

**Domain Name Dispute Resolution Center (DNDRC)**

**Arbitration and Mediation Center**

**COMPLAINT PANEL DECISION**

**Telenor Microfinance Bank vs Najam us Sahar Sabzwari / ABC**

**Case No. C2017-0003**

**Also in PDF C2017-0003**

**1. The Parties**

The Complainant is Telenor Microfinance Bank (formerly known as Tameer Microfinance Bank), having its office at 15-A Block 7-8 Central Commercial Area, K.C.H.S.U 75530, Karachi, Pakistan. The Complainant has initiated the Complaint vide their authorized representatives, Ali & Associates, having its office at First Floor, Shaheen Towers, 23-A, Block 6, P.E.C.H.S., Shahrah-e-Faisal, Karachi.

The Respondent's name is Syed Naj-mus-sahar Sabzwari with its address at O-932, Ferozpora, Murree Road, Rawalpindi, Pakistan, Telephone No: +92 300 5151926 and has described its legal status as that of an individual.

**2. The Domain Names and Registrar**

The domain name in dispute is <telenorbank.com.pk>, hereinafter referred to as the Disputed Domain Name. Vide email dated Friday 03 March 2017, PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is ABC, O-932,, Minhas Manzil, Ferozpora, Rawalpindi, Pakistan and its Create Date was 2016-05-20 with an Expire Date of 2018-05-20.

**3. Procedural History**

DNDRC was informed of the Complaint against the Respondent as per PKNIC - Internet Domain Registration Policy, by notification from the Complainant on 01 March 2017.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 10 March 2017 informing the Respondent that if a Response was not received 10 days from the notification, the dispute would be proceeded with ex parte. DNDRC awaited the submission by the Complainant of the Complaint as per the prescribed forms also available at [www.dndrc.com/downloads](http://www.dndrc.com/downloads). The Respondent sent an email on 15 March 2017 requesting that the Panel extend time to respond to the Complaint till 15 April 2017. The Panel made an exception, but not with the view to create a precedent, and granted an additional seven day period to the Respondent to file a Response by 27 March 2017. The Respondent filed a Response on 26 March 2017.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Ms. Zahra D'souza as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules.

## **Factual Background**

The domain name upon which the Complaint is based is <telenorbank.com.pk >.

PKNIC has confirmed via their email dated Sunday, 6<sup>th</sup> March, 2016 that the Disputed Domain Name has been registered by the Respondent named in the Complaint and that their email address is najmussahar@gmail.com.

## **4. Parties Contentions**

### **A. Complainant**

*The domain name [www.telenorbank.com.pk](http://www.telenorbank.com.pk) (the "Domain Name") is the subject of this Complaint. The present Complaint has been instituted in order to protect the Complainant's rights with respect to the registered trademark TELENOR which has been impermissibly copied by the Respondent and registered as a domain name with PKNIC Registry.*

*The Complainant is a Pakistani company, incorporated under the Companies Ordinance, 1984 and is the wholly owned subsidiary Telenor Group which is a renowned Norwegian multinational telecommunications company headquartered at Fornebu in Baerum, Norway. The Telenor Group's business under the name "TELENOR" was founded in the year 1885. With its humble beginning, the group has grown to become a multi-billion dollar business under the name / mark "Telenor". Telenor Group is widely recognized as*

*one of the world's largest mobile telecommunications companies, with over 166 million mobile subscriptions and a workforce of 33,000. Telenor group is an international provider of voice, data content and mobile communication services in 13 markets across Europe and Asia and an additional 17 markets through its ownership in Vimpel Com Ltd. In addition, it has extensive broadband and TV distribution operations in four Nordic Countries, and a 10-year-old research and business line for Machine-to-Machine technology.. The Complainant's mark "Telenor" is one of the world's best known brands.*

*Telenor Pakistan is a subsidiary of the Telenor Group. Currently, Telenor Pakistan has a total subscriber base of 35.2 million with over 26% SIM market share. On acquiring the license for providing GSM services in Pakistan in 2004, Telenor Pakistan launched its services commercially in Karachi, Islamabad, and Rawalpindi on 15 March 2005 which expanded to Lahore, Faisalabad and Hyderabad on 23 March 2005. As of today, Telenor covers more than 3,500 cities and towns throughout Pakistan. The company creates 2,500 direct and 25,000-plus indirect employment opportunities. It has a network of 23 company-owned sales and service centers, more than 200 franchisees and some 100,000 retail outlets. The company has over 8,000 3G-ready cell sites throughout the country and offers GPRS and EDGE nationwide and 3G services in over 90 cities. It is also well-recognized as being the single largest direct European investment in Pakistan.*

*Telenor has, over decades of commitment and quality, transformed itself into a household name in Pakistan. It has connected the country, covering more than 3500 towns and villages all over Pakistan. The premium services and portfolios nurtured and developed by the Complainant are market-leaders, and have contributed billions of rupees to the National Exchequer.*

*In 2008, a successful joint venture between Tameer Microfinance Bank Limited and Telenor Pakistan, brought about Pakistan's first and largest branchless banking service, "Easypaisa", which was officially launched in October 2009. The Telenor Group wholly acquired Tameer Microfinance Bank in 2016 with the singular aim of providing people with resources they need to succeed. Following the acquisition, Tameer Microfinance Bank Limited's was name changed to Telenor Microfinance Bank. Coupled with deposits of over 22.7 billion rupees and over 336,003 active borrowers, the operations headed under Telenor Microfinance Bank has managed to gain recognition as Pakistan's leading and largest microfinance bank.*

*The Complainant's Group has acquired registration of the trademark "TELENOR" in multiple classes and with various conjunctions. Additionally, the Complainant has secured*

*its rights pertaining to the trademark TELENOR MICROFINANCE BANK in several classes including 9, 14, 16, 35, 36, 38, 41 & 42.*

*The Complainant submits that on account of its extensive popularity the trade mark “TELENOR” is well known to the Pakistani population as a trademark of the Complainant. Therefore, the Respondent can have no plausible reason for adoption of an identical mark as part of the domain name. The Respondent's intention is clearly to illegitimately capitalize upon the goodwill and reputation enjoyed by the Complainant's registered trade mark “TELENOR” by using it in conjunction with this its own service, which is also of the same nature as the complainant.*

The Complainant's brief contentions are reproduced below:

- A. The Domain Name is identical or confusingly similar to the Complainants' trade marks in which they have rights*
- B. The Respondent has no rights or legitimate interests in respect of the Domain Name*
- C. The Domain Name was registered and is being used in bad faith*

Therefore, the Complainant seeks the following remedy:

*In accordance with paragraph 4(1) of the Policy, read in conjunction with paragraph 25, for the reasons described in section V above, the Complainant requests the Registrar/Administrative Panel appointed in the administrative proceeding to issue a decision that the registration of the Domain name <www.telenorbank.com.pk> be cancelled.*

## **B. Respondent**

*The respondent denies the allegations leveled against him. Neither the respondent infringed (or aimed to infringe) the trademark of the respected complainant, nor the domain is registered in bad faith. Also, no monetary – commercial or non-commercial – or any sort of advantage is gained by the respondent. The respondent would like to reject the allegations by the respected complainant.*

*The domain name <www.TeleNorbank.com.pk> is registered on 20<sup>th</sup> May, 2016 with Domain .pk long before the incorporation of Telenor Microfinance Bank Ltd.*

*The domain name is consisting of two words of different languages i.e. TELE and NORBANK. The languages and meaning of words TELE NORBANK are as follows:*

<i>Language</i>	<i>Words</i>	<i>Translation</i>	
		<i>English</i>	<i>Urdu</i>
<i>English</i>	<i>TELE</i>	<i>Over a long distance</i>	<i>دور</i>
<i>Basque</i>	<i>NORBANK</i>	<i>People</i>	<i>ولگ</i>

*The overall meanings of Tele Norbank signifies “People residing over a long distance”*

*Due to inherent limitation of domain names convention the domain name appears as TELENORBANK.*

*The domain name TeleNorbank.com.pk has been acquired in connection with the establishment of travel related portfolio which has nothing to do, directly or indirectly, with the respected complainant.*

*The domain doesn't aim to infringe the trademark, Telenor, as alleged by the respected complainant. See <http://domain.pk/tos.php> for the terms and conditions accepted by the respondent while registering the domain. Note that these terms and conditions have not restricted the respondent regarding purchase of any “Domain Name” and that they only relate to Web Hosting.*

*It is pertinent to mention that the domain is not even hosted, and hence, the website is yet inactive.*

*The respected complainant had repeatedly questioned the intention and integrity of the respondent, as well as falsely accused him of running an online business and cheating the internet users for monetary gain. The respected complainant has accused the respondent of infringing the trademark, registering the domain in bad faith, deriving unfair monetary advantage, deceiving consumers and so on.*

Under section 5(e) of the UDRP, in the absence of a response, the Panel has the authority to commence the proceedings in default and to determine the matter based upon the Complaint.

## **5. Jurisdiction**

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the Rules.

The Respondent applied for and was granted registration of the Disputed Domain Name on the basis of these regulations, and has submitted to, the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

## **6. Discussion and Findings**

In the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website ([http://www.dndrc.com/cases\\_resolved/pdf/c2007-0001.pdf](http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf)), the Panel laid down the following four heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy, dated 07-Aug-2007, version 4.2 and the UDRP:

1. *Illegality, unlawfulness or otherwise invalidity of the Application & Registration (a criteria in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 in addition to the criteria of the UDRP)*
2. *Identical or confusing similarity to a trademark or service mark in which the Complainant has rights (a UDRP criteria)*
3. *Legitimate interest in Domain Name (a UDRP criteria)*
4. *Registration and use in bad faith (a UDRP criteria)*

The decision of the dispute shall be addressed with respect to the following aspects:

- i. *Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 criteria).*
- ii. *Identical or confusing similarity with a trademark or service in which the Complainant has rights (a UDRP criteria).*
- iii. *Legitimate interest in the domain name (a UDRP criteria).*
- iv. *Registration and use of the domain name in bad faith (a UDRP criteria).*

### **I. Illegality, unlawfulness or otherwise invalidity of the Application & Registration**

The PKNIC - Internet Domain Registration Policy Aug-07-2007 version 4.2 states that it creates an exception for, and thus excludes the registration of a domain name that:

- a. infringes upon a registered tradename,*
- b. is not bona fide as recognized by international best practice,*
- c. in the opinion of PKNIC, a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,*
- d. has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law), or*
- e. in the opinion of PKNIC is not appropriate for registration.*

As per the PKNIC - Internet Domain Registration Policy Aug-07-2007, version 4.2,

*If a party claims that a domain name already registered with PKNIC violates their registered tradename, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, PKNIC reserves the right to cancel, or transfer the domain to the claiming party as per the ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.*

Therefore, for the purpose of assessing illegality, unlawfulness or otherwise invalidity of the Application & Registration of the Disputed Domain Name, the application and registration of the Disputed Domain Name shall be assessed in consideration of the following criteria:

- i. Whether the Disputed Domain Name infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Disputed Domain Name is bona fide?
- iii. Whether the application and/or registration of the Disputed Domain Name contravenes the Pakistan Penal Code, 1860 (the “Penal Code”) or any applicable criminal law?

The Panel will deal with each of these sub-issues sequentially below.

- i. Whether the Disputed Domain Name infringes upon, or is an obvious derivation of, a registered trade name / trade mark?**

The Complainant has stated:

1. *TELENOR MICROFINANCE BANK (In English) Class 09 Electronic devices, namely, computer hardware, encoded smart cards containing data and/or programming and electronic smart card readers.*
2. *TELENOR MICROFINANCE BANK (In English) Class 14 Coins, precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes.*
3. *TELENOR MICROFINANCE BANK (In English) Class 16 Bank publications of various kinds, bank notes, cheques, bank drafts, pay orders, securities etc.*
4. *TELENOR MICROFINANCE BANK (In English) Class 35 Accounting services; research and business management advice; marketing research etc.*
5. *TELENOR MICROFINANCE BANK (In English) Class 36 Banking services, and other services included in class 36.*
6. *TELENOR MICROFINANCE BANK (In English) Class 38 Electronic data transmission and transfer and telecommunication services provided in relation to the internet, etc.*
7. *TELENOR MICROFINANCE BANK (In English) Class 41 Entertainment services provided by means of telecommunications networks;*
8. *TELENOR MICROFINANCE BANK (In English) Class 42 Communications consultancy services etc.*
9. *TELENOR MICROFINANCE BANK (In Urdu) Class 09 Electronic devices, namely, computer hardware, encoded smart cards containing data and/or programming and electronic smart card readers.*
10. *TELENOR MICROFINANCE BANK (In Urdu) Class 14 Coins, precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes.*
11. *TELENOR MICROFINANCE BANK (In Urdu) Class 16 Bank publications of various kind, bank notes, cheques, bank drafts, pay orders, securities etc.*
12. *TELENOR MICROFINANCE BANK (In Urdu) Class 35 Accounting services; research and business management advice; marketing research etc.*
13. *TELENOR MICROFINANCE BANK (In Urdu) Class 36 Banking services, and other services included in class 36.*
14. *TELENOR MICROFINANCE BANK (In Urdu) 443954 38 Electronic data transmission and transfer and telecommunication services provided in relation to the internet, etc.*

*15. TELENOR MICROFINANCE BANK (In Urdu) Class 41 Entertainment services provided through telecommunications networks;*

*16. TELENOR MICROFINANCE BANK (In Urdu) Class 42 Communications consultancy services etc.*

In addition to the trade mark applications for registration of the trade mark TELENOR FINANCE BANK, the Complainant has provided a list and evidence of 28 different trade marks which include the word/logo of “TELENOR” registered between 2004 and 2014.

The Respondent has submitted as follows:

*The respondent rejects these allegations. As stated earlier, the trademark of Telenor is not even used or intended to be used. The respondent had registered the domain for Tele Norbank, and NOT for Telenor. It would be interesting to note that when the domain was registered, Telenor Microfinance Bank Ltd. didn't even exist.*

The Panel finds that based on the documentary evidence provided by the Complainant, the Complainant enjoys trade mark rights in the word/logo “TELENOR” in a number of classes. Moreover, the Complainant has applied for registration of the trademark TELENOR MICROFINANCE BANK in several classes. By incorporating a well-known trade mark “TELENOR” within the Disputed Domain Name, it prima facie appears that the Respondent has infringed upon the registered trade mark of the Complainant.

The Panel is not satisfied with the explanation provided by the Respondent with respect to the use of the trade mark of the Complainant. No reason has been provided why the Respondent used the basque language word for People”, “Norbank”, or any significance for using two different languages such that they infringe upon a well-known mark belonging to the Complainant. It is the view of the Panel that the Respondent is merely attempting to justify the incorporation of an obvious derivation of the trademark of the Complainant with such explanation.

Thus, the Panel finds that the Disputed Domain Name is an obvious derivation of trademarks registered by the Complainant, and the use of such trade mark within the Disputed Domain Name by the Respondent constitutes an infringement of such trademarks.

As per paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2, if a Complainant simply establishes this one criterion of infringement upon a registered trade mark/name, the registration would be deemed illegal and unlawful and for all purposes invalid.

Hence, the Panel may well determine, on this criteria alone, that the Disputed Domain Name should be transferred to the Complainant. However, for the purpose of completeness, but not to create any binding precedent requiring the same to be followed in the future, the Panel will also assess and determine the remaining sub-issues as identified above.

**ii. Whether the application and/or registration of Disputed Domain Name is bona fide?**

The Complainant has submitted:

*The Complainant submits that on account of its extensive popularity the trade mark “TELENOR” is well known to the Pakistani population as a trademark of the Complainant. Therefore, the Respondent can have no plausible reason for adoption of an identical mark as part of the domain name. The Respondent's intention is clearly to illegitimately capitalize upon the goodwill and reputation enjoyed by the Complainant's registered trade mark “TELENOR”*

The Respondent has submitted:

*The respondent not only rejects these allegations, but also wonders if the respected complainant even knew that the domain is not even hosted till date. Hence, “The nature of services being provided under the disputed domain name by the Respondent...” absolutely stands on no ground. There are no services, and there's absolutely no “any previous course of business.” Such allegations are indeed the misrepresentation and distortion of facts by the respected complainant.*

The Panel agrees that the Complainant has annexed detailed information in support of the popularity of the trademark “Telenor”. On the other hand, the Respondent has failed to provide any cogent evidence that the registration of the Disputed Domain Name was bona fide.

The tradename/trademark of the Complainant TELENOR is highly recognizable and the same is commonly associated with the Complainant, who holds the intellectual property rights to the tradename/trademark and is thereby entitled to use it in all forms afforded by intellectual property rights legislations, inter alia, Trade Marks Ordinance, 2001 of Pakistan, which allows a trademark holder to use its trademark in corresponding domain name(s).

The Complainant has registered the trademark TELENOR since 2004 and been using it to provide services to the masses for over a decade, well in time before the Respondent registered the

Disputed Domain Name. The documentation/evidence provided by the Complainant depicts the recognition and goodwill associated with the trademark EASYPAY.

Thus, the Panel finds that the registration of the Disputed Domain Name by the Respondent was not bona fide.

**iii. Whether the application and/or registration of the Disputed Domain Name contravene the Penal Code or any applicable criminal law?**

Prior to discussing this sub-issue, it is pertinent to clarify the grounds for examining relevant Pakistani law provisions. Although Pakistani law does not apply by force of law over PKNIC's jurisdiction, by operation of the PKNIC- Internet Domain Registration Policy Aug 07, 2007 version 4.2, it is necessary to examine provisions of the Penal Code and other applicable criminal laws. It is in this spirit and for this purpose alone that the following provisions of Pakistani law are being analyzed. The ordinances, and the sections mentioned herein below, have been discussed at length in *Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001)*.

Trade Marks Ordinance, 2001

***40. Infringement of registered trade mark.-***

*(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without consent of the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.*

***4. Domain name not to be misleading as to character or significance.-*** *(1) A domain name shall not be registered if the public is liable to mislead as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a domain name.*

Electronic Transactions Ordinance, 2002 ("ETO")

***3. Legal recognition of electronic forms.—***

*No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness."*

Penal Code

*Of Trade, Property and Other Marks*

**478. Trade mark.**

*A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this Code the expression “trade mark” includes any trade mark which is registered in the register of trade marks kept under the Trade Marks Act, 1940 (V of 1940)*

Upon a study of the above-quoted sections of the Trade Marks Ordinance, 2001 and the Penal Code, the Panel is of the view that the infringement of Trade Marks and Trade Names have been equated with domain names under Pakistani law. Therefore, the provisions of the Penal Code dealing with Trade Mark infringement appear to apply to domain names.

Moreover, according to Section 3 of the ETO, all material, instruments that would otherwise be in writing or in physical form, if generated or made available in electronic form would attract the provisions of the same sections of the Penal Code or any other applicable law had the material been in physical, written or in printed form. The Penal Code, therefore, by the operation of Section 3 of ETO, equally applies to transactions, publications or materials including the use of any trade mark or trade name made available in any electronic form on the internet through the use of a domain name.

By continuing the registration of the Disputed Domain Name by a person who is other than the owner, holder or authorized user of the trade mark or trade name, the registrant would be an aider, abettor, encourager and co-conspirator and also liable to criminal offences.

**479. Property mark.**

*A mark used for denoting that movable property belongs to a particular person is called a property mark.*

**480. Using a false trade mark.**

*Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.*

As such, if a person other than the owner, rightful holder or authorized user of the trade mark or trade name uses the Disputed Domain Name, if possibly linked to any service or goods, it may constitute an offence under the Penal Code.

**481. Using a false property mark.**

*Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.*

**482. Punishment for using a false trade-mark or property mark.**

*Whoever uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.*

As decided in *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001), the use of a false property mark (which includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages) with the reasonable expectation that people would be misled to believe that the trade mark or trade name or domain name belongs to a person to whom it does not belong may also constitute an offence under the Penal Code.

The Panel, therefore, is of the view that the Respondent's registration of the Disputed Domain Name may attract the above-mentioned provisions of the Trade Marks Ordinance, 2001, Penal Code and ETO. The Panel may decide this Complaint on this basis alone. However, for the sake of completeness and procedural fairness, but not to create a binding precedent, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

**II. Identical or confusing similarity to a trademark or service mark in which the Complainant has rights**

The Complainant has contended the following:

*The Complainant owns trademark registrations for the mark "TELENOR" as contained in Exhibit 2 (above), issued over a decade ago, self-evidently earlier than the registration date (May 20th 2016), for the disputed Domain Name applications filed on May 20, 2016, or any emanations thereof. The trademark registrations remains valid, legally sound and in full force. Thus, the Complainant has rights in the "TELENOR" mark that immensely predates the registration date of the Domain Name, giving the Complainant an appreciable right and interest in the name "TELENOR".*

*A domain name is “nearly identical or confusingly similar” to a complainant’s mark when it “fully incorporate[s] said mark.” PepsiCo. Inc. v. PEPSI SRL, D2003-0696 (WIPO Oct. 28, 2003) (holding pepsiadventure.net, pepsitennis.com, and others confusingly similar to complainant’s PEPSI mark since they “incorporate[ed the] trademark in its entirety”). Microsoft Corporation v. domain for sale etvtelevision@hotmail.com D2003-0938 (‘It is difficult to conceive that Respondent chose to register the domain name <xboxtrucchi.com> by accident. In fact, based on the facts submitted, it is difficult to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be infringing to the Complainant’s marks.’ Here, the Domain Name [www.telenorbank.com.pk](http://www.telenorbank.com.pk) incorporates the registered trademark “TELENOR” in its entirety, and is identical to it, which is the distinguishing and prominent feature of the Domain Name.*

*The Respondent’s domain name ‘www.telenorbank.com.pk’ is derived by incorporating the Complainant’s trademark “TELENOR” in its entirety to attract internet users and consumers for commercial gain. Therefore, there is a likelihood of confusion, and in fact suggests that the disputed domain name refers to the Complainant or that the Respondent is associated with the Complainant which is not the case.*

*The Complainant further submits that it has not licensed or otherwise permitted the Respondent to use the “TELENOR” trademark, alone or in conjunction with any other word, mark and/or feature. The Complainant has also not licensed or otherwise permitted the Respondent to use or apply to register any domain name consisting of or incorporating the “TELENOR” mark.*

On the other hand, the Respondent contends:

*The respondent rejects these allegations. As stated earlier, the trademark of Telenor is not even used or intended to be used. The respondent had registered the domain for Tele Norbank, and NOT for Telenor. It would be interesting to note that when the domain was registered, Telenor Microfinance Bank Ltd. didn’t even exist.*

It is an established principle that the incorporation of a Complainant’s trade mark in full within a disputed domain name may be sufficient to establish confusing similarity between the mark and

the disputed domain name (see *Nokia Group v. Mr. Giannattasio Mario*, [WIPO Case No. D2002-0782](#), *The Ritz Hotel Ltd v. Damir Kruzicevic*, [WIPO Case No. D2005-1137](#)). The Complainant has also referred to WIPO cases wherein it was held that domain names that incorporated a trademark in its entirety were confusingly similar to such trademark.

It is apparent that the Disputed Domain Name incorporates the entirety of the trademark owned by the Complainant, TELENOR. The Panel does not find merit in the contention of the Respondent that Telenor Microfinance Bank did not exist at the time of registration of the Disputed Domain Name by the Respondent, as the trademark “TELENOR” with which the Disputed Domain Name is in the view of the Panel confusingly similar was first registered by the Complainant in 2004.

The Complainant has provided sufficient information, including annexing evidence of the same, that the Complainant has rights in the trademark TELENOR. In the absence of any valid explanation of how the Disputed Domain Name is not confusingly similar to the trademark of the Complainant, the Panel finds confusing similarity between the Disputed Domain Name and the Complainant’s trademark under paragraph 4(a)(i) of the Policy.

### **III. Legitimate interests in a domain name**

As per paragraph 4(c), the UDRP requires the Respondent’s claim to be of legitimate interest and shall be:

*“proved based on ..... all evidence presented” that “shall demonstrate” the Respondent’s “rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii).”*

Paragraph 4(a)(ii) states that:

*“(i) before any notice to you 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 (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 are making a legitimate noncommercial 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.”*

The Complainant has contended:

*The Complainant submits that there is no credible legitimate reason for the Respondent to have chosen to acquire the Domain Name. "TELENOR" is not a natural word nor a common name, nor one which is a common or natural descriptor for the use which is being made of the Domain Name. The Respondent's purpose in selecting the Domain Name was plainly to use the fame of the "TELENOR" mark to generate web-traffic and to confuse internet users visiting the Respondent's site when looking for the Complainant and their famous suite of services. This is a blatant violation of the Complainant's intellectual property rights pertaining to its "TELENOR" trademarks in sheer disregard of the applicable laws.*

*The registration and use of the domain [www.telenorbank.com.pk](http://www.telenorbank.com.pk) by the Respondent is neither bonafide nor a legitimate noncommercial or fair use of the Domain Name. The goodwill in the "TELENOR" mark rightfully belongs to the Complainant and has been improperly appropriated by the Respondent. Such conduct can never constitute a legitimate interest and is a vehement display of defiance of the law.*

*The Complainant submits that when the Respondent registered the disputed domain name, it was aware of the Complainant's activities, its Trademarks including the registered mark "TELENOR" and these facts establish a prima facie case that the Respondent has no right or legitimate interest in the disputed domain name and that pursuant to the Policy the burden shifts to the Respondent to show it does have a right or legitimate interests. Please refer to *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 and *Clerical Medical Investment Group Limited v. Clericalmedical.com* (Clerical & Medical Services Agency), WIPO Case No. D2000-1228.*

*As such, its use of the Domain Name cannot constitute a bona fide offering of goods or services or a bonafide company name or trading name and can be classified as malafide.*

On the other hand, the Respondent contends:

*The respondent rejects these allegations. As clearly stated earlier, neither the trademark of Telenor is infringed (or aimed to be infringed), nor the domain is even hosted yet. Hence, no web-traffic is even generated. The respected complainant has himself admitted that Telenor is neither a natural word, nor a common name. On the other hand, the respondent has registered his domain for Tele Norbank, which is the combination of two words of different languages with clear meanings.*

The Panel is not satisfied with the explanation provided by the Respondent with respect to the use of the trade mark of the Complainant. No reason has been provided why the Respondent used the basque language word for “People”, “Norbank”, or any significance for using two different languages such that they infringe upon a well-known mark belonging to the Complainant. It is reiterated here that it is the view of the Panel that the Respondent is merely attempting to justify the incorporation of an obvious derivation of the trademark of the Complainant with such explanation.

Given the evidence of popularity of the mark “TELENOR” at the time of registration of the Disputed Domain Name, it is difficult in the absence of any proof to the contrary to ignore the contention of the Complainant that the Respondent must have known about its existence. Thus the Panel cannot come to agree that the Respondent decided to use an unprecedented combination of the Basque and English languages within a domain name only to have it coincidentally fully incorporate such a well-known mark.

The Respondent has failed to satisfy the Panel that the Respondent is commonly known by the name of “TELENORBANK”, in any way affiliated with Complainant, nor authorized or licensed to use the trademark “TELENOR”, or to seek registration of any domain name incorporating said mark. In previous decisions, Panels found that in the absence of any license or permission from the Complainant to use such widely-known trademarks, no actual or contemplated bona fide or legitimate use of the domain name could reasonably be claimed (*WIPO Case No. D2010-0138, LEGO Juris A/S v. DomainPark, Ltd, David Smith, Above.com, Domain Privacy, Treasure Enterprise Ltd, Host master*).

In addition, Respondent has not demonstrated use of, or demonstrated preparations to use, the Disputed Domain Name in connection with a bona fide offering of goods and services, but rather the Disputed Domain Name resolves to an inactive page.

As has been previously adopted by the discussions and findings in WIPO Authorities, it is for the Respondent to rebut the allegations put forth by the Complainant. Also, with respect to proving rights or legitimate interests in the disputed domain name(s), it is for the Respondent to submit

evidence pertaining to the same as it would be almost impossible, if not extremely difficult for the Complainant to prove a negative assertion. As such, in order to satisfy the Panel that it has rights or legitimate interests to the Disputed Domain Name, the Respondent was obliged to submit evidence with respect to the same.

In the absence of any satisfactory information provided by the Respondent in support of his legitimate interest in the Disputed Domain Name, the Panel based on the information provided by the Complainant finds that the Respondent does not have rights or a legitimate interest in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

#### **IV. Registration and use in bad faith**

The Complainant has made the following submission:

*The nature of services being provided under the disputed domain name by the Respondent evidences that the use and registration of the domain name is motivated by mal-intentions and unsubstantiated by any previous course of business. Furthermore, the Respondent's bad faith is further exemplified by the fact that they have registered the domain [www.telenorbank.com.pk](http://www.telenorbank.com.pk) on May 20, 2016, which is subsequent to the adoption, registration and the proliferation of the mark TELENOR by the Complainant. The ubiquitous quality of the trademark "TELENOR" make it extremely unlikely that the Respondent created the Domain Name independently. See, e.g., *The J. Jill Group, Inc. v. John Zuccarini d/b/a RaveClub Berlin*, FA0205000112627 (Nat. Arb. Forum July 1, 2002) ("Because of the famous and distinct nature of Complainant's mark and Complainant's J. JILL listing on the Principal Register of the USPTO, [r]espondent is thought to have been on notice as to the existence of Complainant's mark at the time [r]espondent registered the infringing <jjill.com> domain name. Thus, [r]espondent's registration despite this notice is evidence of bad faith registration"). Even constructive knowledge of a well-recognized mark like TELENOR is sufficient. *Google v. Abercrombie 1*, FA0111000101579 (Nat. Arb. Forum Dec. 10, 2001) ("because of the famous and distinctive nature of Complainant's GOOGLE Mark, [r]espondent is thought to have been on notice of the existence of Complainant's mark at the time [r]espondent registered the infringing [domain name]") (re [googld.com](http://googld.com) domain name).*

*The Respondent has registered the Domain Name which is deceptively identical to the Complainant's well reputed and registered mark. In so doing, the Respondent has deliberately attracted for commercial gain Internet users to the web site, with the nefarious intention to mislead and misguide them by creating a likelihood of confusion with the Complainants' trademark as to the source, sponsorship, affiliation, or endorsement of the website. The passive holding of a domain name amounts to the Respondent acting in bad faith and the elements that support bad faith include substantial use of the domain name/ trademark by the Complainant, lack of evidence of good faith use by the Respondent and concealment of identity for registration by the Respondent (Telstra Corporation Limited v. Nuclear Marshmallows Case No. D2000-0003) as is evident and applicable in the registration of the disputed domain name.*

*The Respondent's choice of domain name is not accidental and has clearly been made to derive unfair monetary advantage. In support of this submission, the Complainant contends:*

- (1) The word "TELENOR" is exclusively referable to the Complainant and the suite of services provided by the Complainant. Thus, use of words and domain www.telenorbank.com.pk by the Respondent is clearly to align its business/services with that of the Complainant.*
- (2) The Respondent first registered the Domain Name on May 20, 2016 ( 10 years after the Complainant had registered its trademark "TELENOR" in Pakistan.*
- (3) As previously set out, the Respondent has adopted an identical mark "TELENOR" as part of the Domain Name. The entire business activity of the Respondent is to deceive the innocent trade and public by misrepresenting themselves as part of the Complainant's company or to misrepresent that their activities have been authorized, approved or sponsored by the Complainant. The Respondent has wrongfully registered the Domain Name to deceive consumers. Thus, from the circumstances, it's plain that the adoption of the "TELENOR BANK" domain was not independent but parasitic and made in bad faith.*

*The above clearly shows Respondent's knowledge of TELENOR mark, since it is fully aware of the services of the Complainant.*

The Respondent on the other hand has submitted as follows:

*The respondent not only rejects these allegations, but also wonders if the respected complainant even knew that the domain is not even hosted till date. Hence, “The nature of services being provided under the disputed domain name by the Respondent...” absolutely stands on no ground. There are no services, and there’s absolutely no “any previous course of business.” Such allegations are indeed the misrepresentation and distortion of facts by the respected complainant.*

*The respondent again rejects this allegation. There’s no hosting of any data and no commercial or non-commercial benefit gained or attracted.*

*The respondent rejects this allegation. No monetary gain is derived or aimed to be derived, neither in the past, nor in the present, and not even in the future.*

*The respondent strongly rejects these allegations. As stated earlier, “Telenor Bank” is not even adopted, and hence, no trademark infringement is aimed. Also, there’s absolutely no business activity undertaken by the domain and nothing is being hosted yet.*

It appears from the contentions noted above that the entire defence of the Respondent to the allegation that the Disputed Domain Name was registered and is being used in bad faith is that the Respondent has not hosted the Disputed Domain Name as yet, and is not rendering any services on the Disputed Domain Name.

However, as correctly pointed out by the Plaintiffs, there are precedents that the passive holding of a domain name amounts to the Respondent acting in bad faith and the elements that support bad faith include substantial use of the domain name/ trademark by the Complainant and lack of evidence of good faith use by the Respondent (Telstra Corporation Limited v. Nuclear Marshmallows Case No. D2000-0003).

**WIPO Authorities:**

The Panel, for the purpose of assessing the matter and this Decision, has taken into account, reviewed and made use of the Discussions & Findings in the WIPO Authorities mentioned and relied upon by the Complainant.

Furthermore, the Panel has also relied upon the Discussions & Findings in the following WIPO Administrative Panel Decisions in addition to those mentioned in the decision:

- Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Universal City Studios, Inc., supra
- CBS Broadcasting, Inc. v. Gaddoor Saidi, WIPO Case No. D2000-0243,
- Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525
- Nokia Group v. Mr. Giannattasio Mario, WIPO Case No. D2002-0782
- The Ritz Hotel Ltd v. Damir Kruzicevic, WIPO Case No. D2005-1137
- Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge, WIPO Case No. D2006-1643
- NB Trademarks, Inc. v. Domain Privacy LTD and Abadaba S.A., WIPO Case No. D2008-1984
- The South African Football Association (SAFA) v. Fairfield Tours (Pty) Ltd, WIPO Case No. D2009-0998

## **7. Decision**

Analyzing the details provided by the Complainant, the Panel perceives that the TELENOR mark has been registered by the Complainant, hence the Complainant reserves crucial interest in such mark. Usage of these marks by the Respondent could endanger the reputation that the Complainant has worked hard at building and maintaining and result in confusion as to the registrant of the Disputed Domain Name.

Taking all of the case law and discussion above into consideration, the Panel concludes and decides that:

1. The Respondent's registration of the Disputed Domain Name is contrary to the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2
2. The Respondent has no legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Name is identical to the Complainant's trademark/names and registered domain names.
4. The Disputed Domain Name was registered and being used in bad faith.

Pursuant to Section 4 of the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2, and Section 4(i) of the Policy, the Panel therefore recommends that PKNIC cancel the registration of the domain name in dispute < telenorbank.com.pk >, as prayed within 48 hours of receipt of this decision by email or its being uploaded on to DNDRC's website



[www.dndrc.com/cases\\_resolved/](http://www.dndrc.com/cases_resolved/), whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

**Arbitrator: Ms. Zahra D'souza**

**Sole Panelist**

**Date: 26<sup>th</sup> April 2017**