

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Standard Chartered PLC v. Hosting Campus Domain

Case No. C2007-0001

Also in PDF C2007-0001

1. The Parties

The First Complainant (“1st Complainant”) is Standard Chartered PLC, 1 Aldermanbury Square, London, EC2V 7SB, United Kingdom, Tel No ±65 6331 2748 / +44(0)2072807107, FaxNo+65 633427741+44 (0)20 72807112, Email: Ang.Su-Lin@sg.standardchartered.com which is a Public Limited Company incorporated in England and Wales with its principal place of business at 1 Aldermanbury Square, London EC2V 7SB, United Kingdom.

The Second Complainant (“2nd complainant”) is Standard Chartered Bank, 1 Aldermanbury Square, London, EC2V 7SB, United Kingdom, Tel No +65 6331 2748/±44 (0) 20 72807107, Fax No +65 6334 2774 / +44(0)2072807112, Email: Ang.Su-Lin@sg.standardchartered.com & Rachel.Chong@sg.standardchartered.com which is a Company Limited Liability by Royal Charter 1853 Ref No. ZC 18 incorporated in England and Wales with its principal place of business at 1 Aldermanbury Square, London EC2V 7SB, United Kingdom.

The 2nd Complainant is a wholly-owned subsidiary of the 1st Complainant and is regulated and trades as a bank and conducts its banking activities in over 55 territories around the world through a variety of branches and subsidiaries. The Second Complainant’s official global website is located at www.standardchartered.com.

The 2nd Complainant first established its operations in 1863 in Karachi and has been operating in Pakistan as a branch for more than 140 years. The 2nd Complainant operated under the name ‘The Chartered Bank’ until it was re-named ‘Standard Chartered Bank’ in 1985. The 2nd Complainant ceased operating as a branch and commenced operating through its wholly- owned subsidiary, Standard Chartered Bank (Pakistan) Limited after the acquisition of Union Bank in September 2006, Standard Chartered Bank (Pakistan) Limited, which is listed on the Karachi Stock Exchange, is presently the largest international bank in Pakistan.

The 2nd Complainant commenced use of the “STANDARD CHARTERED” mark in Pakistan on 1 January 1985. Today, the 2nd Complainant, operating through Standard Chartered Bank (Pakistan) Limited, maintains 115 branches in 22 major cities across Pakistan. Through the 2nd Complainant’s extensive use of the “STANDARD CHARTERED” mark and marketing activities in Pakistan, the “STANDARD CHARTERED” mark has gained tremendous goodwill and reputation in Pakistan (particularly in the banking and financial industry) and is a well-known mark. More comprehensive information on the 2nd Complainant’s activities in Pakistan is available publicly at standardchartered.com.pk.

The Respondent’s name is Hosting Campus with its address at 409 Park Avenue, Block 6, Main Shahrah-e-Faisal, Karachi, Pakistan, Telephone No: +92 21 4326583/+92 300 2360, Email admin@hostingcampus.com and has described its legal status as that of an individual. The Respondent Hosting Campus at its web address www.hostingcampus.com does not have any information linking it with any use of any trade name or other activity connected with the use of the names “standard” or “chartered”. Additionally, the Respondent in response to information about its Principal Place of Business has stated that it is an “Offline website” and that “there is no activity start yet”. Its authorized representative who has signed the Response Form is Mr. Abrar Ahmed with the same contact details as those of the Respondents.

The domain name under dispute “standardchartered.pk” (“disputed domain”) is not in use nor has been since its initial registration by the Respondent since 20th June 2006.

2. The Domain Name and Registrar

The domain name at issue is <standardchartered.pk>. Vide their email dated Wednesday July 25th 2007 PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is *Hosting Campus, 1200 Markham Road, Suite # 525, Karachi, Pakistan* and its Create Date was 2006-06-20 with an Expire Date of 2008-06-20.

3. Procedural History

DNDRC was informed of the Complaint against the Respondent as per PKNIC - Internet Domain Registration Policy, by notification from the Complainants on 23rd July 2007 at 16:20 (all times mentioned are Pakistan Standard Time – PST). The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on the same day 23rd July 2007 at 19:25 informing the Respondent that if a Response was not received 7 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.

Subsequently on the last date for submission Monday 30th July 2007 at 16:59 the Respondent submitted via the email address provided by the Complainant and PKNIC (admin@hostingcampus.com) a filled in and signed Response form. As such in addition to the submission to the arbitration contained in the PKNIC - Internet Domain Registration Policy, the Respondent has further confirmed and ratified its submission to the Arbitral jurisdiction of DNDRC and the Arbitration process thereto.

Under the Supplemental Rules of DNDRC which override the ICANN Rules for Uniform Domain Name Dispute Resolution Policy in terms of paragraph 2 of the PKNIC - Internet Domain Registration Policy v 4.1, which states that “*DNDRC may consider and issue a recommendation in the matter in accordance with its own rules for such disputes or in default of such rules apply the Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999) and/or the Rules for Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999).*” As such DNDRC applies its Supplemental Rules to these proceedings as well as the UDRP and in case of any conflict the DNDRC Supplemental Rules to the ICANN Rules for the UDRP and UDRP apply. As such applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*) the Center appointed Barrister Zahid Jamil as Arbitrator who has verified that the Complaint does satisfy the formal requirements of the Policy and the Rules. Payment in the required amount to the Center or the Arbitrator has been made by the Complainant.

All deficiencies/objections have been satisfied.

Subsequently in accordance with the Supplemental Rules of DNDRC the single panelist arbitrator Barrister Zahid Jamil has been appointed to serve as a panelist in this Case No. C2007-0001. He has accepted and declared Impartiality and Independence.

The language of the proceedings is English, being the language of the registration agreement.

4. Factual Background

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

PKNIC has confirmed via their email dated Wednesday July 25th 2007 that the domain name is indeed registered with the Respondents named in the Compliant and that their email contact address is also as mentioned in the Compliant to which the notifications have been sent in addition to the email address postmaster@hostingcampus.com:

Organization: Hosting Campus

Address: 1600 Amphitheatre Parkway Mountain View

City: Karachi

Country: Pakistan

Email: admin@hostingcampus.com

Agent Who registered this domain:

Hosting Campus

1200 Markham Road, Suite # 525

Karachi, Pakistan

Email: admin@hostingcampus.com

Other domains by the same agent:

askaribank.pk admin@hostingcampus.com 202.163.102.143

suzuki.pk admin@hostingcampus.com 202.163.102.143

kesc.pk admin@hostingcampus.com 202.163.102.143

inbox.pk admin@hostingcampus.com 202.163.102.143

marriott.pk admin@hostingcampus.com 202.163.102.143

times.pk admin@hostingcampus.com 202.163.102.143

siemens.pk admin@hostingcampus.com 202.163.102.143

abnamro.pk admin@hostingcampus.com 202.163.102.143

standardchartered.pk admin@hostingcampus.com 202.163.102.143

As can be seen the Respondent has also registered several other domain names of well-known and reputable Financial Institutions, and Corporations.

No reason for registration of the domain has been disclosed even though an opportunity and request to clarify was provided to the Respondent via the notifications dated Monday July 23rd 2007 at 19:25 and dated Thursday July 26th 2007.

Moreover, a representative called DNDRC 3 times on the July 26th 2007 between 13:45 and 13:46 and established contact via the cell phone number +923002128042 and was

called back on that number for a detailed discussion at 15:34 on the same date confirming receipt of the Compliant and the Response form

5. Parties' Contentions

A. The Complainants

The Complainant is generally aggrieved by the domain name registration and potential use of <standardchartered.pk> by the Respondent.

The Complainant is the registered proprietor of the following registered trade marks in Pakistan:

“StandardChartered”, Class 09, Application dated 12/27/1997, Registration No. 145718

“StandardChartered”, Class 16, Application dated 12/27/1997, Registration No. 145717

(collectively referred to as the “Registered Trade Marks”). Copies of Certificates of Registration of the Registered Trade Marks issued by the Pakistan Trade Mark Registry have been received by DNDRC.

In addition, the 1st Complainant has filed the following trade mark applications with the Pakistan Trade Mark Registry on 2 December 2005:

“STANDARD CHARTERED”, Class 09, Application dated 02/12/2005 Application No.215924

“STANDARD CHARTERED”, Class 16, Application dated 02/12/2005 Application No.215925

“STANDARD CHARTERED”, Class 36, Application dated 02/12/2005 Application No.215926

(collectively referred to as the “Trade Mark Applications”). Copies of the Trade Mark Applications have been received by DNDRC.

Further, the 2nd Complainant is the registrant of the following domain names with PKNIC (amongst others):

1. standardchartered.com.pk
2. standardcharteredbank.com.pk

3. standard-chartered.com.pk
4. standardchartered.net.pk
5. standardcharteredbank.net.pk
6. standard-chartered.net.pk
7. standardchartered.org.pk
8. standardcharteredbank.org.pk
9. standardcharteredbank.org.pk
10. standard-chartered.org.pk

(collectively referred to as the “Standard Chartered Domain Names”). Copies of the above- mentioned domain name records have been received by DNDRC.

The Complainants in their Compliant contend that:

1. That the Domain Name, <standardchartered.pk>, is confusingly similar to the Registered Trade Marks, and is identical to the Trade Mark Applications (They have referred to the Uniform Domain Name Dispute Resolution Policy which was adopted by ICANN on August 26, 1999, and forms part of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 para. 4(a), (b) and (c); Rules, para 3)

The Complainants rely upon the precedent of *Zwiesel Kristallglas AG v WWW Enterprise Inc.* Case No. D2005-1223, where the Administrative Panel held that “*for the purpose of assessing whether a domain name is identical or confusingly similar to a trademark or service mark, the suffix “.com” must be disregarded as being simply a necessary component of a generic top level domain name*”. (See also *VAT Holding AG v Vat.com* Case No. D2000-0607; *LG Chemical Ltd v Changhwan, OH* Case No. D2000-0889; *AFMA, Inc., v Globemedia* Case No. D2001-0558; *Nobelstiftelsen (The Nobel Foundation) v Fliks it-solutions GmbH / Randolph Jorberg* Case No. D2006-000 1; *Rosemary Conley Diet and Fitness Clubs Limited v Nikolina Bartels-King* Case No.D2006-1401). The Complainants argue that accordingly, it is well established that the suffix “plc” must be disregarded as simply being a necessary component of a country code top level domain name. A copy of the abovementioned decision is available at www.wipo.int/amc/en/domains/decisions/html/2005/d2005-1223.html.

The Complainants submit that the words “STANDARD CHARTERED”, which are the essential elements of the Registered Trade Marks, have been reproduced and incorporated into the Domain Name. The thrust of the Registered Trade Marks is to convey to the reader the name ‘STANDARD CHARTERED’ and it is this concept that makes up the Domain Name. The Domain Name is completely identical to the readable portion of the Registered Trade Marks, Where the Registered Trade Marks are looked at as a whole, it is clear that they are trade marks consisting of the words “STANDARD CHARTERED”. As the SC logo cannot be reproduced in a domain name for the purpose of assessing the Domain

Name, the SC logo must be disregarded (see *Asset Loan Co. Ply Ltd v Gregory Rogers* Case No. D2006-0300 available at www.wipo.int/amc/en/domains/decisions/word/2006/d2006-0300.doc, and see also *Yell Ltd v Ultimate Search* Case No. D2005-0091 available at www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0091.html).

Consequently, the Domain Name is identical to the Registered Trade Marks according to this test. Further, the Domain Name also reproduces fully and is identical to the Trade Mark Applications over which the 1st Complainant holds rights. In addition, the Domain Name reproduces frilly and is identical to the Standard Chartered Domain Names registered by the 2nd Complainant.

2. Respondent has no rights to or legitimate interests in the Domain Name (Policy, para 4(a)(ii), Rules, para 3(b)(ix)(2)).

They state that Paragraph 4(c) of the Policy provides that evidence of one or more of the following shall demonstrate a respondent's rights or legitimate interests to a domain name:

- a. Before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- b. The respondent (as an individual, business, or other organization) had been commonly known by the domain name; or
- c. The respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.
- d. They rely upon *De Agostini SpA v Marco Cialone* Case No. DTV2002-0005, (available at www.wipo.int/amc/en/domains/decisions/html/2002/dtv2002-0005.html) the Administrative Panel held that:

“satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of a domain name ... is quite onerous, since proving a negative circumstance is always more difficult than establishing a positive one. Accordingly, and in line with other prior decisions, the Panel holds that it is sufficient that the Complainant shows a prima facie evidence in order to shift the burden of proof on the Respondent”.

- e. Accordingly, they contend that once a complainant has made out a prima facie case that a respondent has no rights or interests in the domain name, the burden of proof shifts to the respondent to offer evidence of his rights or legitimate interests in the disputed domain name. (See also *Intocast AG v Lee Daeyoon* Case No. D2000-1467 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1467.html>).

[1467.html](#)); and Cellular One Group v. COJ Cellular One, Inc. Case No, D2000-1521 (available at www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1521.html)),

They argue that in the present case, the prima facie evidence set out below supports the contention that Respondent has no *bonafide* rights or legitimate interests in the Domain Name:

- a. The Respondent's name is "Hosting Campus Domain" and does not resemble the Domain Name at all.
- b. Furthermore, nothing in the domain name record suggests that the Respondent is commonly known by the Domain Name.
- c. The Respondent is not known through the website corresponding to the Domain Name. Based on searches conducted with Google Inc.'s search engine (www.google.com.sg), there is no information existing in respect of "Hosting Campus Domain". A copy of the search result has been received by DNDRC.
- d. There is no linkage between "Hosting Campus Domain" to the Domain Name, and the Respondent is not in any way connected or affiliated to the 1st and/or 2nd Complainants. The Domain Name is not used in connection with a *bonafide* offering of goods or services by the Respondent:
 - i. As at 17 May 2007, there was no content posted on the website identified by the Domain Name, A copy of the same was provided to DNDRC; and
 - ii. A search for the keywords "STANDARD CHARTERED" (which is the Complainant's trading name) conducted with Google Inc.'s search engine (www.google.com.sg) discloses only hits relating to the 2nd Complainant. From the search, there is no hit / evidence that the Respondent operates any proprietary website or conducts any business or trade over the Internet at all. Copies of the first 50 search results which have been provided by the Complainant to DNDRC.
- e. The Respondent is not making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly

divert consumers or to tarnish the Registered Trade Marks and the Trade Mark Applications:

- i. The 1st and/or 2nd Complainants have not at any time ever authorized or consented to the Respondent's use of the Domain Name whether for commercial or non commercial activities; and
- ii. In light of the famous nature of the Registered Trade Marks and the Trade Mark Applications in respect of the "STANDARD CHARTERED" marks and the extensive use of such marks, use of the Domain Name leads to the clear inference that the Respondent's use is an opportunistic attempt to attract visitors via the 1st Complainant's famous marks and is not a legitimate noncommercial or fair use.

The 1st and 2nd Complainants have submitted that the Respondent is diluting the Registered Trade Marks and Trade Mark Applications. The Respondent is, in effect, preventing the 1st and 2nd Complainants from reflecting the Registered Trade Marks and Trade Mark Applications in a domain name that is meaningful to the conduct of their business. In *CSA International (a.k.a Canadian Standards Association) v John O. Shannon and Care Tech Industries, Inc* Case No. D2000-0071 (available at www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0071.html), the Administrative Panel held that "the adoption by the Respondents of an Internet address substantially identical or confusingly similar to that of the name, Internet address and trade marks of the Complainant must inevitably and misleadingly divert consumers to that address and have the effect of tarnishing the trade marks".

The Complainants state that the Respondent has not taken any steps to use the Domain Name. Attempts to access the Domain Name result in a direction to an inactive site. The 2nd Complainant is a well-known bank in Pakistan and has registered "STANDARD CHARTERED" in respect of the Standard Chartered Domain Names mentioned above in order that consumers may conveniently access the 2nd Complainant's internet banking services. The diversion of the Domain Name to an inactive site is misleading to the consumer is likely to create the impression that the 2nd Complainant no longer offers internet banking services. Alternatively, the diversion to an inactive site may cause the consumer to lose confidence in the security of the 2nd Complainant's internet banking services and this could tarnish the 2nd Complainant's goodwill and reputation.

Complainants also state that the Respondent's act of incorporating the "STANDARD CHARTERED" mark in the Domain Name undermines the branding and reputation of the 1st and 2nd Complainants on the Internet. To achieve consistent branding, the 2nd Complainant currently registers all domain names bearing the "STANDARD CHARTERED" mark subject to availability and local registration rules. It is clear that the "STANDARD CHARTERED" branding will be diluted if a domain name bearing the "STANDARD CHARTERED" mark is registered and used by a third party.

The Complainants have submitted that given that the Respondent:

- a. has not made any use of the Domain Name;
- b. is not conducting business or trading via the Internet;
- c. is not commonly known by the Domain Name, and is not in any way connected or affiliated to the 1st and/or 2nd Complainants; and
- d. is not authorized to use the "STANDARD CHARTERED" marks,

the Respondent prima facie has no rights or legitimate interests in the Domain Name. Consequently, the burden of proof shifts to the Respondent to prove that it has rights or legitimate interests in the Domain Name.

3. The Complainants have also alleged that the Domain Name was registered and is being used in bad faith (Policy, paras 4(a)(iii) and 4(b); Rules, para 3(b)(ix)(3))

They rely upon *Telstra Corporation Limited v Nuclear Marshmallows* Case No. D2000-003 ("Telstra Case"), the Administrative Panel held that inactivity by a respondent may amount to the domain name being used in bad faith in certain circumstances. Amongst others, the following two (2) circumstances were mentioned by the Administrative Panel in finding that passive bad faith use existed. These circumstances are where:

- i. A complainant's trade mark has a strong reputation and is widely known, as evidenced by its substantial use in the country of registration of the domain name as well as in other countries; and
- ii. There is no evidence whatsoever of any actual or contemplated good faith use by a respondent of the domain name.

The Complainants argue that applying the first test in determining passive bad faith, namely that a complainant's trade mark has a strong reputation and is widely known, as evidenced by its substantial use in the country of registration of the domain name as well as in other countries:

- a) The 2nd Complainant has been operating as a bank in Pakistan for more than 140 years, and is the largest international bank in Pakistan, and maintains 115 branches in 22 major cities across Pakistan through Standard Chartered Bank (Pakistan) Limited. The Respondent must have been aware of the existence of the 2 Complainant and rights at the time of registration of the Domain Name. Given that the “STANDARD CHARTERED” mark is well-known in Pakistan, the Respondent must have had prior knowledge of these Registered Trade Marks and Trade Mark Applications. The Domain Name is therefore so obviously connected with such a well-known name that its very use by someone with no connection with the industry suggests opportunistic bad faith (see *Veuve Clicquot Ponsardin, Maisoit Fondée en 1772 v The Polygenix Group Co.* Case No. D2000-0163 (available at www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0163.html)).
 - b) From the domain name records, it appears that the Domain Name was registered on 20th June 2006. It should be noted that the Due Diligence Report issued by the 2nd Complainant for the acquisition of Union Bank was dated 19th June 2006. It is submitted that the only reasonable inference is that the registration of the Domain Name at this crucial time when Standard Chartered was seeking to expand its operations in Pakistan was due to an opportunistic motive to hijack the Domain Name for monetary gain.
 - c) That the Respondent has used and is using the Domain Name in bad faith. As stated above, the Domain Name is an inactive site although it was registered nearly one year ago on 20 June 2006, There is therefore no actual use or any evidence of contemplated good faith use by the Respondent. Applying the test in the Telstra Case, this is further evidence of passive bad faith use of the Domain Name.
 - d) Accordingly, the 1st and 2nd Complainant submit that the registration and use of the Domain Name which is identical to the well-known “STANDARD CHARTERED” mark as well as the 1st Complainant’s Registered Trade Marks and Trade Mark Applications was in opportunistic bad faith,
4. The Compliant seeks the remedy of Transfer of the Domain Name to the 2nd Complainant.

B. Respondent

The Respondents have simply stated that they deny the entire Complaint.

They allege that the “Domain “StandardCharted.pk” was registered with PKNIC on the 20th of June 2006 as per PKNIC policy which states: About name.pk. Name.pk domains are .PK domain names without the standard suffix such as .com.pk, .net.pk. The open registration period, on a first come, first served basis, was started on June 20th. 2006.

Since purchasing this domain no activity of any form has taken place on this website. Neither has this domain ever been offered for sale/rent to any third party. Moreover, this domain has not even been used for parking or domain sale services easily available from different domain brokerage companies. The option to use ‘parking’ on this domain would have been economically and financially viable however this may have been seen as a reason to damage the business of the complainant. This ‘parking’ would naturally have been related to our subject and not the banking field at all. However, the reason for not offering this domain or making any quick money from it is to protect the prestige and value of our brand that is going to be launched after completion of proper research that began long before the purchase of this domain. This should clear our intention towards the purchase however there may be confusion on the use of this domain as no activity has started as yet. This delay in activity is purely due to professional reasons and should not be taken in any other meaning on subjective reasoning. However for pursuing this case we will disclose the requirements for this domain and the purpose for this purchase even though this may disclose our project before its implementation and secrecy will be lost as well that may cause damages to our plan. This domain is intended for informative purposes only to provide maximum information on this subject. This is a nonprofit venture that has been pursued on a .pk extension domain as similar such .com and other common extension domains are not available and this was a new domain extension. Our subject has no relation to the complainants bank or any bank in specific or even the banking industry / field in general. The complainant is using malafide intentions to damage our interests as there has been no violation by us in any form either by using the complainant’s trademark / logo name or any other common writing that relates us to the complainant or their business. If the complainant felt aggrieved by any of our activity it should have contacted us, but this has not transpired to date and it is the intention of the complainant to forcefully lay claim on the domain despite no irregular activity or violation by us, nor does the complainant have any interest in the domain which is why it did not make the purchase itself. If the complainant is to be believed it should have contacted us during this 1 year period with at least one complaint that may have come from any of its customers or stakeholders in relation to what it mentions. This clarifies that not a single complaint has ever been received by the complainant and this is being said only for the sake of argument. The following past rulings of similar cases clarify our position and point of view

1. In Slep-Tone Entertainment Corporation El/b/a Sound Choice Accompaniment Tracks v Sound Choice

Case No. 0093631 the Administrative panel held that.

“Based upon the above findings and conclusions and pursuant to the Rules of the Uniform Domain Name Dispute Resolution Policy and the National Arbitration Forum Supplemental Rules of ICANN’s Uniform Domain Resolution Policy. I hereby Order that the domain name SOUNDCHOICE.NET registered by Respondent Sound Choice not be transferred to Complainant Slep-Tone Entertainment Corporation d/b/a Sound Choice Accompaniment Tracks.”

2. In CALSTORE.COM v Infodrive Case No. 91206 the Administrative panel held that.

Complainant having failed to establish items (2 and (3) as set forth above, the Complaint is denied and the Respondent should be allowed to use the domain name.”

3. In Car Toys. Inc v Informa Unlimited. Inc. Case No. 93682 the Administrative panel held that.

“It is the decision of this Arbitrator that the cartoys.net domain name should not be transferred to the Complainant.”

The above mentioned cases have been quoted to support our contention not only because the ruling suits us but because the cases above are very similar in nature to this case. We have only mentioned a portion of the rulings however the entire case study is attached for better understanding. It is pertinent to mention that all cases involved a renowned trademark, however the difference was non-relation of all defendants and their activities to those of the complainants. Our intentions in the purchase of this domain are the same and should not be related to the complainants trademark as no activity using the complainants name or similar trademark has been used or is intended to be used in the future. We are going to launch this website very soon and all are plans are on time as we had always expected our research to take this long, however the purchase was necessary to avoid the usage of this domain by anyone else. We have not approached the complainant ever for any amicable solution that may or may not lead to any economic benefit for us as that was never our intention. Our ongoing efforts towards this non-profit venture will be known to the complainant and the general public at the time of the launching of this website in the very distant future. This will be a futuristic portal of its kind that will provide extensive information on the subject and will even benefit students who may require more information on this subject.

We would like to reiterate that this domain is not being used for any work that is similar to the complainant. Our intentions on the purchase are very clear and should not be construed in any other sense on the basis of conjecture or otherwise.

The Respondents have also claimed that the domain name in dispute <www.standardchartered.pk> is the property of the respondent and should remain so as the contentions of the complainant are only assumptions and based on malafide intentions

on the basis of which their complaint and request for transfer should be outrightly dismissed.

6. Jurisdiction

The Arbitral Panel's jurisdiction over this dispute as between the Complainant and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules and the submissions to jurisdiction by both the parties.

The Respondent applied for and was granted registration of the Domain Name and on the basis of which the Respondent has submitted in the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules to the arbitral jurisdiction of the DNDRC and its arbitration decisions. In addition, as a ratification and confirmation of the same (though the absence of the same would not detract from the submission to jurisdiction and arbitration) the Respondents have submitted their Response form seeking remedies in its favour by DNDRC and the Panel under the jurisdiction of these Arbitration proceedings.

The Complainants voluntarily submitted to the Respondent their Complaint under available provisions and the Respondent submitted the same to DNDRC for decision as per the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules.

Both parties have thus, accepted and submitted to jurisdiction of the DNDRC and its arbitration decision in accordance with the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules.

7. Discussion and Findings

The application for registration of the <standardchartered.pk> domain name in dispute on behalf of the Complainant is subject to the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules which state that "*You, the applicant who wants to register a domain name under .PK is presumed to have read and agreed to this PKNIC Internet Domain Registration Policy*". The Respondent applied for registration on the basis of the same and was offered registration subject to the same. Hence the relationship between the Respondent and PKNIC and its domain name registration service is governed by the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules.

The PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 paragraph 1 clearly states that it creates an exception for and thus, excludes the registration of domain names that:

- a. infringes upon a registered tradename,*
- b. is not bona fide as recognized by international best practice,*
- c. 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,*
- 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.*

The PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 paragraph 4 also states that:

- 4. 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 of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, agitates 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.*

The UDRP lays down three basic requirements under paragraph 4(a) on basis of which a domain name Complaint is to be decided:

- (i) Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and*
- (ii) Respondent has no rights or legitimate interests in respect of the domain name; and*
- (iii) Respondent's domain name has been registered and is being used in bad faith.*

The UDRP requires with regard to Legitimate Interest at paragraph 4(c) that the Respondent's claim as to Legitimate Interest 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\(a\)\(ii\)](#):

*(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**.*

Clearly, the onus of proving any of the above or of Legitimate Interest lies upon the Respondent as laid out in the UDRP and even otherwise under Rules of Evidence, since the party that asserts Legitimate Interest as asserted by the Respondents in their Response must prove the same. In any case it is not possible to prove a negative and by default on this issue the burden would additionally fall on the Respondents to prove their Legitimate Interests in the Domain Name. Interestingly, though the Response form required the Respondent to “(ii) Annex any additional documentation to support the Response, together with a schedule indexing such document(s).” no evidence of any of the three aspects has been provided much less proof of the same tendered and then actually proved based on such evidence.

The UDRP requires that in regards to Bad Faith “*the following circumstances, in particular but **without limitation**, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:*

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 paragraph 6 also state that:

*25. PKNIC has neither the resources nor the legal obligation to screen requested Domain Names to determine if the use of a Domain Name by an Applicant may infringe upon the right(s) of a third party. Consequently, as an express condition and material inducement of the grant of an applicant's ("Applicant") request to register a Domain Name, Applicant represents, agrees and warrants the following four statements and a **failure to comply with them, or any other parts of the PKNIC policy, will cause PKNIC to cancel the domain registration of the non-compliant domains of Applicant:***

- 1. Applicant's statements in the application are true and **Applicant has the right to use the Domain Name** as requested in the Application;*
- 2. Applicant has a **bona fide intention to use the Domain Name on a regular basis on the Internet;***
- 3. The use or registration of the Domain Name by Applicant **does not interfere with or infringe the right of any third party in any jurisdiction in Pakistan, with respect to trademark, service mark, tradename, company name or any other intellectual property right;***
- 4. Applicant is not seeking to use the Domain Name for any unlawful purpose, including, without limitation, tortuous interference with contract or prospective business advantage, unfair competition, injuring the reputation of another, or **for the purpose of confusing or misleading a person, whether natural or incorporated.***

In this context the following aspects of the dispute will be addressed in this decision:

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 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)

Illegality, unlawfulness or otherwise invalidity of the Application & Registration

In terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 a registration of a domain name is allowed subject to inter alia paragraph 1 & 4 which state:

“with the exception of any applications/cases for registration that attempt to register a domain name that:

- a. infringes upon a registered tradename,*
- b. is not bona fide as recognized by international best practice,*
- c. 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,*
- 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.*

The PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 paragraph 4 also state that:

- 4. 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 of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, agitates 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.*

Hence, any registration in contravention of paragraph 1 of The PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 would be ab initio void and in any case voidable in terms of paragraph 4 of The PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1.

Under the head of Illegality, unlawfulness or otherwise invalidity of the Application & Registration to assess whether the application and registration of the Domain Name in dispute “<[standardchartered.pk](#)>”, is ab initio illegal the following aspects in the context of this dispute are to be assessed:

- i. Whether the Domain Name in dispute “<[standardchartered.pk](#)>” infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Domain Name in dispute “<[standardchartered.pk](#)>” is bona fide?
- iii. Whether the application and/or registration of the Domain Name in dispute “<[standardchartered.pk](#)>” contravenes the Pakistan Penal Code or any applicable criminal law?

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

- i. *Whether the Domain Name in dispute “<[standardchartered.pk](#)>” infringes upon a registered trade name / trade mark?*

It is clear from the facts mentioned above that the Domain Name in dispute “<[standardchartered.pk](#)>” is not just similar but is in fact identical to the registered trade name and trade mark of the Complainants who have existing registration of trade marks and trade names as mentioned below:

“StandardChartered”, Class 09, Application dated 12/27/1997, Registration No. 145718

“StandardChartered”, Class 16, Application dated 12/27/1997, Registration No. 145717

(collectively referred to as the “Registered Trade Marks”).

And have in fact got the following pending applications for registration of further trade marks and trade names the Pakistan Trade Mark Registry since 2 December 2005:

*“STANDARD CHARTERED”, Class 09, Application dated 02/12/2005
Application No.215924*

*“STANDARD CHARTERED”, Class 16, Application dated 02/12/2005
Application No.215925*

*“STANDARD CHARTERED”, Class 36, Application dated 02/12/2005
Application No.215926*

(collectively referred to as the “Trade Mark Applications”).

Further, the 2nd Complainant is the registrant of the following domain names with PKNIC (amongst others):

- standardchartered.com.pk
- standardcharteredbank.com.pk
- standard-chartered.com.pk
- standardchartered.net.pk
- standardcharteredbank.net.pk
- standard-chartered.net.pk
- standardchartered.org.pk
- standardcharteredbank.org.pk
- standardcharteredbank.org.pk
- standard-chartered.org.pk

(collectively referred to as the “Standard Chartered Domain Names”).

The above demonstrates and in the Panel’s opinion proves that the Complainants have taken more than the necessary steps to not just protect their trade marks, trade names but also domain names that relate to such trade marks and trade names.

In terms of paragraph 1 of The PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 if a Complainant simply establishes this one criteria the registration would be deemed Illegality, unlawfulness or otherwise invalid. As such since, in the opinion of the Panel this criteria has been established and the same has been admitted and not been refuted by any specific denial by the Respondent in their Response, the same stands proved and constitutes adequate grounds for the transfer of the Domain Name in dispute “<[standardchartered.pk](#)>” to the Complainants.

Nonetheless 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 other issues as listed above.

- ii. *Whether the application and/or registration of the Domain Name in dispute “<[standardchartered.pk](#)>” is bona fide?*

It is the opinion of the Panel that in order to determine this sub-issue an analysis of the actual and possible intention of the Respondents behind registration of the Domain Name in dispute “<[standardchartered.pk](#)>” is relevant to assist the Respondent in inter alia

establishing the bona fide nature of the registration and countering the argument that the registration is not illegal nor intended to deprive the Complainants from use of their domain name and creating the possibility of confusion proliferating in the users and customers due to similarity and identical nature of the domain name to their other domain names and trade marks and trade names.

In this respect, the fact that the Respondent is fully aware of the famous nature and large customer base of the Complainants at the time when the Respondent registered the Domain Name in dispute “<[standardchartered.pk](#)>” is relevant. In fact in one of the cases relied upon by the Respondents themselves (CALSTORE.COM v Infodrive Case No. 94206) the geographical distance and lack of awareness of the parties about each other (One being in California and the other in Calcutta) was seen as evidence indicating proof of bona fide when it was held that:

“The fact that, even though a world apart, both applied to register at the almost identical moment would be an indication that neither knew of the other’s activities. There is no reason why either should have been aware of the other.”

In the present case the fact that both parties are present in the same geographic location and the Respondent is well aware of the existence and value of the Complainants’ trademark, trade name, existing domain names and customer base, is indicative of proof that the Respondent’s registration of the Domain Name in dispute “<[standardchartered.pk](#)>” lacks bona fide.

Moreover, the fact that the Respondent choose specifically to register a domain name not just similar but identical to several existing domain names with several registered trade marks and trade names is also relevant.

Moreover, in case, hypothetically, the Respondent’s intention was to register the Domain Name in dispute “<[standardchartered.pk](#)>” with the intention of using it for a specific and legitimate purpose they would have by now after the elapse of the reasonable time of one year have been able to provide evidence of such activity and would have in fact implemented such activity over the internet/web and/or in the real world. However, the Respondents have not been using the domain name since 20th June 2006 for over a year.

Moreover, the Respondents have also registered several other domain names in similar fashion:

askaribank.pk admin@hostingcampus.com 202.163.102.143

suzuki.pk admin@hostingcampus.com 202.163.102.143

kesc.pk admin@hostingcampus.com 202.163.102.143

inbox.pk admin@hostingcampus.com 202.163.102.143

marriott.pk admin@hostingcampus.com 202.163.102.143

times.pk admin@hostingcampus.com 202.163.102.143

siemens.pk admin@hostingcampus.com 202.163.102.143

abnamro.pk admin@hostingcampus.com 202.163.102.143

standardchartered.pk admin@hostingcampus.com 202.163.102.143

None of these domain names are being used by the Respondents.

It can be seen that the Respondents have been specifically choosing to register domain names which have in Pakistan large market and customer bases and presence and cross-cut from large financial institutions to multinational manufacturers and services industry brand names with registered and identical trade marks and trade names to the domain names chosen to be registered by the Respondents. There is no evidence submitted to suggest, far less the Respondent meeting the burden of proof, that the Respondents represent a particular economic sector or have any authority from such businesses. This establishes the fact that the Respondent's behavior is a part of an overall pattern which constitutes sufficient proof of the lack of bona fide (*Zwiesel Kristallglas AG v WWW Enterprise Inc. Case # D2005-1223* www.wipo.int/amc/en/domains/decisions/html/2005/d2005-1223.html).

In addition the Respondents cannot point to any tradename, trademark or current or even proposed use of these, nor a similar domain name that they have been using similar to the Domain Name in dispute “<standardchartered.pk>”. On the other hand the Complainants have given an extensive list of not just currently owned Trade Marks and Trade names but several functioning domain names which are identical and similar. As such the innocent or bona fide intention of the Respondent in registration of the Domain Name in dispute “<standardchartered.pk>” is not made out.

Most importantly the refusal and failure of the Respondent to provide any facts and details as to the alleged non-commercial purpose have failed to assist them in discharging the burden of their allegation that there is a legitimate and non-commercial purpose in conformity with the PKNIC- Internet Domain Registration Policy June 20, 2006 version 4.1 for which the Respondents initially registered the Domain Name in dispute “<standardchartered.pk>”. Moreover, the deliberate nature to conceal the purpose of the registration by the Respondents and their intentions for use in connection with the Domain Name in dispute “<standardchartered.pk>” brings into doubt the bona fide of the Respondent.

From the discussion under this third sub-issue it can be seen that there are requisite and adequate facts; failure to prove otherwise; deliberate refusal to mention or establish and in fact concealment of the purpose or legitimate interest over the Domain Name in dispute “<[standardchartered.pk](mailto:admin@standardchartered.pk)>”. In addition the similar acts by the Respondent in relation to the other Domain Names registered by the Respondent in the opinion of the Panel demonstrate not just a lack of bona fide but a positive mala fide of the Respondent in registering the Domain Name in dispute “<[standardchartered.pk](mailto:admin@standardchartered.pk)>”.

The Panel in addition to the above would also make mention of another way in which the use of the Domain Name under Dispute “<[standardchartered.pk](mailto:admin@standardchartered.pk)>” would cause confusion and would be contrary both the letter and spirit and public policy of the ICANN UDRP as well as the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1. DNDRC has sent two test emails to the following addresses:

admin@standardchartered.pk sent on Thu 8/16/2007 05:22

and

ali@standardchartered.pk sent on Thu 8/16/2007 05:23

Both the messages were met with the following two Mail Delivery Failure Messages, respectively for each message sent:

The address to which the message has not yet been delivered is:

`admin@standardchartered.pk`

No action is required on your part. Delivery attempts will continue for some time, and this warning may be repeated at intervals if the message remains undelivered. Eventually the mail delivery software will give up, and when that happens, the message will be returned to you.

Received on Fri 8/17/2007 05:41

A message that you sent could not be delivered to one or more of its recipients. This is a permanent error. The following address(es) failed:

`admin@standardchartered.pk`
`unrouteable mail domain "standardchartered.pk"`

Received on Fri 8/17/2007 11:14

The address to which the message has not yet been delivered is:

`ali@standardchartered.pk`

No action is required on your part. Delivery attempts will continue for some time, and this warning may be repeated at intervals if the message remains undelivered. Eventually the mail delivery software will give up, and when that happens, the message will be returned to you.

Received on Fri 8/17/2007 07:26

A message that you sent could not be delivered to one or more of its recipients. This is a permanent error. The following address(es) failed:

ali@standardchartered.pk
unrouteable mail domain "standardchartered.pk"

Received on Fri 8/17/2007 11:34

This demonstrates that in case any “*a reasonable bystander*” or “reasonable user” may be misled and confused when sending emails to this domain name that the domain name may be that of the Complainant. The confusing similarity and in fact identical natures of the domain name would lead to confidential messages being received by the Respondent. This situation would be similar to the one that arose in the famous case commonly known as the One In A Million Judgement before the the Supreme court of the Judicature In the Court of Appeal (Civil Division) On Appeal from the High Court of Justice Chancery Division, UK. The Judgement identified the likelihood that the sending of such emails would lead to substantial confusion which would be detrimental to business of an established business with legitimate interest in the use of the domain name. The Court also came to the conclusion that the act of registration of confusingly similar domain name would constitute passing-off:

It is accepted that the name Marks & Spencer denotes Marks & Spencer Plc and nobody else. Thus anybody seeing or hearing the name realises that what is being referred to is the business of Marks & Spencer Plc. It follows that registration by the appellants of a domain name including the name Marks & Spencer makes a false representation that they are associated or connected with Marks & Spencer Plc. This can be demonstrated by considering the reaction of a person who taps into his computer the domain name marksandspencer.co.uk and presses a button to execute a "whois" search. He will be told that the registrant is One In A Million Limited. A substantial number of persons will conclude that One In A Million Limited must be connected or associated with Marks & Spencer Plc. That amounts to a false representation which constitutes passing-off.

Mr Wilson submitted that mere registration did not amount to passing-off. Further, Marks & Spencer Plc had not established any damage or likelihood of damage. I cannot accept those submissions. The placing on a register of a distinctive name such as marksandspencer makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill in the name. Such persons would not know of One In A Million Limited and would believe that they were connected or associated with the owner of the goodwill in the domain name they had registered. Further, registration of the domain name including the words Marks & Spencer is an erosion of the exclusive goodwill in the name which damages or is likely to damage Marks & Spencer Plc.

I also believe that domain names comprising the name Marks & Spencer are instruments of fraud. Any realistic use of them as domain names would result in passing-off and there was ample evidence to justify the injunctive relief granted by the judge to prevent them being used for a fraudulent purpose and to prevent them being transferred to others.

This case represents good law even today and was upheld finally in Appeal by the Court of Appeal. As such similarly, in this case the registration of the Domain Name in dispute “<[standardchartered.pk](#)>” by the Respondents would also constitute passing-off and a contravention of the criteria (i), (ii) and (iii) of paragraph 1 of The PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1.

In terms of paragraph 1 of The PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 if a Complainant simply establishes this one criteria the registration would be deemed Illegality, unlawfulness or otherwise invalid. As such since, in the opinion of the Panel this criteria has been established by the Complainants and no evidence to the contrary has been tendered by the Respondent in their Response, the same stands proved and constitutes adequate grounds for the transfer of the Domain Name in dispute “<[standardchartered.pk](#)>” to the Complainants.

- iii. Whether the application and/or registration of the Domain Name in dispute “<[standardchartered.pk](#)>” contravenes the Pakistan Penal Code or any applicable criminal law?

Before proceeding with this analysis the Panel feels compelled to clarify the basis and effect of this sub-issue. It is clarified that although Pakistani law does not apply by force of law over the PKNIC Jurisdiction it does apply as a contractual term to the Contract between the Respondent and PKNIC and defines the scope and terms of use of the domain name under The PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1. As such it is clarified for future disputes, Appeals and Complaints that the illegality and examination of Pakistani law in this context does not imply that Pakistani

law has applicability or jurisdiction over PKNIC or the dispute. Instead the fact that Pakistani law is included as part of the terms of the PKNIC- Internet Domain Registration Policy June 20, 2006 version 4.1, the terms and conditions apply to PKNIC and all parties by virtue of contractual and representative clauses and the examination of Pakistani law is thus undertaken to examine whether any of these terms and conditions have been breached, violated and/or there is non-conformity by the applicant or PKNIC.

In this spirit and for this purpose alone the following provisions of Pakistani law are being analyzed.

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.*

Pakistan Penal Code, 1860

Of Trade, Property and Other Marks

1[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)¹.]

As such the Trade Mark Ordinance equates infringements of Trade Marks and Trade Names with Domain Names and hence, under the Trade Mark infringement provisions of the Pakistan Penal Code would possibly also cover domain names.

Moreover, the Electronic Transactions Ordinance, 2002 (“**ETO**”) states that:

“3. Legal recognition of electronic forms.—No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect,

¹ Now to be read as the Trade Marks Ordinance, 2001

validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness.”

As such 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 law had the material been in physical, written or printed form. Thus, the Penal Code equally applies to transactions, publications or material including the use of any trade mark or trade name made available in electronic form on the Internet through the use of a domain name.

Since the Internet by its very nature is a public place, the access of the domain name may involve use by the registrant of a registered trade mark or trade name in the form of a domain name by someone other than the owner/rightful holder/authorized user of the trade mark or trade name, the export and import of data that would violate trade names or trade marks by access to such a domain as well as content at the very least by use of Search engines to the public would attract offences *inter alia* mentioned below under the Penal Code.

By continuing the registration of the Domain Name in dispute “<[standardchartered.pk](#)>” by a person who is other than the owner/rightful holder/authorized user of the trade mark or trade name, not only would the Respondent give the impression that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) would be allowing and become 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 the use of the domain name in dispute “<[standardchartered.pk](#)>” by a person who is other than the owner/rightful holder/authorized user of the trade mark or trade name if possibly linked to any service or goods could be an offence under the Penal Code. Similarly, other provisions below could possibly apply as well:

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.***

Here section 481 includes not only movable goods but moveable property. As such it may easily be extrapolated that the inclusion of the words “movable property” in addition to the words “goods” suggests that the draftsman and legislature intended “movable property” to mean something other than, and in addition to, “goods” and as such intellectual property or now with the aid of the ETO digital property or any “document, record, information, communication or transaction” in electronic form would also be covered under this section. Hence, it would include any electronic means of encasing, packaging, containing intellectual property or property which is movable and other than goods i.e. including domain names or any content on the website hosted on the domain name in dispute “<standardchartered.pk>”. As such the use of a false property mark (which includes trade marks and by virtue of both the Trade Marks Ordinance, 2001 and International best practices) includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages (received from the website hosting the domain name) on the Internet with the reasonable expectation that people would be misled to believe that the trade mark or trade name or domain name belongs to the famous bank and financial institution Standard Chartered Bank, when in fact it does and would constitute use of a false property mark in violation of the Penal Code.

As such the use of the domain name in dispute “<standardchartered.pk>” by a person who is other than the owner/rightful holder/authorized user of the trade mark or trade name could be an offence under the Penal Code. Similarly, other provisions below could possibly apply as well:

*483. **Counterfeiting a trade mark or property mark used by another.** Whoever **counterfeits any trade mark or property mark** used by any other person shall be punished with imprisonment of either description for a term which may extend to two years, or with fine, or with both.*

*485. **Making or possession of any instrument for counterfeiting a trade mark or property mark.** Whoever makes or **has in his possession any die, plate or others instrument for the purpose of counterfeiting a trade mark or property mark or has in his possession a trade mark or property mark for the purpose of denoting***

that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong, shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both.

*473. Making or possessing counterfeit seal, etc., with intent to commit forgery punishable otherwise. **Whoever makes or counterfeits any seal, plate or other instrument for making an impression, intending that the same shall be used for the purpose of committing any forgery** which would be punishable under any section of this chapter other than section 467, or, with such intent, has in his possession any such seal, **plate or other instrument, knowing the same to be counterfeit**, shall be punished with imprisonment of either description for a term which may extend to seven years, and shall also be liable to fine.*

Similarly, the use of the domain name in dispute “<standardchartered.pk>” by a person who is other than the owner/rightful holder/authorized user of the trade mark or trade name may also be seen to be a counterfeiting of the source identifier of the trade name and trade mark and property mark and the use of a domain name apart from being counterfeiting by itself could at least constitute the possession and use of an electronic instrument being used for counterfeiting a trade mark, property mark or domain name.

464. Making a false document. A person is said to make a false document: ---

*First: Who dishonestly or fraudulently **makes, signs, seals or executes a document or part of a document, or makes any mark denoting the execution of a document, with the intention of causing it to be believed that such document or part of a document was made, signed, sealed or executed by the authority of a person by whom or by whose authority he knows that it was not made, signed, sealed or executed, or at a time at which he knows that it was not make, signed, sealed or executed;***

470. Forged document. A false document made wholly or in part by forgery is designated “a forged document”.

*471. Using as genuine a forged document. **Whoever fraudulently or dishonestly uses as genuine any document which he knows or has reason to believe to be a forged document, shall be punished in the same manner as if he had forged such document.***

*476. **Counterfeiting device or mark used for authenticating documents other than those described in section 467, or possessing counterfeit marked material. Whoever counterfeit upon, or in the substance of, any material, any device or***

mark used for the purpose of authenticating any document other than the documents described in section 467 of this Code, intending that such device or mark shall be used for the purpose of giving the appearance of authenticity to any document then forged or thereafter to be forged on such material, or who, with such intent, has in his possession any material upon or in the substance of which any such device or mark has been counterfeited, shall be punished with imprisonment of either description for a term which may extend to seven years, and shall also be liable to fine.

Similarly, the use of the domain name in dispute “<[standardchartered.pk](#)>” by a person who is other than the owner/rightful holder/authorized user of the trade mark or trade name could also be equivalent to the use of an electronic message or document covered under ETO, 2002. Since, the person making, signing or executing this website, the domain name, its contents, its documents on the site and every message that suggests that the message is being executed by “<[standardchartered.pk](#)>” would be representing and making such a document falsely knowing that he is not authorized to do so and hence the electronic message and document would be false/forged and he would thus, contravene sections 464, 470 and 471 of the Penal Code.

Moreover, section 476 of the Penal Code that clearly makes it an offence to possess any device or material (by operation of the ETO 2002 this would extend to electronic instruments or devices including domain names, websites and electronic messages being exchanged between the domain name, the website server and any other party) which is supposed to authenticate or give the impression that it authenticates (the domain name would authenticate) a document (the website and domain name or the electronic messages) when in fact such authentication would be incorrect and counterfeit.

Once again the Electronic Transactions Ordinance 2002 states that:

“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.”

As such 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 law had the material been in physical, written or printed form. Thus, the Penal Code equally applies to transactions, publications or material including the use of any trade mark or trade name made available in electronic form on the Internet through the use of a domain name.

Since the Internet by its very nature is a public place, the access of the domain name may involve use of a registered trade mark or trade name in the form of a domain name by

someone other than the owner/rightful holder/authorized user of the trade mark or trade name, the export and import of data that would violate trade names or trade marks by access to such a domain as well as content at the very least by use of Search engines to the public would attract the offences under the sections mentioned above under the Penal Code.

By continuing the registration of the Domain Name in dispute “<[standardchartered.pk](#)>” by a person who is other than the owner/rightful holder/authorized user of the trade mark or trade name, not only would the Respondent but possibly give the impression that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) would be allowing and become an aider, abettor, encourager and co-conspirator and also liable to criminal offences.

Hence, it is in the opinion of the Panel established that the registration and/or use of the Domain Name in dispute “<[standardchartered.pk](#)>” by the Respondent would be in violation of Pakistani criminal law and the Pakistan Penal Code and therefore as a result of constituting a violation of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1. Since in the opinion of the Panel this criteria has been established by the Complainants and no evidence to the contrary has been tendered by the Respondent in their Response, the same stands proved and constitutes adequate grounds for the transfer of the Domain Name in dispute “<[standardchartered.pk](#)>” to the Complainants.

The Panel therefore, concludes that the registration of the domain name in dispute “<[standardchartered.pk](#)>” would be illegal, unlawful and otherwise invalid in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 not to mention that the Respondent’s registration and/or use of the domain name in dispute “<[standardchartered.pk](#)>” could possibly give the impression that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) by allowing the maintenance of such registration would be committing a contravention of the Pakistani criminal law and a breach of its own Internet Domain Registration Policy June 20, 2006 version 4.1.

It is once again reiterated and clarified for future disputes, Appeals and Complaints that the illegality and examination of Pakistani law in this context does not imply that Pakistani law has applicability or jurisdiction over PKNIC or the dispute. Instead the fact that Pakistani law is included as part of the terms of the PKNIC- Internet Domain Registration Policy June 20, 2006 version 4.1, the terms and conditions apply to PKNIC and all parties by virtue of contractual and representative clauses and the examination of Pakistani law is thus undertaken to examine whether any of these terms and conditions have been breached, violated and/or there is non-conformity by the applicant or PKNIC.

Although it is clear that the Complaints have succeeded in proving their Complaint in terms of the initial requirements of the PKNIC- Internet Domain Registration Policy June 20, 2006 version 4.1, and the registration of the disputed domain name is to be transferred to the Complainants this panel, shall also assess the Complainant in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy June 20, 2006 version 4.1 (which also includes the ICANN UDRP with amendments).

The UDRP lays down three basic requirements under paragraph 4(a) on basis of which a domain name Complaint is to be decided:

- (i) Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and*
- (ii) Respondent has no rights or legitimate interests in respect of the domain name; and*
- (iii) Respondent's domain name has been registered and is being used in bad faith.*

The Panel shall continue to deal sequentially with the next three issues:

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

Looking at the Standard Chartered Domain Names already in use and registered by the Complainants it is quite clear that the suffix “.com.pk”, “.org.pk” and “.net.pk” are already with the Complainants.

- standardchartered.com.pk
- standardcharteredbank.com.pk
- standard-chartered.com.pk
- standardchartered.net.pk
- standardcharteredbank.net.pk
- standard-chartered.net.pk
- standardchartered.org.pk
- standardcharteredbank.org.pk
- standardcharteredbank.org.pk
- standard-chartered.org.pk

In such circumstances it may be asked whether the suffix or TLD “.pk” is distinct, similar or identical to the Standard Chartered Domain Names and the registered trade and service marks of the Complainants

However, in keeping with international best practice and the various decisions issued by other panels it is clear to the Panel that the use of the suffix “.pk” is to be ignored when embarking on an analysis of whether the disputed domain name and the Complainants’ trade and service marks.

In *Zwiesel Kristallglas AG v WWW Enterprise Inc.* Case No. D2005-1223, the Panel held that “for the purposes of assessing whether a domain name is identical or confusingly similar to a trade mark or service mark, the suffix “.com” must be disregarded as being simply a necessary component of a generic top level domain name”.(see also *VAT Holding AG v Vat.com* Case No.D2000-0607;*LG Chemical Ltd v Changhwam, OH* Case No. D2000-0889;

In *LG Chemical Ltd v Changhwam, OH* Case No. D2000-0889 it was held that, “Having ignored the generic top-level domain (gTLD) “.com” of the domain name , the Panel finds that the domain name at issue is identical with the Complainant's trade name *LG Chemical Ltd.* and, also, with the Complainant’s trademark and service mark “*LG CHEMICAL*” and the word portion of the “*LG Chemical & Device*” mark. As to the insignificance of the generic top-level domain, see *VAT Holding AG v Vat.com*, Case No. D2000-0607. Nor does it matter to the identicalness between the domain name and trademarks whether “lg” in “lgchemical” is an acronym of “lonely gate,” the name of Respondent’s proposed search engine, or derived from “Lucky Goldstar,” the previous trade name of the Complainant.

Similarly, it is established that the suffix “.pk” must be disregarded as simply being a necessary component of a country’s Top Level Domain and the Panel is to assess the disputed domain name without the suffix or TLD “.pk” . In comparing the disputed domain name with the Standard Chartered Domain Names, the Panel would again disregard the suffixes such as “.com.pk”, “.org.pk” and “.net.pk”.

As such the operative part of the disputed domain name would simply be “standardchartered” which when compared with the Standard Chartered Domain Names and the Standard Chartered Registered Trade Marks and Trade Mark Applications the Domain Name under dispute “<[standardchartered.pk](#)>” is not only confusingly similar but also identical.

This fact is not disputed by the Respondents in their Response and is in fact admitted.

In the similar case of *Atticabank S.A. v. Net Promotion, Inc.* Case No. D2006-0317 the Panel, when discussing the issue of “Identical and Confusingly Similar”, held the following:

“A. Identical or Confusingly Similar

Although the Complainant’s business is primarily based in Greece, the Complainant has for many years used the words ATTICA BANK and BANK OF

ATTICA in the English language both as a corporate name and as a trademark and service mark. The Complainant has built a substantial goodwill in the use of these marks both in Greece and in other jurisdictions throughout the world for its banking and financial services.

The Complainant's Greek registered trademark ATTICA CARD, registration no. 117698, is for a word mark. The Greek registered trademark TECHNOCARD – BANK OF ATTICA, registration no. 141534, includes a logo but the registration document expressly includes the words as protected indications. Similarly, Greek registered trademark TECHNOCARD – BANK OF ATTICA, registration no. 141535, includes a logo device but again the registration document expressly states that the words are protected indications. Similar protection is afforded to the word elements in the Greek registered trademarks TECHNOCARD – BANK OF ATTICA with logo, registration no. 141535 and ATTICARD EXTRACASH – BANK OF ATTICA with logo, registration no. 143339.

The Complainant has established to the satisfaction of this Panel that it has rights in the trademarks ATTICA BANK and BANK OF ATTICA through long term use, and in addition, it has rights in the marks ATTICA CARD, TECHNOCARD – BANK OF ATTICA and ATTICARD EXTRACASH – BANK OF ATTICA through its Greek registered trademarks.

The domain name <atticabank.com> is clearly identical to the Complainant's trademark ATTICA BANK and is confusingly similar to the Complainant's trademark BANK OF ATTICA.”

In another case of Rosemary Conley Diet and Fitness Clubs Limited v Nikolina Bartels-King Case No.D2006-1401) it was held that

A. Identical or Confusingly Similar

The Complainant has established that it has registered rights in marks comprising the name “Rosemary Conley”.

The disputed domain name is virtually identical to the textual elements of the Complainant's ROSEMARY CONLEY marks. It is well-established under the Policy, that the extension “.com” is to be disregarded in determining identity or confusing similarity. Disregarding that extension, the disputed domain name is clearly identical to the textual elements of the Complainant's mark.

In addition, the case of Asset Loan Co. Ply Ltd v Gregory Rogers Case No. D2006-0300 available at www.wipo.int/amc/en/domains/decisions/word/2006/d2006-0300.doc clarifies the position with regard to the discussion under this head:

The Panel concludes, however, that the domain name is similar to the trademark and confusingly so. That is so for the following reasons. First, the test to be used is to assess how a reasonable bystander would construe the wording of the domain name compared with the trademark. In the opinion of the Panel, the dominant thrust of the trademark is to convey to the reader the name Asset Loan Co and it is this concept that makes up the entirety of the domain name. The fact that the trademark adds that the Asset Loan Co provides alternative financing with discretion is clearly secondary and subsidiary to the name itself and simply qualifies it.

In any event, as the unchallenged evidence is that ‘the Complainant has established a well known reputation’, it clearly has an unregistered trademark in that name and the domain name incorporates its entire name.

As the Panel is concerned to show that it has carefully considered all of the Respondent’s submissions, it should add here that it cannot accept the Respondent’s contention that it is permissible to look at his website to see that he is not selling the same goods and services as the Complainant or using its logo and that accordingly there can be no confusion and ‘no breach of any trademarks of the complainant’. The Panel is unable to accept this submission as it has been held many times that, when comparing a domain name and a trademark for the present purposes, the exercise must involve only a straight comparison of the two names without regard to the contents of the website to which the contentious domain name resolves. This view, the reason for it and the UDRP cases in support of it, are set out in the useful WIPO Overview of WIPO Panel Views on Selected UDRP Questions¹ where it is said:

“1.2 Is the content of a web site relevant in determining confusing similarity?

Consensus view: The content of a website (whether it is similar or different to the business of a trademark owner) is irrelevant in the finding of confusing similarity. This is because trademark holders often suffer from “initial interest confusion”, where a potential visitor does not immediately reach their site after typing in a confusingly similar domain name, and is then exposed to offensive or commercial content. The test for confusing similarity should be a comparison between the trademark and the domain name to determine the likelihood of confusion.....The other feature involved in making the comparison that the Panel is obliged to make is that the domain name must be compared with the entirety of the trademark. In this regard, as the Respondent points out, it must be noted that the mark is a composite one, featuring not only the words set out above, but a logo as well. The question, then, is whether the domain name is identical or confusingly similar to this composite mark.

That type of question is not always easy to resolve, for the figurative or graphic part of a trademark cannot be translated into a domain name and a true comparison is therefore difficult to make.

There are some obvious similarities between the two expressions, for they both contain the words 'Asset Loan Co.' But the question then is whether the logo so dominates the trademark and distracts attention from the words that a reasonable bystander would no longer regard the domain name as confusingly similar to the trademark because of the presence of the logo in the trademark. A recent illustration of how this can happen is Deutsche Post AG v. NJ Domains, [WIPO Case No. D2006-001](#) where the logo so dominated and put its stamp on the mark that it became its principle feature. That is not so however in the present case, where the logo is small, clearly subsidiary and more of a decoration than anything. When the trademark is looked at as a whole, it is therefore clear that it is a trademark consisting of the words 'Asset Loan Co.' and that the logo does not detract from that concept at all. In other words, the proper approach is to look at the overall impression or idea created by the mark and compare the result with the domain name, an approach that was taken in Yell Ltd. v. Ultimate Search, [WIPO Case No. D2005-0091](#). Applying that test, the overall impression of the trademark in the present case is that it is a reference to the trademark of the Complainant'. As the domain name uses all of those words, it is similar to the trademark. It is also confusingly so, because the question immediately arises whether the Asset Loan Co of the domain name is the Asset Loan Co of the trademark.

Similarly in this case the Respondents have alleged, without providing any proof or any factual particulars in the Response, that the website and its contents are potentially to be used for some other purpose than in relation to goods and services offered by the Complainants. Such an explanation (even though not proved) is irrelevant when analyzing a domain name dispute. As mentioned above in the case of Asset Loan Co. Ply Ltd v Gregory Rogers Case No. D2006-0300 available at www.wipo.int/amc/en/domains/decisions/word/2006/d2006-0300.doc, "The Panel is unable to accept this submission as it has been held many times that, when comparing a domain name and a trademark for the present purposes, the exercise must involve only a straight comparison of the two names without regard to the contents of the website to which the contentious domain name resolves."

It is clear from the discussion already undertaken by the Panel above under the heading "Illegality, unlawfulness or otherwise invalidity of the Application", under this head and the cases cited herein that in fact the domain name in dispute is not only confusingly similar but is in fact identical to the trade mark and service marks registered as well as applied for by the Complainants. In addition the disputed domain name is not just confusingly similar but identical to the several domain names already in use by the Complainants.

The Complainants have in addition an extensive use of their trade and service mark which is identical to the disputed domain name. The Complainants are a well known and well established financial institution and their trade and service marks are have an equally well known and well established goodwill within and outside Pakistan. Hence, the Respondent was at all times aware of the existence, reputation and use by the Complainants of the trade and service marks which are identical to the disputed domain name the Respondent specifically chose to register with PKNIC. Moreover, the well established reputation associated with the domain name in dispute “<standardchartered.pk>” would constitute the offence of passing off (as discussed above).

As discussed above the registration of the domain name would in addition to confusing reasonable users of web browsers would also confuse users of email who could easily be confused by sending and receiving emails to and from the Domain Name under dispute “<standardchartered.pk>”.

As such the Panel finds that paragraph 4(a)(i) of the Policy is established.

IV. Legitimate interest in Domain Name

(Para 4(a)(ii) and Para 4(c) of the UDRP Policy read with Para 3(b)(ix)(2) of the Rules for the UDRP)

Paragraph 4(c) of the UDRP (Policy) provides that evidence of one or more of the following shall demonstrate a respondent’s rights or legitimate interests to a domain name:

- a. Before any notice to the respondent of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- b. The respondent (as an individual, business, or other organization) had been commonly known by the domain name; or
- c. The respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

As such the Panel shall deal with each of these sub-issues sequentially:

- a. It is an admitted fact based upon the Complaint and the Response that the Respondent is not using the domain name or the corresponding name under dispute for a bona fide offering of goods and services.

The Respondents have also not provided any facts, particulars, evidence, proved or demonstrated that they are making any preparations for the use of the domain name for any bona fide purpose at all. The Respondents tried to state a purpose for registering the domain name in dispute:

*“.....parking or domain sale services easily available from different domain brokerage companies. The option to use ‘parking’ on this domain would have been economically and financially viable however this may have been seen as a reason to damage the business of the complainant. **This ‘parking’ would naturally have been related to our subject and not the banking field at all.** However, the reason for not offering this domain or making any quick money from it is to **protect the prestige and value of our brand** that is going to be launched after completion of proper research that began long before the purchase of this domain. This should clear our intention towards the purchase however there may be confusion on the use of this domain as no activity has started as yet. This delay in activity is purely due to professional reasons and should not be taken in any other meaning on subjective reasoning. However for pursuing this case **we will disclose the requirements for this domain and the purpose for this purchase even though this may disclose our project before its implementation and secrecy will be lost as well that may cause damages to our plan. This domain is intended for informative purposes only to provide maximum information on this subject.** This is a non-profit venture that has been pursued on a .pk extension domain as similar such .com and other common extension domains are not available and this was a new domain extension. **Our subject has no relation to the complainants bank or any bank in specific or even the banking industry / field in general.**”*

As can be seen, the Respondent is at pains to state that they are not using but are **going to use** the domain name for a **‘subject’**. What this subject is has not been mentioned. In fact not facts relating to or describing the ‘subject’ have been disclosed, demonstrated, tendered nor proved. The Response does, however, state that the purpose would be non-profit and for ‘informative purposes’. Again what sort of ‘informative purposes’ is not mentioned. The deliberate and cagey manner of the Respondent alluding to some ‘subject’ and an alleged non-profit informative purpose cannot be accepted by the panel since no evidence or even facts demonstrating use or preparation for use of the same have been provided or proved by the Respondent. Nor can it be accepted by the Panel that the use of a registered trade and service name and mark can be justified by using it to attract customers to what is a confusingly similar and identical domain name. The fraudulent, passing-off and breach of trade mark law have already been examined

by the Panel and therefore, do not need repeating but can simply be read here for the sake of brevity as including the reasons for rejecting the claims of the Respondent above in general and in particular with the regard to the failure by the Respondents to demonstrate or prove bona fide preparations for use of the domain name.

A case supporting this opinion can be found in Asset Loan Co. Ply Ltd v Gregory Rogers Case No. D2006-0300 available at www.wipo.int/amc/en/domains/decisions/word/2006/d2006-0300.doc

It is clear to the Panel that Respondent failed to elucidate any demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services in accordance with Paragraph 4(c)(i) of the Policy. Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in respect of the domain name at issue.

Hence, the Panel finds that the no evidence of item ‘a’ has been tendered nor proved by the Respondent upon whom the burden to prove the same lies.

- b. The Respondent has also failed to provide any facts, evidence or prove that the Respondent has been commonly known by the domain name. In addition to the reasons mentioned in item ‘a’ above, the fact remains that the Respondent has admitted that the use of the name and the domain name in dispute has not even begun. Moreover, no facts, evidence or proof of the fact that the Respondent is known commonly by the name exists. On the contrary the Complainants have established that they have an extensive, well-known and established name, reputation, market and goodwill; both within Pakistan and globally.

The Panel, hence, finds that the Respondent has also failed to establish or prove item ‘b’ which they in fact admit is not the case.

- c. Once again for the reasons mentioned in item ‘a’, ‘b’ and more generally throughout this decision, it is clear that the Respondent is not making any use of the domain name. For this criteria to apply the language of the UDRP Paragraph 4(c) is clear that the Respondent ‘is making...use of the domain name’. It is an admitted fact that the Respondent is not making use of the domain name in dispute and as such this criteria would not apply and hence, even on this count the Respondent has failed to provide any facts, particulars, evidence or to prove any of the items/criteria required to be proved by the Respondent under paragraph 4 (c). It is a fact that the list of requirements/criteria to be proved under paragraph 4 (c) of the UDRP are not exhaustive being “in particular but without limitation”. However, the Panel finds that even otherwise, the Respondents have generally failed to provide any facts, particulars, evidence or proved that they have a

legitimate interest in the domain name under dispute. Further examination by the Panel on the issue of legitimate interest shall be undertaken further below. However, in dealing with the last criteria the Panel has taken note, additionally of the following. Even if the domain name in dispute were being used by the Respondent, the criteria 'c' would not stand satisfied by the Respondent. The requirements under item/criteria 'c' are the following:

The Respondent should either be making legitimate noncommercial use or fair use of the domain name. It is clear from the discussion above that any use by the Respondent of the domain name under the circumstances would neither be legitimate nor could it be termed fair.

The Respondent is also required to prove that the intention of the Respondent is neither for commercial gain nor to misleadingly divert the Complainants' customers. As can be seen above and later in this decision the systematic behaviour which can only be characterized as mala fide is to in bulk register domain names identical to trade and service mark and names of established businesses in Pakistan. As such the Panel is of the view that, had the Respondent been using the domain name (which it is not and so in any case does not qualify for coverage or qualification under this criteria), on the facts before the Panel, the actions of the Respondent could not but be seen as evidence of a mala fide intent of the Respondent to acquire illegitimate commercial gain from the registration. Moreover, the discussion with regard to passing-off, fraud and the identical nature of the domain name with Standard Chartered Registered Domain Names, Registered Trade Marks and Applications for Trade Marks all demonstrate that consumers of the Complainants would in fact be misleadingly diverted to deal with the domain name under dispute. In addition, the fact that the Respondent admits that the domain name in dispute was registered for an alleged 'informative purpose' and the identical nature of the Domain Name under Dispute shows that the Complainants have established that in fact the Respondent intended to register the domain name under dispute specifically to misleadingly divert the Complainants' consumers.

The Panel, hence, finds that item 'c' does not apply to this case and does not provide any assistance to the Respondents and even had this criteria applied to the case the Respondent has also failed to establish or prove item 'c' which under the facts and circumstances of the case has in fact been proved by the Complainants against the Respondents..

Moreover, it is clear from the name and facts provided by the Respondent that the Respondent is a Hosting Company and admittedly does not in any way have any connection with the banking or a financial industry. Moreover, the name Hosting Campus, prima facie, implies a location, or premises for an educational institute

and therefore has no connection with banking or the financial industry with which the Trade and Service Mark and Name “Standard Chartered” is commonly connected. Hence, even other than and independent to the discussion above, the Respondents have no interest whatsoever at all in using the Domain Name in dispute.

In a similar case supporting the view taken can be found in Atticabank S.A. v. Net Promotion, Inc. Case No. D2006-0317 available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0317.htm>

The Respondent has no connection with the Complainant or with any bank or financial institution of any kind, and does not provide banking services.

The Respondent has not been licensed by the Complainant to use the Complainant’s marks. On the contrary, the Respondent has operated a pornographic site for many years and has aimed to make a profit from the site by whisking-off unsuspected Internet users to its site. Until February 28, 2006, there was nothing on the Respondent’s site at <atticabank.com> which referred to any activities of a bank.

The disputed domain name <atticabank.com> is in no way relevant to the Respondent’s products and services.

A customer who is unsure about the Complainant’s domain name will often guess that the domain name is formed by the Complainant’s name. Any unsuspecting customer who might type in the Complainant’s name followed by the gTLD designation “.com” would be whisked-off to a pornographic site. This would disparage the name of the Complainant and tarnish its reputation, by association with a line of sexual photographs and products that are inconsistent with the image that the Complainant has striven to maintain for itself and the services it provides.

Moreover, in the case of *De Agostini S.p.A v Marco Cialone* Case No. DTV2002-0005, the administrative panel held that:

“....satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of a domain name ... is quite onerous, since proving a negative circumstance is always more difficult than establishing a positive one. Accordingly, and in line with other prior decisions, the Panel holds that it is sufficient that the Complainant shows a prima facie evidence in order to shift the burden of proof on the Respondent”.

Additionally, in the case CSA International (a.k.a Canadian Standards Association) v John O.Shannon and Care Tech Industries, Inc Case No.D2000-0071, the Administrative Panel held that

“the adoption by the Respondents of an Internet address substantially identical or confusingly similar to that of the name, Internet address and trade marks of the Complainant must inevitably and misleadingly divert consumers to that address and have the effect of tarnishing the trade marks”.

Lastly, in the case of The Bank of the Pacific v Digi Real Estate Foundation Case No. D2006-1112 (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1112.html>) the special attention to a bank and danger of confusion in regards confusingly similar domain names misleadingly diverting consumers is rightly highlighted and similarly applies to this case:

The registration and use of an electronic web address for a bank that is identical or virtually identical to the trading style of a complainant trading bank can be particularly dangerous. Customers of the Complainant may be deceived into thinking there is a link or association with the Complainant and be lulled into a false sense of security in accessing the disputed domain name or even seeking to send via any of the links from the disputed domain address confidential information. Such risks in the case of an established commercial trading bank are very real (see Global Projects Management Ltd v Citigroup Inc [2006] FSR 721, High Court, England).

Hence, in all respects, inter alia from the contents of the Complaint, the Response and the facts disclosed before this Panel, as well as the discussion above, the Complainants’ assertion that the Respondent has no rights or legitimate interest in the domain name stands satisfied.

V. Registration and use in bad faith

(Para 4(a)(iii) and Para 4(b) of the UDRP Policy read with Para 3(b)(ix)(3) of the Rules for the UDRP)

In order to decide upon this issue the Panel must evaluate the facts placed before it by the Parties and follow Paragraph 4 (b) of the UDRP which states:

b. Evidence of Registration and Use in Bad Faith. For the purposes of [Paragraph 4\(a\)\(iii\)](#), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Hence, in case any of the elements above are satisfied before the Panel, it would constitute evidence of bad faith on part of the Respondent. It may also be noted that these elements are not exclusive and are “*without limitation*” and further elements evidencing or demonstrating bad faith may be satisfactory for a finding of Registration in bad faith by a Respondent.

General discussion of this issue

Before the Panel deals with the various elements/circumstances as mentioned in Para 4 (b) it is important to first deal with one preliminary aspect of the Paragraph 4(a)(iii) of the UDRP where it requires that it be shown that the “*domain name has been registered and is being used in bad faith*”. Of particular interest and discussion in numerous decisions internationally has been the language *registered and is being used* which on the face of it requires that the Respondent not only register but also be using the domain name in dispute. This has led to some Respondents who have not been using a disputed domain name to allege that the

requirement of use is mandatory and since they are not using the domain name the requirement is not met and the Complaint should be dismissed. This is relevant in the present case since although the Respondent has not used this argument in his defense, he has admitted that the domain name in dispute is not being used. This Panel is aware of the importance of this decision as being the first in Pakistan relating to the “.pk” ccTLD and as such for the sake of completeness and for the benefit of future Panels ventures to clarify this issue in light of international best practice decisions and precedents.

The seminal case of Telstra Corporation Limited v Nuclear Marshmallows Case No. D2000-003 (“Telstra Case”) is most useful in analyzing clarifying this issue and has been quoted, relied upon and followed by other Panels. An example where this case was followed is Rosemary Conley Diet and Fitness Clubs Limited v Nikolina Bartels-King Case No.D2006-1401 where it was held:

C. Registered and Used in Bad Faith

The Complainant supports its allegation of bad faith by essentially reiterating its claim that the Respondent has made no active use of the disputed domain name.

However, a lack of active use does not in itself demonstrate bad faith. Previous panels have found that a lack of active use “does not, however, resolve the question...[T]he relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith.” (See, in particular, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003: “the Telstra case”) (The panel further went on to note that:

“the circumstances identified in paragraphs 4(b)(i), (ii) and (iii) can be found in a situation involving a passive holding of the domain name registration. Of course, these three paragraphs require additional facts...[P]aragraph 4(b) recognises that inaction (e.g. passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith. Furthermore, it must be recalled that the circumstances identified in paragraph 4(b) are “without limitation” - that is, paragraph 4(b) expressly recognizes that other circumstances can be evidence that a domain name was registered and is being used in bad faith.” [emphasis added]

The point is essentially that there must usually be (as there was in the Telstra case) facts or circumstances additional to a passive registration that demonstrate bad faith. On this approach, acting in bad faith requires an assessment of all the circumstances of the case, including other

circumstances of action and/or inaction of the Respondent. The Complainant also contends that the domain name was registered by the Respondent to benefit from the Complainant's goodwill in its mark. (This contention is related to paragraph 4(b)(iv) of the Policy. Paragraph 4(b)(iv) provides that there is evidence of bad faith where the Respondent has attempted to attract Internet users by creating a likelihood of confusion with a complainant's mark.)

Clearly, passive holding as currently being exercised by the Respondents does not detract from evidence of bad faith. As such the Panel must look into the facts and circumstances of this case to assess whether there is bad faith and the lack of use of the domain name in dispute will not be a bar in reaching such a conclusion.

Before proceeding with this analysis it is clear from the discussion of various issues at length above that:

- i. A complainant's trade mark has a strong reputation and is widely known, as evidenced by its substantial use of the domain name in the country of registration ie. Pakistan as well as in other countries. Identical or confusing similarity of the Standard Chartered Registered Trade Marks and Trade Mark Applications the Domain Name under dispute "<standardchartered.pk>" and the discussion on Legitimate Interest has clarified this and the Panel has already found in favour of this contention.
- ii. There is no evidence whatsoever of any actual or contemplated good faith use by a respondent of the domain name. This too has been clarified and accepted by the Panel in the discussion above of Legitimate Interest and item 'a'.

Under the Telstra Corporation Limited v Nuclear Marshmallows Case No. D2000-003 ("Telstra Case"), these are two of the circumstances that, if satisfied, can be evidence of bad faith. Since these already stand satisfied, the Panel is of the view that the Respondent's bad faith in connection with the domain name in dispute has been made out.

Moreover, further support for opportunistic bad faith can be found in the case of Veuve Clicquot Ponsardin, Maisoit Fondée en 1772 v The Polygenix Group Co. Case No. D2000-0163 (available at www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0163.html).

Paragraph 4(b) of the ICANN Policy states:

"For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

It should be noted that the circumstances of bad faith are not limited to the above.

The Panel considers that the Respondent has registered and used the domain name "VEUVECLICQUOT.ORG" in "bad faith" for the following reasons:

(a) "VEUVECLICQUOT.ORG" is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith.

(b) The Respondent's offer to treat with persons with a "property interest" in this domain name is powerful evidence of bad faith: see the decisions in WIPO Center cases of Harrods Ltd v. Boyd ([Case No. D2000-0060](#)), China Ocean Shipping (Group) Co. Ltd v. Cao Shan Hui ([Case No. D2000-0066](#)). This case is very similar to the Harrods case where the Respondent had sought to sell a domain name in an attempt to capitalize on a name well-known throughout the world.

The present situation is similar to that in Educational Tertiary Service v. TOEFL ([WIPO Case D2000-0044](#)) where the learned Panelist said:

"The value which Respondent seeks to secure from sale of the domain name is based on the underlying value of Complainant's trademark. This value is grounded in the right of Complainant to use its mark to identify itself as a source of goods or services. Respondent has failed to establish any legitimate domain name-related use for Complainant's trademark, in a context in which such legitimization might be possible. The Respondent having failed to present any such justification, the Panel may reasonably infer that Respondent neither intended to make nor has made any legitimate use of Complainant's trademark in connection with the [domain name at issue]."

Accordingly, for all the various reasons discussed above, the Panel finds that the domain name "VEUVECLICQUOT.ORG" has been registered and is being used by the Respondent in bad faith.

The Panel will now sequentially deal with each of the sub-issues under Para 4 (b) UDRP:

- i. The Respondents state that they have as yet not offered this domain name to the Complainants when in the Response it states that they are "...not offering the domain or making any quick money from it..." and "We have not approached the complainant ever for any amicable solution that may or may not lead to any economic benefit for us as that was never our intention." As such the Respondent alleges that their intention in acquiring these domain names was not for the purpose of acquiring any economic benefit. However, keeping in mind the discussion above it is quite clear that based upon the facts and circumstances of this case including but not limited to the pattern of cyber squatting of the Respondent and connected precedents this seems highly unlikely and on the balance of probabilities stands proved in favour of the Complainants.

Moreover, the recent celebrated English High Court case of GPM vs. Citigroup Inc. [2005] EWHC 2663 (Ch) is persuasive authority to find that even where the Respondent does not have a cyber squatting track record (and the Respondents in this case have such a record) their action of registration can be held to lack bona fide:

43. It is true that GPM and Mr Davies do not have a cyber-squatting track record, but there is a different species of other evidence which to my mind shows irrefutably that their object was to obtain a domain name which carried the potential threat of deception harmful to Citigroup Inc. That evidence is the timing of the application to Nominet for the domain name citigroup.co.uk. The application was made later in the very day on which the agreement to form Citigroup had been announced with high publicity. Add to that that the next day Mr Davies tried to register citigroup.com as

well, and the conclusion is even more irresistible. In his written evidence on this he tries, with respect to him, to flannel around the issue. He suggests that he may have been looking for a suitable on-line brand for GPM, and possibly he had heard the name Citigroup on the news. This is palpable nonsense, and Mr McGee made no attempt to use this part of Mr Davies's evidence. There is no need for a trial at which, if Mr Davies tried to say that he was not attempting to register the name of the newly announced world financial giant, his evidence would not be accepted and indeed would in all probability be torn to shreds in cross-examination.

44. There is a further feature. GPM has not attempted to use the domain name in its own business, and Mr Davies has not suggested that it ever will. He denies that he is a cyber-squatter. He accepts, and has indeed given evidence himself, that thousands of persons who wanted to send emails to employees of Citigroup had failed to do so because GPM holds the .co.uk domain name. But in those circumstances, where the domain name appears to be of no interest to him, and where its existence in GPM's ownership is demonstrably causing substantial confusion, he is not willing to assign the name to Citigroup. He has defended Citigroup's counterclaim with a view to his company remaining the owner of the name. What acceptable explanation can there be of that? 45. Mr Davies said to me that it enabled him to look out for improprieties and to draw them to the attention of the authorities. I do not accept that as a genuine or bona fide reason at all. It also carries the unacceptable connotation that he intends to snoop on the emails, including confidential emails, which will in considerable numbers inevitably continue to be misdirected and received by GPM. Mr Davies seems almost to preen himself on what he is doing, and he tries to say that it is all Citigroup's fault that large numbers of emails are being addressed to citigroup.co.uk instead of to citigroup.com. The truth is that it is overwhelmingly his fault. No doubt senders of emails have made mistakes, and in some cases, though not most of them, the senders may have been Citigroup insiders who ought to have known better. But the scale of the Group's business in the United Kingdom was bound to generate a large volume of email traffic, and the .co.uk suffix is so common for United Kingdom addresses that Mr Davies must have foreseen what was going to happen as a result of his opportunist action on 6th April 1998. If he did not foresee it at that time he knows it now and his determination to hang on to the domain name speaks volumes as to the true nature of his registration of it.

46. As I have mentioned, Mr Davies denies that he is a cyber-squatter. I think he has in mind two reasons why not. One is that GPM carries on another business of an active nature which has nothing to do with cyber-squatting activities, and thus in that respect is different from the company in One in a Million. The other is that he has made no attempt to sell or

seek to make money out of the existence of the citigroup.co.uk name. Whether those circumstances prevent him being a cyber-squatter may depend on the somewhat arid question of how precisely one defines a cyber-squatter. To my mind, although the two factual points which Mr Davies makes are true, they cannot affect my approach to this case or the outcome of it. It is true that Mr Davies has made no attempt to profit from the domain by selling it to Citigroup for a high price, whereas One in a Million had made attempts of that nature. However, Aldous LJ's reasoning was that the acts of passing off were the registration and maintenance by One in a Million of the domain names, not the subsequent attempts to sell them. So the feature that Mr Davies is not actively trying to sell the name, but rather (as it seems to me must be the case) is biding his time, makes no difference.

Even in this case the Complainants have suggested that:

From the domain name records, it appears that the Domain Name was registered on 20 June 2006, It should be noted that the Due Diligence Report issued by the 2 Complainant for the acquisition of Union Bank was dated 19 June 2006. It is submitted that the only reasonable inference is that the registration of the Domain Name at this crucial time when Standard Chartered was seeking to expand its operations in Pakistan was due to an opportunistic motive to hijack the Domain Name for monetary gain.

This is similar to the case of citigroup.co.uk above where it was found that “That evidence is the timing of the application to Nominet for the domain name citigroup.co.uk. The application was made later in the very day on which the agreement to form Citigroup had been announced with high publicity.” and the same was taken as satisfying the Court that there was evidence of bad faith by the Registrant in that case.

Similarly, in this case the facts and circumstances constitute sufficient evidence even stronger than the citigroup.co.uk case to establish that the Respondent did in fact register and acquire the domain name in dispute “primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name;”

Hence, in the opinion of the Panel this criterion is made out against the Respondent.

- ii. For the reasons mentioned generally above and particularly criterion (i) under this heading it is clear that there is sufficient evidence that the Respondent has deliberately registered the domain name in dispute to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name and engaged in a pattern of such conduct as evidenced by the various domain names registered by the Respondent.

Hence, in the opinion of the Panel this criterion is made out against the Respondent.

- iii. From the discussion above generally and in particular criteria (i) and (ii) the natural and unmistakable consequence of the findings under those criteria necessitate a finding that the Respondent registered the domain name in dispute primarily for the purpose of disrupting the business of the Complainant. However, since the Complainants are not competitors this criterion would not apply in this case.

Hence, in the opinion of the Panel this criterion is not made out against the Respondent.

- iv. Issue ‘a’ under Legitimate Interest and the General discussion under Registration and use in bad faith, and as an example the case of *Rosemary Conley Diet and Fitness Clubs Limited v Nikolina Bartels-King Case No.D2006-1401* in addition to the facts and circumstances show that the Respondents admittedly intentionally chose to register the domain name under dispute *“to attract, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”*

The aspect of *“for commercial gain”* is made out since in criteria ‘a’ in particular the decision of the seminal case of *citigroup.co.uk* it was held that the actions similar to and even less serious than those undertaken by the Respondent would constitute sufficient cause on the balance of probabilities to satisfy the requirement and intention of the Respondent to register the domain name in dispute for commercial gain.

The criterion does require, however, that the Respondent be undertaking the above *“by using the domain name”*. Admittedly, in this case the Respondent is not actively using the domain name in dispute. Clearly, if the requirement of use of a domain name in connection with proving bad faith can be proven

despite passive holding of a domain name as dealt in detail in the General Discussion of this issue above, the same logic applies to the requirement of 'use' under this criteria.

As such the Panel finds that this criterion too is sufficiently made out against the Respondent.

As supporting precedent for the Panels finding of bad faith in a case of passive holding the case *Ladbroke Group Plc v. Sonoma International LDC* (Case No. D 2002-0131), lends much support, where it was stated that :

any attempt to actively use any of the said domain names would inevitably lead to a likelihood of confusion to the source, sponsorship, affiliation, or endorsement of the registrant's web site among users of the Internet who would inevitably be led to believe that such a www site would be owned by, controlled by, established by or in some way associated with the Complainant. In the circumstances outlined above this Administrative Panel is satisfied that the passive holding of the said domain names the subject of these Administrative Proceedings amounts to a use of said domain names in bad faith by the Respondent.

In the view of this Administrative Panel the Complainant has therefore made out a prima facie case sufficient to satisfy the third element in Paragraph 4 (a) of the Policy.

And it was held : With specific reference to Paragraphs 4(i) of the Policy and 15 of the Rules it is the decision of this Administrative Panel that the Complainant has established that said domain names <ladbrokespoker.com>, <ladbrokepoker.com>, <ladbrokepoker.org> and <ladbrokepoker.net> and each of them are confusingly similar to a service mark in which the Complainant has rights, that the Respondent has no rights or legitimate interest in said domain names and that the Respondent has registered and is using said domain names in bad faith.

This Administrative Panel therefore directs that said domain names <ladbrokespoker.com>, <ladbrokepoker.com>, <ladbrokepoker.org> and <ladbrokepoker.net> shall be transferred to the Complainant.

Very useful in this context as well as a general supporting precedent for the current case's findings by the Panel is the celebrated One In A Million

Judgement before the Supreme court of the Judicature In the Court of Appeal (Civil Division) On Appeal from the High Court of Justice Chancery Division, UK. A reproduction of the same is sufficient to show its similarity to the facts and circumstances of this case:

The name marksandspencer could not have been chosen for any other reason than that it was associated with the well-known retailing group. There is only one possible reason why anyone who was not part of the Marks & Spencer Plc group should wish to use such a domain address, and that is to pass himself off as part of that group or his products off as theirs. Where the value of a name consists solely in its resemblance to the name or trade mark of another enterprise, the court will normally assume that the public is likely to be deceived, for why else would the defendants choose it? In the present case, the assumption is plainly justified.

In my view there was clear evidence of systematic registration by the appellants of well-known trade names as blocking registrations and a threat to sell them to others. No doubt the primary purpose of registration was to block registration by the owner of the goodwill. There was, according to Mr Wilson nothing unlawful in doing that. The truth is different. The registration only blocks registration of the identical domain name and therefore does not act as a block to registration of a domain name that can be used by the owner of the goodwill in the name. The purpose of the so-called blocking registration was to extract money from the owners of the goodwill in the name chosen. Its ability to do so was in the main dependent upon the threat, expressed or implied, that the appellants would exploit the goodwill by either trading under the name or equipping another with the name so he could do so.

The judge rightly analysed the position in his judgement. He said:

"For a dealer in Internet domain names there are in principle only four uses to which the names can be put. The first and most obvious is that it may be sold to the enterprise whose name or trade mark has been used, which may be prepared to pay a high price to avoid the inconvenience of there being a domain name comprising its own name or trade mark which is not under its control. Secondly, it may be sold to a third party unconnected with the name, so that he may try to sell it to the company whose name is being used, or else use it for purposes of deception. Thirdly, it may be sold to someone with a distinct interest of his own in the name, for example a solicitor by the name of John Sainsbury or the Government of the British Virgin Islands, with a view to its use by

him. Fourthly, it may be retained by the dealer unused and unsold, in which case it serves only to block the use of that name as a registered domain name by others, including those whose name or trade mark it comprises."

In my view there was evidence that the appellants registered the domain names in issue in this case with all those forms of use in mind.

It is accepted that the name Marks & Spencer denotes Marks & Spencer Plc and nobody else. Thus anybody seeing or hearing the name realises that what is being referred to is the business of Marks & Spencer Plc. It follows that registration by the appellants of a domain name including the name Marks & Spencer makes a false representation that they are associated or connected with Marks & Spencer Plc. This can be demonstrated by considering the reaction of a person who taps into his computer the domain name marksandspencer.co.uk and presses a button to execute a "whois" search. He will be told that the registrant is One In A Million Limited. A substantial number of persons will conclude that One In A Million Limited must be connected or associated with Marks & Spencer Plc. That amounts to a false representation which constitutes passing-off.

Mr Wilson submitted that mere registration did not amount to passing-off. Further, Marks & Spencer Plc had not established any damage or likelihood of damage. I cannot accept those submissions. The placing on a register of a distinctive name such as marksandspencer makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill in the name. Such persons would not know of One In A Million Limited and would believe that they were connected or associated with the owner of the goodwill in the domain name they had registered. Further, registration of the domain name including the words Marks & Spencer is an erosion of the exclusive goodwill in the name which damages or is likely to damage Marks & Spencer Plc.

I also believe that domain names comprising the name Marks & Spencer are instruments of fraud. Any realistic use of them as domain names would result in passing-off and there was ample evidence to justify the injunctive relief granted by the judge to prevent them being used for a fraudulent purpose and to prevent them being transferred to others.

"The history of the defendants' activities shows a deliberate practice followed over a substantial period of time of registering domain names which are chosen to resemble the names and marks of other people and are plainly intended to deceive. The threat of passing-off and trade mark infringement, and the likelihood of confusion arising from the infringement of the mark are made out beyond argument in this case, even if it is possible to imagine other cases in which the issue would be more nicely balanced."

I also believe that the names registered by the appellants were instruments of fraud and that injunctive relief was appropriate upon this basis as well. The trade names were well-known "household names" denoting in ordinary usage the respective respondent. The appellants registered them without any distinguishing word because of the goodwill attaching to those names. It was the value of that goodwill, not the fact that they could perhaps be used in some way by a third party without deception, which caused them to register the names. The motive of the appellants was to use that goodwill and threaten to sell it to another who might use it for passing-off to obtain money from the respondents. The value of the names lay in the threat that they would be used in a fraudulent way. The registrations were made with the purpose of appropriating the respondents' property, their goodwill, and with an intention of threatening dishonest use by them or another. The registrations were instruments of fraud and injunctive relief was appropriate just as much as it was in those cases where persons registered company names for a similar purpose.

Another useful precedent which assists in the finding of the Panel on bad faith which is similar in its facts and circumstances is the case of Jupiters Limited v. Aaron Hall (Case No. D2000-0574) (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0574.html>)

In this case the Panel laid down the four grounds:

6.1 Complainant asserts that Respondent has registered and used the domain names in bad faith.

6.1.1 Paragraph 4(b) of the Rules sets out, without limitation, four circumstances which, if present, will be evidence of, but not proof of, registration and use of a domain name in bad faith.

6.1.2 The record does not establish that the Respondent's conduct falls within any of the first three of these categories. There is no

evidence indicating that Respondent registered either of the domain names with the intention of selling renting or otherwise transferring the domain names to Complainant. Respondent made no approach to Complainant for this purpose and the indication in Miss Nguyen's letter of December 22, 1998 that Respondent may be interested in assigning the domain name for an appropriate consideration falls short of establishing such intention.

6.1.3 Equally there is no evidence that Respondent registered the domain names in order to prevent Complainant from reflecting its mark in a corresponding domain name, let alone that he engaged in a pattern of such conduct.

6.1.4 There is also no evidence that Respondent registered the domain names primarily for the purpose of disrupting the business of Complainant.

6.1.5 The fourth circumstances enumerated in paragraph 4(b) is that by using the domain name Respondent has intentionally attempted to attract, for commercial gain, users to the web site by creating a likelihood of confusion. Unlike the proceeding three circumstances paragraph 4(b)(iv) seems to require active use of the domain name rather than encompassing mere passive use of the kind referred to in Case D2000-0003 – Telstra v. Nuclear Marshmallows cited by Complainant.

6.1.6 Thus, in the opinion of the Panel Respondent's conduct does not fall within any of the circumstances specifically enumerated in paragraph 4(b) of the Rules. But that is not the end of the matter. These circumstances do not constitute a code and there are many other circumstances which may evidence bad faith.

6.1.7 In the present case the fact that Complainant's name and trade mark is so well and widely known, coupled with the fact that Respondent's mailing address is in the same district as Complainant's business, makes it inevitable that Respondent registered the domain names in full knowledge of Complainant's rights and interests. Certainly there could be no doubt as to Respondent's knowledge at the time of registration of the second domain name. Respondent has offered no explanation as to why the domain names were chosen and no legitimate reason is apparent. The inference may be drawn therefore that in some way Respondent hoped to capitalise on the reputation of Complainant. That conclusion is reinforced by Respondent's subsequent trade mark application in the United States for Complainant's name and

trade mark in respect of services of the same description as those for which Complainant and its trade mark are well known.

6.1.8 The Panel therefore finds that each of the domain names was registered in bad faith.

6.1.9 There remains the question of whether the domain names are being used in bad faith. There is no active use of the domain names in the sense that they resolve to an active web site. Nevertheless the circumstances of the registration of the domain names and Respondent's US trade mark application are indicative of his intention to hold the trade mark and the domain names for some future active use in a way which would be competitive with or otherwise detrimental to Complainant.

6.1.10 There are several cases, of which Telstra supra is an example, where so called "passive holding" of a domain name has been held to constitute use within the meaning of paragraph 4(a)(iii) of the Policy. That such passive holding may fall within paragraph 4(a)(iii) finds support from the fact that the circumstances enumerated in sub-paragraphs (i), (ii) and (iii) of paragraph 4(b) do not appear to require active use. Indeed, most cases falling within sub-paragraph (i) would be cases in which no such active use takes place.

6.1.11 The Panel is therefore of the opinion that each of the domain names is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

And it was held :

The Panel therefore concludes and decides that:

(i) the domain names of Respondents are each confusingly similar to trade marks in which Complainant has rights;

(ii) Respondent has no rights or legitimate interest in respect of the domain names;

(iii) the domain names have been registered and are being used in bad faith;

(iv) the domain names should each be transferred to Complainant.

In another case of World Wrestling Federation Entertainment, Inc, v. Michael Bosman(Case No. D00-0001) <http://www.wipo.int/amc/en/domains/decisions/html/1999/d1999-0001.html> ,the Panel stated that:

*However, the name must not only be registered in bad faith, but it must also be **used** in bad faith. The issue to be determined is whether the respondent used the domain name in bad faith. It is not disputed that the respondent did not establish a Web site corresponding to the registered domain name. Accordingly, can it be said that the respondent "used" the domain name?*

It is clear from the legislative history that ICANN intended that the complainant must establish not only bad faith registration, but also bad faith use. "These comments point out that cybersquatters often register names in bulk, but do not use them, yet without use the streamlined dispute-resolution procedure is not available. While that argument appears to have merit on initial impression, it would involve a change in the policy adopted by the Board. The WIPO report, the DNSO recommendation, and the registrars-group recommendation all required both registration and use in bad faith before the streamlined procedure would be invoked. Staff recommends that this requirement not be changed without study and recommendation by the DNSO." Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy, submitted for Board meeting of October 24, 1999, para. 4.5,a.

*Paragraph 4,b,i of the Policy, provides that "the following circumstances . . . shall be evidence of the registration and **use** of a domain name in bad faith: . . . circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark . . . for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name." (Emphasis added.)*

Because respondent offered to sell the domain name to complainant "for valuable consideration in excess of" any out-of-pocket costs directly related to the domain name, respondent has "used" the domain name in bad faith as defined in the Policy

And it was held that For all of the foregoing reasons, the Panel decides that the domain name registered by respondent is identical or confusingly similar to the trademark and service mark in which the complainant has rights, and that the respondent has no rights or legitimate interests in respect of the domain name, and that the respondent's domain name has

been registered and is being used in bad faith. Accordingly, pursuant to Paragraph 4,i of the Policy, the Panel requires that the registration of the domain name <worldwrestlingfederation.com> be transferred to the complainant.

The Panel also thinks it is appropriate to reiterate for the sake of completeness the findings regarding bad faith in the famous and landmark decision of *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D2000-0003) February 18, 2000) <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0003.html> where the panelist noted that

"[t]he domain name ... does not resolve to a web site or other on-line presence. There is no evidence that a web site or other on-line presence is in the process of being established which will use the domain name. There is no evidence of advertising, promotion or display to the public of the domain name. Finally, there is no evidence that the Respondent has offered to sell, rent or otherwise transfer the domain name to the Complainant, a competitor of the Complainant, or any other person. In short, there is no positive action being undertaken by the Respondent in relation to the domain name."

The panelist noted that *"the relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith"* and concluded that *"it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith."*

The panelist concluded that *"it must be recalled that the circumstances identified in paragraph 4(b) are "without limitation" - that is, paragraph 4(b) expressly recognises that other circumstances can be evidence that a domain name was registered and is being used in bad faith."*

He went on to say that *"[t]he question that then arises is what circumstances of inaction (passive holding) other than those identified in paragraphs 4(b)(i), (ii) and (iii) can constitute a domain name being used in bad faith? This question cannot be answered in the abstract; the question can only be answered in respect of the particular facts of a specific case. That is to say, in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the Administrative Panel must give close attention to all the circumstances of the Respondent's behaviour. A remedy can be obtained under the Uniform Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith."*

It was further laid out that

7.3 It is less clear cut whether the Complainant has proved the third element in paragraph 4(a) of the Uniform Policy, namely that the domain name "has been registered and is being used in bad faith" by Respondent. The Administrative Panel notes two things about this provision. First, the provision contains the conjunction "and" rather than "or". Secondly, the provision refers to both the past tense ("has been registered") and the present tense ("is being used").

7.4 The significance of the use of the conjunction "and" is that paragraph 4(a)(iii) requires the Complainant to prove use in bad faith as well as registration in bad faith. That is to say, bad faith registration alone is an insufficient ground for obtaining a remedy under the Uniform Policy. This point is acknowledged in the Administrative Panel Decision in the WIPO Center Case No. D99-0001, the first case decided under the Uniform Policy. In paragraph 6 of that Decision, the Administrative Panel refers to the legislative history of the Uniform Policy, and in particular to the Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy submitted to the ICANN Board at its meeting on October 24, 1999. That Report, at paragraph 4.5, contains the following relevant statement and recommendation:

Several comments (submitted by INTA and various trademark owners) advocated various expansions to the scope of the definition of abusive registration. For example:

a. These comments suggested that the definition should be expanded to include cases of either registration or use in bad faith, rather than both registration and use in bad faith. These comments point out that cybersquatters often register names in bulk, but do not use them, yet without use the streamlined dispute-resolution procedure is not available. While that argument appears to have merit on initial impression, it would involve a change in the policy adopted by the Board. The WIPO report, the DNSO recommendation, and the registrars-group recommendation all required both registration and use in bad faith before the streamlined procedure would be invoked. Staff recommends that this requirement not be changed without study and recommendation by the DNSO.

7.5 From the fact that the ICANN Board accepted the approach recommended in the Second Staff Report, and thus adopted the Uniform Policy in the form originally proposed, it is clear that ICANN intended that bad faith registration alone not give rise to a remedy under the Uniform Policy. For a remedy to be available, the Complainant must

prove both that the domain was registered in bad faith and that it is being used in bad faith.

7.6 This interpretation is confirmed, and clarified, by the use of both the past and present tenses in paragraph 4 (a)(iii) of the Uniform Policy. The use of both tenses draws attention to the fact that, in determining whether there is bad faith on the part of the Respondent, consideration must be given to the circumstances applying both at the time of registration and thereafter. So understood, it can be seen that the requirement in paragraph 4(a)(iii) that the domain name "has been registered and is being used in bad faith" will be satisfied only if the Complainant proves that the registration was undertaken in bad faith and that the circumstances of the case are such that Respondent is continuing to act in bad faith.

7.7 Has the Complainant proved that the domain name "has been registered in bad faith" by the Respondent? In light of the facts established in paragraphs 4.6 to 4.8, the Administrative Panel finds that the Respondent does not conduct any legitimate commercial or non-commercial business activity in Australia. In light of the facts established in paragraphs 4.6 to 4.8, the Administrative Panel further finds that the Respondent has taken deliberate steps to ensure that its true identity cannot be determined and communication with it cannot be made. Given the Complainant's numerous trademark registrations for, and its wide reputation in, the word <TELSTRA>, as evidenced by the facts established in paragraphs 4.2 to 4.5, it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the domain name <telstra.org>. It is also not possible to conceive of a plausible situation in which the Respondent would have been unaware of this fact at the time of registration. These findings, together with the finding in paragraph 7.2 that the Respondent has no rights or interests in the domain name, lead the Administrative Panel to conclude that the domain name <telstra.org> has been registered by the Respondent in bad faith.

7.8 Has the Complainant proved the additional requirement that the domain name "is being used in bad faith" by the Respondent? The domain name <telstra.org> does not resolve to a web site or other on-line presence. There is no evidence that a web site or other on-line presence is in the process of being established which will use the domain name. There is no evidence of advertising, promotion or display to the public of the domain name. Finally, there is no evidence that the Respondent has offered to sell, rent or otherwise transfer the domain name to the Complainant, a competitor of the Complainant, or any other person. In

short, there is no positive action being undertaken by the Respondent in relation to the domain name.

7.9 This fact does not, however, resolve the question. As discussed in paragraph 7.6, the relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. The distinction between undertaking a positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that the concept of a domain name "being used in bad faith" is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith.

7.10 This understanding of paragraph 4(a)(iii) is supported by the actual provisions of the Uniform Policy. Paragraph 4(b) of the Uniform Policy identifies, without limitation, circumstances that "shall be evidence of the registration and use of a domain name in bad faith", for the purposes of paragraph 4(a)(iii). Only one of these circumstances (paragraph 4(b)(iv)), by necessity, involves a positive action post-registration undertaken in relation to the domain name (using the name to attract custom to a web site or other on-line location). The other three circumstances contemplate either a positive action or inaction in relation to the domain name. That is to say, the circumstances identified in paragraphs 4(b)(i), (ii) and (iii) can be found in a situation involving a passive holding of the domain name registration. Of course, these three paragraphs require additional facts (an intention to sell, rent or transfer the registration, for paragraph 4(b)(i); a pattern of conduct preventing a trade mark owner's use of the registration, for paragraph 4(b)(ii); the primary purpose of disrupting the business of a competitor, for paragraph 4(b)(iii)). Nevertheless, the point is that paragraph 4(b) recognises that inaction (eg. passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith. Furthermore, it must be recalled that the circumstances identified in paragraph 4(b) are "without limitation" - that is, paragraph 4(b) expressly recognises that other circumstances can be evidence that a domain name was registered and is being used in bad faith.

7.11 The question that then arises is what circumstances of inaction (passive holding) other than those identified in paragraphs 4(b)(i), (ii) and (iii) can constitute a domain name being used in bad faith? This question cannot be answered in the abstract; the question can only be answered in respect of the particular facts of a specific case. That is to say, in considering whether the passive holding of a domain name, following a

bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the Administrative Panel must give close attention to all the circumstances of the Respondent's behaviour. A remedy can be obtained under the Uniform Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith.

7.12 The Administrative Panel has considered whether, in the circumstances of this particular Complaint, the passive holding of the domain name by the Respondent amounts to the Respondent acting in bad faith. It concludes that it does. The particular circumstances of this case which lead to this conclusion are:

(i) the Complainant's trademark has a strong reputation and is widely known, as evidenced by its substantial use in Australia and in other countries,

(ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name,

(iii) the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name,

(iv) the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement, and

(v) taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

In light of these particular circumstances, the Administrative Panel concludes that the Respondent's passive holding of the domain name in this particular case satisfies the requirement of paragraph 4(a)(iii) that the domain name "is being used in bad faith" by Respondent.

And it was held that

The Administrative Panel decides that the Complainant has proven each of the three elements in paragraph 4(a) of the Uniform Policy. Accordingly, the Administrative Panel requires that the domain name <telstra.org> be transferred to the Complainant.

As such the Panel finds that on multiple counts the Respondent has been found to have registered the domain name in dispute under bad faith therefore satisfying also the third requirement under the UDRP.

Decisions/Precedents cited by the Respondent

In addition to the discussion by the Panel above in relation the precedents relied upon by the Respondents the Panel finds that none of them are applicable to the case at hand and are distinguishable for the following reasons:

The case of Slep-Tone Entertainment Corporation d/h/a Sound Choice Accompaniment Tracks v Sound Choice Case No. 93631 (“Slep-Tone Case”) may be distinguished on the different factual matrix:

- i. There was evidence that the complainant and the respondent operated with in the same industry;
- ii. There was honest, concurrent, competing use of the “Sound Choice” name or mark. The respondent had been successfully providing services using the “Sound Choice” name for many years;
- iii. The respondent was commonly known by the domain name in question and had gained credibility in the industry; and
- iv. There is no evidence that the respondent registered the domain name in order to prevent the complainant (who was the owner of the trade mark or service mark) from using the corresponding domain name.

In the present case:

The Respondent claims that the “research” topic is not related to the Complainants, any banks or the banking industry. This claim has not been substantiated nor any facts tendered nor the same has been proved by the Respondent;

The Respondent has not furnished any evidence of prior use of the “Standard Chartered” name. In fact, there has been no activity on the website since 20 June 2006;

There is no linkage between the Respondent and the Domain Name. The Respondent has not provided any evidence to prove that he is commonly known by the Domain Name; and

As it is the Respondent’s own admission that he had prior knowledge of the Standard Chartered Domain Names as well as the 2nd Complainant. Further, given that the “STANDARD CHARTERED” mark is well- known in Pakistan, the Respondent must have had prior knowledge of the Registered Trade Marks and Trade Mark Applications.

In fact, the Respondent's admission that the "STANDARD CHARTERED" mark is well-known may be inferred from the statement that "*all [of the case authorities cited] involved a renowned trademark*" and the Respondent's reliance on the Slep-Tone Case in support of his case.

In view of the above, the Slep-Tone Case does not support the Respondent's case and should therefore be disregarded.

In respect of Calstore. corn v Infodrive Case No. 94206 ("Calstore Case"), this case is not applicable for the following reasons:

In the Calstore Case, the parties had no prior knowledge of each other as the complainant was based in California whereas the respondent was based in Calcutta. However, both parties had applied for the domain name at the almost identical moment. In the present case, both the 2nd Complainant and the Respondent are based in Pakistan. Further, the Respondent has admitted to having prior knowledge of the Standard Chartered Domain Names as well the 2nd Complainant. Given that the "STANDARD CHARTERED" mark is well-known in Pakistan, the Respondent must have had prior knowledge of the Registered Trade Marks and Trade Mark Applications; and

Unlike the present case, the complainant did not claim that the respondent was attempting to misleadingly divert consumers or to tarnish its service mark. In the present case, it is the Complainants' claim that the Respondent is diluting the Registered Trade Marks and the Trade Mark Applications. In the Calstore Case, the complainant also failed to prove that the respondent had acted in bad faith in registering the domain name.

In Car Toys, Inc v Informa Unlimited, Inc. Case No. 93682 ("Car Toys Case"), the arbitrator found that:

- The respondent had a legitimate interest in the domain name as the "Car Toys" trade mark was not fanciful or arbitrary, and the complainant had failed to submit evidence to establish the fame or strong secondary meaning in the trade mark. There was evidence that the "Car Toys" mark was in use elsewhere. In addition, the respondent had provided evidence that it was in the business of selling descriptive domain names; and
- The complainant had failed to show that the respondent had acted in bad faith,

In the present case, the Complainants have established that the 2nd Complainant is a well-known bank in Pakistan and that the 1st Complainant's "STANDARD CHARTERED"

mark is well-known in Pakistan. Furthermore, the Complainants have established that the domain name was registered and is being used in bad faith. In view of the above the Car Toys Case cannot be taken into consideration. As such the cases cited by the Respondent stand distinguished and do not assist the Respondent from escaping the inevitable conclusions resulting from the discussions above.

Conclusion

For the foregoing reasons, the Panel therefore concludes and decides that

1. The Respondent's registration of the domain name in dispute is in violation of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1
2. The Respondents have no legitimate interest in the Complainants' Domain name
3. The domain names are confusingly similar/identical.
4. The Respondents are making mala fide use of the Complainants' Domain name.

Pursuant to Paragraphs 4 of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1, and Paragraph (i) of the UDRP the Panel therefore recommend to the PKNIC that PKNIC to transfer the registration of the domain name at issue <standardchartered.pk> to the 2nd Complainant, 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/, whichever is earlier. The Complainants shall also be at liberty to contact PKNIC for implementation of this decision.

Zahid Jamil, Barrister-at-law

Sole Panelist

Dated: 30th August 2007