

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

TechnoBird v. Muhammad Aslam

Case No. C2011-0002

Also in PDF C2011-0002

1. The Parties

The Complainant is TechnoBird, located at 7-C, 2nd Floor, Afsar Plaza, Haider Road, Saddar, Rawalpindi, Pakistan

The Respondent is Muhammad Aslam.

2. The Domain Name and Registrar

The disputed domain names <mustakbil.pk> and <mustakbil.com.pk> hereinafter collectively known as the Disputed Domain Names, are registered with PKNIC by an individual named Mr. Muhammad Aslam, located at Karachi. The Disputed Domain Names have been registered by the Respondent since 04th April, 2010 valid upto 04th April, 2012.

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 24th May, 2010.

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 28th March, 2011 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 04th April, 2011.

The Center has delayed decision on this matter due to procedural non-compliance, as allowed under section 10(2) of the Supplemental Rules of DNDRC. Upon fulfillment of such procedure, 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 Arbitrator has sworn 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 is TechnoBird, and has authorized Mr. Naveed Ahmed as its authorized representative in this matter. The Contentions as put forth by the Complainant are mentioned below herein.

The Respondent is an individual named Muhammad Aslam. The PKNIC Whois data of the Respondent shows his location to be Flat number 3, Moosa Jee Street, Ramswami, Karachi.

5. Parties' Contentions

A. Complainant

The Complainant has put forth following assertions in this matter:

TechnoBird is the certified applicant of the mark MUSTAKBIL with Trademark office of Pakistan under Trade Marks Ordinance, 2001 of Pakistan Under section 22(1), Section 84(2); Rule 12. We are using the mark Mustakbil since 2005 for selling jobs/online recruitment solutions in Pakistan. We have a website configured on the domain MUSTAKBIL.COM which is Pakistan's leading jobs site. It is a well known brand in Pakistan and has recently received Emerging Brand of The Year Award 2009. We have registered several domains that are similar to MUSTAKBIL to protect the potential misuse of our name. We were the registrant of the domains MUSTAKBIL.PK AND MUSTAKBIL.COM.PK since 2006 but due to some reason we were not able to renew these domains this year and these domains were released by PKNIC and were registered by Mr. Muhammad Aslam on April 04, 2010. As soon as we came to know about these registrations (April 20, 2010), we contacted PKNIC about the issue. We also sent a message to Mr. Muhammad Aslam through PKNIC and asked him to rescind the ownership of these domains for some nominal "profit" without the cost and hassle of a legal dispute etc, but we didn't receive any response from his side. If you look at the history of these domains you will see that these domains were registered by TechnoBird since 2006 the traffic from these domains was also redirected to our primary domain which is MUSTAKBIL.COM. Whereas if you look at the currently configured websites on the domains MUSTAKBIL.PK and MUSTAKBIL.COM.PK you will realize that these domains have been registered by Mr. Muhammad Aslam just to take benefit of our name. So it is evident that these domains have been registered with bad intentions. We therefore request you to please cancel these registrations and transfer the ownership of these domains to TechnoBird.

TechnoBird is using the mark MUSTAKBIL to sell online recruitment solutions in Pakistan since 2005 and has a well know website configured on the domain MUSTAKBIL.COM. The registration of the domains MUSTAKBIL.PK and MUSTAKBIL.COM.PK by the current registrant Mr. Muhammad Aslam will therefore create confusion among the users of the website MUSTAKBIL.COM. TechnoBird is the certified applicant of the mark MUSTAKBIL with Trademark office of Pakistan. (See the certificates at the end of this document)

TechnoBird was the registrant of the domains MUSTAKBIL.PK AND MUSTAKBIL.COM.PK since 2006 (Screenshot of the confirmation email from PKNIC is attached at the end of this document, more details can be obtained from PKNIC) From the currently configured websites on the domains MUSTAKBIL.PK and MUSTAKBIL.COM.PK it is evident that these domains have been registered just to take benefit of the popularity of the mark MUSTAKBIL. (Screenshot attached at the end of this document)

If you look at the history of the domains MUSTAKBIL.PK AND MUSTAKBIL.COM.PK using independent services such as WayBackMachine (accessible through the url <http://www.archive.org/>) you can see that these domains were pointing to our primary website which is MUSTAKBIL.COM. (Screenshot attached at the end of this document)

A screenshot of the whois details using the service DomainTools also shows that these domains were pointing to MUSTAKBIL.COM (screenshot attached at the end of this document).

In light of the above mentioned contentions, the Complainant prays the following:

We came to know that Mr. Muhammad Aslam has recently (April 04, 2010) registered the domains Mustakbil.pk and Mustakbil.com.pk. TechnoBird is the certified applicant of the mark MUSTAKBIL with Trademark office of Pakistan under Trade Marks Ordinance, 2001 of Pakistan Under section 22(1), Section 84(2); Rule 12. We are using the mark Mustakbil since 2005 for selling jobs/online recruitment solutions in Pakistan. Hence Mr. Muhammad Aslam's registration and use of the above mentioned domains without our prior written permission is the violation of our intellectual property rights. Therefore we want him to rescind the ownership of these domains to us (TechnoBird).

Cancel the current registration of the domains MUSTAKBIL.PK and MUSTAKBIL.COM.PK and transfer these domains to TechnoBird.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

The application for the registration of the Disputed Domain Names 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 Names 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).

Illegality, unlawfulness or otherwise invalidity of the Application & Registration

In terms of the PKNIC - Internet Domain Registration Policy Aug 7, 2007, ver 4.2, 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.*

Under the head of Illegality, unlawfulness or otherwise invalidity of the Application & Registration, in order to assess whether the application and registration of the Disputed Domain Names is ab inito illegal, the following shall have to be taken into consideration:

- i. Whether the Disputed Domain Names infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Disputed Domain Names is bona fide?
- iii. Whether the application and/or registration of the Disputed Domain Names contravene the Pakistan Penal Code or any applicable criminal law?

In the seminal case of *Standard Chartered PLC v. Hosting Campus Domain Case No. C2007-0001*, the DNDRC used for the first time the conditions for deciding the issue of Illegality, unlawfulness or otherwise invalidity of the Application & Registration as laid out in the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 and made use of the same in rendering the landmark decision related to the disputed domain name <standardchartered.pk>, whereby it was held that:

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)*

The Panel therefore, concludes that the registration of the domain name “<[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 “<[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.

The Panel, taking into account the discussions and findings in the case of <standardchartered.pk> will now apply those onto the facts of this case and will deal with each of the sub-issues sequentially below:

i. Whether the Disputed Domain Names infringe upon, or is an obvious derivation of, a registered trade name / trade mark?

Before embarking upon an analysis on this issue, it is pertinent to clarify that the Complainant does not have a trade mark registration for the trademark “Mustakbil” as yet. The Complainant has applied for the same at the Trade Marks Registry, Government of Pakistan, vide application number 218571 on 18th March, 2006. As such, the Complainant has taken steps to ensure protection of its intellectual property rights.

Since the Complainant does not have a registered trade mark, the reasonable issue to be considered would be whether domain name rights extend to unregistered trademarks. In order to seek assistance in this regard, the Panel has reverted to WIPO and WIPO Authorities with respect to domain name disputes concerning domain name rights in corresponding trademarks which are unregistered.

The WIPO Consensus View with respect to domain name rights in favor of unregistered trademarks is:

Consensus view: The complainant must show that the name has become a distinctive identifier associated with the complainant or its goods or services. Relevant evidence

of such "secondary meaning" includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition. The fact that the secondary meaning may only exist in a small geographical area does not limit the complainant's rights in a common law trademark. For a number of reasons, including the nature of the Internet, the availability of trademark-like protection under passing-off laws, and considerations of parity, unregistered rights can arise for the purposes of the UDRP even when the complainant is based in a civil law jurisdiction. However, a conclusory allegation of common law or unregistered rights (even if undisputed) would not normally suffice; specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required. Some panels have also noted that in cases involving claimed common law or unregistered trademarks that are comprised of descriptive or dictionary words, and therefore not inherently distinctive, there may be a greater onus on the complainant to present compelling evidence of secondary meaning or distinctiveness. Some panels have noted that the more obvious the viability of a complainant's claim to common law or unregistered trademark rights, the less onus there tends to be on that complainant to present the panel with extensive supporting evidence. However, unless such status is objectively clear, panels will be unlikely to take bald claims of trademark fame for granted.

The WIPO Consensus View could be taken as guidance with respect to determining the kind of consideration to be allocated with respect to rights in unregistered trademarks demonstrates that in such cases, it is for the Complainant to support his assertions pertaining to the rights in the disputed domain names with substantial evidence of use. Another important assistance that could be derived from the above mentioned Consensus View taken by WIPO is that a higher standard of proof is levied on the Complainant in cases of unregistered trademarks that comprise of descriptive or dictionary words. As such, in this case, the Panel has taken into account each piece of document submitted as evidence and assessed it on a higher standard of proof basis. Furthermore, it is imperative to note the guidance rendered by the discussions and findings in the WIPO Authorities that pertains to the issue of generic/descriptive names/terms. In such cases, the WIPO's view is as:

If the complainant makes a prima facie case that the respondent has no rights or legitimate interests, and the respondent fails to show one of the three circumstances under Paragraph 4(c) of the Policy, then the respondent may lack a legitimate interest in the domain name, even if it is a domain name comprised of a generic word(s). Factors a panel should look for when determining legitimate use would include the status and fame of the mark, whether the respondent has registered other generic names, and what the domain name is used for (a respondent is likely to have a right to a domain name "apple" if it uses it for a site for apples but not if the site is aimed at selling computers or pornography).

In WIPO Arbitration and Mediation Center Administrative Panel Decision 402 Shoes, Inc. dba Trashy Lingerie v. Jack Weinstock and Whispers Lingerie Case No. D2000-1223 it was held:

The question as to whether a mark is or has become generic such that the Complainant should not be seen to have "rights" in respect of the mark used or and/registered has been presented to a number of Panels. The concurring opinion, filed herewith, notes the minority view in the existing decisions under the Policy regarding the propriety and the wisdom of analyzing defenses that Complainant's alleged trademark was or is descriptive or generic. The majority here adhere to the minority position that such defenses are beyond the purview of the Panel. We believe that the courts or regulatory authorities are better able to grapple with the question of the generic nature of words and phrases, and the acquisition of secondary meaning.

In addition, the summary nature of the procedures under the Rules is not adequate to develop the proof necessary to make an informed decision on these issues. Therefore, the majority here accepts the registered trademark as prima facie evidence of the existence of the mark without analysis of Respondent's assertions that the TRASHY LINGERIE mark is descriptive or generic and without analyzing secondary meaning.

In WIPO Arbitration and Mediation Center Administrative Panel Decision *Classmates Online, Inc. v. John Zuccarini, individually and dba RaveClub Berlin* Case No. D2002-0635 it was held:

There is authority that a panel absolutely lacks authority to ignore a valid USPTO registration. Christie v. Porcaro, [WIPO Case No.D2001-0653](#); Hola S. A. v. Idealab, [WIPO Case No.D2002-0089](#) ("It is not for the Panel to decide whether registration of the marks should or should not have been granted. The holding of a registered mark is sufficient for the purposes of the Policy

In WIPO Arbitration and Mediation Center Administrative Panel Decision *Emmanuel Vincent Seal trading as Complete Sports Betting v. Ron Basset* Case No. D2002-1058 it was held:

Respondent, however, does appear to dispute that Complainant has any rights in the term "Cultured Stone," contending that the term is generic. The Panel notes, however, that Complainant owns a registration for the mark CULTURED STONE and that such registration carries with it a presumption that the mark is valid, i.e., not generic. Giving due deference to the determination of the United States Patent and Trademark Office, the administrative agency charged with responsibility for determining the registrability of marks, and in the absence of any evidence to the contrary, the Panel concludes that Complainant has rights in the mark CULTURED STONE.

As such, following the discussions and findings in the WIPO Authorities, as mentioned above herein, the Panel is not empowered to assess the issue of the trademark/tradename being generic and/or descriptive. Even in this case, with respect to the issue of generic names and/or descriptive term, the Panel has followed the guidelines found and discussed in WIPO Authorities pertaining to generic/descriptive names, and this Decision does not lay down a binding precedent with respect to the findings based on the trade mark being a generic term. The Panel has reviewed and assessed the information, data, material, evidence etc submitted in this case and it is understood that every matter pertaining to generic name(s) would be dealt with on an individual basis and on the basis of information, data, record, evidence submitted.

The primary issue is whether the Complainant has protectable rights in the mark/name to which it contends that the Disputed Domain Names are confusingly similar. In this case, the Complainant has applied for trade mark "mustakbil" and as such the registration process has been initiated and is under process. As a consequence, the questions arise as to (i) whether the Policy applies to unregistered trademarks and (ii) whether the mark at issue has acquired sufficient distinctiveness through use and promotion to identify the source of this particular service with Complainant.

With regard to the first aspect, it is undisputed and accepted practice, that paragraph 4(a)(i) of the Policy refers merely to a "trademark or service mark" in which the complainant has rights, and does not expressly limit the application of the Policy to a registered trademark or service mark. Further, the WIPO Final Report on the Internet Domain Name Process (*The Management of Internet Names and Address: Intellectual Property Issues*, April 1999), from which the Policy is derived, does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names. It is therefore open to conclude that the Policy is applicable to unregistered trademarks and service marks. This is further reiterated and reinforced by the WIPO Consensus View which was also followed in several WIPO Administrative Panel Decisions, whereby disputed domain name(s) were

transferred to the Complainant even though the latter did not have a registered trademark. This illustrates the broader interpretation of the Policy and the mechanism whereby disputed domain name(s) are corresponding to unregistered trademarks and yet the Complainant successfully obtains the remedy that is prayed.

The Complainant established its business of providing online employment recruitment and business solutions in the year 2005 and that is when the Complainant registered its primary domains on the gTLD .com and used the same along with ccTLDs in order to provide for an online job selling/job recruitment business. This demonstrates the Complainant's intentions to use the domain names for its business purposes and as such the importance of the domain names corresponding with its trade name was tantamount to the Complainant. Furthermore, the Complainant went ahead to protect its trade name by registering the same at the Trade Marks Registry, Pakistan and in the year 2006 applied for trade mark registration of the trade mark "mustakbil" which is pending before the Registry. Bearing in mind the customer base that the Complainant has built and is providing the above mentioned services to, it can be reasonably inferred by the Panel that the tradename is not only important to the Complainant, but is in fact closely associated with recognition customer loyalty and provision of services vide internet (online services). The Complainant is currently providing a multitude of services online via its official website. Thus, the registration under a similar/confusingly similar domain name by the Respondent may not only confuse the existing customer(s) of the Complainant looking for the Complainant's website but may also cause new customers being misled into believing that the Disputed Domain Names are also being operated by the Complainant.

The fact that in this case, the Complainant has not as yet obtained the registration of the trade mark "mustakbil" in its favour as the same is pending at the Registry, it does not preclude a finding that it has established trademark or service mark rights in that name for the purpose of the Rules. This is by virtue of a fundamental principle of trademark law is that rights in a trademark can be acquired through use, and such rights exist even though the trademark may not be registered. This is further reinforced by the Complainant's use of the trade mark "mustakbil" since the year 2005 till present.

In order to determine whether the Complainant has common law trademark rights in its trade name), the Panel notices that common law trademark and service mark rights exist when a party proves that there is enough goodwill and reputation in and to a name and sufficient association of the same with the party itself, no matter how strong or weak those trademark and service mark rights may be or whether use of the same is restricted to a particular jurisdictional boundary or geographical limits. This has been reiterated and provided for by the WIPO Consensus View as mentioned above herein.

The Panel reasonably infers that the Complainant has bona fide rights to the disputed domain name since the same is closely associated with its recognition in the market and is used as a commonly known entity for online jobs and recruitment. In addition to this, the Panel notes that the Disputed Domain Names incorporate the Complainant's trade name in its entirety. Numerous panel decisions under the Policy have regarded that as a compelling indicator that the domain name at issue is confusingly similar to the complainant's mark.

The issue under consideration here is whether or not the disputed Domain Name is confusingly similar to the Complainant's tradename. In coming to a conclusion in this aspect, the Panel first notes the approach to the confusing similarity issue which was adopted by the panel in *Research in Motion Limited v. One Star Global LLC*, [WIPO Case No. D2009-0227](#), where the domain name <unofficialblackberrystore.com> was held to be confusingly similar to the complainant's BLACKBERRY mark. The panel in *Research in Motion Limited* took the view that the confusing similarity requirement in paragraph 4(a)(i) of the Policy sets a fairly low threshold test, which is concerned only to establish that the complainant has sufficient rights to

give it *standing* to bring the complaint (citing *Aubert International SAS and Aubert France SA v. Tucows.com Co.*, [WIPO Case No. D2008-1986](#)). This Panel respectfully agrees with that approach.

Using the above mentioned precedents as guidance, it can be reasonably inferred that the Disputed Domain Names are not just similar to the Complainant's trade mark but are in fact identical to the trade name of the Complainant who have Common law rights in the trade name which has been reproduced in entirety into the disputed domain name.

A fundamental principle of trademark law is that rights in a trademark can be acquired through use, and such rights exist even though the trademark may not be registered. Therefore, given that the Complainant has been using its trade name in association with its business for a number of years, in fact since 2005, which is prior to the Disputed Domain Names being registered leads to the Complainant having rights in the trade name even though the same is not officially registered as yet and the process is underway at the Registry.

The Complainant has been using its trade name "mustakbil" since 2005 till present and the fact that it has never changed/altereD/modified its trade name is clear indication of the Complainant's goodwill and reputation associated with the Complainant. Not only that, but the same is widely recognized and well renowned with its trade name and the services being rendered by the Complainant. The Complainant is providing services which are exclusively online and as such make extensive use of the internet and online users who search for jobs and recruitment for the same on the internet. This illustrates the importance of the Disputed Domain Names for the Complainant. This is further reinstated by the Complainant's contention and evidence annexed thereto, that it has not only registered a primary domain, on a gTLD, being <mustakbil.com>, but that the Disputed Domain Names had been registered by the Complainant for itself and had been using the same for its purposes. However, due to some technical omissions, the Complainant was unable to obtain renewal of the same and this is when the Disputed Domain Names were registered by the Respondent. The Panel has taken into account the evidence submitted by the Complainant to show that it was the registrant of the Disputed Domain Names prior to the same being registered by the Respondent. This further reinforces the importance of the Disputed Domain Names to the Complainant. In addition to this, the same also reasonably paves way to the Complainant establishing its rights to the Disputed Domain Names, as shall be further discussed herein this Decision.

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 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 20040814](#)). Therefore the Panel determines the Disputed Domain Names to be an obvious derivation of the Complainant's trade name.

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. In addition to this, the fact that the Respondent has failed to submit a Response to the DNDRC even when an opportunity to do so was provided to him, the Panel is required to decide the matter based upon the Complaint on an ex parte basis. Therefore subject to the above stated discussion, the Panel may well determine the domain name in dispute to be transferred to the Complainant. However for the sake of brevity, clarity and 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.

In addition to the above, it was recently decided in a DNDRC Decision in the matter of <thedawn.pk>, <thedawn.com.pk> and <thedawn.net.pk> that even in cases where the Respondent has not submitted a Response, the Panel has to decide the matter on the basis of the Contentions put forth by the Complainant and the evidence submitted has to be reviewed and analyzed. The same line of reasoning as discussed in the above cited DNDRC Authorities has been put to use in this matter and as such the Decision is not simply decided on the basis of default on part of the Respondent but on the basis of the assertions put forth and supported with evidence by the Complainant.

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

The Complainant has made use of its trade name “mustakbil” in order to register its trade mark, its domain names and for the purposes of its business as a leading web portal for jobs and recruitment since 2005. The Complainant has not only made use of its trade mark “mustakbil” for establishing a well reputed and widely recognized service provider, but has also been successful in doing so. This is further reinforced by the Complainant winning the Brand of the Year Award in 2009. The Complainant, in order to assert its lack of mala fide and its legitimate interest in the Disputed Domain Names has annexed evidence thereto which shall be discussed herein this Decision.

As far as the registration of the Disputed Domain Names and the bona fide nature of such registration/acquisition is concerned, since the same has been made by the Respondent, it would be for the Respondent to assert its bona fide and support the same with evidence. However, in this matter, the Respondent has not submitted a Response to the Complaint even though an opportunity to do so was made available to the Respondent. As such, the Panel is unable to reasonably assume/infer a lack of mala fide on part of the Respondent, even more so in absence of any contention(s) at all put forth by the Respondent in this matter.

Furthermore, since the Respondent is also residing in the same jurisdiction as that of the Complainant, it is highly unlikely that the Respondent was not aware of the Complainant, its distinctive nature of being an online job provider and recruitment services. So much so, it is highly probable that the Respondent is himself a consumer of the Complainant. The Panel concludes that the Respondent must therefore have known of the Complainant’s trade name 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 trade name 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.

In addition to the above, it was the Complainant who had primarily registered the Disputed Domain Names and had directed the same to its primary domain name <mustakbil.com>. The Complainant has annexed supporting documentation in favor of this which has been reviewed and evaluated by the Panel which reasonably infers the lack of bona fide on part of the Respondent.

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 Respondent behind registration of the Disputed Domain Names is relevant to assist the Respondent in, inter alia, inferring the bona fide nature of the registration and countering the argument that the registration is not illegal nor intended to deprive the Complainant from use of their trade mark/ trade 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, it can be reasonably opined that the Respondent is aware of the famous nature and large customer base of the Complainant at the time when the Respondent registered the Disputed Domain Names. This is so because both the Complainant and the Respondent are located in the geographical location whereby the Complainant has not only provided its online services but has in fact also advertised the same in local newspapers and other print media. Furthermore, the Complainant has also registered other domain names corresponding to its trade mark in order to protect its online presence and online brand awareness. The Complainant has also registered the following domain names for its purposes:

mustakbil.com
mustakbil.net
mustakbil.org
mustakbil.info
mustakbil.biz
mustakbil.net.pk
mustakbil.org.pk
mustaqbil.com.pk
mustaqbil.net.pk
mustaqbil.org.pk
mustaqbil.pk
mustaqbal.org.pk
mustaqbal.net.pk
mustaqbal.com.pk

In the present case, the fact that both parties are present in the same geographic location i.e. Pakistan, and that the initial registration of the Disputed Domains rested with the Complainant, the Panel reasonably opines that it is highly unlikely and probable that the Respondent was not aware of the Complainant at the time of registering the Disputed Domain Names. Furthermore, the Complainant has maintained a regular and consistent presence online, as such, the Panel reasonably infers that the Respondent may, in high probability be well aware of the existence and value of the Complainant's trademark, trade name, existing domain names and customer base and might be a customer himself, is indicative of the Complainant's contention that the Respondent's registration of the Disputed Domain Names lack bona fide.

Moreover, the fact that the Respondent chose specifically to register a domain name not just similar but identical to the Complainant's trade name is also relevant.

Most importantly the 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 the their allegation that there is a legitimate and non-commercial purpose in conformity with the PKNIC-Internet Domain Registration Policy Aug 7, 2007 . ver 4.2 for which the Respondents initially registered the Disputed Domain Names. Moreover, the deliberate nature to conceal the purpose of the registration by the Respondents and their intentions for use in connection with the Disputed Domain Names brings into doubt the bona fide of the Respondent.

From the discussion under this second 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 Disputed Domain Names.

Furthermore, the Complainant has not authorized, allowed, permitted and/or consented to the use of its trade mark by the Respondent in corresponding domain name(s), nor has the Complainant conceded to the Respondent registering domain name(s) identical and confusingly similar to those of the Complainant. This sheds light on the Complainant's securing its trade mark exclusively for its own purposes in order to avoid its users being misled and/or confused

into believing that the Respondent and/or anybody else using the Complainant's trade mark, bears any kind of assistance, affiliation, collaboration, partnership, subsidiary, or the kind with the Complainant. This demonstrates the bona fide on part of the Complainant to protect itself against any third party associations. Also, since the Complainant is using the internet portal to offer its services, the Complainant is basically relying on and making use of customer loyalty which serves as an asset for the Complainant. This leads the Panel to reasonably infer that the Complainant is not incorrect in asserting that the Respondent's registering the Disputed Domain Names lacks bona fide.

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 evidence of 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 Disputed Domain Names 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, could 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 Disputed Domain Names by a person other than the owner/rightful holder/authorized user of the 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 2009 section 15 (although, the same is not in effect at the moment, but it was at the time of registering the disputed domain name by the Respondent) 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 2009. The punishment under this legislation is not simply limited to fines and could also amount to imprisonment.

The above mentioned factors could increase the likelihood of giving rise to liability under the above mentioned legislations, which in turn could 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 satisfied by the Complainant 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.

The Panel in addition to the above would also make mention of another way in which the use of the Disputed Domain Names 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 Aug 07 2007 version 4.2. This is the aspect related to emails being sent onto the email address(es) corresponding to the Disputed Domain Names, whereby a user might be unaware that the Disputed Domain Names are not currently with the Complainant and that a third party, independent to that of the Complainant and not bearing any affiliation with the Complainant has access to such emails, wherein the user might have disclosed confidential information and/or personal details of a sensitive nature which would then fall into the hands of the Respondent, who is not the intended recipient. In this way, the user's trust that he has in the Complainant would not only be blatantly breached, but would also affect the loyalty the user has towards the Complainant. Also, a customer, seeking any of the online services being provided by the Complainant, seeking any information, providing his own confidential information etc may be misled into sending an email to any of the above email addressed considering either/all of them to be that of the Complainant. In such a fashion, not receiving a response, or his confidential information being misused, or any other confusion being created in a customer's mind would not only affect the customer loyalty that forms an asset for the Complainant but might also endanger the Complainant's sales/profits/revenue that the Complainant earns from its customer base. 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 Judgment 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. The Judgment 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 Disputed Domain Names 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 Aug 07 2007 version 4.2.

In order to succeed in their claim, Complainant must demonstrate that all of the elements enumerated in Paragraph 4(a) of the Policy have been satisfied. The Panel shall continue to deal sequentially with the next three issues:

- (i) the domain name in dispute is identical or confusingly similar to a trademark or service mark in which the Complainant have rights; and
- (ii) the Respondents have no rights or legitimate interests with respect to the domain name; and
- (iii) the domain name has been registered and used in bad faith.

A. Identical or Confusingly Similar

The basic element to be taken into account while discussing this head is whether the Complainant has protectable rights in the trade name to which it contends that the disputed domain name is confusingly similar.

The Complainant's application for the trade mark "mustakbil" is pending before the Trade Marks Registry, Pakistan and as such the registration process has not concluded as yet. In such a scenario, the question arise as to (i) whether the Policy applies to unregistered trademarks and (ii) whether the mark at issue has acquired sufficient distinctiveness through use and promotion to identify the source of this particular service with Complainant.

As far as the first question is concerned, it is undisputed and accepted practice, that paragraph 4(a)(i) of the Policy refers merely to a "trademark or service mark" in which the complainant has rights, and does not expressly limit the application of the Policy to a registered trademark or service mark. Further, the WIPO Final Report on the Internet Domain Name Process (The Management of Internet Names and Address: Intellectual Property Issues, April 1999), from which the Policy is derived, does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names. It is therefore open to conclude that the Policy is applicable to unregistered trademarks and service marks.

It has been extensively discussed above herein that the even though the Complainant does not have actual rights by virtue of trade mark registration arising in its favor, it does have common law trade mark rights, which are both acknowledged by the Trade Marks Ordinance, 2001 and WIPO Authorities.

With regard to the second question (whether Complainant has common law trademark rights in the trade mark "mustakbil"), the Panel notices that common law trademark and service mark rights exist when a party proves that there is enough goodwill and reputation in and to a name

and sufficient association of the same with the party itself, no matter how strong or weak those trademark and service mark rights may be (*Action Sports Videos v. Jeff Reynolds*, WIPO Case No. D2001-1239).

On the other hand, even if Complainant's trade name acquired goodwill and reputation only in a limited capacity, this would still be sufficient to establish common law trademark rights within the meaning of paragraph 1(a)(i) of the Policy. The Panel endorses the following observation of the Administrative Panel in *Funskool (India) Ltd. v. funskool.com Corporation*, WIPO Case No. D2000-0796, wherein it was stated as follows:

"The Policy places no limitation on the operative extent of a trademark, which the Complainant must show the disputed domain name to be identical or confusingly similar to."

In the light of the above, the Panel accepts that Complainant has provided adequate grounds for a finding that it holds common law trademark and service mark rights in the name "mustakbil". The Panel also took into account the distinctive nature of the Complainant's trade mark, which does not constitute a literate word, nor is a commonly used word that could hold multiple meanings/interpretations. As such, the Panel reasonably opines that the Complainant has common law rights to the trade mark by virtue of its extensive use of the same, both online and in print media.

The Panel has also taken into account several WIPO Authorities while arriving at the Decision herein:

- **UITGERVERIJ CRUX v. W. FREDERIC ISLER, Case No. D2000-0575:**

Identical or Confusingly Similar to Trademark

The Panel has found that the Complainant has rights in the mark "CRUX Editions". Therefore the Panel is of the opinion that the Domain Name is confusingly similar with marks in which the Complainant has rights. The Panel is therefore of the opinion that the Complainant has readily met the burden of proof as established by paragraph 4(a)(i) of the ICANN Policy.

*Furthermore, the Complainant maintains that it has been using "crux" as a subdomain since December 1996. In this regard, the Panel is of the opinion that given Respondent's failure to submit a response, the Panel accepts as true all of the allegations of the Complaint (see, for example, *Talk City, Inc. v. Michael Robertson*, Case No. D2000-0009 at paragraph 5(d) or *Shopping.com v. Internet Action Consulting*, Case No. D2000-0439).*

- **Skattedirektoratet v. Eivind Nag, Case No. D2000-1314**

(i) Confusing similarity with a mark in which the Complainant has rights

The Complainant has used, since many years, the term "Skatteetaten" as a business identifier and the Panel is satisfied that the Complainant has rights in that business identifier. However, under the Policy, the Complainant must have rights in a mark (trademark or service mark). The Complainant has no registration of the word "Skatteetaten" as a mark. However, Norwegian Trademark Law also recognizes rights on unregistered marks on the condition that they have acquired distinctiveness through use.

The Panel therefore accepts that Complainant has rights in the (unregistered) word mark "Skatteetaten" and that the domain name "skatteetaten.com" of the Respondent must be considered to be identical. Applying the similarity test, the suffix ".com", which indicates the gTLD in which the domain name is registered cannot be taken into consideration since otherwise a domain name would practically never be identical to a protected trademark. Anyhow, beyond any doubt, the domain name " skatteetaten.com" is confusingly similar to the term "Skatteetaten ", in which the Panel is satisfied that the Complainant has rights.

- **Australian Trade Commission v. Matthew Reader, Case No: D2002-0786**

- 2. *The Domain Name is Identical or Confusingly Similar To Complainant's Mark*

There is no question but that the Domain Name is identical or confusingly similar to all three of Complainant's registered trademarks as well as Complainant's common law trademark in the word "Austrade." Excluding the gTLD identifier ".com", which is not to be taken into consideration when judging identity or confusing similarity, the Domain Name either replicates the entirety of the distinctive part of each and every one of the marks in which the Complainant has rights.

The Panel finds the Australian concept of "deceptive similarity" is equivalent to the ICANN Policy requirement of "confusing similarity" such that our analysis here is consistent with Australian law.

In the case of the unregistered service mark "Austrade", the Panel finds that there is no need to consider the issue of confusing similarity, as the domain name is identical to this mark.

- **Imperial College v. Christophe Dessimoz Case No. D2004-0322**

- A. *Identical or Confusingly Similar to a Trademark or Service Mark in which Complainant has Rights*

Preliminary issue is whether Complainant has protectable rights in the mark to which it contends Respondent's Domain Names are confusingly similar.

Complainant has not registered the name THE IDEA LEAGUE as a trademark, therefore the questions arise as to (i) whether the Policy applies to unregistered trademarks and (ii) whether the mark at issue has acquired sufficient distinctiveness through use and promotion to identify the source of this particular service with Complainant.

In the light of the above, the Panel accepts that Complainant has provided adequate grounds for a finding that it holds common law trademark and service mark rights in the name THE IDEA LEAGUE. That being stated, there is no doubt on the similarity of the Domain Names with Complainant's common law trademark THE IDEA LEAGUE, the only difference lying in the absence of the definite article "the."

- **Fairview Commercial Lending, Inc. v. Aleksandra Pesalj Case No. D2007-0123**

- A. *Identical or Confusingly Similar*

The threshold issue confronting any panel in a UDRP proceeding is whether a complainant has rights in the trademark or service mark to which that complainant claims a disputed domain name is identical or confusingly similar. In the present case, the Complainant did not furnish the Panel with evidence that the Complainant possesses a valid trademark registration of either FAIRVIEW or FAIRVIEW COMMERCIAL LENDING in any jurisdiction or venue. Thus, in determining whether the Complainant's case can be sustained, the Panel must first decide whether the Complainant can legitimately assert rights in either of those unregistered marks on another basis.

*Many previous panels operating under the Policy have found complainants to have common law trademark rights sufficient to satisfy the degree of trademark or service mark ownership required under paragraph 4(a)(i). See *Pilgrim Films and Television Inc. v. Brandon Bator*, NAF Case No. FA909831 (March 15, 2007); and *Jeffrey Archer v. Alberta Hotrods tda CELEBRITY 1000*, [WIPO Case No. D2006-0431](#) (June 1, 2006).*

Accordingly, the Panel rules that the Complainant has satisfied its burden in proving that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The Complainant has used the trade mark "mustakbil" for its business of online jobs and recruitment services since 2005. Furthermore, the Complainant had registered the Disputed Domain Names along with the other domains that the Complainant has registered corresponding to its trade mark. Furthermore, the distinctive character of the trade mark "mustakbil" is further proof of the Complainant's rights, albeit in common law, in the trade mark.

Furthermore, the Complainant has demonstrated sufficiently that they hold bona fide and legitimate interests in the trade mark "mustakbil" and it is this act of incorporating same in the entirety of the Disputed Domain Names. In addition to this, the suffix ".pk" should be disregarded for the purpose of comparison under this criterion of the Policy.

The Panel also notes that the Respondent has not challenged/countered any/all of the Complainant's assertion against the Respondent.

In assessing identity and confusing similarity for the purposes of paragraph 4(a) (i) of the Policy it is acceptable for the generic domain suffix to be ignored.

The Panel finds that the Domain Name is identical or confusingly similar to a trade mark in which the Complainant has common law rights.

Facts, as submitted by the Complainant demonstrate that the Complainant has been using its name since its incorporation in 2005. The assertions put forth by the Complainant about its growth give a clear illustration of its expansion, large customer base and recognition with the massive multitude of people in the region. Any alteration in the ownership/association to the same would not only disrupt the large customer/consumer base of the Complainant, but could also cause widespread confusion, floodgates of complaints/queries and the Respondent being considered an affiliate/subsidiary of the Complainant, which is not the case. Hence, the Complainant's trade name is not only significantly well associated with its business, but is also well recognized throughout Pakistan. This paves way to the Complainant's being eligible for common law rights to the trade name, even though the same is unregistered. Relying on the above discussed WIPO authorities on situations where common law rights arise to a trade name/mark even when the same is not registered, and applying the same to the facts of this case, the Panel accepts that Complainant has rights in the trade mark "mustakbil". As such, the

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a non-exhaustive list of what shall demonstrate rights or legitimate interests for the purposes of paragraph 4(a)(ii) of the Policy. It is addressed to registrants of domain names and reads:

“How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint: When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your 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 non-commercial 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.”

As has been previously cited in DNDRC Decisions and has been adopted by the Discussions and Findings in WIPO Authorities, it is for the Respondent to rebut the allegations put forth by the Complainant. Also, with respect to proving rights or legitimate interests in the disputed domain name(s), it is for the Respondent to submit evidence pertaining to the same. This is in accordance with the law of Evidence which states that it who alleges has to prove the same. And in any case, it would be almost impossible, if not stark difficult for the Complainant to prove a negative assertion. As such, in order to satisfy the Panel that it has rights or legitimate interests to the Disputed Domain Names, the Respondent was obliged to submit evidence with respect to the same. However since the Respondent has not availed the opportunity of countering the allegations put forth by Complainant, nor has submitted any kind of information, data, record, or the like either in its own favour or in order to counter the contentions levied against it by the Complainant, the Panel is left with no other option but to draw reasonable inferences out of the information, data, record available with it along with its own initiatives to assess the facts.

The Respondent has not submitted any kind of information, nor has provided any kind of material to be used as supporting documentation/evidence. As such, the Panel is unable to decipher the true picture on part of the Respondent. However, the Complainant, along with the Complaint, had annexed a screenshot of the content of the Disputed Domain Names and using that to evaluate the “use” of the Disputed Domain Names by the Respondent, the Panel reasonably evaluates that the Respondent is using the Disputed Domain Names to offer services that are similar to those offered by the Complainant, i.e. online job offerings and recruitment, etc. This led the Panel to reasonably believe that the Respondent has registered the Disputed Domain Names not for a bona fide offering of services. This is further reiterated by the inference that the Respondent is not known by the trade name “mustakbil” and is not making any non-commercial use of the Disputed Domain Names.

The Complainant has made out a persuasive case. The Complainant's name has been in continuous use in Pakistan since 2005. The Respondent has not submitted any response to the Complaint and hence there are no counter allegations and/or submissions by the Respondent that the Panel could take into account while rendering this Decision.

The simplest thing, of course, for the Respondent to have done was to produce some evidence of his business plan in relation to the Domain Name. If he has any bona fide interest in the disputed domain name, one would have expected him to have something to show for it (e.g. his business plan), but he has submitted nothing which is evidence of lack of bona fide on his part.

While it is for the Complainant to prove the three elements of paragraph 4(a) of the Policy, it is now well-established that in relation to the second element (paragraph 4(a)(ii) of the Policy), once the Complainant has made out a *prima facie* case (i.e. a case to answer) it is for the Respondent to answer that case. The rationale behind this policy is that whether or not the Respondent has rights or legitimate interests is a question, which the Respondent is best-placed to answer. In the absence of an answer, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

Furthermore, the Panel has taken into account the Discussions and Findings in several WIPO Authorities:

- **S.N.C. Jesta Fontainebleau v. Po Ser, Case No. D2009-1394**

C. Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent contends that none of the examples of what shall constitute rights or legitimate interest for this purpose as set out in paragraph 4(c) of the Policy is applicable.

The issue is as to whether or not the Respondent's service offering by way of the Domain Name is "a bona fide offering of services." For the reasons set out in the following section, the Panel concludes that the Respondent's service offering is not a bona fide service offering. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

- **La Mafafa, Inc. dba Cultura Profética v. Domains Real Estate, Case No. D2009-0534**

B. Rights or Legitimate Interests

Respondent has not provided evidence that he has been commonly known by the disputed domain name, or that he has made or planned to make a bona fide offer of goods or services using that name. Although Respondent states that he has acted on behalf of a client who plans to research, write and publish a book on a subject matter arguably described by the disputed domain name, Respondent has provided no evidence of the existence of the client or of the planned publication. Such self-serving statements do not establish preparations for a bona fide offering of goods or services under the disputed domain name, particularly in the context of Respondent's practice of registering and offering for sale other domain names incorporating trademarks of third parties

(see *Helen Fielding v. Anthony Corbert aka Anthony Corbett*, [WIPO Case No. D2000-1000](#)).

The Panel finds that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

- **Fairview Commercial Lending, Inc. v. Aleksandra Pesalj, Case No. D2007-0123**

B. Rights or Legitimate Interests

Faced with a complainant's prima facie case regarding paragraph 4(a)(ii) of the Policy, a respondent relies typically on one of the three possible avenues of rebuttal offered in paragraphs 4(c)(i-iii). However, in this case the Respondent falls short with respect to all three.

In light of the above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

- **Imperial College v. Christophe Dessimoz, Case No. D2004-0322**

B. Rights or Legitimate Interests

*It has been consistently and repeatedly established by WIPO panels that "once a complainant establishes a prima facie evidence showing that none of the three circumstances establishing legitimate interests or rights applies, the burden of proof on this factor shifts to respondent to rebut the showing" (see among others, *Ditting Maschinen AG v. I.C.T. Company*, [WIPO Case No. D2003-0170](#); *Universal City Studios, Inc. v. David Burns and Adam-12 Dot Com*, [WIPO Case No. D2001-0784](#)).*

In the case at hand, it is clear that Complainant has never authorized or licensed Respondent to use Complainant's trademark THE IDEA LEAGUE. Furthermore, Respondent does not contend that it has been commonly known by the Domain Names and has offered no explanation for his choice of that name.

For the foregoing reasons, the Panel concludes that the second element under paragraph 4(a) has been established.

- **Skattedirektoratet v. Eivind Nag, Case No. D2000-1314**

(ii) Rights or legitimate interests in respect of the domain name

The term "Skatteetaten" is a mark in which the Claimant has protected rights in Norway, and no doubt the Claimant has not authorized the Respondent to use it. Even if the Claimant uses his mark for a restricted number of goods and, in particular, services, all in connection with tax-related issues, it is in view of the high degree of recognition of the term "Skatteetaten" as identifier of the Claimant, difficult to imagine any use of that term which would not automatically be associated, in the mind of Norwegian tax payers, with the Claimant. Therefore an assumption speaks in the Claimant's favor that the Respondent infringes its rights by using a domain name identical to his protected mark, and it must be seen whether the Respondent has put forward

arguments to prove his rights or legitimate interests in the domain name "skatteetaten.com".

The Panel, accordingly, finds that it is satisfied that the test of paragraph 4a(ii) has been met, and that the Respondent had no rights or legitimate interests in respect of the domain name at issue.

The Respondent has provided no response to the allegations of the Complainant, even though an invitation to submit a response was sent to them, as per the Rules.

The file contains no evidence that the use of the Domain Names meets the elements for any of the nonexclusive methods provided for in the Policy paragraph 4(c). As such, based on the detailed discussions above and point by point analysis of the requirements under this head, the Panel finds that the Respondent has no rights or legitimate interest in the Domain Names pursuant to the Policy paragraph 4(a) (ii).

Based on the present record, the above noted discussions and the applicability of the above mentioned precedents to the facts of this case, the Panel finds that Respondent has no rights or legitimate interests with regard to the domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states circumstances which, if found, shall be evidence of the registration and use of the domain name in bad faith:

(i) circumstances indicating that Respondent has registered or 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 the Complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or

(ii) Respondent has 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 Respondent has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website 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 Respondent's website or location of a product or service on Respondent's website or location.

The Panel shall now take each sub element and discuss the same:

(i) circumstances indicating that Respondent has registered or 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 the Complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name;

As has been mentioned repeatedly above herein, the Panel has no information, record, data

and/or material to take into account on part of the Respondent. However, basing its findings on reasonable inferences that could be drawn, the Panel is unable to decide upon this aspect of the issue. Furthermore, the Panel is entirely oblivious to the purpose(s) of registering the Disputed Domain Names by the Respondent.

Complainant has shown that the domain name is being used for commercial gain to attract Internet users to Respondent's website based on a likelihood of confusion with Complainant's trade name "mustakbil". Without any indication to the contrary, Complainant's prior use and continuing use of the same trade mark for its own purposes leads to the inevitable conclusion that Respondent has registered and is using the domain name with actual knowledge of Complainant's common law rights in the trade name.

(ii) Respondent has 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 Respondent has engaged in a pattern of such conduct

The Complainant has been using the trade mark "mustakbil" consistently since the year 2005 till present. The Complainant has made use of this trade mark for provision and rendition of services and publicity/advertisement, both in print and electronic media. Not only this, the Complainant has also secured its presence on the internet portal by virtue of registering domains as has been listed above in the Decision.

In addition to the above, the Disputed Domain Names had been registered with the Complainant before being registered by the Respondent. The Complainant had registered the Disputed Domain Names and had been using the same to direct the ccTLDs onto their primary domain on the gTLD .com i.e. <mustakbil.com>. This reflects the importance of the Disputed Domain Names to the Complainant, who in this case are unable to register the same for their own purposes since the Respondent has registered them. This obstruction to register the Disputed Domain Names has affected the business for the Complainant since their rightful ccTLDs are not in their possession and in fact have been registered by another individual who could be obtaining/making use of the same in a unfair commercial manner. Also, it is not simply one domain name that the Respondent has registered, but in fact two of domain names which are identical and confusingly similar and to which the Respondent does not have rights or legitimate interest have been registered by the Respondent. As such, the Panel is led to no other reasoning but to infer that the Respondent has registered the Disputed Domains to obstruct/hinder the Complainant from registering the Disputed Domain Names for its own purposes.

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

The Respondent has not provided any information, data, record and/or material at all or as evidence to demonstrate lack of bad faith. As discussed earlier, it is again reiterated for the sake of brevity and clarity that the Complainant, in order to provide online services on a .pk ccTLD is unable to do so since the domain name with the .pk ccTLD is unavailable for registering because the same has been registered by the Respondent. As such, the Complainant is unable to register the domain name on the .pk ccTLD for itself even though it has been using the tradename "mustakbil" since 2005. Furthermore, the exact nature of the business that the Respondent is involved in is unknown to the Panel. In absence of information available to take into account, the Panel cannot disregard the similar nature of services being provided by the Respondent on the Disputed Domain Names. This leads the Panel to reasonably believe that the Respondent is either attempting to disrupt the Complainant's business and/or create competition for the same, if the Respondent is not already a competitor.

Accordingly, it is the Panel's view that, on the balance of probabilities, the Respondent had actual knowledge of the trade name of the Complainant and the products/services in connection with which the trade name is used by the Complainant.

In the current proceedings, the Complainant has contended that no authorization, permission, consent or the like was ever granted/ given to the Respondent at any point in time with respect to the registration and/or use of the Disputed Domain Names. Without any form of substantial evidence to indicate that the Complainant approved of or authorised the Respondent's use of their trade name in the disputed domain name, the Panel cannot infer that such a relationship of association/affiliation existed between the Respondent and the Complainant. (See *Tom Cruise v. Network Operations Center / Alberta Hot Rods*, WIPO Case No. D 2006-0560).

In conclusion, the Panel finds that the test under this head has been established successfully by the Complainant and the Respondent has failed to provide any fact(s)/reason(s)/justification(s) to the contrary.

(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."

As has already been found, the Respondent has registered domain names that incorporate the trade mark of the Complainant in entirety and are identical and confusingly similar to the trade mark and other domain names of the Complainant. Furthermore, the Complainant is a well known, well recognized and functioning organization whereby one of its key assets is the recognition and the customer loyalty that fuels the Complainant's business. However, the Complainant is unable to register the Disputed Domain Names for itself, even though they have in the past been registered by the Complainant along with several other domain names. In addition to this, the Complainant has an online services based business which relies in a substantive amount on the users coming to the domain name whereby the services are being hosted. As such, the Complainant's consumer(s) might be misled into believing that the services being provided by the Respondent on the disputed domain name are in any way connected to or infact actually those being provided by the Complainant. This would be even more the case if the Complainant's consumer(s) falsely believe that there is another entity existing which provides similar services to that of the Complainant for a lesser price maybe. This would cause the Complainant's business being severely disrupted, the consumers being falsely led into believing something that is not true and furthermore, the Respondent gaining on the expense of the Complainant. Also important to bear into account is the fact that the Complainant has not in any way authorized, sponsored, sourced, delegated, consented, and/or conveyed any affiliation, association, subsidiary, co ownership or the like with the Respondent. However the consumers seeing an online website with the same tradename as the domain name and providing similar services might be misled and confused into believing that there is a relationship of affiliation, sponsorship, source, endorsement, association, subsidiary, partnership, co ownership or the like between the Complainant and the Respondent which is obviously not the case. Any user searching for the Complainant's online site might be misled into believing that the .pk ccTLD is also being used by the Complainant and hence would falsely believe that the Disputed Domain Names are that of the Complainant or that there exists a relationship of affiliation, sponsorship, source, endorsement, association, subsidiary, partnership, co ownership or the like between the Complainant and the Respondent which is in fact not the case since the Complainant has expressly conveyed in the Complaint that at no point in time have they ever authorized the Respondent's registration/use of the Disputed Domain Names.

The Panel has taken into account the Discussions and Findings in the following WIPO

Authorities while rendering this Decision:

- **Imperial College v. Christophe Dessimoz, Case No. D2004-0322**

C. Registered and Used in Bad Faith

Under the Policy, Complainant is also required to prove the third element provided for in paragraph 4(a)(iii), namely that the Domain Names have been registered and are being used in bad faith.

As extensively set forth under paragraph B of this decision, the Panel agrees that Respondent has registered the Domain Names for the purpose of attracting for commercial gain Internet users to his web site by creating an initial interest confusion with Complainant's mark as to its source, sponsorship, affiliation or endorsement, as stated in paragraph 4(b)(iv) of the Policy. In fact, Respondent, by using Complainant's common law trademark, can derive a potential business opportunity from those visiting the web site "www.idealeague.org" expecting to find Complainant's site.

Therefore the Panel concludes that also the third element under paragraph 4(a) has been established

- **Fairview Commercial Lending, Inc. v. Aleksandra Pesalj, Case No. D2007-0123**

C. Registered and Used in Bad Faith

*The Panel accepts the Complainant's contention that the Respondent benefits commercially by charging fees for lending services that Internet users never receive. The Respondent accomplishes this goal by use of a domain name that is confusingly similar to the Complainant's trademark – a trademark associated with lending services. As a result, the Panel determines that the Respondent is attempting to divert Internet users for commercial gain by attracting them to its website through a likelihood of confusion with Complainant's mark, which is conclusive evidence of bad faith registration and use pursuant to paragraph 4(b)(iv) of the Policy. See *Mostchoice.com Inc. v. Xianqing Zhu c/o Most choice.com, Inc.*, NAF Case No. FA424540 (April 11, 2005); *Baudville, Inc. v. Henry Chan*, [WIPO Case No. D2004-0059](#) (April 5, 2004); and *Hewitt Associates LLC*, *supra*.*

Therefore, the Panel rules that the disputed domain name was registered and is being used by the Respondent in bad faith.

- **La Mafafa, Inc. dba Cultura Profética v. Domains Real Estate, Case No. D2009-0534**

C. Registered and Used in Bad Faith

Respondent registered the distinctive trademark and service mark of Complainant in the disputed domain name, and he has offered to sell it to Complainant at a price well in excess of any reasonable expenses directly associated with the domain name. Respondent has offered no plausible good

faith explanation for registering the disputed domain name. Respondent is presently offering for sale other domain names that incorporate trademarks of third parties. The Panel determines that Respondent registered the disputed domain name with the bad faith intention to sell it within the meaning of Paragraph 4(b)(i) of the Policy.

The Panel determines that Respondent registered and has used the disputed domain name in bad faith within the meaning of the Policy.

- **S.N.C. Jesta Fontainebleau v. Po Ser, Case No. D2009-1394**

D. Registered and Used in Bad Faith

The inevitable inference is that the Respondent registered the Domain Name knowing it to be a confusingly similar name to the name of the Complainant's hotel complex for the purpose of deriving PPC revenue. A not insignificant proportion of that revenue will be derived from Internet users, hoping to reach the Complainant, visiting the Respondent's site in error. The allegation is made out clearly in the Complaint and, in the view of the Panel, the evidence and the surrounding circumstances support that allegation. The Respondent does not challenge the allegation.

The Panel finds that the Domain Name was registered and is being used in bad faith within the meaning of paragraphs 4(b)(iv) and 4(a)(iii) of the Policy.

- **Skattedirektoratet v. Eivind Nag, Case No. D2000-1314**

(iii) Registration and use in bad faith.

For a Complainant to succeed, not only must the Panel be satisfied that a domain name has been registered in bad faith, but must also be used in bad faith

The Respondent detracted Norwegian citizens seeking information on tax-related issues to his website. Persons who attempted to access Claimant's website either trying the "skatteetaten.com" domain name or coming to this website by using a search machine, were likely to be confused with respect to the context of the website or may have become discouraged and may not have searched any further, to the Complainant's and their own detriment.

The Panel, accordingly, finds that it is satisfied that the test of paragraph 4a(iii) has been met.

Since the Respondent has not countered/justified the Complainant's allegations(s) nor has it provided the DNDRC with any fact(s), reason(s), justification(s) of to support his position, the Panel can reasonably infer that the Respondent by registering/using the Disputed Domain Names, has intentionally attempted to attract, for commercial gain, internet users to the disputed domain name by creating a likelihood of confusion with the Complainant's tradename as to the source, sponsorship, affiliation, or endorsement of his web site or location and the services being provided online. Based on the above discussions under this head as well as the applicability of the above mentioned precedents and the applicability of those to the facts of this case, the Panel finds the disputed domain name to be registered and used in bad faith.

7. Decision

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

1. The Respondent's registration of the Disputed Domain Names is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
2. The Respondents have no legitimate interest in the Complainant's Domain name
3. The domain names are confusingly similar/ identical.
4. The Respondents are making mala fide use of the Complainant's Domain name.

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 recommend to the PKNIC that PKNIC to transfer the registration of the Disputed Domain Names to the 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 Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Dated: 18th April, 2011

Sole Panelist: Mr. Mustafa Syed