

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Rediff.com India Ltd. v. Daniyal Waseem

Case No. C2009-0005

Also in PDF C2009-0005

1. The Parties

The Complainant is **Rediff.com India Ltd.**, having its principle place of business at Mahalaxmi Engineering Estate, L.J. Road # 1, Mahim (West), Mumbai 400 016, India, Tel No: +91-22-24449144, Fax No: +91-22-24455346, Email: jyotid@rediff.co.in

The Respondent is Daniyal Waseem, located at 34 Oxford Street, London, United Kingdom

2. The Domain Name and Registrar

The domain name in dispute <rediff.com.pk> is registered by the individual Daniyal Waseem.

3. Procedural History

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.

The Complaint was filed with the Domain Name Dispute Resolution Center (the “DNDRC”) on February 21, 2009.

In accordance with the PKNIC - Internet Domain Registration Policy and the Rules of ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP], paragraphs 2(a) and 4(a), DNDRC formally notified the Respondent of the Complaint via email dated Monday, 13th June, 2009 and the Respondent was asked to provide DNDRC with the Response in the format provided. The Respondent was informed that if a Response was not received within 7 days from the notification, the dispute would proceed *ex parte*.

The Respondent failed to submit the Response. Under section 5(e) of the UDRP, the Panel has the authority, in the absence of a proper response, to commence with the proceedings in default and to determine the matter ex parte based upon the Complaint. The proceedings commenced on 21st June, 2009.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), the Center appointed Mr. Mustafa Syed as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, to ensure compliance with the Rules, paragraph 7.

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

4. Factual Background

The Complainant's principal place of business in Mumbai, India.

The name REDIFF and REDIFF.com was adopted in 1996 by the Complainant and the same is an arbitrary mark having all the trappings of an invented word. On account of its highly distinctive nature and the pioneering activities in the field of E-Commerce, the name REDIFF and REDIFF.com has acquired an excellent reputation from the very beginning and down the years, the said name has consistently been associated with, and has denoted the business and services of the Complainant, as also the high quality of the services rendered under the trademark REDIFF.

The Complainant is one of the premier worldwide providers of news, information, communication, entertainment and shopping services through its website/ domain REDIFF.com. Its genesis was in 1996 and over the years it has become a household name, synonymous with excellence in almost every field of E-service and E-commerce.

The Complainant is the owner of numerous REDIFF trademarks that are registered in its name in India:

- i. Trade Mark registration number 822870 since 13th October, 1998;
- ii. Trade Mark registration number 1358320 since 19th March, 2005;
- iii. Trade Mark registration number 1358321 since 19th March, 2005;
- iv. Trade Mark registration number 970605 since 15th November 2000;
- v. Trade Mark registration number 970606 since 15th November 2000;
- vi. Trade Mark registration number 1358316 since 19th May, 2005;

The Complainant is the owner of numerous REDIFF trademarks that are registered in its name in United States of America:

- i. Trade Mark registration number 3,101,026 since 06th June, 2006;
- ii. Trade Mark registration number 2,511,409 since 17th November, 2001;
- iii. Trade Mark registration number 2,779,891 since 04th November, 2003;

Prior to initiating the Complaint, the Complainant made substantial efforts to identify and contact the Respondent, using the details current on PKNIC's registry. The Complainant's representative issued a cease and desist letter to the Respondents dated 31st December, 2008 in order to alert the Respondents of the possible infringement of the Complainant's registered trademarks taking place by the registration of the domain name in dispute <rediff.com.pk> by the Respondent and to request a transfer of the domain name in dispute in order to stave off further action on the part of the Complainant. However the same has not been responded to, or complied with, by the Respondent.

The Respondents have failed to provide DNDRC with a Response to the Complaint initiated against them.

5. Parties' Contentions

A. Complainant

- Background on the Complainant

Since its inception, the Complainant has been using the trademark REDIFF.com for its various online services and E-commerce activities. The services provided have been extensively promoted by the Complainant. Today, Rediff.com has a major presence on the Internet whilst providing services ranging from email services, news, online shopping, chat, messenger, online sharing of audio/videos and astrology to stock market updates. Most of these services use REDIFF as the initial part of their trade names, like REDIFF MAIL, REDIFF BOL, REDIFF NEWS, REDIFF MATCHMAKER, REDIFF SHOPPING, REDIFFISHARE, REDIFF CONNEXIONS, REDIFF P4C CLASSIFIEDS, REDIFF Q&A, REDIFF ASTROLOGY etc.

Thus the mark REDIFF has become synonymous with the goods and services of the Complainant and substantial goodwill on account of continuous, expansive and prior use of the mark REDIFF and REDIFF.com accrue to the Complainant.

For its millions of Users all over the world, the word "REDIFF" is a distinguishable mark – a mark on which they have implicit faith and trust, whether they are using email services (Rediffmail, Rediffmail Pro), shopping (Rediffshopping), chatting (RediffBol), blogging (Rediffiland) and/or sharing online videos (Rediffishare), matchmaking (Rediff Matchmaker), etc.

A key focus for Complainant has been to use world-class technology to drive community building. Through a single login facility, REDIFF.COM provides a combination of free and paid community features and products to individuals and businesses. These include e-mail, news, instant messaging, chat, matchmaker, astrology services, blogs, message boards, social networking and mobile services, online shopping and auctions, etc.

The company REDIFF has a current market capitalization of \$64.60 million. This is ahead by leaps and bounds of other well-known and famous Indian E-service/ E-commerce web sites. For

financial year 2007-08, Rediff.com, reported Revenues for the fiscal year ended March 31, 2008 of US\$32.25 million.

The Complainant's business has generated revenues for the quarter ended March 31, 2008 totaling to US\$9.06 million, an increase of 7% over revenues from the quarter ended March 31, 2007.

On June 14, 2000, the Complainant became one of the first Indian Companies to have commenced trading on Nasdaq. The Complainant's ADSs are traded on The Nasdaq Global Market under the symbol REDF. The company's stock moved up to \$25.41 per ADs on July 13, 2007. The trading volume has increased to more than a million shares from an average of 50,000 ADs a day.

In short, people across the globe associate the name REDIFF and REDIFF.com exclusively with the Complainant and the multifarious electronic services, services and activities of the Complainant, which contain the prefix REDIFF.

The explosive popularity and consumer recognition of the REDIFF name and site have made REDIFF one of the most famous online marks in the world. Given the exclusively online nature of the Complainant's social networking business, the Complainant's domain names consisting of the term REDIFF are not only the heart of its entire business, but also the only way for its millions of users to avail themselves of its services.

The fame of the REDIFF trademark is, ironically, also evidenced by the number of cybersquatters that have tried to unfairly exploit the enormous consumer recognition and goodwill attached to the mark and social networking site.

It is also submitted that the Complainant has in the past successfully restrained other parties from using the trademark REDIFF and other deceptively similar marks in relation to different and similar services by filing suits for interim injunction seeking reliefs, inter alia, for permanent injunction restraining infringement of trademark. The Complainant has in the past successfully restrained other parties from using the trademark REDIFF and other deceptively similar marks in relation to different and similar services by filing complaints with WIPO.

Domain dispute panelists in earlier cases have recognized the strength and renown of the REDIFF mark, and have ordered infringing respondents to transfer infringing domain names to REDIFF: ***Rediff.com India Ltd. v. Abadaba S.A., Domain Admin***, WIPO Case No. D2008-0803 (27th August, 2008) (<rediffbol.com>); ***Rediff.com India Ltd. v. Laksh Internet Solutions Private Limited.***, WIPO Case No. D2008-0804 (29th July, 2008) (<rediff.com>); ***Rediff.com India Ltd. V. REDIFFMOBILE.COM/ c/o "Whois Identity Shield"***, WIPO Case No. D2008-0806 (30th July, 2008) (<rediffmobile.com>).

The Complainant has also successfully won a case against Cyberbooth and another in AIR 2000 Bombay 27, whereby the Complainant was held entitled to interlocutory injunction restraining the Defendant from using the domain name "rediff".

The Complainant has secured its ownership of the REDIFF mark through extensive national and international trademark registrations worldwide (See section 4 above).

- Background on Respondent and the Domain Name

The Domain Name is currently registered in the name of Daniyal Waseem.

As of 31st July, 2009, Respondent's web site located at www.rediff.com.pk has been active and been causing sufficient losses to the Complainant.

The Complainant addressed an email dated 31st December, 2008 to the Respondent appraising them about their rights in the trademark REDIFF and asked them to immediately stop using the disputed domain name <rediff.com.pk>. The Respondent was also asked to remove all such links which were directing towards the complainant's website from their website. The Respondent vide email dated 31st December 2008 replied to the above email and stated that they are not violating any right of the Complainant and said that they have a disclaimer on their website which clarifies that they are not associated with the Complainant's website. Later on the Respondent removed the links directing towards the Complainant's website and further changed the color of their logo from red to green.

However, the Respondent refused to give up the disputed domain name <rediff.com.pk>. The Respondent in his email further stated that his choice of the domain name <rediff.com.pk> was inspired by the Complainant's mark REDIFF. This clearly demonstrates the dishonest intentions of the respondent to trade off on the reputation and goodwill of the Complainant by registering <rediff.com.pk>. The respondents later on also removed the contact details of the Complainant as mentioned on their website <rediff.com.pk> still they continued the use of the Complainant's trademark/tradename as their domain name.

- Legal Analysis

The Complainant asserts that the Respondent's registration and use of the Domain Name satisfies each of the elements set out in section 4(a) of the Policy, as established below:

(1) The Domain Name is identical or confusingly similar to the Complainant's trademark

The addition of the suffix .PK to domain(s) is immaterial in considering the confusing similarity between the Complainant's Rediff trademark and the Domain Name (See *Standard Chartered PLC v. Hosting Campus Domain*, DNDRC Case No. C2007-0001 (August 30, 2007), "Similarly, it is established that the suffix ".pk" must be disregarded as simply being a necessary component of a ccTLD[.]")

The Complainant asserts that the disputed domain name <rediff.com.pk> includes the word REDIFF, which is identical to the Complainant well-known, famous and registered trademark REDIFF in which the Complainant has statutory rights as well as overwhelming common law rights, by virtue of a long and continuous user and being its registered proprietor thereof.

Further the disputed domain name <rediff.com.pk> attempts to associate itself to the Complainant's online service under the trade name/ domain name REDIFF.com by incorporating the name of the service in full. The malicious intention of the Respondent is evident from the blatant misappropriation of the Complainant's trade mark/service mark REDIFF and REDIFF.com by the Respondent. In the present instance if any user searching for the Complainant's service online as REDIFF and REDIFF.com will be taken to the Respondents domain name, which enhances the possibility of inevitable confusion. Moreover the Respondent had given Complainant's contact details on his website thereby maliciously attempted to associate himself with the Complainant. The Respondent had given the contact details of the Complainant as "head office" and his own details as "Pakistan office" on his website, thereby maliciously represented himself as a part of the Complainant's Company. The Respondent's website <rediff.com.pk> also had some links directing towards the Complainant's website <rediff.com> which clearly demonstrates that the respondent is trying to associate himself with the Complainant's trademark/tradename.

Furthermore the use of the word REDIFF in the domain name would be understood as a reference to the Complainant because it is a registered and well-known trademark. Incorporating of a trademark in entirety in a domain name is sufficient in establishing confusing similarity as stated by numerous UDRP decision such as **Magnum Piering Inc v. The Mudjackers and Garwood, eAuto, LLC v. triple S Auto Parts**.

An Internaut or the unwary general public who do not know that the Complainant and the Respondent have no affiliation with each other or that the Complainant has not licensed or authorized or endorsed the use of its famous and well known mark REDIFF or REDIFF.com will thus confuse the Respondents activities as those authorized or endorsed or affiliated with the Complainant which would lead to the dilution of the Complainant well-known and famous trademarks.

Hence the domain name is identical to the trademark in which the Complainant has rights.

By registering the Domain Name which reproduces the Complainant's exact trademark and conveys the same overall visual and phonetic impression as the Complainant's mark, the Respondent has undoubtedly created confusing similarity with the Complainant's trademark. See, e.g., *Dr. Ing. h.c. F.Porsche AG v. Vasily Terkin*, WIPO Case No. D2003-0888 (January 6, 2004) ("In numerous cases, it has been held that a domain name that wholly incorporates a Complainant's registered mark may be sufficient to establish confusing similarity for purposes of the UDRP."). Respondent thus intends to mislead consumers to believe that the Domain Names and/or their operator are affiliated with or endorsed by Rediff. See, e.g., *Microsoft Corporation v. Microsof.com aka Tarek Ahmed*, WIPO Case No. D2000-0548 (July 21, 2000). Respondent also intends to prohibit Rediff from reflecting its mark in a corresponding domain. See *eBay Inc. v. SGR Enterprises and Joyce Ayers*, WIPO Case No. D2001-0259 (April 11, 2001). Given the enormous popularity of Rediff's services and the fame of the REDIFF mark it is apparent that

Registrant's intention in registering the Domain Name was to misappropriate for itself - and deny to Complainant - the benefit of the reputation that Complainant has established.

The Domain Name is therefore identical or confusingly similar to the Complainant's Rediff trademark.

(2) The Respondent has no rights or legitimate interests in the Domain Name

The Complainant asserts that the Respondent has no rights or legitimate interests in the Domain Name.

The Respondent is not commonly known by the Rediff name, and has not secured or even sought to secure any trademark rights in the Rediff name. See *Harrice Simons Miller v. H Rheyne*, WIPO Case No. D2004-0504 (September 3, 2004) (transferring domain name where there was no evidence in the record that the Respondent was "*commonly known*" by the disputed domain name).

The Respondent has not made any legitimate non commercial or fair use of the Domain Name. The same is being used to offer services similar to that of the Complainant. In addition to this, the Respondent has also put up advertisements on the disputed domain name and is earning revenue through these. The evidence shows that Respondent's website has sponsored links that offers goods and/or services for sale that compete with Complainant's goods and/or services. "The unauthorized use of Complainant's trademark to generate pay-per-click revenue or to sell competitive products constitutes bad faith under paragraphs 4(b)(iii) and (iv) of the Policy." *Hoffmann-La Roche Inc. v. Kevin Chang*, WIPO Case No. D2008-1344 (October 27, 2008); see also *Wal-Mart Stores, Inc. v. Modern Limited - Cayman Web Development, Domain Administrator*, WIPO Case No. D2005-0322 (May 24, 2005).

The Respondent is not an authorized dealer, distributor, or licensee of the Complainant, nor has it been otherwise allowed by the Complainant to make any use of its trademarks. Yet the Domain Name registered by the Respondent reproduces the exact Rediff famous trademark. See, for instance, *Philip Morris Incorporated v. Alex Tsytkin*, WIPO Case No. D2002-0946 (February 13, 2003) ("*Complainant has not authorized Respondent to use its distinctive and famous MARLBORO mark nor the 'red roof' logo. These circumstances are sufficient to constitute a prima facie showing by Complainant of absence of rights or legitimate interest in the disputed domain name on the part of Respondent.*").

Since the disputed domain name comprises of a well-known and famous trademark REDIFF as well as the Complainants service name REDIFF.com, it is evident that the Respondent can have no right or legitimate interest in the domain name. Further it is apparent that the sole purpose of registering the domain name is to misappropriate the reputation associated with the Complainant's famous trademark REDIFF.

The Respondent is not commonly known by the domain name <rediff.com.pk> or REDIFF. Further neither has the Complainant authorized nor licensed the Respondent to register or use the disputed domain name incorporating its trademarks or authorized or licensed the Respondent to register or use the disputed domain name or any trademark forming part of it.

Further, the Respondent's choice of the Complainant's well-known trademark REDIFF as its domain name is totally unnecessary and the sole purpose of carrying on business through the use of the disputed domain name incorporating the Complainant's well-known and famous trademarks is to cause confusion as to the source, sponsorship, affiliation, or endorsement of the activity being carried on through the website.

The Respondent's website is not *bona fide* since the Respondent is trading on the fame and recognition of the Complainant's well-known trademark in order to cause initial interest confusion and bait internet users to accessing its website and force the Complainant to buy the Respondent out in order to avoid said confusion as is typically the strategy of such cybersquatters.

The above facts are sufficient to establish, *prima facie*, that the Respondent has no legitimate interest or rights in the Domain Name.

(3) The Domain Name was registered and is being used in bad faith

Paragraph 4(b) of the Policy lists six factors which, without limitation, may be evidence of the registration or use of a domain name in bad faith for the purposes of paragraph 4(a)(iii) of the Policy.

The Respondent registered the Domain Name on June 24, 2007, by which time the Complainant had already acquired tremendous goodwill and reputation as well as protected rights in the term REDIFF and the services offered by it.

The Complainant asserts that the Respondent registered the Domain Name as it became aware of the fact that the Complainant's online business was one of the fastest growing and most successful in the world. It is therefore not conceivable that the Respondent did not have the Complainant's trademark in mind when registering the Domain Name. "*Actual or constructive knowledge of the Complainant's rights [] is a factor supporting bad faith.*" See, for instance, *eBay Inc. v. Sunho Hong*, WIPO Case No. D2000-1633 (January 18, 2001). This is further supported by, for instance, *Telenor v. Mohammad Tahir*, DNDRC Case No. C2008-0001 (February 5, 2008) "*The Domain Name is composed of the term "telenor", which is identical to the Complainant's Telenor trademarks. The Panel considers that the Telenor trademarks have a reputation and are well known throughout the world. In accordance with ACCOR v. Tigertail Partners, WIPO Case No. D2002-0625, the Panelist finds it is reasonable to conclude that only someone who was familiar with the Telenor trademark could have registered the Domain Name.*"

Given Rediff's global recognition, it is clear that the Respondent registered the Domain Name in bad faith, with full knowledge that reproducing the Complainant's exact Rediff trademark in entirety in the Domain Name would be likely to cause an Internet user visiting the web site to which <rediff.com.pk> is pointing to assume that the Domain Name is somehow sponsored by or affiliated with Rediff. See, e.g., *eBay Inc. v. ebayMoving / Izik Apo*, WIPO Case No. D2006-1307 (January 31, 2007); *Guinness UDV North America, Inc. v. Dallas Internet Services*, WIPO Case No. D2001-1055 (December 12, 2001) ("*Registration of a domain name containing a famous mark is strong evidence of bad faith.*"). The Respondent thus attempted to capitalize on the valuable REDIFF brand by misleading consumers. See, for instance, *Microsoft Corporation v. Microsof.com aka Tarek Ahmed*, WIPO Case No. D2000-0548 (July 21, 2000).

The domain name <rediff.com.pk> was created by the Respondent on 27th May 2008. It is pertinent to note that the Complainant offers its online service via the domain name www.rediff.com. The factum of the argument is that the Respondent acquired the same name, in which the Complainant has a substantial interest, as it being its registered trademark and/or service mark. The Respondent was aware of the commercial value and significance of the domain name “REDIFF.com” and that’s why Respondent grabbed the domain name <rediff.com.pk>. It is nothing but an opportunistic bad faith registration on the part of the Respondent. The Respondent thus is trying to seek illegal commercial gratification. The Complainant states that in the light of aforesaid submissions, the bad faith registration and bad faith use of the domain name <rediff.com.pk> on the part of the Respondent is thus proved.

The Complainant submits that the Respondent, no doubt, was aware prior to its registration of the domain name that there was substantial reputation and goodwill associated with the Complainant’s trademark and/or service mark, which inures and continues to inure to the Complainant. This is evident from the fact that the Respondent in its email dated 31st December 2008 to the Complainant stated that his adoption of the domain <rediff.com.pk> was inspired by the Complainant’s trademark/trade name REDIFF.

To reiterate the pleadings of the earlier paragraph the disputed domain name <rediff.com.pk> incorporates the Complainants well-known and famous marks REDIFF it is, but evident that the Respondent can have no rights or legitimate interest in the domain name and rather the sole purpose of the adoption of the Complainants trademark in entirety by the Respondent is to misappropriate the Complainant well-known and famous trademark REDIFF.

The Respondent has registered the impugned domain name <rediff.com.pk> in order to disrupt the business of the Complainant. It is apparent that the Respondent has attempted to attract for commercial gain Internet users to the website to which the impugned domain name resolves to by creating a likelihood of confusion with the Complainants well-known and famous trademark REDIFF.

Further, there is a great likelihood that actual or potential unwary visitors to the Respondent’s present web page or any future web page that is resolved to this disputed domain names, will be induced to:

- Believe that the Complainant has licensed their trademark REDIFF and/or the service mark trade name, to the Respondent or authorized the Respondent to register the disputed domain name.
- Believe that the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with the REDIFF Group or has been authorized by the Complainant to carry out these activities.
- Believe that the website to which the impugned domain name resolves to is affiliated to the Complainant or that it is the Indian arm of the Complainants Service, REDIFF.com

It is therefore submitted that the disputed domain name has been registered and is being used in bad faith.

Being undoubtedly aware of the Complainant's development, the Registrant anticipated that the Complainant would be interested in registering under the .PK ccTLD and thus registered the Domain Name to prevent the Complainant from reflecting its globally famous trademarks in a corresponding .PK domain name. This is supported, for instance, by *Telenor v. Mohammad Tahir*, DNDRC Case No. C2008-0001 (February 5, 2008): "*The Domain Name uses the Complainant's trade name in its entirety. The Complainant is a very widely and well established [] service provider, and is commonly known by its trade name 'Telenor' all over the world. The Respondent has registered [] 'telenor.pk', and hence prevented the Complainant from getting it registered and using it for their own purposes, or provision of services.*"

Furthermore, as decided in, *Microsoft Corporation v. Whois Privacy Protection Service / Lee Xongwei*, WIPO Case No. D2005-0642 (October 12, 2005) "*while a proxy service can have a legitimate purpose[], the Panel considers that its use in this case is suggestive of bad faith when taken with the other factors [].*" See also *Advance Magazine Publishers Inc. d/b/a Condé Nast Publications v. MSA, Inc. and Moniker Privacy Services*, WIPO Case No. D2007-1743 (Feb. 22, 2008) (*[A] motive for using a domain privacy service in this instance was to increase the difficulty for a trademark owner of identifying the registrant, assessing the merits of a legal claim or Policy complaint, and contacting the registrant, which does not reflect good faith.*) See also *The Saul Zaentz Company d/b/a Tolkein Enterprises v. Eurobox Ltd.* / "*The Saul Zaentz Company*" WIPO Case No. D2008-0156 (May 20, 2008): "*The use of a proxy service would more usually [] be indicative that the respondent is seeking to hide its activity from scrutiny in proceedings under the Policy. The natural inference from this is a negative one [].*"

The Complainant therefore asserts that the Domain Name was registered and is being used in bad faith

In accordance with Paragraph 4(b)(i) of the Policy, for the reasons described above, the Complainant requests that the Administrative Panel appointed in this administrative proceeding transfer the Domain Name to the Complainant.

B. Respondent

The Respondent failed to provide a Response to the Complainant's contentions even though they were notified of the same along with an opportunity to respond was provided to them by DNDRC. Thus the Panel shall proceed with the decision ex parte by deciding the dispute based upon the Complainant initiated by the Complainant in line with section 5(e) of the UDRP Rules. However, it is pertinent to note that the Respondent, vide email dated 13th June, 2009 emailed DNDRC, putting forth certain remarks in connection with the Complainant's contentions against them. The Panel is not obliged to consider this as a response by the Respondent, as it was not submitted in accordance with the UDRP and the Rules, the same is being taken into account for the sake of clarity and fairness. The Panel has analyzed the contents of the Respondent's email and the same are mentioned in this Decision.

6. Jurisdiction

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

The Respondent applied for, was granted registration of the disputed domain name on the basis of and has submitted to 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.

7. Discussion and Findings

The application for the registration of the domain name in dispute <rediff.com.pk> on behalf of the Complainant is regulated by both, the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 as well as the UDRP Rules.

The Respondent applied for registration of the disputed domain name <rediff.com.pk> on the basis of these regulations and was allowed registration subject to the same.

The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 paragraph 6 states that:

*“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.**”*

Additionally the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 paragraph 4 states that:

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.

ICANN's Uniform Domain Name Dispute Resolution Policy (UDRP) lays down three basic requirements under paragraph 4(a) on the basis of which a domain name Complaint shall 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.*

Therefore the Panel shall determine the Complainant subject to the following issues:

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

I. Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration of the domain name

In terms of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2, a domain name is registered , and hence is deemed valid, subject to inter alia paragraph 1 & 4and is held invalid if it:

- 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 Aug 7, 2007 ver 4.2 paragraph 4 also states that:

If a party claims that a domain name already registered with PKNIC violates their registered trade name, 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.

Therefore, for the assessment of illegality, unlawfulness or otherwise invalidity of the Application & Registration of the domain name in dispute, the application and registration of the domain name in dispute “<rediff.com.pk>” shall be assessed under the following aspects:

- i. Whether the Domain Name in dispute “<rediff.com.pk>” infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Domain Name in dispute “<rediff.com.pk>” is bona fide?
- iii. Whether the application and/or registration of the Domain Name in dispute “<rediff.com.pk>” contravene 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 “<rediff.com.pk>” infringes upon, or is an obvious derivation of, a registered trade name / trade mark?**

The registered trademarks of the Complainant have been set out with section 4 of this decision. Furthermore it is apparent that the Complainant has utilized all reasonable methods to internationally protect its registered trademarks. The domain name in dispute is <rediff.com.pk>. The relevant part of this domain name is <rediff>. The Panel indubitably finds that this part of the domain name is identical to the numerous trademark registrations of the word <REDIFF> held by the Complainant. In addition, the Panel finds that the whole of the domain name in dispute is confusingly similar to the above mentioned trademark registrations.

Furthermore it is established law to disregard the ccTLD when considering the matter of confusing similarity or obvious derivation, as the addition of the suffix “.pk” does not create any distinctive distinction that may eliminate the possibility of confusion by the Complainant’s customers (see *Nokia Corporation v. Firdaus Adinegoro/Beli Hosting*, [WIPO Case No. D 2004-0814](#)). Therefore the Panel determines the domain name in dispute <rediff.com.pk> to be an obvious derivation of the Complainant’s registered trademark and correspondingly in obvious infringement of the same.

As per paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2, if a Complainant simply establishes this one criterion of infringement upon a registered trade mark/name, the registration would be deemed illegal and unlawful and for all purposes invalid, furthermore due to the lack of Response from the Respondents, the Panel is required to decide the matter based upon the Complaint. Therefore subject to the above stated conclusion, the Panel may well determine the domain name in dispute to be transferred to the Complainant, however for the purpose of completeness (but not to create any binding precedent requiring the same to be followed in the future), the Panel will also assess and determine the remaining issues as listed above.

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

It has been established by the Complainant, and has not been refuted by the Respondent, that the Complainant is the registered owner of the trade mark/name Rediff. The Complainant has registered numerous trademarks and domain names world wide in order to reflect and protect the same. The facts prove that the REDIFF name is internationally renowned and highly recognizable. Since in light of the same the Respondent could not help but be aware of the name Rediff being the registered trade mark of the Complainant, the Respondent’s registration of the domain name in dispute <rediff.com.pk>, with the salient feature of the domain name i.e. “rediff” being identical to the registered trademark of the Complainant, does not appear to be bona fide. The Respondent’s motives are not entirely clear however a lack of bona fide on the Respondent’s part may be construed on the basis of the facts before this Panel i.e. the Respondent has registered a world-famous trademark and has not pleaded any tenuous possible legitimacy, such as agency, for its intended use.

The Panel concludes that the Respondent must therefore have known of the Complainant’s name, trademark and business, and that it is not reasonably credible that the Respondent’s purpose would be of a bona fide nature, as appropriation of a well known trademark of which a Respondent must have been aware, for the purposes of a domain name without authorization, is commonly a sufficient basis for a finding lack of bona fide (*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, [WIPO Case No. D2000-0163](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, [WIPO Case No. D2000-0226](#); *Société des Hôtels Méridien v. LaPorte Holdings, Inc.*, [WIPO Case No. D2004-0849](#); *Société pour l’Oeuvre et la Mémoire d’Antoine de Saint Exupéry – Succession Saint Exupéry – D’Agay v. Perlegos Properties*, [WIPO Case No. D2005-1085](#)).

The failure of the Respondent to reply to the Complainant's cease and desist letter of 31st December, 2008 is found to be compounding evidence of lack of bona fide as well (*Ebay Inc. v. Ebay4sex.com and Tony Caranci*, WIPO Case No. D2000 1632).

Taking into account all of the above, it would not be probable to conceive any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate and constitute an bona fide on the part of the Respondent. Thus the Panel finds the second criteria of paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 to be established as well thus the registration of the domain name in dispute is held to be deemed illegal and unlawful and for all purposes invalid.

iii. Whether the application and/or registration of the Domain Name in dispute “<rediff.com.pk>” contravene the Pakistan Penal Code or any applicable criminal law?

Although Pakistani law does not apply by force of law over PKNIC's jurisdiction, conformity with it is a contractual term of the agreement executed between the Respondent and PKNIC, therefore any illegality pertaining to the Application and Registration of the domain name in dispute would render the registration of the domain name in dispute to be void.

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

The relevant laws pertaining to registration of the domain name in dispute includes the Trade Marks Ordinance, 2001 section 4 and 40, The Electronic Transactions Ordinance, 2002 section 3, subject to which infringements of Trade Marks and Trade Names is equated with the infringement of domain names hence the Pakistan Penal Code section 478(1), that deal with infringement of Trade Marks, would possibly also cover domain names.

Additionally under the Pakistan Penal Code, 1860 sections 464, 470, 471, 473, 476, 479, 480, 481, 482, 483 and 485 the continuing registration of the domain name in dispute “<rediff.com.pk>” by a person other than the owner/rightful holder/authorized user of the registered trade marks/names could be construed to be an offence on multiple accounts, and by operation, would not only give the impression to the Respondent 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) was allowing aiding, abetting, encouraging and conspiring with the Respondent and would also be liable to criminal offences under the above mentioned legislations.

Lastly by operation of the Electronic Transactions Ordinance 2002 section 3 and the Prevention of Electronic Crimes Ordinance 2008 section 15 it can be construed that in any event where a Respondent has established or is using a website or a domain for any purpose, in which he does not hold legitimate interests, is entitled to be charged with the offence of spoofing under s.15 of the PECO 2008. The punishment under this legislation is not simply limited to fines and could also amount to imprisonment.

The above mentioned factors would increase the likelihood of giving rise to liability under the above mentioned legislations, which in turn would raise significant doubt regarding the legitimacy and bona fide of the Respondent's registration of the domain name in dispute.

In the opinion of the Panel this criteria has been sufficiently proven by the Complainants and no evidence to the contrary has been tendered by the Respondent. However this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

II. Identical or confusing similarity with a trademark or service in which the Complainant has rights

The Complainant's trademark Rediff is a unique word, not holding any literary meaning, however the use of the word is arbitrarily is used in a manner that distinguishes the services provided by the Complainant and thus makes the term Rediff inherently distinctive. Such trademarks, that comprise of generic terms (other examples are "apple" for computers and "camel" for cigarettes) are in fact considered to be very strong marks. The Complainant's registration of the mark Rediff shows that it has exclusive rights in the Rediff mark in numerous countries demonstrated the carrying out of all reasonable methods possible to protect its registered trademark.

As is evident, the domain name in dispute <rediff.com.pk.> comprises of the entirety of the Complainant's registered trademark as the addition of the generic ccTLD indicator ".pk" cannot be taken into consideration when judging confusing similarity. It is well-established that the incorporation of a Complainant's mark in full within a disputed domain name, may be sufficient to establish confusing similarity between the mark and the disputed domain name (see *Nokia Group v. Mr. Giannattasio Mario*, [WIPO Case No. D2002-0782](#), *The Ritz Hotel Ltd v. Damir Krzicevic*, [WIPO Case No. D2005-1137](#), and *Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge*, [WIPO Case No. D2006-1643](#).)

Confusing similarity is evident in the real world, but also, when considering the particular circumstances of use on the Internet. People in Pakistan, who are searching for the Complainant's Rediff website, may expect to find it under its principal identifier "Red If" combined with the ccTLD indicator, such as ".pk". They may therefore type the sequence <rediff.com.pk> and will be directed to the website of the Respondent. Thereby being misled by the confusing similarity between the domain name in dispute and the Complainant's registered trademark.

The Complainant has produced adequate evidence of its rights in the trademark Rediff as is accepted by several Panel decisions as well (see above). gTLD suffix ".com" or its equivalent is an integral part of a domain name and is not considered relevant to the consideration of confusing similarity. The remainder of the domain name, whilst contiguous, is easily read as the words "red", "iff", therefore the generic words

“red” and “iff” in combination are readily discerned as Rediff, being the strong, distinctive and globally renowned trademark of the Complainant. (see *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1059 9th Cir. 1999; "*The intentional registration of a domain name knowing that the second level domain is another company's valuable trademark weighs in favor of likelihood of confusion.*").

The domain name in dispute reasonably creates likelihood that individuals will be confused into thinking that the domain name or the related site is owned, endorsed, licensed, sponsored, or maintained by the Complainant to promote their services therefore the Complainant has established the confusing similarity of the disputed domain names with its own legitimate registered trademarks.

Thus The Panel finds confusing similarity between the disputed domain name and the Complainant's trademark under paragraph 4(a)(i) of the Policy.

III. Legitimate interest or rights in the Domain Name

The onus is on the Complainant to satisfy the Panel that the Respondent does not have rights or legitimate interests in the disputed domain name <rediff.com.pk>. The Complainant has alleged that it has not authorized the Respondent to use its registered trademark in any manner or form, and that as far as may be ascertained the Respondent is not commonly known by the disputed domain name and has not made any legitimate use of the domain name in dispute as the website is inactive.

It is for the Respondent to refute the Complainant's *prima facie* case as provided for in paragraph 4(c) of the Policy. The Respondent has not replied to the allegations made against its registration of the domain name in dispute; therefore the Panel may decide the matter *ex parte* based upon the Complaint and the relevant facts contained therein.

Given the fame of the Rediff mark and the popularity of the services provided by the Complainant, it is inconceivable that the Respondent was unaware of the Complainant's rights and interests prior to the registration of the domain names in dispute. It can, therefore, reasonably be concluded, on the basis of the facts and proof provided by the Complainant that the Respondent did not create a fabricated name, which happened to consist of the trademark Rediff of the Complainant, in light of the recent popularity of the Rediff network within the Respondent's home country, India, and the country that hosts the domain name in dispute <rediff.com.pk>, Pakistan. The Respondent has tendered no proof to claim registration to any trademark related to the Rediff name (see *Harrice Simons Miller v. H Rheyne*, WIPO Case No. D2004-0504)

The Complainant has not consented to the Respondent's use of the domain name in dispute <rediff.com.pk>, which incorporates its trademark REDIFF entirely. Mere registration of the domain name in dispute by the Respondent does not create any right or legitimate interest in the domain name in dispute (see *Red Bull GmbH v. Mario Maranda*, WIPO Case No. D2008-0941). Furthermore as the Respondent is not an authorized dealer, distributor, or licensee of the Complainant, nor has it been

otherwise allowed by the Complainant to make any use of its trademarks, the use of the Complainant's registered trademark may then "*constitute a prima facie showing by Complainant of absence of rights or legitimate interest in the disputed domain name on the part of Respondent.*" (*Philip Morris Incorporated v. Alex Tsypkin*, WIPO Case No. D2002-0946).

Furthermore, none of the circumstances listed under 4(c) of the Policy, possibly demonstrating rights or legitimate interests, are given. The Respondent has not provided evidence of circumstances of the type specified in paragraph 4(c) of the Uniform Policy, or of any other circumstances giving rise to a right to or legitimate interest in the domain name in dispute due to the fact that:

- i. the Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to apply for or use any domain name incorporating any of those marks, and;
- ii. the word Rediff appears to be an invented word, and as such is not one entities would legitimately choose unless seeking to create an impression of an association with the Complainant.

There is no evidence that Respondent was making a *bona fide* use of the disputed domain name before receiving notice from Complainant or that Respondent has been commonly known by "rediff.com.pk". Rather, the submissions attached to the Complaint indicate that Respondent is using the disputed domain name in connection with "sponsored links" to products that compete with Complainant's products and services. "The use of a domain name (that is identical or confusingly similar to a trademark) as a parking page that generates click through revenue typically does not give rise to rights or legitimate interests." *MAACO Enterprises, Inc. v. IP Admin / DNAV ASSOCS*, WIPO Case No. D2008-0009 (March 4, 2008). Further, the sale of competitive products using a complainant's trademark typically is not considered *bona fide* or "legitimate" or "fair" for purposes of paragraph 4(a)(ii). *LTD Commodities, LLC v. Nadeem Qadir*, NAF Claim No. FA0601000636445 (March 10, 2006) ("the Panel is entitled to and does presume that Respondent receives click-through fees in exchange for diverting Internet users to such websites. Respondent's use of the disputed domain name in this fashion is not in connection with a *bona fide* offering of goods or services pursuant to Policy 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy 4(c)(iii)."); *Humana Inc. v. Henry Tsung*, WIPO Case No. D2005-0221 (May 9, 2005) ("Use for a portal linking to websites of the Complainant's competitors is not a *bona fide* offering, but rather one which seeks to profit from confusion with the Complainant"); *Interstate National Dealer Services, Inc. v. Selwyn Colley*, WIPO Case No. D2003-0934 (April 5, 2004) ("When Respondent is engaged in the commercial sale of competitive products, Respondent cannot take advantage of the rights or legitimate interests defenses of paragraph 4(c)(i) or (iii) of the Policy by relying on uses that are infringing, because such uses are not considered 'bona fide' or 'legitimate' or 'fair use.'").

Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that paragraph 4(a)(ii) of the Policy is satisfied.

Therefore the Panel concludes that the Respondent has not discharged its burden of proof with respect to proving its legitimate rights or interests in the domain name in dispute.

IV. Registration and use of the domain name in bad faith

Paragraph 15(a) of the Rules instructs the Panel to “*decide a complaint on the basis of the statements and documents submitted in accordance with the policy, these rules and any rules and principles of law that it deems applicable*”.

The fact that the Respondent has deliberately disregarded the opportunity to submit a Response is particularly relevant to the issue of whether the Respondent has registered and is using the domain name in bad faith. Paragraph 14(b) of the Rules provides that, in the absence of exceptional circumstances, a Panel shall draw such inferences as it considers appropriate from the failure of a party to comply with a provision or requirement of the Rules. This Panel could not find any exceptional circumstances for Respondent’s failure to submit a response; therefore the Panel draws the following inferences:

- i. Respondent does not deny the facts which the Complainant asserts, and;
- ii. Respondent does not deny the conclusions which the Complainant asserts can be drawn from these facts.

Nevertheless, the Panel still assumes the responsibility of determining which of the Complainant’s assertions are established as facts, and whether the conclusions asserted by the Complainant can be drawn from the established facts (see, *Inter-IKEA Systems B.V. v. Hoon Huh*, WIPO Case No. D2000-0438).

The third element in paragraph 4(a) of the Policy requires the determination of the fact that the domain name in dispute “*has been registered and is being used in bad faith*” by the Respondent. The Panel highlights two essential facts. 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”).

This draws attention to the fact that that paragraph 4(a)(iii) requires the Complainant to prove use in bad faith as well as registration in bad faith.

Paragraph 4(a)(iii) of the Policy utilizes both, past and present, tenses thereby inferring that upon determining bad faith on the part of the Respondent, the Panel should consider the circumstances at the time of registration as well as the subsequent behavior of the Respondent following the registration, with regards to the domain name in dispute.

The Panel cannot conceive of a plausible situation in which the Respondent would have been unaware of the popularity and success of the Complainant's services at the time of registration (*Rediff.com India Ltd. v. Abadaba S.A., Domain Admin*, [WIPO Case No. D2008-0803](#) (27th August, 2008) (<rediffbol.com>); *Rediff.com India Ltd. v. Laksh Internet Solutions Private Limited.*, [WIPO Case No. D2008-0804](#) (29th July, 2008) (<rediff.com>); *Rediff.com India Ltd. V. REDIFFMOBILE.COM/ c/o "Whois Identity Shield"*, [WIPO Case No. D2008-0806](#) (30th July, 2008) (<rediffmobile.com>). Subject to these findings as well as the conclusions reached by the Panel in the above section, relating to the legitimate right and interest of the Respondent, the Panel concludes that the domain name in dispute <rediff.com.pk> has been registered by the Respondent in bad faith.

The second prong of the requirement for bad faith requires the Complainant to show that the domain name in dispute "is being used in bad faith" by the Respondent. The domain name <rediff.com.pk> is linked to an active website comprising of advertising, promotion/display to the public on the domain name in dispute.

Complainant also asserts that Respondent's sponsored links satisfy bad faith factors (iii) and/or (iv). The evidence shows that Respondent's website has sponsored links that offers goods and/or services for sale that compete with Complainant's goods and/or services. "The unauthorized use of Complainant's trademark to generate pay-per-click revenue or to sell competitive products constitutes bad faith under paragraphs 4(b)(iii) and (iv) of the Policy." *Hoffmann-La Roche Inc. v. Kevin Chang*, WIPO Case No. D2008-1344 (October 27, 2008); see also *Wal-Mart Stores, Inc. v. Modern Limited - Cayman Web Development, Domain Administrator*, WIPO Case No. D2005-0322 (May 24, 2005).

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith, and that paragraph 4(a)(iii) of the Policy is satisfied.

Lastly, the Complainant informed the Respondent of the infringement of their registered trademarks taking place by their registration of such a domain name via the cease and desist letter sent to the Respondent, however the Respondent failed to acknowledge or respond to the letter thereby laying further credence to the existence of bad faith on the part of the Respondent.

In light of these circumstances, the Panel concludes that the Respondent's registration 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.

Therefore, by registration of the domain name in dispute, the Respondent appears to have intentionally attempted to create a likelihood of confusion with the Complainant's registered mark.

Improper response of the Respondent: DNDRC, vide email dated 13th June, 2009 notified the Respondent of the Complaint against them and provided them with a copy of the Complaint, inviting them to submit their response. However, the Respondent failed to do so. He did, however, vide email dated 13th June, 2009 inform DNDRC that their legal counsels would be corresponding with DNDRC. No such correspondence took place, nor did the Respondent submit a response to the Complaint. This is further indication of lack of bona fide on their part.

The Respondent has not submitted the response in accordance with the UDRP. However, for the sake of clarity and completeness, the Panel will endeavor to discuss the same, even though it does not constitute a proper and appropriate response in compliance with the Rules and without prejudice to the determination and observations already made by the Panel.

The Respondent, vide his email dated 13th June, 2009 asserts several things, which the Panel has sought to clarify individually.

The Respondent asserts that:

Rediff.com.pk is a separate entity with entirely different logo and has no link to Rediff India which we have clearly mentioned in our disclaimer.

When it was being registered, it is highly unlikely that the respondent was well aware of the existence of the legitimate interest and trade mark of Rediff India/USA. In particular, the specific spelling of the “ff” in the end of the trade name and the conjunction of Red and Iff are clear indications that the registration by the respondent is highly unlikely to be co incidental and as such it can be presumed that the registration by the respondent was not bona fide and the respondent has voluntarily chosen not to provide any evidence to the contrary and hence it is reasonable to assume that it is highly unlikely that such registration was bona fide.

In any case, all the arguments above cannot stand in the face of WIPO domain name decisions in favor of Rediff in (*Rediff.com India Ltd. v. Abadaba S.A., Domain Admin, WIPO Case No. D2008-0803* (27th August, 2008) (<rediffbol.com>); *Rediff.com India Ltd. v. Laksh Internet Solutions Private Limited., WIPO Case No. D2008-0804* (29th July, 2008) (<rediff.com>); *Rediff.com India Ltd. V. REDIFFMOBILE.COM/ c/o “Whois Identity Shield”, WIPO Case No. D2008-0806* (30th July, 2008) (<rediffmobile.com>) which are squarely applicable here

Domain is completely within registration parameters of ICANN. and there is no such rule which limitize one not to register a domain name already present as a TLD.

This contention has no relevance since ICANN rules do not apply to ccTLDs and it is the ruled procedures and framework of each individual ccTLD which determines the registration of each ccTLD. As can be seen above, the registration has to be in compliance with the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.

In any case, all the arguments above cannot stand in the face of WIPO domain name decisions in favor of Rediff in (*Rediff.com India Ltd. v. Abadaba S.A., Domain Admin, WIPO Case No. D2008-0803* (27th August, 2008) (<rediffbol.com>); *Rediff.com India Ltd. v. Laksh Internet Solutions Private Limited., WIPO Case No. D2008-0804* (29th July, 2008) (<rediff.com>); *Rediff.com India Ltd. V. REDIFFMOBILE.COM/ c/o “Whois Identity Shield”, WIPO Case No. D2008-0806* (30th July, 2008) (<rediffmobile.com>) which are squarely applicable here

Moreover the complainant said that the trade marks of Rediff.com are registered with the authorities of Bombay India, whereas ours Website belongs to Pakistan so hopefully the law firm they hired would understand that Pakistan is not under the jurisdiction Maharashtra High courts. And there are number of examples already existing in this regard, like: yello.pk and yello.com, songs.pk and songs.com and even the registrant of our domain i.e nexus.pk and nexus.com moreover the registration authority of .pk pknict.net.pk and pknict.com. All the above mentioned pairs have different registrants and ownerships.

The contention is inaccurate since rule 4 of the UDRP and the terms of PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2 prescribe limitations on registrations which do extend to registration of domain names which may be confusingly similar/identical or in which another party may have a legitimate interest. [The respondent has failed to submit any evidence to substantiate any legitimate interest attached to the infringed trademark/tradename of Rediff].

In any case, all the arguments above cannot stand in the face of WIPO domain name decisions in favor of Rediff in (*Rediff.com India Ltd. v. Abadaba S.A., Domain Admin*, [WIPO Case No. D2008-0803](#) (27th August, 2008) (<rediffbol.com>); *Rediff.com India Ltd. v. Laksh Internet Solutions Private Limited.*, [WIPO Case No. D2008-0804](#) (29th July, 2008) (<rediff.com>); *Rediff.com India Ltd. V. REDIFFMOBILE.COM/ c/o “Whois Identity Shield”*, [WIPO Case No. D2008-0806](#) (30th July, 2008) (<rediffmobile.com>) which are squarely applicable here

It is not a requirement under the either the rules of ICANN nor under the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2, that in order to protect one’s trademark and domain names, the same has to be registered within Pakistan. That the registration of trademark and jurisdiction of Pakistan is not the only requirement to justify a claim with respect to a domain name by incorporating the UDRP it is quite clear that what needs to be shown in order to claim the rights to a domain name are:

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.”*

As can be seen from above, the requirement of a trade mark is not limited to one particular jurisdiction. This is not only rational, but also necessary since the internet and domain name system is not restricted within the boundaries of any legal jurisdiction and is instead a global name addressing system. For instance the ccTLD .tv, .me and others, though they are ccTLDs do not require registration within the legal jurisdictions in order to hold a domain name. The same is true for the .pk ccTLD. In addition the

existence of difference registrations in separate TLDs but with the same domain name does not constitute justification for infringement in a case where a party which has a legitimate interest in a trademark/domain name chooses to challenge such registration. Obviously if such a registration is not challenged, the registrant who may have registered a domain name which is identical to the domain name of a trademark holder in a domain name will continue to hold such registration until and unless the legitimate interest holder or trademark holder elects to assert his rights.

In any case, all the arguments above cannot stand in the face of WIPO domain name decisions in favor of Rediff in (*Rediff.com India Ltd. v. Abadaba S.A., Domain Admin*, [WIPO Case No. D2008-0803](#) (27th August, 2008) (<rediffbol.com>); *Rediff.com India Ltd. v. Laksh Internet Solutions Private Limited.*, [WIPO Case No. D2008-0804](#) (29th July, 2008) (<rediff.com>); *Rediff.com India Ltd. V. REDIFFMOBILE.COM/ c/o “Whois Identity Shield”*, [WIPO Case No. D2008-0806](#) (30th July, 2008) (<rediffmobile.com>) which are squarely applicable here

There is no evidence that Respondent was or is making a *bona fide* use of the disputed domain name before receiving notice from Complainant or that Respondent has been authorised by the Complainant to use the tradename “Rediff”. Rather, the submissions attached to the Complaint indicate that Respondent is using the disputed domain name in connection with “sponsored links” to products that compete with Complainant’s products. “The use of a domain name (that is identical or confusingly similar to a trademark) as a parking page that generates click through revenue typically does not give rise to rights or legitimate interests.” *MAACO Enterprises, Inc. v. IP Admin / DNAV ASSOCS*, WIPO Case No. D2008-0009 (March 4, 2008). Further, the sale of competitive products using a complainant’s trademark typically is not considered *bona fide* or “legitimate” or “fair” for purposes of paragraph 4(a)(ii). *LTD Commodities, LLC v. Nadeem Qadir*, NAF Claim No. FA0601000636445 (March 10, 2006) (“the Panel is entitled to and does presume that Respondent receives click-through fees in exchange for diverting Internet users to such websites. Respondent’s use of the disputed domain name in this fashion is not in connection with a *bona fide* offering of goods or services pursuant to Policy 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy 4(c)(iii).”); *Humana Inc. v. Henry Tsung*, WIPO Case No. D2005-0221 (May 9, 2005) (“Use for a portal linking to websites of the Complainant’s competitors is not a *bona fide* offering, but rather one which seeks to profit from confusion with the Complainant”); *Interstate National Dealer Services, Inc. v. Selwyn Colley*, WIPO Case No. D2003-0934 (April 5, 2004) (“When Respondent is engaged in the commercial sale of competitive products, Respondent cannot take advantage of the rights or legitimate interests defenses of paragraph 4(c)(i) or (iii) of the Policy by relying on uses that are infringing, because such uses are not considered ‘*bona fide*’ or ‘legitimate’ or ‘fair use.’”).

Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that paragraph 4(a)(ii) of the Policy is satisfied.

Both under past UDRP decisions (see for instance *Nike, Inc. v. B.B. de Boer*, [WIPO Case No. D2000-1397](#); and *Carolina Herrera, Ltd. v. Alberto Rincon Garcia*, [WIPO Case No. D2002-0806](#)) and under the Policy, a well-established principle is that when someone registers a domain

name, it represents and warrants to the registrar that, to its knowledge, the registration of the domain name will not infringe the rights of any third party. In the case at issue, the Panel reasonably finds that since the Complainant's marks are widely known, it is unlikely that the Respondent, at the time of registration of the disputed domain name or thereafter, was not aware that it was infringing the Complainant's marks.

Under the appropriate circumstances, bad faith can also be inferred based on the fame of the Complainant's marks, such that the Respondent was aware or should have been aware of the Complainant's mark and claims of rights thereto (particularly in view of the Complainant's use of its mark on the Internet). The Panel in light of the present circumstances finds it highly doubtful that the Respondent would have registered the disputed domain name without having knowledge of the Complainant.

The Respondent is using the disputed domain name to link to other sites with the same business activity as the Complainant. The fact that various commercial websites are linked to the Respondent's website is a clear indication of bad faith use (see *DORMEUIL FRERES and DORMEUIL UK v. Keyword Marketing, Inc.*, [WIPO Case No. D2007-1424](#)).

According to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in the disputed domain name. In connection with the burden of proof, several decisions of UDRP panels have held that "[o]nce a Complainant establishes *prima facie* showing that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondents to rebut the showing" (see among others, *Universal City Studios, Inc. v. David Burns and Adam-12 Dot Com*, [WIPO Case No. D2001-0784](#); see also *International Hospitality Management - IHM S.p.A. v. Enrico Callegari Ecostudio*, [WIPO Case No. D2002-0683](#)).

The Complainant has asserted that the Respondent has no relationship with or authorization from the Complainant to use its mark; the Panel notes that there is nothing in the record to suggest that the Respondent has been commonly known by the disputed domain name; the Panel further notes that the Respondent has not, and has never been, commonly known by the domain name. The Panel's view is that these facts may be taken as proven in the circumstances of this case provided that they have not been denied by the Respondent in a proper and appropriate response submitted to the DNDRC. In any case, all the arguments above cannot stand in the face of WIPO domain name decisions in favor of Rediff in (*Rediff.com India Ltd. v. Abadaba S.A., Domain Admin*, [WIPO Case No. D2008-0803](#) (27th August, 2008) (<rediffbol.com>); *Rediff.com India Ltd. v. Laksh Internet Solutions Private Limited.*, [WIPO Case No. D2008-0804](#) (29th July, 2008) (<rediff.com>); *Rediff.com India Ltd. V. REDIFFMOBILE.COM/ c/o "Whois Identity Shield"*, [WIPO Case No. D2008-0806](#) (30th July, 2008) (<rediffmobile.com>) which are squarely applicable here

8. Decision

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

- i. The Respondent's registration of the disputed domain name <rediff.com.pk> is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
- ii. The Respondents have no legitimate interest in the disputed domain name.
- iii. The disputed domain name is identical to the Complainant's trade marks/names and registered domain names.
- iv. The Respondent is making mala fide use of the Complainant's trade marks/names.
- v. Pursuant to Paragraphs 4 of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2, and Paragraph (i) of the UDRP the Panel therefore recommends to PKNIC to transfer the registration of the domain name at issue <rediff.com.pk> to the Complainant, as prayed for within 48 hours of receipt of this decision by email or it being uploaded onto the DNDRC website www.dndrc.com/cases_resolved/, whichever takes place earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Mr. Mustafa Syed

Sole Panelist

Date: 01st August, 2009