

**Domain Name Dispute Resolution Center (DNDRC)**

**Arbitration and Mediation Center**

**COMPLAINT PANEL DECISION**

**Khalil Ahmad v. Dizyn.com**

**Case No. C2016-0002**

**Also in PDF C2016-0002**

**1. The Parties**

The Complainant is Mr. Khalil Ahmad of Paknic Private Limited & Paksys Software LLC. Having its office at 116 Salem Road, North Brunswick, NJ 08902, U.S.A., and having a regional office at 6LG Business Center, 73-Shadman, Lahore 54000, Pakistan.

The Complainant has initiated the Complaint vide his authorized representative, Mr. Aqeel Ahmad and his stated address is 6LG Business Center, 73-Shadman, Lahore 54000 Pakistan.

As per the PKNIC Whois database, the Respondent is dizyn.com and the contact details are [dizyn1@gmail.com](mailto:dizyn1@gmail.com) [provided by Registry].

**2. The Domain Names and Registrar**

The domain name in dispute is <pakhost.pk>, hereinafter referred to as the Disputed Domain Name and has been registered by dizyn.com since 18.05.2012.

**3. Procedural History**

Under the Supplemental Rules of DNDRC which override the ICANN Rules for Uniform Domain Name Dispute Resolution Policy in terms of paragraph 2 of the PKNIC - Internet Domain Registration Policy v 4.2, 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 19<sup>th</sup> January, 2016.

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 4<sup>th</sup> February, 2016 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 was sent a second notice on 26<sup>th</sup> March, 2016 and was asked to provide DNDRC with a Response within 7 days. Subsequently, on 1<sup>st</sup> April, 2016, the Respondent submitted the Response in the format provided via the email address provided by the Complainant and PKNIC ([dizyn1@gmail.com](mailto:dizyn1@gmail.com)).

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Ms. Zahra D’souza 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 domain name upon which the Complaint is based is <pakhost.pk>.

PKNIC has confirmed via their email dated Monday, 1<sup>st</sup> February, 2016 that the Disputed Domain Name has been registered by the Respondent named in the Complaint and that their email address is [dizyn1@gmail.com](mailto:dizyn1@gmail.com).

#### **5. Parties Contentions**

##### **A. Complainant**

The Complainant’s contentions are reproduced below:

*Complainant holds trademark of “PAKHOST” in Pakistan as well as in U.S.A.*

*In addition, complainant has been in business with this name and same category (hosting and Domain Names) since 2001. The domain name under dispute “PAKHOST.PK” was with the complainant until 2012 and got expired by negligence. That time respondent re-registered the said domain name with bad intention and started using under the same category for which we hold trademark. Not to mention, we have built a solid reputation under this name and business which is being hurt in addition to misleading the people and customers to believe who is the real entity under name of Pakhost. This act also violates PKNIC (.PK ccTLD registry) policies and qualifies for UDRP dispute.*

*In addition to the trademark violation, the complainant has been actively doing business under this name since 2001. The same name has also been used for country ccTLD .PK domain registry SRS membership.*

*Further, the complainant also hold several domain names with the same name under various gTLDs and ccTLDs such as:*

- a. PAKHOST.COM*
- b. PAKHOST.COM.PK*
- c. PAKHOST.NET.PK*
- d. PAKHOST.NET*
- e. PAKHOST.BIZ*
- f. PAKHOST.ORG*
- g. PAKHOST.INFO*
- h. PAKHOST.TEL*
- i. PAKHOST.CO.UK*
- j. PAKHOST.ORG.UK*
- k. PAKHOST.CC*
- l. PAKHOST.TV*
- m. PAKHOST.US*
- n. PAKHOST.MOBI*
- o. PAKHOST.ASIA*
- p. PAKHOST.ME*
- q. PAK.HOST*

*and more...*

Hence, the Complainant seeks the following remedies:

*Under the circumstances, the complainant strongly urges and requests to revoke the current registrant rights for this domain name and the same should be transferred to the complainant and trademark holder at the earliest.*

## **B. Respondent**

The Respondent's contentions are reproduced below:

*We disagree to this complain because their trademark is for "PAKHOST WEB SERVICES" where as our business name and domain name is "Pakhost.pk". We are not using their trademark and never even mentioned their trademark anywhere on our website or other place. We are using Pakhost.pk since May 18, 2012 whereas their Trademark was issued on 26<sup>th</sup> of November, 2015.*

*Their trademark is for "PAKHOST WEB SERVICES" and we have not used it on our website. Our website and business name is Pakhost.pk moreover we are using Pakhost.pk even before the issuance date of their Trademark. We have not used even 1% of their logo design as well.*

*They mentioned many domain names, we do not have any of them, a disclaimer is also its clearly stated in their trademark that they do not have exclusive right word of "Pak". If by getting a trademark for "PAKHOST WEB SERVICES" they get full rights to all the words in their trademark it means all these words cannot be registered in all gTlds and ccTlds, if this is the case then, thhy is it available for registration in all Tlds? We do not have any bad intention towards them and we have never ever used their trademark "PAKHOST WEB SERVICES" on our website since we registered it. They also wanted to get pak.host but they should have gone for it before it went to general availability (all new tlds where available to Trademark holders before they went for general availability). There are so many websites with same name in different gtlds and cctlds where different people hold same domain names for example londontown.com and londontown.no both are into same business without any problem and 100% same name is being used in 2 different tlds whereas in our case 100% name is not same. If one of them gets Trademark do they get right to take over the other party's domain name? fifa.pk is taken by a common person where as fifa.com holds full rights to word fifa. I want to understand why fifa.pk was sold to a common person? If by getting a .com and*

*a trademark someone gets 100% rights for that word then there should be only .com and there should not be other GTLs or ccTLDs because as per the complainant party they get full rights to world pakhost by getting its trademark and none can register this word in any gtld or cctld. Some of our clients do have trademark but domain names has been registered by someone else, can they get those domains since they have Trademark for them? If this trademark allows complainant 100% exclusive rights to all the words in then ICANN should not have launched hundreds of new gtlds. Our own trademark for SilkHost.pk is in process, they day we get certificate will we get right to takeover silkhost.com.*

*Again, we are saying that we have not used their trademark “PAKHOST WEB SERVICES” and respect to their right to use “PAKHOST WEB SERVICES”. We are PakHost.pk and will never use their trademark. If they had trademark for “PakHost.pk” then they can say we are using their right but not in current case. By giving 100% rights to all the words in trademark a wrong precedent will get set and there will be so many cases like this where people will say someone has registered one word or part of my trademark.*

Hence, the Respondent seeks the following remedies:

*They do not have trademark for PakHost.pk and we are not using their trademark “PAKHOST WEB SERVICES” so there should not be any issue for them. For their satisfaction we can clearly mention on our website that we are not PAKHOST WEB SERVICES or PAKHOST.com, we have been using this website since 2012 and not been violating any rules at all. If they have any reasonable solution, they can suggest and will try our best to satisfy them.*

## **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 these regulations, 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 the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website ([http://www.dndrc.com/cases\\_resolved/pdf/c2007-0001.pdf](http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf)), the Panel laid down the following four 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 decision of the dispute shall be addressed with respect to the following aspects:

- 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 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. *in the opinion of PKNIC, 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 purpose of assessing illegality, unlawfulness or otherwise invalidity of the Application & Registration of the Disputed Domain Name, the application and registration of the Disputed Domain Name shall be assessed in consideration of the following criteria:

- 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, 1860 (the "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 stated:

*The Complainant holds trademark of "PAKHOST" in Pakistan as well as in U.S.A. Copies of the trademark certificates are attached:*

*In addition, complainant has been in business with this name and same category (hosting and Domain Names) since 2001.*

The Complainant contends that it has trademark registrations in both Pakistan and United States. In support of this contention, the Complainant has annexed a Certificate of Registration of Trade Mark issued by the Trade Marks Registry, Government of Pakistan which states that the mark

“PakHost” has been registered in the name of the Complainant as of the date 13/03/2009 for a period of ten years in Class 42. Further, the Complainant has also annexed a Certificate of Registration issued by the Principal Register, United States of America wherein it is stated that the mark “PAKHOST” has been registered on 17/07/2007 for a period of ten years in Class 42.

The Respondent has contended:

*We disagree to this complain because their trademark is for “PAKHOST WEB SERVICES” where as our business name and domain name is “Pakhost.pk”. We are not using their trademark and never even mentioned their trademark anywhere on our website or other place. We are using Pakhost.pk since May 18, 2012 whereas their Trademark was issued on 26<sup>th</sup> of November, 2015.*

*Their trademark is for “PAKHOST WEB SERVICES” and we have not used it on our website, our domain name and business name is PakHost.pk moreover we are using PakHost.pk even before the issuance date of their Trademark. We have not used even 1% of their logo design as well. They mentioned many domain names, we do not have any of them, a disclaimer is also its clearly stated in their trademark that they do not have exclusive right word of "Pak". If by getting a trademark for “PAKHOST WEB SERVICES” they get full rights to all the words in their trademark it means all these words cannot be registered in all gTlds and ccTlds, if this is the case then, thhy is it available for registration in all Tlds? We do not have any bad intention towards them and we have never ever used their trademark “PAKHOST WEB SERVICES” on our website since we registered it. They also wanted to get pak.host but they should have gone for it before it went to general availability (all new tlds where available to Trademark holders before they went for general availability). There are so many websites with same name in different gtlds and cctlds where different people hold same domain names for example londontown.com and londontown.no both are into same business without any problem and 100% same name is being used in 2 different tlds whereas in our case 100% name is not same. If one of them gets Trademark do they get right to take over the other party’s domain name? fifa.pk is taken by a common person where as fifa.com holds full rights to word fifa. I want to understand why fifa.pk was sold to a common person? If by getting a .com and a trademark someone gets 100% rights for that word then there should be only .com and there should not be other GTLs or ccTLDs because as per the complainant party they get full rights to world pakhost by getting its trademark and none can register this word in any gtld or cctld. Some of our clients do have trademark but domain names has been registered*

*by someone else, can they get those domains since they have Trademark for them? If this trademark allows complainant 100% exclusive rights to all the words in then ICANN should not have launched hundreds of new gtlds. Our own trademark for SilkHost.pk is in process, they day we get certificate will we get right to takeover silkhost.com.*

It is apparent that the Certificate of Registration of Trade Mark states that “*the Trade Mark, of which a representation is annexed hereto*” has been registered in the name of the Complainant Aqeel Ahmad s/o Malik Bahadur Ali, trading as PAKHOST WEB SERVICES. The mark annexed is a depiction of the word “PakHost” and not “PAKHOST WEB SERVICES”, which is merely the trading name of the registrant/Complainant. Thus, the Panel concludes that the Complainant had a valid registration to the trade mark “PakHost” prior to the registration of the Disputed Domain Name by the Respondent.

The Respondent has further contended that the Complainant does not have exclusive rights over use of the word “Pak” due to the presence of a disclaimer restricting the same. The Panel finds that the Complainant does not have exclusive rights over use of the word “Pak” but that the Complainant has neither contended that the Respondent has use the mark “Pak” exclusively. The Certificate of Registration of Trade Mark issued by the Trade Marks Registry, Government of Pakistan grants them exclusive rights over the mark “PakHost”, which is the same mark that the Complainant contends has been used by the Respondent in the Disputed Domain Name.

Further, the Respondent has submitted that they are not using the Complainant’s logo anywhere on the website, but have failed to negate the allegation put forth by the Complainant with respect to using the trademark of the Complainant in the Disputed Domain Name itself. Nor has the Respondent shown and/or alleged to have any intellectual property rights to the name “PakHost” which would shed light on him using the same to register the Disputed Domain Name.

Finally, the Respondent contends that the trade mark was issued by Trade Mark Registry on 26.11.2015 whereas the Certificate of Registration of Trade Mark states that the trade mark “PakHost” was registered in the name of the Complainant as of 13.03.2009 as stated by the Complainant in the Complaint.

The Panel therefore finds that the Disputed Domain Name <www.pakhost.com> incorporates the registered trade mark of the Complainant “PakHost” in its entirety, and that the same is identical to the trademark registrations of the word “PakHost” that are held by the Complainant.

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.

Hence, the Panel may well determine, on this criteria alone, that the Disputed Domain Name should 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 sub-issues as identified above.

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

The Complainant has stated:

*(the) complainant has been in business with this name and same category (hosting and Domain Names) since 2001. The domain name under dispute "PAKHOST.PK" was with the complainant until 2012 and got expired by negligence. That time respondent re-registered the said domain name with bad intention and started using under the same category for which we hold trade mark. Not to mention, we have built a solid reputation under this name and business which is being hut in addition to misleading the people and customers to believe who is the real entity under name of Pakhost.*

The Respondent has stated:

*We do not have any bad intention towards them and we have never ever used their trademark "PAKHOST WEB SERVICES" on our website since we registered it.*

It has been asserted by the Complainant that the Complainant is the registered owner of the trade mark "PAKHOST" and that such mark has been registered in Pakistan in Class 42 in both Pakistan and the United States.

The Complainant has been offering its services under the trade mark "PAKHOST" since 2001, years before the Respondent registered the Disputed Domain Name. The Respondent has admitted that the Respondent has been using the Disputed Domain Name since 2012, well after the Complainant obtained registration for the mark "PakHost". Since the Respondent alleges that the registration and use of the Disputed Domain Name was bona fide, the burden is on the Respondent to support the assertion with evidence. However, the Respondent has not provided any evidence

to this effect. As such, the Panel is unable to reasonably assume/infer bona fide on part of the Respondent, based on any documentary evidence of any kind, even more so in the absence of any coherent information with respect to the Respondent's intentions/reasons for using the word "PakHost" to register a domain name.

Therefore, the Panel finds that the Respondent has failed to demonstrate that the registration of the Disputed Domain Name is bona fide.

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

Prior to discussing this sub-issue, it is pertinent to clarify the grounds for examining relevant Pakistani law provisions. Although Pakistani law does not apply by force of law over PKNIC's jurisdiction, by operation of the PKNIC- Internet Domain Registration Policy Aug 07, 2007 version 4.2, it is necessary to examine provisions of the Penal Code and other applicable criminal laws. It is in this spirit and for this purpose alone that the following provisions of Pakistani law are being analyzed. The ordinances, and the sections mentioned herein below, have been discussed at length in *Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001)*.

Trade Marks Ordinance, 2001

**40. Infringement of registered trade mark.-**

*(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without consent of the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.*

**4. Domain name not to be misleading as to character or significance.-** *(1) A domain name shall not be registered if the public is liable to mislead as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a domain name.*

Electronic Transactions Ordinance, 2002 ("ETO")

**3. Legal recognition of electronic forms.—**

*No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness."*

## Penal Code

### *Of Trade, Property and Other Marks*

#### **478. Trade mark.**

*A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this Code the expression “trade mark” includes any trade mark which is registered in the register of trade marks kept under the Trade Marks Act, 1940 (V of 1940)*

Upon a study of the above-quoted sections of the Trade Marks Ordinance, 2001 and the Penal Code, the Panel is of the view that the infringement of Trade Marks and Trade Names have been equated with domain names under Pakistani law. Therefore, the provisions of the Penal Code dealing with Trade Mark infringement appear to apply to domain names.

Moreover, according to Section 3 of the ETO, all material, instruments that would otherwise be in writing or in physical form, if generated or made available in electronic form would attract the provisions of the same sections of the Penal Code or any other applicable law had the material been in physical, written or in printed form. The Penal Code, therefore, by the operation of Section 3 of ETO, equally applies to transactions, publications or materials including the use of any trade mark or trade name made available in any electronic form on the internet through the use of a domain name.

By continuing the registration of the Disputed Domain Name by a person who is other than the owner, holder or authorized user of the trade mark or trade name, the registrant would be an aider, abettor, encourager and co-conspirator and also liable to criminal offences.

#### **479. Property mark.**

*A mark used for denoting that movable property belongs to a particular person is called a property mark.*

#### **480. Using a false trade mark.**

*Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.*

As such, if a person other than the owner, rightful holder or authorized user of the trade mark or trade name uses the Disputed Domain Name, if possibly linked to any service or goods, it may constitute an offence under the Penal Code.

**481. Using a false property mark.**

*Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.*

**482. Punishment for using a false trade-mark or property mark.**

*Whoever uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.*

As decided in *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001), the use of a false property mark (which includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages) with the reasonable expectation that people would be misled to believe that the trade mark or trade name or domain name belongs to a person to whom it does not belong may also constitute an offence under the Penal Code.

The Panel, therefore, is of the view that the Respondent's registration of the Disputed Domain Name may attract the above-mentioned provisions of the Trade Marks Ordinance, 2001, Penal Code and ETO. The Panel may decide this Complaint on this basis alone. However, for the sake of completeness and procedural fairness, but not to create a binding precedent, 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:

*[W]e have built a solid reputation under this name and business which is being hurt in addition to misleading the people and customers to believe who is the real entity under name of Pakhost.*

The Respondent has not refuted the contention put forth by the Complainant that the Respondent's use of the trade mark is misleading people and leading people to believe that the Respondent rather than the Complainant is the owner of the trade mark and the real entity behind the PakHost trade mark or provided any information to this effect.

It is an established principle that the incorporation of a Complainant's trade 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](#)). It is also a well-established principle that the mere addition of a gTLD suffix ".com" or its equivalent is not relevant to the consideration of confusing similarity as it is an integral part of a domain name (*Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge*, [WIPO Case No. D2006-1643](#)).

It is apparent that the Disputed Domain Name reproduces the trademark owned by the Complainant in its entirety, thereby rendering the Disputed Domain Name confusingly similar to the trademark of the Complainant.

The Complainant has provided sufficient evidence, including annexures, that the Complainant has rights in the trademark "PAKHOST". The Complainant has been in the business of web hosting and domain names since 2001. It appears that the diversion of the Domain Name to a site such as that created by the Respondent may be misleading to the consumer, and it is likely to create an impression that the Complainant is linked to the site in some way. This would not only cause harm to the goodwill and reputation of the Complainant, but also cause confusion to customers of the Complainant and those who wish to use the Complainant's website for web-based services.

In the absence of any information or evidence provided by the Respondent, the Panel is unable to infer that the Respondent is commonly known by the Disputed Domain Name. The Panel therefore 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**

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.”*

The Complainant has contended:

*[The] complainant has been in business with this name and same category (hosting and Domain Names) since 2001. The domain name under dispute “PAKHOST.PK” was with the complainant till 2012 and got expired by negligence. That time respondent re-registered the said domain name with bad intention and started using under the same category for which we hold trademark. Not to mention, we have built a solid reputation under this name and business which is being hurt in addition to misleading the people and customers to believe who is the real entity under name of Pakhost.*

As has been previously adopted by the discussions and findings in WIPO Authorities, it is for the Respondent to rebut the allegations put forth by the Complainant. Also, with respect to proving rights or legitimate interests in the disputed domain name(s), it is for the Respondent to submit evidence pertaining to the same as it would be almost impossible, if not extremely difficult for the Complainant to prove a negative assertion. As such, in order to satisfy the Panel that it has rights or legitimate interests to the Disputed Domain Name, the Respondent was obliged to submit evidence with respect to the same. In the present case, although it submitted a Response, the Respondent has provided no information or evidence to suggest that the Respondent seeks to bring itself within any one of the three categories abovementioned, or demonstrate any other basis of a right or legitimate interest in the Disputed Domain Name. Further, there is no information before the Panel that suggests that the Respondents ever sought approval from the Complainant to use the mark “PakHost” in which the Complainant has trademark rights in Pakistan and the United States.

Moreover, the Respondent has not been able to demonstrate any rights or legitimate interests with respect to the Disputed Domain Name.

Therefore, the Panel finds that the Respondent does not have rights or a legitimate interest in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

#### **IV. Registration and use in bad faith**

The Complainant has made the following submission:

*The domain name under dispute “PAKHOST.PK” was with the complainant until 2012 and got expired by negligence. That time respondent re-registered the said domain name with bad intention and started using under the same category for which we hold trademark. Not to mention, we have built a solid reputation under this name and business which is being hurt in addition to misleading the people and customers to believe who is the real entity under name of Pakhost.*

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"*.

According to paragraph 4(b) of the Policy quoted above, an indication for use in bad faith is if the Respondent is intentionally attempting to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of his website or of a product or service on his website. The Respondent appears to generate, for commercial gain, traffic to the websites linked to the Disputed Domain Name by creating a likelihood of confusion with the PakHost trade mark.

The Respondent has not provided any information or evidence to demonstrate lack of bad faith. It is reiterated for the sake of clarity that the Complainant, in order to provide online services on a .pk ccTLD is unable to do so since the domain name with the .pk ccTLD is unavailable for registration because the same has been registered by the Respondent. As such, the Complainant is unable to register the domain name on the .pk ccTLD for itself even though it has registered the trade mark PakHost for its own use in both Pakistan and the United States. In the absence of any information provided by the Respondent, the Panel cannot disregard the similar nature of services being provided by the Respondent using the Disputed Domain Name. This leads the Panel to believe that the Respondent is either attempting to disrupt the Complainant's business and/or create competition for the same, if the Respondent is not already a competitor.

Therefore, the Panel finds that the registration and use of the Disputed Domain Name by the Respondent is in bad faith.

**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:

- Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Universal City Studios, Inc., supra
- 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
- Nokia Group v. Mr. Giannattasio Mario, WIPO Case No. D2002-0782
- The Ritz Hotel Ltd v. Damir Kruzicevic, WIPO Case No. D2005-1137
- Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge, WIPO Case No. D2006-1643
- 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**

Analyzing the details provided by the Complainant, the Panel perceives that the PakHost mark and the Registered Trade Marks are recognized both domestically and in the United States, 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 concludes and decides that:

1. The Respondent's registration of the Disputed Domain Name 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 is engaging in the 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.pakhost.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/](http://www.dndrc.com/cases_resolved/), whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

**Arbitrator: Ms. Zahra D'souza**

**Sole Panelist**

**Date: 11<sup>th</sup> April, 2016**