

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

OLX B.V. v. Paradise Estate and Construction Company

Case No. C2015-0002

Also in PDF C2015-0002

1. The Parties

The Complainant is OLX B.V., having its office at Taurusavenue 105, 2132 LS Hoofddorp.

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 Paradise Estate and Construction Company and the contact details are khalid_pakistan_skp@yahoo.com [provided by Registry].

2. The Domain Names and Registrar

The domain name in dispute is <OLX.org.pk>, hereinafter referred to as the Disputed Domain Name and has been registered by Paradise Estate and Construction Company since 24.09. 2011 until 24.09.2019.

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 19th February, 2015.

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 March, 2015 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 24.09. 2011 until 24.09.2019.

5. Parties Contentions

A. Complainant

The Complainant’s contentions are reproduced below:

Founded in 2006 and based in Hoofddorp, The Netherlands (see Annex 7), the Complainant is today one of the world’s leading free online classifieds platforms. Indeed, the Complainant is currently present in over 40 countries and its service is available in 42 languages. Together with its subsidiary, OLX Inc., the Complainant has registered domain names incorporating the OLX trademark in several countries across the world (see Annex 8). The Complainant’s online classifieds platform is No.1 in Pakistan, India, Brazil, and several other countries. The Complainant maintains offices in Buenos Aires,

Cape Town, Delhi, Sao Paulo, Rio de Janeiro, Lisbon and New York, and operates subsidiaries in Argentina, Pakistan and in China where the Respondent is located. The Complainant's platform has over 200 million monthly unique users generating traffic of over 11 billion monthly page views, or around 360 million page views per day (see Annex 12). The fame of the OLX trademark has been established in previous UDRP decisions, for example; in the recent case No. D2014-1037, OLX, Inc. v. J D Mason Singh, involving the Complainant, where it was stated that: "The Panel recalls that the trademark OLX is a well-known trademark..." In case No. D2013-0473, OLX, Inc. - OLX S.A. v. PrivacyProtect.org / Saqib, N/A, Rana Saqiband, the Panel stated that: "The Complainant has rights in the mark OLX by virtue of its registered trademarks. The Complainant has also acquired common law rights derived from extensive trading under the name "OLX"." As demonstrated, the OLX trademark is in possession of substantial inherent and acquired distinctiveness, and the OLX mark and brand are well-recognized by consumers, industry peers, and the broader global community in all of its markets.

Hence, the Complainant seeks the following remedies:

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 that the disputed Domain Name be transferred to the Complainant.

B. Respondent

The Respondent has not submitted any response to DNDRC.

Under section 5(e) of the UDRP, in the absence of a response, the Panel has the authority to commence the proceedings in default and to determine the matter based upon the Complaint.

6. Jurisdiction

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy 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.

7. Discussion and Findings

In *Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001)*, the Panel laid down the following 4 heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy, dated 07-Aug-2007, version 4.2 and the UDRP:

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 mark 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, tortious 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 of the Application & Registration

The PKNIC - Internet Domain Registration Policy Aug-07-2007 version 4.2 clearly states that it creates an exception for and thus, excludes the registration of 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.*

As per the PKNIC - Internet Domain Registration Policy Aug-07-2007, version 4.2,

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 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, PKNIC reserves 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:

Complainant OLX, B.V. (hereinafter referred to as the Complainant) is the owner of the OLX trademark, which is the principal trademark relevant to this complaint. In accordance with Paragraph 3(b)(viii) of the Rules, provided as Annex 6A, are lists of the registered trademarks on which the Complaint is based, including a copy of the trademark certificate for OLX in Pakistan, where the Respondent resides (see Annex 6B). All of these trademarks are registered in at least Nice class 35: “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”. Some trademarks also cover Nice class 38 for telecommunications, among other classes.

The trademark OLX is short for “online exchange”. The Complainant operates online classifieds sites 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 Complainant’s

*website; display ads on profiles across social networking sites, such as Facebook; and search for jobs across numerous locations and industries (see **Annex 10A**).*

The Complainant has provided, along with annexing evidence of the same, that the Complainant has trademark registrations in favor of the trademark OLX in several countries across the world including Pakistan.

As submitted by the Complainant and evidence of the same annexed with the Complaint, the Complainant holds trademark registration rights to OLX in several countries, including Pakistan in class 35 and class 38.

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 OLX. The Complainant has registered its trademark and domain names in various countries. The facts illustrate that the entity OLX 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 OLX in providing services to the masses since 2006, 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 OLX. 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 apply as a contractual term to the contract executed between the Respondent and PKNIC and 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 in Appeal by the Court of Appeal. As such similarly, in this case the registration of the Disputed Domain Name by the Respondent would 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 to a trademark or service mark in which the Complainant has rights

The Complainant has contended the following:

- i. As established above, the Complainant is the owner of the famous OLX trademark, registered in numerous countries across the world, including in Pakistan (see **Annex 6A-B**). A comparison between the Domain Name and the OLX trademark shows that the Domain Name is clearly confusingly similar to said trademark. In fact, it is identical as it reproduces the entirety of the trademark, without the addition of prefixes or suffixes that has become so common in similar cases. In UDRP Case No. D2011-1537, Flybe Group PLC v. Robb Dobin, regarding the domain name theflybe.com, the panel stated that: “it has been held in many previous UDRP cases that incorporating a trademark in its entirety is typically sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see Oakley, Inc. v. Kate Elsberry, Elsberry Castro, Case No. D2009-1286 and World Wrestling Federation Entertainment, Inc. v. Ringside Collectibles, Case No. D2000-1306).”*
- ii. The addition of the country code top-level domain (cc TLD) “.org.pk” does not have any impact on the overall impression of the dominant portion of the Domain Name and is therefore irrelevant to determine the confusing similarity between the trademark and Domain Name.*
- iii. Anyone viewing the Domain Name is bound to mistake it for a name linked, associated, or affiliated with Complainant. The likelihood of confusion obviously includes a mistaken association with the Complainant’s OLX trademark as there is a considerable risk that the trade public will mistakenly perceive the Respondent’s Domain Name either as a domain name owned by the Complainant, or else, as possessing some commercial partnership with the Complainant. The overall impression given by the Domain Name is that it is somehow connected to the Complainant, when in fact it is not. This is particularly true since the Complainant runs its own extremely popular website under the similar domain name “OLX.com.pk” (see **Annex 9D** and **Annex 10C**). By using the trademark as a domain name, the Respondent exploits the goodwill and fame of the trademark, which may result in dilution and other damage to the Complainant’s trademark and brand.*
- iv. In summary, the above facts serve to establish that the Domain Name is identical to the Complainant’s famous OLX 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 OLX.

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 OLX 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 interests in a domain name

The Complainant has contended:

- i. *The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the Domain Name. There is also no evidence, including the whois, to suggest that the Respondent has been commonly known by the Domain Name. In fact, the Complainant has not found anything that would suggest that the Respondent has been using OLX in any other way that would provide legitimate rights in any of the names. Consequently, the Respondent may not claim any rights established by common usage.*
- ii. *It is also clear that no license or authorization of any kind has been given by the Complainant to the Respondent to use the OLX trademark. However, no disclaimer has been used on the website connected to the Domain Name explaining the non-existent relationship with the Complainant. 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.” In the instant case, the Respondent is not an authorized provider or dealer of the Complainant’s services and 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).

- iii. It is obvious that it is the fame of the trademark that has motivated the Respondent to register the Domain Name. Certainly, the Respondent has been 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 were practically identical to the Complainant’s website. In addition, sponsored links promoting a dating site by showing half naked women have been displayed on the website, clearly tarnishing the Complainant’s trademark (compare **Annex 10A** and **Annex 11**). Thus, the Respondent has clearly not been 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.” The same reasoning applies here.*
- iv. Moreover, the Respondent has been using a modified copy of the Complainant’s logo in order to create a false link to the Complainant. The use of logos has been discussed in several other cases, see for example, LEGO Juris A/S v. Probuilders, case No. D2011-0226, where the Panel stated: “The prominent use by the Respondent of the Complainant’s own logo is clearly designed to imply a connection between the Respondent and the Complainant. Accordingly, such use of the disputed domain name could not be said to be bona fide.” The same reasoning applies here.*
- v. By virtue of the fact that Respondent has been using the Domain Name to copy the Complainant’s business, intentionally and specifically targeting the Complainant’s customers and falsely attempting to pass itself off as the Complainant, the Respondent must necessarily have been aware of and known of the Complainant and its OLX trademark. Thus, the Respondent cannot claim to have been using said trademark without being aware of the Complainant’s rights to it.*
- vi. Thus, the Respondent has no rights or legitimate interest in respect of the Domain Name.*

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 OLX. 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 in bad faith

The Complainant has made the following submission:

- i. *The OLX trademark is well-known with a substantial and widespread reputation throughout the Community where the Complainant operates. The Respondent registered the Domain Name on August 24, 2011, subsequent to the registration of numerous of the Complainant's trademarks (see **Annex 6A**), as well as the launch of the Complainant's famous websites OLX.com (registered on February 8, 1999), OLX.in (registered on February 22, 2006) and OLX.com.pk (registered on March 6, 2007) (see **Annex 10D-F**).*
- ii. *The Complainant's website OLX.in has a rank of 23 on the Alexa Traffic Rank in India, and 362 worldwide (see **Annex 9C**), and its website OLX.com.pk has a rank of 10 on the Alexa Traffic Rank in Pakistan, and 1,662 worldwide, clearly showing a very high level of popularity in these jurisdictions (see **Annex 9D**). Thereby, it is obvious that its fame and popularity is being targeted by the Respondent in order to direct traffic to its own commercial website. Indeed, the Complainant runs the largest Online Marketplaces in both India and Pakistan. See *Vevo LLC v. Ming Tuff*, FA 1440981 (NAF May 29, 2012) ("the only feasible explanation for Respondent's registration of the disputed domain name is that respondent intends to cause confusion, mistake, and deception by means of the disputed domain name. Accordingly, any use of the disputed domain name could only be in bad faith").*
- iii. *The Complainant first tried to contact the Respondent on August 22, 2014, through a cease and desist letter sent by email (see **Annex 13A**). The Complainant advised the Respondent that the unauthorized use of the OLX trademark within the Domain Name violated the Complainant's rights in said trademark. The Complainant requested a voluntary transfer of the Domain Name. However, the Respondent did not comply with this request, instead, someone claiming to be the Respondent's representative replied claiming that "OLXian" is a trademark which has nothing to do with the OLX trademark. In addition, the*

*representative claimed that the website connected to the Domain Name had a different color scheme and structure than the Complainant's famous websites. Moreover, the representative informed the Complainant that the Domain Name had cost the Respondent USD 115,200 during a four year period (please note, however, that the Domain Name only have been registered for three years), including SEO expenses, holding staff and office rent and that the Respondent would solve the matter amicably only if the Complainant met the necessary expenditures of the Respondent, referring to the amount above. Further, in the absence of a positive response from the Complainant, the Respondent reserved itself the right to take further action (see **Annex 13B**). Once more, the Complainant requested a voluntary transfer and advised the Respondent to run its business under the name "OLXian", if it did have such a trademark, without copying the trademark of the Complainant. The Respondent's representative warned the Complainant that it would initiate proceedings against the Complainant in case it did not comply with the Respondent's payment request. Next, the Respondent's website developer stated that they had changed the logo on the website, sharing a screen shot showing no real difference from before (see **Annex 11**). The Complainant explained that either way the Respondent was still infringing on the Complainant's trademark and gave the Respondent one last chance to solve the matter amicably. The Respondent's representative replied that it would get back with a response after consultation with the Respondent; however, no further response was ever received (see **Annex 13C**). As a consequence, and to stop the ongoing trademark infringement, the Complainant was forced to initiate actions to have the site taken down due to brand abuse (see **Annex 14**). Since the Complainant cannot rest as long as the Domain Name is in the hands of the Respondent, it also chose to file a complaint according to the UDRP process, adopted by the registration authority of .PK.*

- iv. *It is quite clear from the correspondence above that the Respondent wanted to sell the Domain Name to the Complainant for an amount exceeding out of pocket expenses. 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).*
- v. *Even if the website is currently inactive, such passive holding could constitute an act of bad faith and any realistic use of the Domain Name by the Respondent*

would constitute “passing off” and/or trademark infringement. In the UDRP case D2009-0938, where the website resolved to an inactive website, the Panel stated: “there is no evidence or suggestion that the Respondent had any intention of using the domain name for any purpose or legitimate activity consistent with good faith use. Paragraph 3.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions states the lack of active use of the domain name does not as such prevent a finding of bad faith. The Panel must examine all the circumstances of the case to determine whether a respondent is acting in bad faith. The Complainant’s well-known registered and unregistered trademark and the impossibility of conceiving a good faith use of the domain name are indicative of bad faith. The Panel infers bad faith use considering the circumstances surrounding registration”. In the current case, surrounding circumstances would definitely be the Complainant’s high level of popularity in India and Pakistan in addition to the Respondent’s previous use of the Domain Name and the impossibility of conceiving a good faith use of the Domain Name.

- vi. *Prior to the Complainant having the site taken down, the Domain Name was connected to a commercial website offering services identical to those of the Complainant, using a modified copy of its logo (see **Annex II**). In the above mentioned case, No. D2011-0226, the Panel discussed the use of the Complainant’s logo: “In the Panel’s view, it is obvious that the Respondent registered the disputed domain name with the Complainant’s distinctive and well-known trade mark in mind. As mentioned above, the Respondent has resold the Complainant’s products under the banner of the Complainant’s own logo, thereby deliberately seeking to imply a connection with the Complainant.” Also in this case, the Respondent must have been aware of the Complainant and its OLX trademark when registering and using the Domain Name.*

- vii. *By using the Domain Name for purposes of copying the Complainant’s business and displaying sponsored links, the Respondent has not been making a legitimate or fair use, but misleadingly diverted consumers for his own commercial gain. In case No. D2011-1933 Inter Ikea Systems B.V. v. Daniel Woodson, the Panel stated: “The Panel has already found that Internet users are likely to be misled by the confusing similarity between the disputed domain name and the Complainant’s trade mark into supposing that the disputed domain name indicates a site belonging to, or authorized by, the Complainant where the Complainant’s coupons can be obtained or exchanged. The only rational reason for using such a domain name would be to attract some of the Complainant’s*

customers to the Respondent's site. Once there, at least some of them will click the sponsored links for which the Respondent will be paid. This falls full square within the ambit of paragraph 4(b)(iv) of the Policy. Accordingly the Panel finds that the disputed domain name was registered and is being used in bad faith." This reasoning applies here as well.

- viii. *Thereby, the Respondent has been using the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the website. Thereby, the Respondent should be considered as having registered and used the Domain Name in bad faith under Paragraph 4(b)(iv) of the Policy. Moreover, the Respondent is potentially causing the Complainant to lose traffic intended for its official website OLX.com.pk, disrupting the Complainant's business in the process.*
- ix. *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).*
- x. *By referring to the above, 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 OLX 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

The Panel recognizes and appreciates the contributions the Complainant made in assisting this Panel through proper drafting of the Complaint with adequate supporting evidence allowing this Panel to come to its decision regarding this issue.

Analyzing the details provided by the Complainant, the Panel perceives that the OLX marks and the Registered Trade Marks are recognized, both, domestically, and globally, hence the Complainant reserves crucial interest in them. Usage of these marks by the Respondent for unfair commercial gain could endanger the reputation that the Complainant has worked hard at building and maintaining.

Taking all of the case law and discussion above into consideration, the Panel is of the opinion that the Respondent registered the domain name in dispute <OLX.org.pk> with mala fide intent.

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

1. The Respondent's registration of the domain name in dispute is contrary to the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2
2. The Respondent has no legitimate interest in the Disputed Domain name.
3. The Disputed Domain Name is identical to the Complainant's trademark/names and registered domain names.
4. The Respondent unfair use of the Complainant's trade marks/names for personal commercial gain.

Pursuant to Section 4 of the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2, and Section (i) of the Policy, the Panel therefore recommends that PKNIC transfer the registration of the domain name in dispute <www.OLX.org.pk> 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.

Arbitrator: Mr. Mustafa Syed

Sole Panelist

Date: 23rd March, 2015