

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Orient Color Lab (Private) Limited v. Orient Engineering Services

Case No. C2012-0001

Also in PDF C2012-0001

1. The Parties

The Complainant is Orient Color Lab (Private) Limited, located at 26 Kilometer, Multan Road, Maraka, Lahore, Pakistan and has filed proceedings with DNDRC through its authorized representative, Mr. Ahmad Nawaz Khurram, located at 1 Farrah Center, 2 Mozang Road, Lahore, Pakistan.

The Respondent is Orient Engineering Services, located at 5 R-II, Khayaban-e-Firdausi, Johar Town, Lahore, Pakistan and has filed the Response with DNDRC through its authorized representative, Mr. Shaigan Ijaz Chaudhry, located at 48-Hajvery Complex, 2 Mozang Road, Lahore, Pakistan.

2. The Domain Name and Registrar

The disputed domain name is <orient.com.pk> hereinafter collectively known as the Disputed Domain Name, registered with PKNIC by Orient Engineering Services. The Disputed Domain Name has been registered by the Respondent since 13th April, 2001 valid up to 13th April, 2013.

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 05th October, 2011.

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 11th November, 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 submitted the Response on 16th November, 2011. The proceedings commenced thereafter.

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 Barrister Samay Shams 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.

4. Factual Background

The Complainant is Orient Color Lab (Private) Limited. The Contentions as put forth by the Complainant are mentioned below herein.

The Respondent is Orient Engineering Services. The Response as submitted by the Respondent is reproduced below herien.

5. Parties' Contentions

A. Complainant

The Complainant has put forth following assertions in this matter:

The Complainant is a Private Limited Company, incorporated under the Laws of Pakistan on 15th of December 1983 and doing business since under the name and style of Orient Color Lab (Private) Limited. The Complainant has already spent more than 100 million rupees on advertising since 1983 for establishing its brand 'ORIENT' and not 'ORIENT' has become a brand/house hold name.

The disputed domain name orient.com.pk is identical or confusingly similar to the Complainant Trade Mark. A domain name is "identical or confusingly similar" to a Trademark for purposes of the policy when a domain name includes a Trademark or a confusingly similar approximation, regardless of the other terms in the domain name.

The respondent has no right or legitimate interests in respect of the disputed domain name. The Complainant has no relationship with the respondent. The Respondent is not affiliated with the Complainant and does not have the permission, consent or license of the Complainant to register the disputed domain name. The Respondent is using the disputed domain name which includes Complainant's "ORIENT" mark

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

That the directions may very kindly be issued that the Domain Name be transferred in the Complaint's name or an appropriate relief may very kindly be allowed.

B. Respondent

The Respondent has filed the following Response:

The disputed domain name orient.com.pk is neither identical nor similar to the complainant's trademark. The complaint is not in accordance with UDNDR Policy. The domain name has been acquired by the respondent in good faith. The domain name of respondent is causing no confusion for internet users as it is in no way similar to the complainant's mark. The registration of respondent's domain name is bonafide and not an attempt to disrupt the complainant's business. The respondent has legitimate interests in the domain name and has been using it since 13-04-2001, which is more than seven years earlier than the complainant's registration of his trademark in 2008. The respondent is commonly known by his domain name. The respondent's domain name is in no way misleadingly diverting the complainant's consumers nor tarnishing its mark as it is in no way similar to the complainant's mark. By using his registered domain name respondent is in no way interfering in complainant's mark. The complaint has been filed in bad faith and an attempt to hijack the respondent's registered domain name.

Based on the Respondent's Response, it has sought the following remedies:

The complaint under reply having no substance or legal basis is liable to be dismissed.

6. Discussion and Findings

The application for the registration of the Disputed Domain Name 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 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 Name is ab initio illegal, the following shall have to be taken into consideration:

- i. Whether the Disputed Domain Name infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Disputed Domain Name is bona fide?
- iii. Whether the application and/or registration of the Disputed Domain Name contravenes the Pakistan Penal Code 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 Name infringes upon, or is an obvious derivation of, a registered trade name / trade mark?

The Complainant has the following Trade Mark registration for the Trade Mark “Orient”:

Class	Trade Mark Registration Number	Date of Registration
36	251778	05/06/2008
39	251781	05/06/2008
41	251783	05/06/2008
13	251756	05/06/2008
08	251750	05/06/2008
12	251574	05/06/2008
15	251758	05/06/2008
33	251776	05/06/2008
40	251782	05/06/2008
36	251780	05/06/2008

This issue calls for the Complainant to have a registered trade name or a trademark from which the Disputed Domain Name has been derived. What is important to note is that, it does not mention or require the Complainant to have a registered trade name or trademark **at the time of registration of the Disputed Domain Name**. This is important in assessing and discussion whether the Disputed Domain Name is an obvious derivation of a registered trade name or a trademark, since, the Complainant acquire trade mark registration rights to the name ORIENT on 05th June, 2008, while the Disputed Domain Name was registered on 13th April, 2001.

Since the Complainant apparently did not have a registered trade mark at the time when the Disputed Domain Name was registered, the reasonable issue to be considered would be whether domain name rights still accrued. 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:

1.4 Does the complainant have UDRP-relevant trademark rights in a trademark that was registered, or in which the complainant acquired unregistered rights, after the domain name was registered?

Consensus view: Registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the UDRP. The UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired rights.

Relevant decisions:

Madrid 2012, S.A. v. Scott Martin-MadridMan Websites, WIPO Case No. [D2003-0598](#), <2m12.com> inter alia,

(in which the Disputed Domain Name was transferred to the Complainant).

Stoneygate 48 Limited and Wayne Mark Rooney v. Huw Marshall, WIPO Case No. [D2006-0916](#), <waynerooney.com>, (in which the Disputed Domain Name was transferred to the Complainant).

Esquire Innovations, Inc. v. Iscrub.com c/o Whois Identity Shield; and Vertical Axis, Inc, Domain Administrator, WIPO Case No. [D2007-0856](#), <iscrub.com>, (in which the Disputed Domain Name was transferred to the Complainant).

The above mentioned Consensus View of the WIPO illustrates and reiterates that the date on which the Complainant acquired registration of a trade mark is not something that is lent much weight/consideration.

The primary issue is whether the Complainant has protectable rights in the mark/name to which it contends that the Disputed Domain Name is confusingly similar. In this case, the Disputed Domain Name's registration pre dates the Complainant's trade mark registration. 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 incorporated its business in the year 1983 and since then has been using the trade mark/trade name Orient for the purposes of providing its goods/services.

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 its business. In addition to this, the Panel notes that the Disputed Domain Name incorporates 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.

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 1983, which is prior to the Disputed Domain Name was registered leads to the Complainant having rights in the trade name even though the same was not officially registered at the time of registration of the Disputed Domain Name.

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 Name 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. 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.

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

The Complainant has made use of its trade name “ORIENT” in order to register its trade mark, and for the purposes of its business since 1983.

As far as the registration of the Disputed Domain Name 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, even though the Respondent has submitted a Response to the Complaint and has asserted that the Disputed Domain Name registration was not done in bad faith, no evidence to of any kind has been annexed. As such, the Panel is unable to reasonably assume/infer a lack of mala fide on part of the Respondent, based on any documentary evidence of any kind, even more so in absence of any coherent information with respect to the Respondent’s intentions/reasons for using the word ORIENT to register a domain name.

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 in business since 1983. 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.

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 Name is relevant to assist the Panel 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 trade mark and trade name.

Failure of the Respondent to provide any documentary facts and details as to the purpose for registering the Disputed Domain Name has rendered the Panel unable to determine a legitimate and non-commercial purpose in conformity with the PKNIC- Internet Domain Registration Policy Aug 7, 2007. ver 4.2 for which the Respondent initially registered the Disputed Domain Name. Moreover, omission to provide purpose of registration and use of the Disputed Domain Name by the Respondent renders the Panel unable to identify any bona fide with respect to same.

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 Name.

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. This leads the Panel to reasonably infer that the Complainant is not incorrect in asserting that the Respondent's registering the Disputed Domain Name 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 Name 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 Name 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 Name 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 Name, whereby a user might be unaware that the Disputed Domain Name is 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 Name by the Respondent 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 Respondent 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

There are two requirements that a Complainant must establish under this paragraph; that it has rights in a trade or service mark, and that the domain name is identical or confusingly similar to

the marks. The Complainant has provided the registration documents for its Orient mark, registered at the Trade Marks Registry, Pakistan. Registration for these marks postdate the Disputed Domain Name registration; however, Paragraph 4.a.(i) does not require that the trade mark be registered prior to the Disputed Domain Name. As such, the Panel finds that the Complainant has satisfied the first requirement of Paragraph 4.a.(i). As to the second requirement, the Disputed Domain Name is identical to the trademark in entirety.

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.”

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

Digital Vision, Ltd. v. Advanced Chemill Systems, Case No. D2001-0827

A. The Complainant has rights in a trade or service mark, with which Respondent’s domain name is identical or confusingly similar

There are two requirements that a Complainant must establish under this paragraph; that it has rights in a trade or service mark, and that the domain name is identical or confusingly similar to the marks.

The Complainant has provided the registration documents for its DIGITAL VISION marks, within the USA and the EU. Registration for these marks postdate the domain name registration; however, Paragraph 4.a.(i) does not require that the trade mark be registered prior to the domain name. This may be relevant to the assessment of bad faith pursuant to Paragraph 4.a.(iii), which is considered below. I conclude therefore that the Complainant has satisfied the first requirement of Paragraph 4.a.(i). As to the second requirement, the domain name is identical to the trademark, except for the addition of a space between the two words in the domain name. Since it is not possible to render spaces in the domain name system, many cases have concluded domain names to be identical to trade marks in similar circumstances. I conclude that the second element of Paragraph 4.a.(i) is made out.

I conclude therefore that the Complainant has satisfied the requirements of paragraph 4.a.(i) of the UDRP.

MADRID 2012, S.A. v. Scott Martin-MadridMan Websites, Case No. D2003-0598

A. Identical or Confusingly Similar

<madrid2012.com>

The Complainant has rights in numerous trademarks including the element MADRID2012, inter alia a wordmark registered with the OEPM (Spanish Patent and Trademark Office) on January 29, 2001. As the suffix “.com” only indicates that the domain name is registered under this gTLD and is not distinctive, the Panel finds Respondent’s domain name <madrid2012.com> to be identical with Complainant’s trademarks.

These trademarks are sufficient for the purposes of the Policy, paragraph 4(a)(i), although it is noteworthy that they are quite recent and do not appear to predate the registration of the domain name in question.

Regarding the domain name <madrid2012.com> the Complainant has therefore satisfied the requirements of the Policy, paragraph 4(a)(i).

<2m12.com>, <2m12.org> and <2m12.info>

Regarding the domain names <2m12.com>, <2m12.org> and <2m12.info> the Complainant has therefore also satisfied the requirements of the Policy, paragraph 4(a)(i).

Stoneygate 48 Limited and Wayne Mark Rooney v. Huw Marshall, Case No. D2006-0916

A. Identical or Confusingly Similar

There is no dispute that the Complainants have trademark rights in the name WAYNE ROONEY, nor is there any dispute that the Domain Name is identical to that trademark if one discounts the generic domain suffix.

That being so, the Panel finds that the Domain Name is identical to a trademark in which the Complainants have rights.

As will be noted from section 5B above, the Respondent argues that the Complainants' rights should be ignored because they did not exist at the date of registration of the Domain Name.

The Panel refers to the passage in [paragraph 1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions](#) (accessible on the WIPO website),

The Panel adopts the consensus view and stands by his finding above that the Domain Name is identical to a trademark in respect of which the Complainant has rights.

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.

In this matter, the Complainant has trade mark registrations for Orient in 10 different Classes. This trade mark has been incorporated and reproduced in entirety in the Disputed Domain Name. The Consensus View lends guidance in assessing the issue of the Disputed Domain Name being registered prior to acquiring the Trade Mark Registrations and helps in concluding that it does not matter that the former was dated prior to the latter.

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

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 Name, the Respondent was obliged to submit evidence with respect to the same. In this matter, even though the Respondent has availed the opportunity of countering the allegations put forth by Complainant, and has submitted a Response, it has not 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.

The Complainant has made out a persuasive case. The Complainant’s name has been in continuous use in Pakistan since 1983. The Respondent has not rebutted this in the Response submitted.

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 it had any bona fide interest in the Disputed Domain Name, one would have expected it to have something to show for it (*e.g.* the business plan), but in this matter, it has submitted nothing which is evidence of lack of mala fide on its 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 evidence, documentary or any kind for the matter, the Panel is does

not have any information, documentary evidence, etc., with respect to the Respondent's rights or legitimate interests in respect of the Domain Name.

The file contains no evidence that the use of the Domain Name meets the elements for any of the nonexclusive methods provided for in the Policy paragraph 4(c) and therefore the Panel is unable to observe that the Respondent has rights or legitimate interest in the Domain Name pursuant to the Policy paragraph 4(a) (ii).

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 Name by the Respondent.

(iii) 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 "Orient" consistently since the year 1983 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. The Complainant has annexed further information to the Complaint in form of the invoices and other documentation on which their trade mark Orient appears, thereby illustrating the recognition and importance of the trade mark Orient to their course of trade/business.

(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. It is 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 "Orient" since 1983. 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 Name. 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 Name. 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 name that incorporate the trade mark of the Complainant in entirety and is identical and confusingly similar to the trade mark 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 a domain name with its corresponding Trade Mark "Orient", as the same has already been registered by the Respondent, thereby preventing the Complainant from availing one of the benefits/uses enjoyed by holder of a registered trade mark (i.e. domain name registration). The Panel finds it likely that 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 in fact 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 trade name as the domain name 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 Name is 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 Name.

The Panel has taken into account the Discussions and Findings in the following WIPO Authorities while rendering this Decision:

Kangwon Land, Inc. v. Bong Woo Chun (K.W.L. Inc), Case No. D2003-0320

C. Registered and Used in Bad Faith

The Complainant alleges that Respondent registered and used the Domain Name in bad faith and with the intent of making commercial gain. This allegation is non-rebutted.

On the other hand, as the translations to the trademark and service mark registrations of Complainant show that Respondent's registration of the Domain Name was prior to any of the trademark or service mark registration applications of Complainant, the first of which were filed in 1999, whereas the Domain Name was registered in 1998.

The Panel is well aware that that this situation is not directly addressed by paragraph 4(b) of the Policy. Paragraph 4(b), however, is a non-exclusive enumeration of circumstances that may prove the existence of bad faith of the disputed domain name holder.

Therefore, the Panel concludes that the requirements of paragraph 4(a)(iii) of the Policy have been sufficiently made out by the Complainant and that the Respondent's bad faith registration and use of the Domain Name has been proven.

General Growth Properties, Inc., Provo Mall L.L.C. v. Steven Rasmussen/Provo Towne Centre Online, Case No. D2003-0845

C. Registered and Used in Bad Faith

Complainant relies on a common law trademark in presenting its case to this Panel. However, the use that Complainant made of the mark prior to the registration of <provotownecentre.com> was de minimis. There is no evidence the mark had acquired secondary meaning or otherwise matured into a common law mark at the time of that domain name registration.

*One three member Panel addressed the issue of bad faith in relation to the registration of domain names occurring prior to the rise of a trademark. In *John Ode d/ba ODE and ODE - Optimum Digital Enterprises v. Intership Limited*, [WIPO Case No. D2001-0074](#), the Panel found that Complainant's trademark rights arose three years after the registration of the domain name about which it was then complaining.*

Respondent has not convincingly explained why he registered the domain name <provotownecentre.com> at the same time that the mall of the same name was announced and construction commenced. In addition, the two matching misspellings in the domain name and the name of the mall indicate to the Panel that the registration was not coincidental. As discussed above, the Panel finds that Respondent had knowledge of the name of the mall at the time the domain name <provotownecentre.com> was registered.

*The Panel follows the precedent set in *Kangwon Land, Inc. v. Bong Woo Chun (K.W.L. Inc.)*, [WIPO Case No. D2003-0320](#), and *Madrid 2012, A.A. v. Scott Martin-MadridMan Websites*, [WIPO Case No. D2003-0598](#). The Panel concludes that Respondent knew of the pending widespread announcement of the mall at the time he registered the domain name <provotownecentre.com>. Respondent hoped to either benefit from confusion and the diversion of web traffic or by selling the domain name to the trademark holder. This constitutes bad faith registration of the domain name.*

Respondent's use of the domain name <provotownecentre.com> and later registration and use of <provotownecentre.net> also constitute bad faith use and registration. Respondent has been benefiting from confusion with the land-based mall. Respondent's registration of the ".net" domain name was certainly undertaken in bad faith and with full knowledge of Complainant's dispute.

537397 Ontario Inc. operating as Tech Sales Co. v. EXAIR Corporation, Case No. D2009-0567

D. Registered and Used in Bad Faith

The Respondent's defence to the bad faith claim is that because the Domain Names, <ring-blade.com> and <ring-vac.com>, were registered prior to the Complainant's trade mark applications, none of the examples of bad faith registration and use set out in paragraph 4(b) of the Policy is applicable. The Respondent asserts that all those examples pre-suppose the existence of a trade mark.

The Panel disagrees. First, the list of examples in paragraph 4(b) of the Policy is expressed to be non-exhaustive, so there is room for a Panel to find abuse in another form. Secondly, as can be seen from the response to question [3.1 WIPO Overview of WIPO Panel Views on Selected UDRP Questions](#), the latter part of which appears to the Panel to be precisely on point, there are circumstances where the rights may post-date the registration of the domain name.

The Panel is satisfied that in the hands of the Respondent, a competitor, the Domain Names constitute an abusive threat hanging over the Complainant's head, which equates to a bad faith use under the Policy. After all, as is apparent from paragraph 4(b)(ii) of the Policy, in the view of this Panel, active use is not always a dispositive pre-requisite for the purposes of paragraph

4(a)(iii) of the Policy.

The Panel finds that the Domain Names were registered and are being used in bad faith.

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 Name, 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 trade name as to the source, sponsorship, affiliation, or endorsement of its 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 Name is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
2. The Respondent has no legitimate interest in the Complainant's Domain name.
3. The domain name is confusingly similar/ identical.
4. The Respondent is 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 Name 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: 22nd January, 2012

Sole Panelist: Barrister Samay Shams