

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Dubizzle Limited BVI v. Muhammad Ammad Siddique

Case No. C2015-0001

Also in PDF C2015-0001

1. The Parties

The Complainant is Dubizzle Limited BVI, having its office at Pasea Estate, Road Town, Tortola, VG1110, British Virgin Islands.

The Complainant has initiated the Complaint vide their authorized representative, Ms. Helena Myrin of CSC Digital Brand Services AB, located at Saltmätargatan 7, Box 3396, 103 68 Stockholm, Sweden.

As per the PKNIC Whois database, the Respondent is Muhammad Ammad Siddique and the contact details are ammadiddique2008@gmail.com [provided by Registry]

2. The Domain Name and Registrar

The domain name in dispute is < DUBIZZLE.com.pk >, hereinafter referred to as the Disputed Domain Name and has been registered by Muhammad Ammad Siddique since 2013.03.04 until 2015.03.04.

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.

A complaint was received and accepted by the Domain Name Dispute Resolution Center (the “DNDRC”) with all completed formalities as on 15th October 2014.

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 17th December, 2014 and the Respondent was asked to provide DNDRC with the Response in the format provided. The Respondent was informed that if a Response in accordance with the Rules, on the Response Form provided was not received within 10 days from the notification, the dispute would proceed *ex parte*.

The Respondent failed to submit a 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.

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 language of the proceedings is English.

4. Factual Background

The Disputed Domain Name has been registered by the Respondent as of 2013.03.04 until 2015.03.04.

Parties' Contentions

The Complaint contends the following:

- 1. Founded in 2005, the Complainant's platform Dubizzle.com is the Middle East and the North Africa (MENA) region's leading online classifieds and community portal, facilitating trade by providing an online marketplace. In August 2013, Naspers (also owner of the popular classified site OLX) acquired a 25% stake in Dubizzle.com, which was increased to 54% during 2014. With a presence in 11 countries and over 21 cities, the Complainant has over 8 million visitors to its website, viewing more than 290 million pages, every month (Annex 12A-B). For more information about the history of the Complainant see Annex 12C-D.*
- 2. Dubizzle.com is followed by a large group of people working in the*

United Arab Emirates (UAE), with a total of 75% of visits originating within the UAE. Of this, 40% are Western expatriates and 20% are from the MENA region, in addition to a significant number of expatriates from Pakistan and India (see Annex 12E for a breakdown over the last four years of significant traffic source by geographic location).

- 3. The DUBIZZLE trademark and brand is in possession of substantial inherent and acquired distinctiveness, and are well-recognized by the broader community where the Complainant operates. Currently, the Complainant is targeting the markets in the UAE, Egypt, Saudi Arabia, Kuwait, Qatar, Bahrain, Oman, Jordan, Lebanon, Algeria and Tunisia).*

Remedies Sought by the Complainant:

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

Respondent's Contention:

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 the proceedings in default and to determine the matter based upon the Complaint.

5. Jurisdiction

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

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

6. Discussion and Findings

In the 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 Complaint and will deal with each of the sub-issues sequentially below.

The application for the registration of the Disputed Domain Name on behalf of the Complainant is regulated by the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 and the UDRP Rules. The PKNIC Policy states:

“You, the applicant who wants to register a domain name under .PK is presumed to have read and agreed to this PKNIC Internet Domain Registration Policy”.

The Respondent applied for registration of the Disputed Domain Name on the basis of these regulations and was allowed registration subject to the same. Hence the relationship between the Respondent and PKNIC with respect to PKNIC’s domain name registration service is governed by the PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4.2 and the UDRP Rules, as such the Respondent’s registration must be legitimate and in accordance with the requirements of these regulations and Rules.

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.**”*

Correspondingly the 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 in the present context the decision of the dispute shall be addressed with respect to the following aspect:

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

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

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

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

e. in the opinion of PKNIC is not appropriate for registration.

The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 paragraph 4 also states that:

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

Therefore, for the assessment of illegality, unlawfulness or otherwise invalidity of the Application & Registration of the domain name in dispute, the application and registration of the Disputed Domain Name shall be assessed under the following aspects:

- 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?

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

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

The complainant has submitted that:

In accordance with Paragraph 3(b)(viii) of the Rules, provided as Annex 6A is a list of the trademarks on which the Complaint is based. Complainant Dubizzle Limited BVI (hereinafter "the Complainant is the sole owner of the DUBIZZLE trademark, with trademark registrations in Saudi Arabia and Lebanon, including both the DUBIZZLE logo and word mark (Annex 6B-F). In addition, the Complainant has filed trademark applications which are in the final stages of the registration process in several countries (Annex 6A). The trademark registrations in Saudi Arabia

and Lebanon are made in Nice class 35 for “online advertising services for others, namely, providing advertising space on Internet websites, online advertising on computer communication networks, providing classified advertising space via the global computer network, promoting the goods and services of others over the Internet and providing online computer databases and online searchable database featuring classified listing and want ads”.

The Complainant operates an online classifieds site, namely Dubizzle.com (Annex 10), that enables users to buy and sell goods, including vehicles, real estate, tickets, and electronics; solicit and offer services, such as babysitting, event services, and repairs; design ads to post on the website; display ads on profiles across social networking sites, such as Facebook; and search for jobs across numerous locations and industries. Jobs, residential property and automotive classifieds are among the most popular categories.

The Complainant has provided, along with annexing evidence of the same, that the Complainant has trademark registrations in favor of the trademark DUBIZZLE in Saudi Arabia and Lebanon and filed trademark applications which are in the final stages of the registration process in several countries, for example, Pakistan, Bahrain, Qatar, Jordan, Kuwait, Saudi Arabia, Lebanon, UAE, Egypt, Oman, Algeria and Tunisia

As submitted by the Complainant and evidence of the same annexed with the Complaint, the Complainant holds trademark registration rights to DUBIZZLE in several countries, and trademark registration is pending in Pakistan in Class 38, 35 and 42 as of the date 28th July, 2014.

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.

The Respondent has not provided any information whatsoever at all with respect to the Disputed Domain Name and as such, the Panel has no data with it in order to consider on part of the Respondent.

Therefore subject to the above stated observations, the Panel may well determine the Disputed Domain Name to be transferred to the Complainant, However for the purpose of completeness (but not to create any binding precedent requiring the same to be followed in the future), the Panel will also assess and determine the remaining issues as listed above.

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

It has been asserted by the Complainant, and has not been refuted by the Respondent, that the Complainant is the registered owner of the trade mark/name DUBIZZLE. The Complainant has registered its trademark and domain names in various countries and applied for registration worldwide in order to reflect and protect the same. The facts illustrate that the entity DUBIZZLE is internationally renowned and highly recognizable and that the same is associated with the Complainant who holds the intellectual property rights to the tradename/trademark and thereby is entitled to use it in all forms afforded by intellectual property rights legislations, inter alia, Trade Marks Ordinance, 2001 of Pakistan, which allows a trademark holder to use its trademark in corresponding domain name(s).

The Complainant has been using the trademark DUBIZZLE in providing services to the masses since 2005, well in time before the Respondent registered the Disputed Domain Name. The documentation/evidence provided by the Complainant depicts the recognition and goodwill associated with the trademark DUBIZZLE. As for the Respondent, it has not availed the opportunity to submit a Response in order for the Panel to take into deliberation. In such a case, the Panel is unable to decipher anything on part of the Respondent.

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

Before discussing this sub issue, it is imperative to clarify the grounds and consequences of the same. It is clarified that although Pakistani law does not apply by force of law over PKNIC's Jurisdiction it does however apply as a contractual term to the contract executed between the Respondent and PKNIC thus defines the scope and terms of use of the domain name under the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2. As such it is clarified for future disputes, Appeals and Complaints that illegality with respect to the Application and Registration and examination of Pakistani law in this context does not imply that Pakistani law has applicability or jurisdiction over PKNIC or the dispute in question. Conversely the fact that Pakistani law is included as part of the terms of the PKNIC- Internet Domain Registration Policy Aug 07, 2007, version 4.2, these terms therefore apply to PKNIC and all relevant parties by virtue of the contractual and representative clauses thus the examination of Pakistani law is undertaken to determine whether any and/or all of these terms and conditions have been breached, violated and/or if there exists any non-conformity by the applicant or PKNIC.

The relevant Pakistani legislations pertaining to registration of the Disputed Domain Name includes, inter alia, The Trade Marks Ordinance, 2001, The Electronic Transactions Ordinance, 2002, subject to which infringements of Trade Marks and Trade Names is equated with the

infringement of domain names hence the provisions of the Pakistan Penal Code Act, 1860 that deal with infringement of Trade Marks, would possibly also cover domain names.

Additionally under the Pakistan Penal Code Act, 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 registered trademarks/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 would increase the likelihood of giving rise to liability under the above mentioned statutes, which in turn would raise significant doubt regarding the legitimacy and bona fide of the Respondent's registration of the Disputed Domain Name.

The Panel reasonably opines and infers that the Respondent's registering the Disputed Domain Name could incur liability under the above mentioned Pakistani Legislations. This, in itself, is a basis on which this Complaint could be decided. However, for the sake of completeness and procedural fairness, 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, has made note of the issue pertaining to email(s) sent by users, being bona fide customers/consumers of the Complainant. The Panel has taken into account another way in which the use of the Disputed Domain Name would cause confusion and would be contrary to 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.

The Panel notes the manner in which any "*a reasonable bystander*" or "reasonable user" may be misled and confused when sending emails to the Disputed Domain Name, being under the impression that the same, either are or maybe that of the Complainant. 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 address corresponding to the Disputed Domain Name, considering either/all of them to be that of the Complainant. In such a manner, 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 nature of the way in which the Complainant's trademark is used 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.

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

In the opinion of the Panel this criteria has been sufficiently proven by the 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.

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

The Complainant has contended the following:

- i. As established above, the Complainant is the owner of the DUBIZZLE trademark, registered in Saudi Arabia, Lebanon, and pending registration in numerous other countries (Annex 6A-F). The fact that the Respondent registered the Domain Name prior to the registration date of the Complainant's trademarks, on March 4, 2013 (Annex 2), does not prevent a finding of identity or confusing similarity under the UDRP according to the consensus view under section 1.4 in the WIPO Overview 2.0. The UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired rights.*
- ii. The Domain Name is identical to the Complainant's DUBIZZLE trademark. When comparing the Domain Name to said trademark, the relevant comparison to be made is between only the second-level portion of the Domain Name and the Complainant's mark. See Rollerblade, Inc. v. McCrady, D2000-0429 (WIPO June 28, 2000)); see also Gardline Surveys Ltd. v. Domain Fin. Ltd., FA 0153545 (NAF May 27, 2003). Accordingly, the country code top level domain (cc TLD) ".com.pk" is irrelevant when comparing the Domain Name to the trademark.*

- iii. *Anyone viewing the Domain Name is bound to mistake it for associated or affiliated with the Complainant. The likelihood of confusion includes a mistaken association with the Complainant's DUBIZZLE trademark as there is a considerable risk that the trade public will mistakenly perceive the Respondent's Domain Name either as owned by the Complainant, or else as possessing some commercial partnership with the Complainant, when this is not the case. Indeed, when performing a Google search by entering "Dubizzle" and "Pakistan" the website connected to the Domain Name is the top result (Annex 15).*
- iv. *The above facts serve to establish that the Domain Name is not only clearly confusingly similar, but identical, to the Complainant's registered DUBIZZLE trademark.*

The Respondent has not provided any information whatsoever at all and in particular not refuted the contention put forth by the Complainant with respect to its trademark DUBIZZLE.

As is evident, the Disputed Domain Name reproduces the Complainant's trademark, thereby rendering the Disputed Domain Name confusingly similar to the trademark of the Complainant. Furthermore, the addition of the generic ccTLD indicator ".pk" cannot be taken into consideration when judging confusing similarity. It is well-established that the incorporation of a Complainant's mark in full within a disputed domain name may be sufficient to establish confusing similarity between the mark and the disputed domain name (see *Nokia Group v. Mr. Giannattasio Mario*, WIPO Case No. D2002-0782, *The Ritz Hotel Ltd v. Damir Kruzicevic*, WIPO Case No. D2005-1137, and *Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge*, WIPO Case No. D2006-1643.)

The Complainant has produced adequate evidence of its rights in the trademark DUBIZZLE. gTLD suffix ".com" or its equivalent is an integral part of a domain name and is not considered relevant to the consideration of confusing similarity. The remainder of the Disputed Domain Name, being DUBIZZLE is the strong, distinctive and globally renowned trademark of the Complainant. (see *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1059 9th Cir. 1999; "*The intentional registration of a domain name knowing that the second level domain is another company's valuable trademark weighs in favor of likelihood of confusion.*").

The Panel finds confusing similarity between the Disputed Domain Name and the Complainant's trademark under paragraph 4(a)(i) of the Policy.

III. Legitimate interest or rights in the Domain Name

The Complainant has contended:

- i. *The mere registration of a domain name does not give the owner a right or legitimate interest in the name. The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the Domain Name, nor anything that would suggest that the Respondent has been using DUBIZZLE in any other way that would provide legitimate rights in the name. Consequently, the Respondent may not claim any rights established by statute or common usage.*
- ii. *In Policy, 4(c)(ii) it is stated that where “the WHOIS information suggests that Respondent is known as an entity other than the trademark associated with Complainant, and Complainant has not licensed, authorized, or permitted Respondent to register domain names incorporating Complainant’s...mark,” a Panel should find that the respondent is not commonly known by the disputed domain name(s). See United Way of America v. Alex Zingaus, FA 1036202 (NAF Aug. 30, 2007). In the instant case, the pertinent WHOIS information for the Domain Name identifies the Registrant as “Muhammad Ammad Siddique”, which does not resemble the Domain Name in any manner (Annex 2). Thus, the Respondent cannot be regarded as having been commonly known by the Domain Name.*
- iii. *The Respondent has never had a business relationship with the Complainant. Such a fact was considered a factor in finding of non-legitimate interest with the Respondent in Dr. Ing. h.c. F. Porsche AG v. Ron Anderson, D2004-0312 (July 2, 2004). Also, in Guerlain S.A. v. Peikang, D2000-0055 (Mar. 21, 2000), the Panel stated that: “in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bona fide or legitimate use of the domain name could be claimed by Respondent.” The same reasoning applies here. The Respondent does not sufficiently disclose the lack of relationship to the Complainant. The Complainant managed to locate an attempt to “disclose” said relationship when clicking on the “About Us” tab in the right bottom corner of the website (Annex 11A). However, the Respondent’s attempt is not sufficient to form an effective defense.*

See the similar case No. D2003-0316, Pliva, Inc. v. Eric Kaiser, where the disclaimer read: "Antabuse is Manufactured by Ayerst Laboratories, Inc. A Wyeth-Ayerst Company. This site is not endorsed or affiliated with the company Ayerst Laboratories, Inc." The Panel stated that there were at least two reasons why this disclaimer was not effective: "First, it comes after a full page of marketing where the "Antabuse" name appears many times. Second, the disclaimer appears only towards the bottom of the home page, after the customer's ordering option."

- iv. *The Respondent is using the Domain Name to operate a commercial website, copying the business of the Complainant. Further, modified copies of the Complainant's logotype have been displayed on said website (compare Annex 10A and Annex 11A) and on several Social Media accounts promoting the same (Annex 11C). In case No. D2000-0385, Kyocera Mita Corporation and Kyocera Mita America, Inc. v. Office Land, it was stated that: "The panel finds that the use of the domain name was so closely associated with this improper use of the logotype that the respondent's use of the domain name in connection with its offering of goods or services was not bona fide." The same reasoning applies here. By referring to the above, the Respondent is today clearly not using the Domain Name in connection with a bona fide offering of goods or services. In case, Drexel University v. David Brouda, D2001-0067 (Mar. 27, 2001) the Panel stated that: "rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the Complainant."*
- v. *As demonstrated, DUBIZZLE is a famous trademark where the Complainant operates. The Respondent has no rights or legitimate interest in respect of the Domain Name. There is no disclaimer on the website and the Respondent is using the Domain Name to intentionally and specifically targeting its customers and falsely attempting to pass itself off as the Complainant. This, among other facts stated throughout this complaint, proves that the Respondent's interests cannot have been legitimate.*

The Respondent has not submitted a Response, nor has it provided any information, annexures, evidence, documentation or the like to support its registration of the Disputed Domain Name and in particular assert a legitimate interest in the Disputed Domain Name.

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

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

Paragraph 4(a)(ii) states that:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Although paragraph 4(a)(ii) requires the Complainant to prove that the Respondent has no rights to or legitimate interests in the Domain Name, once the Complainant establishes a *prima facie* case that none of the three circumstances establishing the legitimate interests or rights applies, the burden of production of evidence on this factor shifts to the Respondent to rebut the showing, despite the overall burden of proof remaining upon the Complainant to prove each of the three elements of paragraph 4(a). (*Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270; *Universal City Studios, Inc.*, *supra*).

In the present case, on the evidence before the Panel there is nothing to suggest that the Respondent seeks to bring itself within any one of the three abovementioned categories or demonstrate any other basis of a right or legitimate interest. Also, there is no evidence suggesting that an approval was ever sought by the Respondent from the Complainant who has trademark rights in the mark DUBIZZLE. It further avers that even upon becoming aware of the existence of the Complaint, the Respondent did not avail the opportunity to submit a Response and put before the Panel its case.

The Panel accordingly finds that the Complainant has established the second element in terms of paragraph 4(a)(ii) of the Policy.

Furthermore, the Respondent has failed to demonstrate any rights or legitimate interests with respect to the Disputed Domain Name and has, in effect conveyed lack of legitimate interest and

rights pertaining to the Disputed Domain Name. The Panel is unable to find that the Respondent has any legitimate interest and rights to the Disputed Domain Name.

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

The Complainant has made the following submission:

- i. *The Respondent registered the Domain Name on March 4, 2013, subsequent to the registration of the Complainant's Domain Name and launch of its famous platform on the website Dubizzle.com, registered on July 13, 2005 (Annex 10A-C).*
- ii. *The Complainant argues that it had unregistered common law rights in the mark DUBIZZLE prior to when the Domain Name was registered. According to section 1.7 of the WIPO Overview 2.0, the Complainant is to be considered to have such rights it can prove that the name has become a "distinctive identifier associated with the Complainant and its services". Moreover, it is stated that: "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." See for example Australian Trade Commission v. Matthew Reader, case No. D2002-0786c, where it was stated that: "the Policy makes no distinction between localized and widespread trademark rights, and there is no requirement that a Complainant own a famous mark to invoke the protections of the Policy".*
- iii. *The DUBIZZLE trademark, in respect of online classified services, has the status of a well-known trademark with a substantial and widespread reputation throughout the communities in the 11 countries, and over 21 cities, where the Complainant operates. As stated above, the Complainant's platform was launched in 2005. The Complainant's has been generating revenue from its business since 2006. The life to date revenue generated by the Complainant is USD 67,5 million. According to Ghighi.com - Premium Website Statistic,*

Dubizzle.com is worth over EUR 8,6 million, with earnings of over EUR 8,000 per day (Annex 12F). During this time the Complainant has invested USD 28 million in marketing activities; advertisement and media recognition, including brand building and Social Media presence. Most of these activities were carried out prior to the Domain Name was registered (see Annex 14A-B for examples of video campaigns and interviews).

- iv. Already in 2011, “Dubizzle” was one of the top three fastest rising words used to Google search in the UAE, next to “Facebook” and “Cricket live” (Annex 12G). In the same year, the Complainant’s co-founder was interviewed by the TV channel, Dubai One. Following this event, the Complainant had a video campaign to celebrate the 40th National Day in the UAE and another one called “What is Dubizzle?”, prominently displaying the DUBIZZLE logo and brand name (Annex 14B). In 2012, the Complainant had several campaigns. For example, one campaign promoting a new function connected to Dubizzle.com where users can upload photos when placing ads on their iPhone. Moreover, a major marketing campaign named “Give a Gift a Home” was carried out in the UAE in 2012-2013, at cost of USD 250 000, including radio commercials, outdoor and digital campaigns, as well as building public relations, including a video campaign regarding unwanted gifts which currently has 937,246 likes (Annex 14B-C). In February 2013, the Complainant was undertaking a major marketing push to promote its website in Egypt, at a cost of USD 2000 000, including TV commercials, outdoor and digital campaigns, as well as building public relations (Annex 14D-E).*
- v. In order to promote its business the Complainant has several Social Media accounts (Annex 13). For example, the Complainant’s Facebook page “DUBIZZLE”, which currently has 2,697,632 likes. Here users can follow the “Life Events” of Dubizzle, for example that; Dubizzle.com had 1 million page views per month in 2006, which increased to 10 million page views in early 2009 (Annex 14F).*
- vi. By referring to the above, it has been proven that the name DUBIZZLE has become a “distinctive identifier associated with the Complainant and its services”. Consequently, the*

Complainant is to be considered to have had unregistered common law rights in the trademark DUBIZZLE, when the Domain Name was registered.

- vii. *The vast majority of the Complainant's trademark applications for the DUBIZZLE mark were filed shortly after the Domain Name was registered. However, coupled with the arguments throughout this complaint, it is obvious that it is the fame of the DUBIZZLE brand which has motivated the Respondent to register the Domain Name. Indeed, the Complainant's Dubizzle.com platform is attracting an enormous amount of visitors every day (Annex 12A) with a Compete Traffic rank of over 48,000 and an Alexa rank of 1,066 worldwide (Annex 9B). As stated above, a significant number of the Complainant's users are expatriates from Pakistan and India, and it is unlikely that the Respondent was unaware of the DUBIZZLE brand when the Domain Name was registered (Annex 12E). In fact, it is quite obvious that the popularity of the Complainant's brand is being targeted by the Respondent in order to direct traffic to its own commercial website, disrupting the Complainant's business in the process. See Vevo LLC v. Ming Tuff, FA 1440981 (NAF May 29, 2012).*
- viii. *The Complainant first tried to contact the Respondent on August 12, 2014, through a cease and desist letter, sent by e-mail to the concerned registrar asking it to forward said letter (Annex 16). The Complainant advised the Respondent that the unauthorized use of the DUBIZZLE trademark within the Domain Name violated the Complainant's rights in said trademark. The Complainant requested a voluntary transfer of the Domain Name and offered compensation for the expenses of registration and transfer fees (not exceeding out of pocket expenses). However, the Respondent never responded to this letter.*
- ix. *To stop the ongoing trademark infringement, the Complainant initiated actions to have the Social Media accounts removed and the website taken down. As a result, most of the accounts were suspended. The Respondent replied to the Complainant's take down team, claiming to be using a totally different logo, design and content on their website, not copying anything from the DUBIZZLE brand, referring to the URL address "www.dubizzle.com.pk/firstindex.php". The Respondent*

claimed to have obtained a right to use the name “Dubizzle International” through the registration of the Domain Name, and claimed that the existence of the so called “disclaimer” on the website was enough. Nonetheless, the Respondent promised to remove any copyright issue that the Complainant could find on the website. The Complainant informed the Respondent of the infringing domain name registration, Social Media accounts and website content; in addition, it requested a voluntary transfer of the Domain Name to solve the issue amicably. The Respondent claimed not to be responsible for the Social Media accounts promoting its website. Further, the Respondent claimed to have contacted the Complainant prior to the registration of the Domain Name and that it had replied that it were not interested, nor needed, the Domain Name. As the Complainant did not recall to have engaged in such conversation it requested proof. The Respondent provided a screen shot (Annex 17A) showing an offer from the Respondent to sell the Domain Name and a reply from the Complainant’s Support Team stating: “Your satisfaction is important to us, and we value your feedback”. Clearly, this was an automated reply and it does not create any legitimate interest for the Respondent to use the Domain Name to build a commercial website, copying the Complainant’s business. Further, the Respondent explained that it had reached out to the Complainant with the purpose of selling the Domain Name when it was registered. As a final point, the Respondent encouraged the Complainant to make a serious business proposal in the matter (Annex 17B).

- x. Since the Complainant’s efforts to solve this matter amicably were unsuccessful, the Complainant chose to file a complaint according to the UDRP process.*
- xi. Besides declaring that the Respondent knew about the Complainant and its DUBIZZLE brand at the point of the registration, the “proof” shows that the Respondent was aware that building a classified site targeting Pakistan using this Domain Name would affect the Complainant’s business.*
- xii. The Respondent is using the Domain Name to operate a commercial website, directly copying the business of the Complainant. Indeed, the color scheme and structure of the website (the navigation menu, search function, ad posting tab,*

etc.) is practically identical to the Complainant's platform Dubizzle.com, and the Respondent claims to be active in the same countries as the Complainant (compare Annex 10A and Annex 11A). Also, it is quite clear that the Respondent has created Social Media accounts to promote said website through the Domain Name, incorporating the Complainant's DUBIZZLE mark, and displaying modified copies of its trademarked DUBIZZLE logo (Annex 11A and Annex 11C). Thus, the Respondent has been using the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to the website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the website, constituting bad faith registration and use under Paragraph 4(b)(iv) of the Policy.

- xiii. Considering that the Domain Name fully incorporates the DUBIZZLE trademark, and that the Respondent went so far as to pass itself off as the Complainant, disrupting the Complainant's business, the registration also qualifies as a bad faith registration and use under Paragraph 4(b)(iii) of the Policy. See *EthnicGrocer.com, Inc. v. Unlimited Latin Flavors, Inc.*, FA94385 (NAF July 7, 2000).*
- xiv. Finally, it is quite clear that the Respondent registered to Domain Name primarily in order to sell the Domain Name to the Complainant, for an amount exceeding out of pocket expenses, which constitutes evidence of bad faith under Paragraph 4(b)(i) of the Policy. In case No. D2000-0243, *CBS Broadcasting, Inc. v. Gaddoor Saidi*, the Panel stated that: "an offer to sell the domain name for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name is not only evidence of, but conclusively establishes that, the domain name has been registered and is being used in bad faith. Policy, ¶ 4(b)(i)."*
- xv. It has been established that a "finding of bad faith hinges squarely on the probability that it was more likely than not that the respondent knew of, and targeted, the complainant's trademarks," and the above paragraphs should be taken as having met this standard. See *GO Local NC Farms, LLC v. Paul Darcy*, FA 1426087 (NAF Mar. 13, 2012). Consequently, the Respondent should be considered as having registered and used the Domain Name in bad faith.*

In regards to the issue of bad faith the Paragraph 4(b) of the UDRP states that:

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

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

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

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

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

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

The Complainant has demonstrated, vide the Complaint and the Annexures provided, that it has trademark rights to DUBIZZLE and that the Disputed Domain Name is confusingly similar to their trademark. By virtue of the Respondent having registered the Disputed Domain Name, the Complainant is unable to utilize to full potential its intellectual property rights, which it has sought to protect by way of several trademark registrations in various jurisdictions across the world.

Furthermore, the Respondent has not responded to the contentions and assertions put forth by the Complainant, nor has it refuted any of the allegations brought by the Complainant. The Respondent has not provided any information whatsoever at all to the DNDRC that could have been taken into account for the purposes of this Decision.

As such, the Panel is unable to infer any bona fide on part of the Respondent.

WIPO Authorities:

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

Furthermore, the Panel has also relied upon the Discussions & Findings in several WIPO Administrative Panel Decisions, inter alia:

- CBS Broadcasting, Inc. v. Gaddoor Saidi, WIPO Case No. D2000-0243,
- Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525
- Advance Magazine Publishers Inc. v Marcellod Russo, WIPO Case No. D2001-1049
- McMullan Bros., Limited, Maxol Limited, Maxol Direct Limited Maxol Lubricants Limited, Maxol Oil Limited Maxol Direct (NI) Limited v. Web Names Ltd, WIPO Case No. D2004-0078
- NB Trademarks, Inc. v. Domain Privacy LTD and Abadaba S.A., WIPO Case No. D2008-1984
- The South African Football Association (SAFA) v. Fairfield Tours (Pty) Ltd, WIPO Case No. D2009-0998

8. Decision

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

- i. 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.
- ii. The Respondent has no legitimate interest in the Disputed Domain Name.
- iii. The Disputed Domain Name is identical to the Complainant's trademark/names and registered domain names.
- iv. The Respondent is making mala fide use of the Complainant's trade marks/names.
- v. Pursuant to Paragraphs 4 of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2, and Paragraph (i) of the UDRP the Panel therefore recommends to PKNIC to transfer the registration of the Disputed Domain Name <dubizzle.com.pk> to the Complainant, as prayed for within 48 hours of receipt of

this decision by email or it being uploaded onto the DNDRC website www.dndrc.com/cases_resolved/, whichever takes place earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Mr. Mustafa Syed

Sole Panelist

Date: 24th February, 2015