Domain Name is identical or confusingly similar to a trademark or service mark to which Complainant has rights; and&lt;br&gt;b) registered and/or use of Domain Name in bad faith</td>
<td>a) Domain Name is identical or confusingly similar to the trademark or service mark in which Complainant has rights&lt;br&gt;b) Respondent has no rights or legitimate interests in respect of the domain name and&lt;br&gt;c) Domain name has been registered and is being used in bad faith</td>
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<tr>
<td>MYNIC with AIAC (exclusive dndr provider)</td>
<td>ICANN with several global dispute resolution service providers e.g. WIPO, ADNDRC (Asia), NAF (USA)</td>
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<td>For .my ccTLD</td>
<td>For gTLDs &amp; still applicable for new gTLDs and some ccTLDs worldwide</td>
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<td>Panel decisions can be challenged in Malaysian courts</td>
<td>Panel decisions can be challenged in courts where Registrant or Registrar is based</td>
</tr>
<tr>
<td>MYNIC implements Panel Decisions e.g. transfer of domain name or it remains</td>
<td>Registrar which implements Panel Decisions</td>
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MYNIC as Complainant under UDRP

- MYNIC was a Complainant e.g. mynic.info complaint filed with ADNDRC, Kuala Lumpur office
  - Settled with Respondent and domain name was transferred to MYNIC BEFORE Panel Decision
MYNIC’s Regulated Names Policy
MYNIC as Complainant under UDRP

- Under MYNIC’s Regulated Names Policy:
  - A Regulated Name may only be used as a domain name subject to the necessary qualifications, consents, licences and/or permissions having been obtained by the Registrant from the relevant government ministry, department, agency or regulatory authority.

- Malaysian National News Agency known as BERNAMA vs Viaweb Trading, Registrant of bernama.com.my
  - filed a Complaint on 16th August 2019 with MYNIC, with Sections 1 & 3 of the Bernama Act 1967 as basis
  - MYNIC notified Registrant about complaint on 16th August 2019
  - MYNIC suspended the domain name on 28th August 2019
    - Registrant failed to obtain written consent from BERNAMA within timeline given
Conclusion

MYNIC’s Domain Name Dispute Resolution Policy (MYDRP)
• Affordable and fast method to resolve trademark-related disputes over .my domain names
  • compared to court proceedings or arbitration
• Not all Cases filed with AIAC result in Panel Decisions
  • Some of the parties settle
• Brand owners may not win all the time
• No award of damages or costs can be made by Panel
• Trademark rights issues are left to the Trademark Office or Malaysian courts to decide e.g. Trademarks Act 1976
• MYNIC implements Panel Decision or Court Order (where there is challenge to Panel Decision - rare)

• Follow UDRP best practice, with some differences
Thank you

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