

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Jang (Pvt) Ltd v. Muhammad Asif (Jang Friends Group)

Case No. C2009-0002

Also in PDF C2009-0002

1. The Parties

The Complainant is Jang (Pvt) Ltd, having its principle premise of business at Printing House, I.I. Chundrigar Road, Karachi-74200, Pakistan. The Complainant is an organization that is the proprietor of, among other media concerns, the Daily Jang, considered to be the world's largest Urdu language newspaper.

The PKNIC Whois data base shows the registrant of the domain name in dispute <janggroup.pk> to be the organization, Jang Friends Group.

2. The Domain Name and Registrar

The disputed domain name <janggroup.pk> has been registered by the Jang Friends Group located at 1-33/A Saddar, Sukkur and the owner is listed as Mr. Muhammad Asif. This domain name has been created on 2007-02-27 at 08:06:02 (all times mentioned are Pakistan Standard Time – PST).

3. Procedural History

The Complaint was filed with the Domain Name Dispute Resolution Center (the “DNDRC”) on 6th June, 2008.

In accordance with the PKNIC - Internet Domain Registration Policy and the Rules of ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP], DNDRC formally notified the Respondent of the Complaint via email dated Wednesday, August 20, 2008 19:55 and the Respondent was asked to provide DNDRC with the Response in the format provided. The Respondent was informed that if a Response was not received within 7 days from the notification, the dispute would proceed *ex parte*.

The Respondent failed to submit the Response. Under section 5(e) of the UDRP, the Panel has

the authority, in the absence of a proper response, to commence with the proceedings in default and to determine the matter based upon the Complaint. The proceedings commenced on 10th of September, 2008.

Under the Supplemental Rules of DNDRC which override the ICANN Rules for Uniform Domain Name Dispute Resolution Policy in terms of paragraph 2 of the PKNIC - Internet Domain Registration Policy v 4.1, which states that “*DNDRC may consider and issue a recommendation in the matter in accordance with its own rules for such disputes or in default of such rules apply the Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999) and/or the Rules for Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999).*” As such DNDRC applies its Supplemental Rules to these proceedings as well as the UDRP and in case of any conflict the DNDRC Supplemental Rules to the ICANN Rules for the UDRP and UDRP apply.

The Center has delayed decision on this matter due to procedural non-compliance, as allowed under section 10(2) of the Supplemental Rules of DNDRC. Upon fulfillment of such procedure, applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), the Center appointed Ms. Nazifa Azmat Khan as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules. She has accepted and declared Impartiality and Independence.

The language of the proceedings is English, being the language of the registration agreement.

4. Factual Background

The Respondent registered the disputed domain name <janggroup.pk> on 27th February, 2007 in its name. The domain name is being used in connection with a website that offers products and services relating to news, television channels, job opportunities, business ventures, videos and other news related products. In addition, the domain name is also available to be purchased (PDF version of the website has been provided as annexure).

The Complainant is the registered proprietor of the trade mark “Jang” Class 16, registration number 106183. This trade mark is closely associated and synonymous with the Complainant’s business of printing and publishing of newspapers as well as other related media concerns being carried out of the past twenty years.

The Respondents have failed to provide DNDRC with a Response to the complaint lodged against them.

5. Parties’ Contentions

A. Complainant

The Complainant is the registered owner of the following domain names:

<http://www.jang.com.pk>

<http://www.jang-group.com>

<http://www.jang.net>

The Complainant contends that:

- i. It is a well-known and prominent company that has been engaged in the business of printing and publishing newspapers with significant distribution for over two decades therefore its trade name is closely linked to its operation of business and its customer base is contingent upon the “Jang” mark.
- ii. It has developed and registered the brand/trade mark “Jang” which it uses notably in connection with its well established business of newspapers and motion media. It prints and publishes various other newspapers, several of them incorporating the brand/trade mark “Jang” in them thereby becoming the Complainants personal insignia that they, their products and services are recognized and identified by.
- iii. It operates various websites vide domain name(s) including but not limited to the ones listed above, which constitute the mark “Jang” as an integral part of them.
- iv. The disputed domain name is confusingly similar and an obvious derivation of a mark in which the Complainant has rights for the following reasons:
 - a) The Complainant is a well known proprietor of newspapers and other media concerns and has used the title “Jang” in most of its commodities thus the fact that the disputed domain name comprises of the words “Janggroup” may be any and all reasonable deduction be inferred to be confusingly similar and obvious derivation of “Jang”.
 - b) The Complainant’s use of the trade mark “Jang” is very well known, both nation wide as well as internationally, both in the print and the motion media industry therefore the disputed domain name of <janggroup.pk> would inherently be assumed to belong to the Complainant by the general public and the Complainant’s clients as the trade mark has been developed by the Complainant solely for the purpose of its business.
 - c) That the disputed domain name, <[janggroup.pk](http://www.janggroup.pk)>, is confusingly similar to the registered trade mark of the Complainant (They have referred to the Uniform Domain Name Dispute Resolution Policy which was adopted by ICANN on August 26, 1999, and forms part of the PKNIC - Internet Domain Registration Policy June 20, 2006

version 4.1 para. 4(a), (b) and (c); Rules, para 3). The Complainant relies upon the precedent of *Zwiesel Kristallglas AG v WWW Enterprise Inc.* Case No. D2005-1223, where the Administrative Panel held that

“for the purpose of assessing whether a domain name is identical or confusingly similar to a trademark or service mark, the suffix “.com” must be disregarded as being simply a necessary component of a generic top level domain name”

The Complainant contends that accordingly, it is well established that the suffix “.pk” must be disregarded as simply being a necessary component of a country code top level domain name as well as the word “group”.

The Complainant submits that the word “Jang” is the essential element of the registered trade mark and has been reproduced and incorporated into the disputed domain name. The thrust of the registered trade mark is to convey to the reader the name “Jang” and it is this concept that makes up the disputed domain name. The domain name is confusingly similar and an obvious derivation of the readable portion of the registered trade mark of the Complainant.

- v. The Respondent has no rights or legitimate interests in respect of the disputed domain name for the following reasons:
 - a) The Respondent is not making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue as they are offering services similar to those offered by the Complainant on the Complainant’s websites.
 - b) Complainant has at no point licensed or allowed the Respondent the use of the trade mark “Jang” nor licensed or permitted the use of the trade mark “Jang” as part of a domain name not yet under the control of the Complainant but which they might intend to use in future.
 - c) The Respondent is not, and has never been, one of the printer(s), publisher(s), distributor(s) or any other business related entity of the Complainant thus has no connection, relevance or rights in the trade/service mark prior to the registration of the disputed domain name. Therefore, the Respondent cannot be seen to possess any legitimate interest in the domain name in dispute or its use.
 - d) The Respondent could not fail to be aware of the goodwill and reputation of the trade mark “Jang” given the extent of the international and national distribution of the Complainant’s business for the past twenty years thus their registration of such a domain name could not under any circumstances be deemed legitimate.

- e) The Respondent is not commonly, or otherwise, known by the disputed domain name, unlike the Complainant, nor has it acquired any rights in the name, or similar names.
 - f) The Respondent has not made legitimate, non-commercial or fair use of the disputed domain name as they have offered services in direct competition to the Complainant on the disputed domain name and the Complainant has been hindered from registering the disputed domain name in its own name to further its business as it was already registered by the Respondent.
- vi. The domain name was registered and is being used in bad faith by the Respondent. This contention is supported by the following:
- a) The Respondent is using the disputed domain name in a manner that is intended towards attracting Internet users to his own website by creating a link with the well established trade mark of the Complainant, in order to intercept users who wish to access the Complainant's website. The Respondent could not have failed to be aware that infringement of the Complainant's rights with respect to their registered trade mark "Jang" shall be taking place by the registering of a domain name that was confusingly similar or an obvious derivation of the mark. The Respondent could not reasonably fail to be aware of the Complainant's mark since both the Complainant and the Respondent operate in the same country and the Complainant is the proprietor of numerous well-reputed newspapers with various other commodities in the same industry as well as motion media in the form of television channels, all prominently displaying the "Jang" trade mark.
 - b) The Respondent was aware of the repute of the Complainant's registered trademark and this constitutes proof of the Respondent's bad faith, corresponding to which the Respondent registered the disputed domain name with the apparent intent to prevent the Complainant from registering the same domain name for the purposes of facilitating the Respondent's offline selling to customers of the Complainant identically similar services as offered by the Complainant on their own website.
 - c) The Respondent has no affiliation and/or association with the Complainant and is diverting the latter's customers by creating a web-site leading off from the disputed domain name <janggroup.pk> that is confusingly similar to the Complainant's trade mark and offering similar services (online news) via the website in direct competition with the Complainant's business. The Respondent has used the mark belonging to the Complainant knowingly, deliberately and in bad faith to gain benefit from the sterling reputation of the Complainant that the Complainant has built over two decades. There is no evidence of the disputed domain name being put to any use that may amount to good faith by the Respondent.
 - d) The Respondent is diluting the authenticity of the registered trade mark of the Complainant. In CSA International (a.k.a Canadian Standards Association) v John O.

Shannon and Care Tech Industries, Inc Case No. D2000-0071 the Administrative Panel held that:

“the adoption by the Respondents of an Internet address substantially identical or confusingly similar to that of the name, Internet address and trade marks of the Complainant must inevitably and misleadingly divert consumers to that address and have the effect of tarnishing the trade marks”.

- e) The Respondents have put the disputed domain name up for sale thereby providing substantial evidence of the fact that the disputed domain name has indeed been registered in bad faith thus the Respondent’s interest is not bona fide and appears to be for monetary gain at the expense of the Complainant’s business.

For all the above reasons, the Complainant requests a transfer of the disputed domain name.

B. Respondent

The Respondent failed to provide a Response to the Complainant’s contentions even though the opportunity to do so was provided to them by DNDRC. Thus the Panel shall proceed with the decision by deciding the dispute based upon the Complainant issued by the Complainant in line with section 5(e) of the UDRP Rules.

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 June 20, 2006 version 4.1 and the Rules.

The Respondent applied for, was granted registration of the disputed domain name on the basis of and has submitted to the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 and the Rules to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

7. Discussion and Findings

The application for the registration of the domain name in dispute <janguroup.pk> 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 <janggroup.pk> 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 and thus the Respondent's registration must be legitimate as per the requirement of these regulations and Rules.

The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 paragraph 6 states that:

*“PKNIC has neither the resources nor the legal obligation to screen requested Domain Names to determine if the use of a Domain Name by an Applicant may infringe upon the right(s) of a third party. Consequently, as an express condition and material inducement of the grant of an applicant's ("Applicant") request to register a Domain Name, Applicant represents, agrees and warrants the following four statements and a **failure to comply with them, or any other parts of the PKNIC policy, will cause PKNIC to cancel the domain registration of the non-compliant domains of Applicant:***

- 1. Applicant's statements in the application are true and **Applicant has the right to use the Domain Name** as requested in the Application;*
- 2. Applicant has a **bona fide intention to use the Domain Name on a regular basis on the Internet;***
- 3. The use or registration of the Domain Name by Applicant **does not interfere with or infringe the right of any third party in any jurisdiction in Pakistan, with respect to trademark, service mark, tradename, company name or any other intellectual property right;***
- 4. Applicant is not seeking to use the Domain Name for any unlawful purpose, including, without limitation, tortuous interference with contract or prospective business advantage, unfair competition, injuring the reputation of another, or **for the purpose of confusing or misleading a person, whether natural or incorporated.**”*

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

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

Correspondingly the UDRP lays down three basic requirements under paragraph 4(a) on the basis of which a domain name Complaint shall be decided:

- (i) Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and*
- (ii) Respondent has no rights or legitimate interests in respect of the domain name; and*
- (iii) Respondent's domain name has been registered and is being used in bad faith.*

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

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

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

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

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

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

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

Hence, any registration in contravention of paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007. ver 4.2 would be ab initio void and as well as voidable under the requirements of paragraph 4 of The PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.

For the assessment of illegality, unlawfulness or otherwise invalidity of the Application & Registration in order to determine whether the application and registration of the Domain Name in dispute “<[janggroup.pk](#)>” is ab initio illegal with respect to the following aspects in the context of which this dispute shall be assessed:

- i. Whether the Domain Name in dispute “<[janggroup.pk](#)>” infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Domain Name in dispute “<[janggroup.pk](#)>” is bona fide?
- iii. Whether the application and/or registration of the Domain Name in dispute “<[janggroup.pk](#)>” contravene the Pakistan Penal Code or any applicable criminal law?

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

- i. Whether the Domain Name in dispute “<[janggroup.pk](#)>” infringes upon, or is an obvious derivation of, a registered trade name / trade mark?**

The facts indicate that the Domain Name in dispute “<[janggroup.pk](#)>” is not just confusingly similar to the registered trade mark of the Complainant, but would also, by reasonable deduction, appear to be an obvious derivation of registered trade name and trade mark of the Complainant that is used by the Complainant with respect to the products and services it offers over a large national and international market. The Complainant has also registered the domain names of <http://www.jang.com.pk>, <http://www.jang-group.com> and <http://www.jang.net> in order to protect and facilitate its customers and its products from infringement.

Following the above, it has been reasonably deduced, and in the Panel’s opinion, proves that the Complainant has taken the necessary steps, not just to protect their trade marks, but also domain names that relate to such trade marks, however the Respondent has prevented the Complainant from registering the disputed domain name <[janggroup.pk](#)> and does in fact offer services similar and in direct competition with the Complainant on such a website.

Paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 sets out the condition that 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. As such since, in the opinion of the Panel, this criterion has been established as, due to the lack of Response from the Respondents, the Panel is required to decide the matter based upon the Complaint. The same stand proves and constitutes adequate grounds for the transfer of the domain name in dispute “<[janggroun.pk](#)>” to the Complainant.

Nonetheless 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 the Domain Name in dispute “<[janggroun.pk](#)>” is bona fide?

It is the opinion of the Panel that in order to determine this sub-issue an analysis of the possible intentions of the Respondent behind the registration of the domain name in dispute “<[janggroun.pk](#)>” is required. This shall assist the Respondent in inter alia establishing the bona fide nature of the registration and countering the argument that the registration is neither illegal nor intended to maliciously deprive the Complainant from the use of the domain name and creating confusion amongst the users and customers of the Complainant by virtue of the similarity and identical nature of the disputed domain name to the Complainant’s domain names and trade marks.

In this respect, it is a pertinent fact that the Respondent could not fail to be fully aware of the reputable nature and large customer base of the Complainant at the time when the Respondent registered the Domain Name in dispute “<[janggroun.pk](#)>” is relevant. The Panel takes into account the WIPO decision of **Hollywood Foreign Press Association v. F.M.I. Case No. D2008-1610**, whereby it was noted that:

“The Complainant contends that the Respondent registered the Domain Names knowing of the existence of the Complainant’s trade mark, GOLDEN GLOBE, and with a view to exploiting the Complainant’s trade mark rights, a primary claim being that the Respondent registered the Domain Names with a view to selling them at a profit. If the Complainant’s allegations are made out, such a registration could not conceivably give rise to rights or legitimate interests in respect of the Domain Names. The Panel accepts the Complainant’s unchallenged contention that it is inconceivable that the Respondent was unaware of the Complainant’s mark, GOLDEN GLOBE, when the Domain Names were registered. The Complainant has undertaken various enquiries and has found no basis upon which the Respondent could be said to have rights or legitimate interests in respect of the Domain Names. Moreover, the Respondent’s name has no obvious connection with the Domain Names and the Complainant has granted the Respondent no license in respect of the GOLDEN GLOBE trade mark. The Complainant has made out a prima facie case under this head, a case calling for an answer from the Respondent. The Respondent has not

responded to the Complaint; nor did the Respondent respond to letters from the Complainant's representative. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name."

In the present case the fact that both parties exist within the same geographic location and that the Respondent was, by reasonable deduction, well aware of the existence and value of the Complainant's registered trade mark, existing domain names and customer base, is indicative of substantial proof that the Respondent's registration of the domain name in dispute "<[janguroup.pk](#)>" lacks bona fide.

Moreover, the fact that the Respondent chose specifically to register a domain name which is not just confusingly similar to, but appears to be an obvious derivative of the Complainant's trade mark is also highly relevant to the consideration of the Respondent's lack of bona fide. Furthermore the Respondent offers services and products similar to and in direct competition to the products and services offered on the Complainant's website which is an additional indication of lack of bona fide on the part of the Respondent.

Essentially due to failure on the part of the Respondent to provide any facts and details regarding the alleged non-commercial purpose and lack of bona fide behind the registration of the disputed domain name, the Respondents have not been able to discharge the burden of the allegation against them that there exists no legitimate and non-commercial purpose in conformity with the PKNIC-Internet Domain Registration Policy Aug 7, 2007 ver 4.2 under which the Respondents initially registered the domain name in dispute "<[janguroup.pk](#)>". Moreover, deliberate lack of Response by the Respondent regarding their intentions for the registration of the domain name in dispute "<[janguroup.pk](#)>" casts further doubt upon the bona fide of the Respondent.

As per the requirements of paragraph 1 of the PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4.2, if a Complainant simply establishes this one criteria the registration of the domain name in dispute would be deemed illegal, unlawful or otherwise invalid. As such since, in the opinion of the Panel, this criteria has been established by the Complainant within their Complaint and no evidence to the contrary has been tendered by the Respondent thus the Panel has determined the issue on the same stands and constitutes adequate grounds for the transfer of the domain name in dispute "<[janguroup.pk](#)>" to the Complainant.

iii. Whether the application and/or registration of the Domain Name in dispute "<[janguroup.pk](#)>" contravene the Pakistan Penal Code or any applicable criminal law?

Prior to proceeding with this analysis the Panel feels compelled to clarify the basis and effect of this sub-issue. It is clarified that although Pakistani law does not apply by force of law over PKNIC's jurisdiction it does however apply as a contractual term to the contract executed between the Respondent and PKNIC thus defines the scope and terms of use of the domain name under the

PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2. As such it is clarified for future disputes, Appeals and Complaints that illegality with respect to the Application and Registration and examination of Pakistani law in this context does not imply that Pakistani law has applicability or jurisdiction over PKNIC or the dispute in question. Conversely the fact that Pakistani law is included as part of the terms of the PKNIC- Internet Domain Registration Policy Aug 07, 2007, version 4.2, these terms therefore apply to PKNIC and all relevant parties by virtue of the contractual and representative clauses thus the examination of Pakistani law is undertaken to determine whether any and/or all of these terms and conditions have been breached, violated and/or if there exists any non-conformity by the applicant or PKNIC.

In this spirit and for this purpose alone the following provisions of Pakistani law are being analyzed.

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.*

Pakistan Penal Code, 1860

Of Trade, Property and Other Marks

1[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)¹.]“

The disputed domain name provides an option for a visitor to the website to enquire regarding the purchase of the disputed domain name thereby casting doubt upon the bona fide of the Respondents and creating the possibility of infringement under the terms of the above section 40 of the Trademarks Ordinance as it provides proof of the Respondent’s intention to sell the domain name in dispute to party, including the Complainant, the registered owner of the trade mark “Jang”.

Furthermore the Trade Mark Ordinance equates infringements of Trade Marks and Trade Names with the infringement of domain names hence, under the Trade Mark Ordinance; provisions of the Pakistan Penal Code that deal with infringement of Trade Marks would possibly also cover domain names.

The 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.”

As such all material, documents or instruments that would otherwise be in writing or in physical form, if generated or made available in electronic form would attract and be subject to the provisions of the same sections of the Penal Code or any law had the material been in physical, written or printed form. Thus, the Penal Code applies equally to transactions, publications or material including the use of any trade mark made available in electronic form on the Internet through the use of a domain name as it does to physical material.

Since the Internet by its very nature is a public domain, obtaining access of the domain name that may involve use by the registrant of a registered trade mark in the form of a domain name by an entity other than the owner/rightful holder/authorized user of the registered trade mark for the purposes of export and import of data, would result in a violation of trade marks by virtue of access to such a domain as well as to the content as at the very least, use of Search engines by the public, would attract offences *inter alia* mentioned below under the Penal Code.

By the continuing registration of the domain name in dispute “<janggroup.pk>” by a person other than the owner/rightful holder/authorized user of the registered trade mark, 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.

Pakistan Penal Code, 1860

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 the use of the domain name in dispute “<[janguroup.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade mark could constitute an offence under the Penal Code. Similarly, other provisions below could possibly apply as well:

“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.”

Section 481 provides not only for movable goods but moveable property as well. As such it may logically be extrapolated that the inclusion of the words “movable property” in addition to the words “goods” suggests that the draftsman and legislature intended “movable property” to refer to items other than, and in addition to, “goods” and as such intellectual property or now, with the aid of the ETO digital property, any “document, record, information, communication or transaction” in electronic form would also be covered under this section. Hence, it would include any electronic means of encasing, packaging, containing intellectual property or property which is movable other than goods i.e. including domain names or any content on the website hosted on the domain name in dispute “<[janguroup.pk](#)>”.

As such the concept of use of a false property mark (which includes trade marks and by virtue of both the Trade Marks Ordinance, 2001 and international best practices) includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages (received from the website hosting the domain name) on the Internet with the reasonable expectation that people would be misled into believing that the trade mark or domain name belongs to the internationally renowned organization of the Complainant, when in fact it does not.

This issue is compounded by the fact that the Respondent offers services similar to those provided by the Complainant on their website, and would thus constitute use of a false property mark in clear violation of the Penal Code.

Therefore the use of the domain name in dispute “<[janguroup.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade mark could constitute as an offence under the Penal Code. Similarly, other provisions below could possibly apply as well:

*“483. Counterfeiting a trade mark or property mark used by another. Whoever **counterfeits any trade mark or property mark** used by any other person shall be punished with imprisonment of either description for a term which may extend to two years, or with fine, or with both.*

*485. Making or possession of any instrument for counterfeiting a trade mark or property mark. Whoever makes or **has in his possession** any die, plate or others **instrument for the purpose of counterfeiting a trade mark or property mark or has in his possession a trade mark or property mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong, shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both.***

*473. Making or possessing counterfeit seal, etc., with intent to commit forgery punishable otherwise. **Whoever makes or counterfeits any seal, plate or other instrument for making an impression, intending that the same shall be used for the purpose of committing any forgery** which would be punishable under any section of this chapter other than section 467, or, with such intent, has in his possession any such seal, plate or other instrument, knowing the same to be counterfeit, shall be punished with imprisonment of either description for a term which may extend to seven years, and shall also be liable to fine.”*

The use of the domain name in dispute “<[janggroup.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade mark to offer services similar to those that are being offered on the owner/rightful holder/authorized user’s website may also be construed to be counterfeiting of the source identifier of the trade mark and property mark and thus the use of a domain name, apart from being counterfeiting by itself, could at the least constitute possession and use of an electronic instrument being used for counterfeiting a trade mark, property mark or domain name.

“464. Making a false document. A person is said to make a false document: ---

*First: Who dishonestly or fraudulently **makes, signs, seals or executes a document or part of a document, or makes any mark denoting the execution of a document, with the intention of causing it to be believed that such document or part of a document was made, signed, sealed or executed by the authority of a person by whom or by whose authority he knows that it was not made, signed, sealed or executed, or at a time at which he knows that it was not make, signed, sealed or executed;***

470. Forged document. A false document made wholly or in part by forgery is designated “a forged document”.

471. Using as genuine a forged document. Whoever fraudulently or dishonestly uses as genuine any document which he knows or has reason to believe to be a forged document, shall be punished in the same manner as if he had forged such document.

476. Counterfeiting device or mark used for authenticating documents other than those described in section 467, or possessing counterfeit marked material. Whoever counterfeit upon, or in the substance of, any material, any device or mark used for the purpose of authenticating any document other than the documents described in section 467 of this Code, intending that such device or mark shall be used for the purpose of giving the appearance of authenticity to any document then forged or thereafter to be forged on such material, or who, with such intent, has in his possession any material upon or in the substance of which any such device or mark has been counterfeited, shall be punished with imprisonment of either description for a term which may extend to seven years, and shall also be liable to fine.”

Similarly, the use of the domain name in dispute “<[janggroup.pk](#)>” by a person other than the owner/rightful holder/authorized user of the registered trade mark, to offer services similar to those that are being offered on the owner/rightful holder/authorized user’s website in a manner that could reasonably mislead the authorized user’s customers/clients, could also be equivalent to the wrongful use of an electronic message or document covered under ETO, 2002. Since, the person making, signing or executing this website, the domain name, its contents, its documents on the site and every message that suggests that the message is being executed by “<[janggroup.pk](#)>” would be representing and making such a document falsely knowing that he is not authorized to do so, hence the electronic message and document would be false/forged and he would thus, contravene sections 464, 470 and 471 of the Penal Code.

Moreover, section 476 of the Penal Code clearly makes it an offence to possess any device or material (by operation of the ETO 2002 this would extend to electronic instruments or devices including domain names, websites and electronic messages being exchanged between the domain name, the website server and any other party) which is intended to authenticate or give the impression that it authenticates (the domain name would authenticate) a document (the website and domain name or the electronic messages) when in fact such authentication would be incorrect and counterfeit and in breach of the Code.

Electronic Transactions Ordinance 2002

“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.”

Prevention of Electronic Crimes Ordinance 2008

“15. Spoofing.(1) Whoever establishes a website, or sends an electronic message with a counterfeit source intended to be believed by the recipient or visitor or its electronic system to be an authentic source with intent to gain unauthorized access or obtain valuable information which later can be used for any unlawful purposes commits the offence of spoofing. (2) Whoever commits the offence of spoofing specified in sub-section (1) shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both”.

Hence 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 2008. The punishment under this legislation is not simply limited to fines and could also amount to imprisonment.

Therefore, it is in the opinion of the Panel that the registration and/or use of the domain name in dispute “<[jangugroup.pk](#)>” by the Respondent would be in violation of Pakistani criminal law and the Pakistan Penal Code and therefore as a result of, would constitute a violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2. Since in the opinion of the Panel this criteria has been established by the Complainants and no evidence to the contrary has been tendered by the Respondent, thus the Panel has decided the matter based on the Complaint hence the same stands proved and constitute adequate grounds for the transfer of the domain name in dispute “<[jangugroup.pk](#)>” to the Complainants.

The Panel therefore, concludes that the registration of the domain name in dispute “<[jangugroup.pk](#)>” would be illegal, unlawful and otherwise invalid in terms of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2, not to mention that the Respondent’s registration and/or use of the domain name in dispute “<[jangugroup.pk](#)>” could very 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 Aug 07, 2007 version 4.2.

Although it is evident that the Complaint has succeeded in establishing their Complaint in terms of the initial requirements of the PKNIC- Internet Domain Registration Policy June 07, 2007 version 4.2, and the registration of the disputed domain name is to be transferred to the Complainant, this Panel shall also assess the Complainant in terms of the ICANN UDRP as amended by the PKNIC-

Internet Domain Registration Policy Aug 7, 2007.ver 4.2(which also includes the ICANN UDRP with amendments).

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

The trade mark “Jang” belongs to the Complainant. The addition of the suffix “.pk” or the additional of the word “group” does not create any distinctive distinction that may eliminate the possibility of confusion by the Complainant’s users. This concept is strengthened by the fact that the Respondent offers services and products on the disputed domain name that are similar and in direct competition with the services and products available on the Complainant’s website. In similar cases, the addition of the suffix “.pk” has not been considered to add any element of distinctiveness (see *Nokia Corporation v. Firdaus Adinegoro/Beli Hosting*, WIPO Case No. D 2004-0814).

In the case of *Atticabank S.A. v. Net Promotion, Inc.* Case No. D2006-0317 the Panel, when discussing the issue of “Identical and Confusingly Similar”, held the following:

“A. Identical or Confusingly Similar

Although the Complainant’s business is primarily based in Greece, the Complainant has for many years used the words ATTICA BANK and BANK OF ATTICA in the English language both as a corporate name and as a trademark and service mark. The Complainant has built a substantial goodwill in the use of these marks both in Greece and in other jurisdictions throughout the world for its banking and financial services.

The Complainant’s Greek registered trademark ATTICA CARD, registration no. 117698, is for a word mark. The Greek registered trademark TECHNOCARD – BANK OF ATTICA, registration no. 141534, includes a logo but the registration document expressly includes the words as protected indications. Similarly, Greek registered trademark TECHNOCARD – BANK OF ATTICA, registration no. 141535, includes a logo device but again the registration document expressly states that the words are protected indications. Similar protection is afforded to the word elements in the Greek registered trademarks TECHNOCARD – BANK OF ATTICA with logo, registration no. 141535 and ATTICARD EXTRACASH – BANK OF ATTICA with logo, registration no. 143339.

The Complainant has established to the satisfaction of this Panel that it has rights in the trademarks ATTICA BANK and BANK OF ATTICA through long term use, and in addition, it has rights in the marks ATTICA CARD, TECHNOCARD – BANK OF ATTICA and ATTICARD EXTRACASH – BANK OF ATTICA through its Greek registered trademarks.

The domain name <atticabank.com> is clearly identical to the Complainant’s trademark ATTICA BANK and is confusingly similar to the Complainant’s trademark BANK OF ATTICA.”

The trade mark “Jang” is very well associated and connected with the services and products offered by the Complainant. The same being newspapers, magazines, television channel(s) and news in other forms including, but not limited to, online news provided via the websites/domains registered by the Complainant.

The domain name in dispute <janggroup.pk> contains the Complainant’s trade mark in entirety thus is confusingly similar to the Complainant’s registered trade mark. Not only would this cause confusion to the user(s) and customer(s) of the Complainant but would also hinder the Complainant from registering the domain name in dispute for the purposes of provision of their online news and other related services in furtherance to their business thus causes substantial and irredeemable harm to the Complainant.

III. Legitimate interest in 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.”*

Evidently the onus of proving any of the above including legitimate interest rests solely upon the Respondent as laid out in the UDRP and even otherwise under Rules of Evidence, since the party that asserts legitimate interest must be able to conclusively prove the same. It would not be feasible to put the burden of proof upon the Complainant in any event as it is not possible to prove a negative factor.

The Respondent had the opportunity to demonstrate its rights or legitimate interest in the disputed domain name in accordance with paragraph 4(c) of the Policy however they chose not to do so. In this paragraph, the following are listed as circumstances that in particular, but without limitation, would demonstrate a respondent’s legitimate interest or right in a disputed domain name:

- i. that the Respondent used or presented demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services;
- ii. that the Respondent has been commonly known by the domain name;
- iii. that the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of the Complainant.

The Respondent has not submitted any evidence that establishes its rights or legitimate interests based upon any of the above requirements. While failure to respond does not present conclusive evidence against the Respondent and the burden of proof lies upon the Complainant to prove mala fide on the part of the Respondent, the Panel did consider the Respondent's lack of response indicative of the Respondent's lack of rights or legitimate interests in the disputed domain name (See *Nokia Corporation v. Firdaus Adinegoro/Beli Hosting*, WIPO Case No. D 2004-0814).

Furthermore, although the Response form sent to the Respondent created a provision for the Respondent to:

“(ii) Annex any additional documentation to support the Response, together with a schedule indexing such document(s).”

The Respondent has not provided any Response, nor any proof or documentation to assert the legitimacy of their claim upon the disputed domain name, thus the Panel is required to decide the matter on the basis of the Complaint and as such cannot establish any legitimate interest on the part of the Respondent to the dispute domain name as the Respondent is not linked to the Complainant or its business in any manner of form nor does it act on the Complainant's behalf in any capacity as the Complainant has contended that no authorization has been given to the Respondent to make use of the trade mark “Jang” as part of the disputed domain name.

The disputed domain name is being used in connection with the offering of online news and other related services similar to those offered by the Complainant on their website. Such use of the disputed domain name cannot be considered *bona fide* due to the as on a balance of probabilities, the Respondent, operative in the same country of business as the Complainant, would reasonably have been familiar with the business and trade mark of the Complainant. Based on the evidence submitted by the Complainant, the Panel was satisfied that the trade mark of the Complainant is substantially well-known and is associated with great value and esteem solely with the Complainant. The Panel was guided by previous WIPO UDRP cases in reaching this conclusion.

“In the Panel's opinion, the use of the expression “bona fide” in Paragraph 4(c)(i) is sufficient to prevent a respondent who knowingly adopted another's well known mark as a domain name from claiming the benefit of mere use of or demonstrable preparations to use the domain name in connection with the offering of goods or services prior to notice of a dispute. The Panel accepts that SCANIA is a well known mark in the motor industry,

particularly in Sweden, and, accordingly takes the view that the respondent would have been unlikely to have been unaware of the fame of the complainant's mark SCANIA in the motor industry before adopting the name."

(See *Scania CV AB v. Leif Westlye*, WIPO Case No. D2000-0169).

Therefore the Panel cannot determine the Respondent to be making legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of the Complainant.

It is the view of the Panel that similar reasoning applies to the case at hand and based on all of the above factors, the Panel finds the Respondent to have no rights or legitimate interest in the disputed domain name.

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

In regards to the issue of bad faith 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."

The fact that the trademark of the Complainant was registered long before the registration of the disputed domain name is suggestive of bad faith on the Respondent's part. The Panel opines that the name of the Complainant and the trade mark "Jang" is so well entrenched with the Complainant's entity and business and is used unstintingly, both in print and motion media as the trade mark of the Complainant. The facts indicate conclusively that the Complainant is a relatively well-known enterprise and that its trade mark would hence be recognized publicly, and the Respondent could not help but be aware of the trademark "Jang" being associated with the Complainant as well as have knowledge of the services and products offered by the Complainant.

Upon independent verification being carried out by DNDRC for the benefit of the Panel, a visit to the website of the Complainant showed the trade mark “Jang” being prominently visible and displayed on the website. DNDRC noted from the website of the Complainant that it offers online news services, amongst other services/products related to the news industry. Following DNDRC’s visit to the domain name in dispute, the Panel determined that the Respondent uses the disputed domain name for offering and advertising news as well. Thus the services offered by the Respondent on the disputed domain name are in direct competition with the Complainant.

Both Complainant and Respondent operate in the same country. This suggests further that the Respondent was aware of the existence and of the business of the Complainant.

The Respondent vide the domain name in dispute has provides services similar to the services Complainant provides in the course of its long standing business and it is therefore the balance of probabilities lead the Panel to infer that the Respondent deliberately used the trade mark of the Complainant within their registered domain name <janggroup.pk> to create confusion and divert customers of the Complainant.

Accordingly, it is the Panel’s view that, on the balance of probabilities, the Respondent had actual knowledge of the trademark of the Complainant and the products/services in connection with which the trademark is used by the Complainant. As it was noted in *Herbalife International, Inc v. Surinder S. Farmaha*, WIPO Case No. D2005-0765:

“the registration of a domain name with the knowledge of the complainant’s trademark registration amounts to bad faith.”

In the current proceedings, no indication of any correspondence between the Complainant and/or any representative of Complainant, on one side, with Respondent, on the other, or similar evidence, have been determined to suggest or imply that the Complainant may have approved of or condoned the Respondent’s use of the registered trade mark “Jang”. Without any form of substantial evidence to indicate that the Complainant approved of or condoned the Respondent’s use of their registered trade mark in the disputed domain name, the Panel cannot infer that such a relationship of association/affiliation existed between the Respondent and the Complainant. (See *Tom Cruise v. Network Operations Center / Alberta Hot Rods*, WIPO Case No. D 2006-0560).

In conclusion, the Panel finds that the third test under paragraph 4(a) has been established successfully by the Complainant.

It is reiterated for the sake of brevity that the Respondent’s action of offering similar service as the Complainant on the domain name in dispute <janggroup.pk>, that has been determined to be confusingly similar to the trade mark of the Complainant, is clear evidence of mala fide on part of the Respondent.

8. Decision

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

- i. The Respondent's registration of the disputed domain name <janggroup.pk> is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
- ii. The Respondents have no legitimate interest in the disputed domain name.
- iii. The disputed domain name confusingly similar to the Complainant's trade mark and registered domain names.
- iv. The Respondent is making mala fide use of the Complainant's trade mark.
- v. Pursuant to Paragraphs 4 of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2, and Paragraph (i) of the UDRP the Panel therefore recommends to PKNIC to transfer the registration of the domain name at issue <janggroup.pk> to the Complainant, as prayed for within 48 hours of receipt of this decision by email or it being uploaded onto the DNDRC website www.dndrc.com/cases_resolved/, whichever takes place earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Ms. Nazifa Azmat Khan

Sole Panelist

Dated: 10th June, 2009