

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

**Arbitration and Mediation Center**

**COMPLAINT PANEL DECISION**

**Television Media Network (Pvt.) Ltd v. Mohammed Khan**

**Case No. C2010-0002**

**Also in PDF C2010-0002**

**1. The Parties**

The Complainant is Television Media Network (Pvt.)Ltd., having its principle premise of business at Plot No. 5, Express Way, Off Korangi Road, Karachi, Pakistan.

The PKNIC Whois data base shows the registrant of the domain name in dispute <express.pk> to be Mohammed Khan located at 32 Garsington Road, Oxford, Oxfordshire, OX4 2LG, United Kingdom.

**2. The Domain Name and Registrar**

The disputed domain name <express.pk> has been registered by Mohammed Khan located at 32 Garsington Road, Oxford, Oxfordshire, OX4 2LG, United Kingdom.

**3. Procedural History**

The Complaint was filed with the Domain Name Dispute Resolution Center (the “DNDRC”) on 15<sup>th</sup> March, 2010.

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 Monday, 07<sup>th</sup> June, 2010 at 1611 hours and the Respondent was asked to provide DNDRC with the Response in the format provided. The Respondent was informed that if a Response was not received within 7 days from the notification, the dispute would proceed *ex parte*.

The Respondent submitted his Response to the Complaint vide email dated 10<sup>th</sup> June, 2010. As such in addition to the submission to the arbitration contained in the PKNIC - Internet Domain Registration Policy, the Respondent has further confirmed and ratified its submission to the Arbitral jurisdiction of DNDRC and the Arbitration process thereto.

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 Barrister Samay Shams as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules. He has accepted and declared Impartiality and Independence.

The language of the proceedings is English.

#### **4. Factual Background**

The Respondent registered the disputed domain name <express.pk> on 20<sup>th</sup> January, 2006 in its name. The domain name is being used to host a parking page with a search engine and all links/tabs on the web page are inactive. Hits to the links/tabs on the web page results in the hits being redirected to the home page.

The Complainant is the registered proprietor of the trade mark “Express”. The Complainant applied for registration of the trademark “Express” in Class 38 and Class 48 in March, 2005 and were awarded registration of the trade name “Express” in November, 2008 vide registration number 206622 and Class 41, registration number 206621. This trade mark is closely associated and synonymous with the Complainant’s business of printing and publishing of newspapers, news channel as well as other related media concerns being carried out in Pakistan. And in particular, Reporter Services (NEWS), Production of Shows, Television Entertainment, Video Taping, Entertainment, Sporting and Culture Activities, Information (Education and Entertainment), Production of Radio and Television Programs etc.

#### **5. Parties’ Contentions**

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

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

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

The Complainant contends that:

*We are the owners of the trade mark “**EXPRESS**” registered with the Trade Marks Registry, Karachi vide trade mark number 206621, dated March 2, 2005. The trade mark EXPRESS is being used by our company for the following goods / services: Reporter Services (NEWS), Production of Shows, Television Entertainment, Vide Taping, Entertainment, Sporting and Culture Activities, Information (Education an Entertainment), Production of Radio and Television Programs etc.*

*The Products which we have are as follows:*

***Express NEWS**  
**Express 24/7**  
**Daily Express**  
**Express Tribune***

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

## **B. Respondent**

The Respondent contends the following:

*Respondent contends that Complainant fails to prove all three elements of the ICANN UDRP Policy therefore failing to meet the burden of proof. Respondent contends that its rights in the <express.pk> domain name predate the Complainant's rights in the EXPRESS mark. The Respondent registered the domain name on January 20, 2006 whilst the Complainant did not have its trademark granted until 2008 see following journal by the Pakistan Trademark. [http://www.ipo.gov.pk/Trademark/Downloads/Journals/685%20\(February,%202008\).zip](http://www.ipo.gov.pk/Trademark/Downloads/Journals/685%20(February,%202008).zip) Respondent contends that Complainant does not even establish that prior to 2008 and at the time of registration of the domain name Complainant held common law rights in the word EXPRESS. Respondent contends that Complainant has failed to establish a prima facie case in support of its allegations that Respondent lacks rights and legitimate interests since sentimental and personal value has been attached to the phrase, both of which cannot be disproved. Respondent has proof of having commonly been known as <express.pk> from Bank, friends and business affiliates. From such business dealings Respondent argues that it can be assumed that Respondent has rights and a legitimate interest in the domain name. Under Paragraph 4(c)(ii) of the ICANN UDRP Policy, a complainant cannot prevail if the respondent have been commonly known by the domain name. The Respondent argues that he*

should prevail because: (1) the term "Express" are generic terms for describing Respondent's services to be marketed at the express.pk Web site; (2) that, as a result, his decision to register the domain name was not in bad faith; (3) he has been discussing and developing the website and business over the past 4 years with various companies and individuals; and (4) his use constitutes "fair use." It is contended that if Respondent has rights and legitimate interest he cannot have acted in bad faith. It is also contended that as Respondent registered <express.pk> as a domain name before EXPRESS was registered as a trademark the earlier good faith transaction cannot later become bad faith if the other company was not within the reasonable contemplation of the Respondent. See *Aspen Grove Inc. v. Aspen Grove*, D2001-0798 (WIPO Oct. 5 2001) (finding it impossible to register a domain name in bad faith if the complainant's company did not exist at the time of registration). The Respondent asserts that its use of the disputed domain name has been in good faith for the bona fide offering of services, and that it has rights and legitimate interests in the disputed domain name. Respondent also launches a counterclaim in the form of allegations of Reverse Domain Name Hijacking. Respondent contends that Complainant uses the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name (UDRP Rule 1) thus constituting an abuse of the administrative proceedings. Complainant had several years of knowledge about <express.pk> as it has been over 4 years. Complainant therefore had knowledge of Respondent's registration and this is ground for dismissing the Complaint. The complainant owns CYBERNET which is internet data firm and therefore it had prior knowledge of domains being sold. The complainant has been using the domain <express.com.pk> for the last 7 years without any complaints about <express.pk>. See *Aspen Grove, Inc. v. Aspen Grove*, D2001-0798 (WIPO Oct. 5 2001) (finding that the respondent's registration of <aspengrove.com> domain name two years before the Complainant's incorporation justified a reverse domain name hijacking ruling); see also *Onu S.R.L. v. Online Sales*, AF-0672 (eResolution Feb. 16, 2001); see also *NetDeposit, Inc. v. NetDeposit.com*, D2003-0365 (WIPO July 22, 2003) (finding reverse domain name hijacking because "Respondent's domain name registration preceded the Complainant's creation of its trademark rights."). Complainant promotes its brand name and news media under the trademark EXPRESS through the domain name <EXPRESS.com.pk>. Complainant maintains a presence on the Internet by use of the domain name < EXPRESS.com.pk >. It is also found through Alexa research that the top search for the complainant current domain is "Express News" which would be inline with its brand of Express News. This is why the complainant has bought domain name expressnews.tv. Therefore the complainant does not promote itself as Express, but as Express News or Daily Express, as stated in para 7 of complainant documentation. Respondent contends that it has a legitimate right to use the Domain Name based on Paragraph 4(c)(i) of the ICANN UDRP Policy on grounds that it has made "use of, or demonstrable preparations to use, the domain name in connection with a bona fide offering of services." See *SFX Entertainment, Inc. v. Phillip Cushway*, WIPO Case No. D2000-0356 (finding that the Respondent had a legitimate interest in the domain name by showing demonstrable preparations to use the domain name). Under Paragraph 4(c)(i) of the ICANN UDRP Policy, a complainant cannot prevail if the respondent, prior to notice of the dispute, has made "use of, or demonstrable preparations to use, the domain name in connection with a bona fide offering of goods or services". Respondent contends that it has made demonstrable

*steps to develop content for its websites located at the Domain Name at issue here. Since the Respondent registered the name, it has developed its website which is live and is in the process of developing the further content sections for the websites. In order to test new sections of the websites, the Respondent developed a series of “test sites.” To access the website, a user types in “http://test.express.pk”. While the general public would not see the test websites located at the test domain names, the Respondent is able to test the additional sections of the website live. Respondent used the domain name <express.pk> for a significant period of time for business purposes, thus further highlighting his rights and legitimate interests in the title. Also the respondent has spent considerable investment of money and time on the domain name. Respondent alleges that at all times his business was entirely unrelated to that carried on by Complainant. See Warm Things Inc. v. Weiss, D2002-0085 (WIPO Apr. 18, 2002) (finding that the respondent was making a bona fide offering of goods or services at the <warmthings.com> domain name as the respondent was operating in a field unrelated to the Complainant or its products).*

For the above mentioned reasons, the Respondent seeks as follows:

*We would like to maintain our ownership of express.pk as we have invested significant time and money developing the website and business and we are commonly known as express.pk, or we would like compensation for the time and money invested in the business and domain.*

## **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 <express.pk> on behalf of the Complainant is regulated by both, the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 as well as the UDRP Rules.

The Respondent applied for registration of the disputed domain name <express.pk> on the basis of these regulations and was allowed registration subject to the same.

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

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

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

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

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

ICANN's Uniform Domain Name Dispute Resolution Policy (UDRP) lays down three basic requirements under paragraph 4(a) on the basis of which a domain name Complaint shall be decided:

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

Therefore the Panel shall determine the Complainant subject to the following issues:

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

### **Illegality, unlawfulness or otherwise invalidity of the Application & Registration**

In terms of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 . ver 4.2a registration of a domain name is allowed subject to inter alia paragraph 1 & 4 which state:

*“with the exception of any applications/cases for registration that attempt to register a domain name that:*

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

Under the head of Illegality, unlawfulness or otherwise invalidity of the Application & Registration to assess whether the application and registration of the Domain Name in dispute “<express.pk>”, is ab initio illegal the following aspects in the context of this dispute are to be assessed:

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

In the seminal case of ***Standard Chartered PLC v. Hosting Campus Domain Case No. C2007-0001*** the DNDRC used for the first time the conditions for deciding the issue of Illegality, unlawfulness or otherwise invalidity of the Application & Registration as laid out in the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 and made use of the same in rendering the landmark decision related to the disputed domain name <standardchartered.pk>, whereby it was held that:

*In this context the following aspects of the dispute will be addressed in this decision:*

1. *Illegality, unlawfulness or otherwise invalidity of the Application & Registration ( a criteria in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 in addition to the criteria of the UDRP)*
2. *Identical or confusing similarity to a trademark or service in which the Complainant has rights (a UDRP criteria)*
3. *Legitimate interest in Domain Name (a UDRP criteria)*
4. *Registration and use in bad faith (a UDRP criteria)*

*The Panel therefore, concludes that the registration of the domain name “<[standardchartered.pk](#)>” would be illegal, unlawful and otherwise invalid in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 not to mention that the Respondent’s registration and/or use of the domain name “<[standardchartered.pk](#)>” could possibly give the impression that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) by allowing the maintenance of such registration would be committing a contravention of the Pakistani criminal law and a breach of its own Internet Domain Registration Policy June 20, 2006 version 4.1.*

*It is once again reiterated and clarified for future disputes, Appeals and Complaints that the illegality and examination of Pakistani law in this context does not imply that Pakistani law has applicability or jurisdiction over PKNIC or the dispute. Instead the fact that Pakistani law is included as part of the terms of the PKNIC- Internet Domain Registration Policy June 20, 2006 version 4.1, the terms and conditions*

*apply to PKNIC and all parties by virtue of contractual and representative clauses and the examination of Pakistani law is thus undertaken to examine whether any of these terms and conditions have been breached, violated and/or there is non-conformity by the applicant or PKNIC.*

The Panel, taking into account the discussions and findings in the case of <standardchartered.pk> will now apply those onto the facts of this case and will deal with each of the sub-issues sequentially below:

**i. Whether the Domain Name in dispute “<express.pk>” infringes upon, or is an obvious derivation of, a registered trade name / trade mark?**

The Complainant is a well-known and prominent company that has been engaged in the business of printing and publishing newspapers with significant distribution for over years. As such, its trade name is closely associated to its offering of services and its colossal customer base is contingent upon the “Express” mark.

The Complainant has developed and registered the brand/trade mark “Express” which it uses widely in relation to its well established business of newspapers and motion media. It prints and publishes various other newspapers, several of them incorporating the brand/trade mark “Express” in them thereby becoming the Complainant’s personal insignia that they, their products and services are recognized and identified by.

It operates an online e-paper on a registered domain name, which constitutes the mark “Express” as an integral part of the domain name. For this purpose, the Complainant has registered the domain name express.com.pk with PKNIC.

It is clear from the facts mentioned above that the Domain Name “<express.pk>” is not just similar but is in fact identical to the registered trade name and trade mark of the Complainant who has existing registration of trade marks and trade names as mentioned below:

Express, Class 38; Registration Number: 206622

Express, Class 41; registration number: 206621

The above clearly illustrates that the Complainants have taken more than the necessary steps to not just protect their trade mark, trade name but also domain name that relate to such trade mark and trade name. As for efforts on part of the Respondent, neither has he applied for and/or obtained any trademark/tradename registrations from an official authority, nor had it raised an objection to the application for trade mark registration filed by the Complainant. As per section 28 sub section (2) of the Trade Marks Ordinance, 2001,

*(2) any person may, within two months from the date of the advertisement or re advertisement of an application for registration or within such further period not exceeding two month in the aggregate as the Registrar, on application made to him in the prescribed manner and on payment of the prescribed fee, may allow, give notice to the Registrar of opposition to the registration.*

Furthermore in accordance with sub section (3) of the same section, it is mandatory that the notice of opposition to the application of a trade mark be in writing and in the manner prescribed therein:

*(3) the notice under sub section (2) shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.*

As per 33 of the Trade Marks Ordinance, 2001, where no objection has been raised to an application for a trade mark, the Registrar shall register the trade mark:

*33. Registration.-*

*(1) Where an application has been accepted and-*

*(a) no notice of opposition has been given within the period referred to in sub-section (2) of section 28; or*

*(b) all opposition proceedings have been withdrawn or decided in favour of the applicant, the Registrar shall, within such period as may be prescribed, register the trade mark, unless it appears to him having regard to matters coming to his notice since he accepted the application that it was accepted in error.*

*(2) A trade mark shall not be registered unless any fee prescribed for the registration is paid within the prescribed period. If the fee is not paid within the prescribed period, the application shall be deemed to have been withdrawn.*

*(3) A trade mark when registered shall be registered as of the date of filing of the application for registration and that date shall be deemed for the purposes of this Ordinance to be the date of registration.*

*(4) On the registration of a trade mark the Registrar shall publish the registration in the prescribed manner and issue to the applicant a certificate in the prescribed form of registration, sealed with the seal of the Trade Marks Registry.*

*(5) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner, treat the*

*application as abandoned unless it is completed within the time specified in that behalf in the notice.*

Upon registration of a trade mark, the registration grants the applicant several rights, including but not limited to the exclusive rights in the trade mark which is infringed by use of the mark in Pakistan without his consent, right to use, authorize to use the trade mark in Pakistan:

*39. Rights conferred by registration.-*

*(1) A registered trade mark shall be a personal property.*

*(2) The proprietor of a registered trade mark shall have exclusive rights in the trade mark which are infringed by use of the trade mark in Pakistan without his consent.*

*(3) Without prejudice to the rights of the proprietor of a registered trade mark to also have the right to obtain relief under this Ordinance if the trade mark is infringed.*

*(4) References in this Ordinance to the infringement of a registered trade mark shall be to any such infringement of the rights of the proprietor.*

*(5) The rights of the proprietor shall have effect from the date of registration:*

*Provided that no infringement proceedings shall begin before the date de mark is in fact registered.*

*(6) The rights conferred by registration of trademarks under this Ordinance shall extend to trade marks registered under the Trade Marks Act, 1940 (V of 1940).*

As such, from the above mentioned and discussed provisions of the TMO, 2001, the Panel opines that since the Respondent had not raised an objection to the application for registration of trade mark/trade name filed by the Complainant, even though they had a statutory right to do so, it clearly demonstrates waiver on their part to object the registration of the trade mark/trade name Express in favor of the Complainant.

The Respondent contends that its rights in the <express.pk> domain name predate the Complainant's rights in the Express mark. The Respondent registered the domain name on 20<sup>th</sup> January, 2006 whilst the Complainant did not have its trademark granted until 2008. It is noteworthy to mention that even though the Express mark was not registered till 2008, application to register the same was filed in 2005 and was accepted by the Trade Mark Registry of Pakistan. According to sub section (3) of the section 33 of the Trade Marks Ordinance, 2001, the date of registration of a trade mark shall be deemed to be the date of filing of an application to the same effect.

*33. Registration:*

*(3) A trade mark when registered shall be registered as of the date of filing of the application for registration and that date shall be deemed for the purposes of this Ordinance to be the date of registration.*

As such, from the above mentioned statutory provision, it is evident that the Complainant had statutory rights to the trade name Express arising out from the time the application for registration was filed, i.e. 02<sup>nd</sup> March, 2005. This was months before the disputed domain name was registered by the Respondent. As such, when the Respondent registered the disputed domain name, he held, neither common law rights nor statutory rights to the trade name/trade mark Express since statutory rights to the same had already been claimed by the Complainant and had not been objected to by the Respondent.

In terms of paragraph The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2if a Complainant simply establishes this one criteria the registration would be deemed Illegality, unlawfulness or otherwise invalid. As such since, this criteria has been demonstrated, the same stands proved and constitutes adequate grounds for the transfer of the Domain Name “<express.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 other issues as listed above.

**ii. Whether the application and/or registration of the Domain Name in dispute “<express.pk>” is bona fide?**

The Complainant has made use of its trade name Express, which has been reproduced and incorporated in entirety into the disputed domain name. Furthermore, the Complainant has used the same trade name to offer its multitude of services throughout Pakistan. It is thus apparent and reiterated by the facts provided by the Complainant that its trade name is widely recognized and that it is closely associated with the Complainant. The Complainant does not only offer physical services, in form of newspapers/magazines but also uses the internet to offer online services in a form of e-paper vide its domain name www.express.com.pk. Thus, in order to safeguard its trade name on the ccTLD of .pk as well, the Complainant sought to register the domain name express.pk. However, it was restricted from acquiring the domain name express.pk on the ccTLD since the same is being passively held by the Respondent and is being used to host a parking page with inactive links/tabs. The Respondent, however, is neither known by nor associated with the trade mark/trade name Express. The Respondent is a private individual who is resident in the United Kingdom. The dispute domain name is not being used to offer bona fide services. In fact, the disputed domain name is not being used for any active provision of services or goods. It is merely a parking page which is being used to host a search engine with all links/tabs inactive. As such, no bona fide can be deduced on the

part of the Respondent in connection with the disputed domain name. The Complainant has been using the trade name Express for over 05 years now in Pakistan to offer media related services, inter alia, newspapers, news channels, other print and media publications, both in still and motion forms. The Complainant is well known and widely recognized by its trade name Express throughout Pakistan as well as abroad. The Respondent, however, has not demonstrated the relevant intention(s), motive(s), purpose(s) etc behind using the word Express for a domain name. The disputed domain name is not being used to offer any bona fide services which could be related to the word Express.

The fact that the Respondent chose specifically to register a domain name not just similar but identical to the Complainant's trade name is something to be given consideration and discussed. Most importantly the failure of the Respondent to provide any facts and details supported by evidence as to the alleged non-commercial purpose have failed to assist them in discharging the burden of their allegation that there is a legitimate and non-commercial purpose in conformity with the PKNIC- Internet Domain Registration Policy Aug 7, 2007 . ver 4.2 for which the Respondents initially registered the Domain Name in dispute "<express.pk>". Moreover, the deliberate nature to conceal the purpose of the registration by the Respondents and their intentions for use in connection with the Domain Name in dispute "<express.pk>" brings into doubt the bona fide of the Respondent.

From the discussion under this second sub-issue it can be seen that there are requisite and adequate facts; failure to prove otherwise; deliberate refusal to mention or establish and in fact concealment of the purpose or legitimate interest over the Domain Name in dispute "<express.pk>".

Taking into account all of the above, it would not be probable to conceive any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate and constitute evidence of bona fide on the part of the Respondent. Thus the Panel finds the second criteria of paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 to be established as well thus the registration of the domain name in dispute is held to be deemed illegal and unlawful and for all purposes invalid.

**iii. Whether the application and/or registration of the Domain Name in dispute "<express.pk>" contravene the Pakistan Penal Code or any applicable criminal law?**

Although Pakistani law does not apply by force of law over PKNIC's jurisdiction, conformity with it is a contractual term of the agreement executed between the Respondent and PKNIC, therefore any illegality pertaining to the Application and Registration of the domain name in dispute would render the registration of the domain name in dispute to be void.

In this spirit and for this purpose alone the following provisions of Pakistani law are being taken into consideration while rendering this Decision.

The relevant laws pertaining to registration of the domain name in dispute includes the Trade Marks Ordinance, 2001 section 4 and 40, The Electronic Transactions Ordinance, 2002 section 3, subject to which infringements of Trade Marks and Trade Names is equated with the

infringement of domain names hence the Pakistan Penal Code section 478(1), that deal with infringement of Trade Marks, would possibly also cover domain names.

Additionally under the Pakistan Penal Code, 1860 sections 464, 470, 471, 473, 476, 479, 480, 481, 482, 483 and 485 the continuing registration of the domain name in dispute “<express.pk>” by a person other than the owner/rightful holder/authorized user of the registered trade marks/names could be construed to be an offence on multiple accounts, and by operation, would not only give the impression to the Respondent that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) was allowing aiding, abetting, encouraging and conspiring with the Respondent and would also be liable to criminal offences under the above mentioned legislations.

Lastly by operation of the Electronic Transactions Ordinance 2002 section 3 and the Prevention of Electronic Crimes Ordinance 2009 section 15, (although, the same is not in effect at the moment, but it was at the time of registering the disputed domain name by the Respondent) it can be construed that in any event where a Respondent has established or is using a website or a domain for any purpose, in which he does not hold legitimate interests, is entitled to be charged with the offence of spoofing under s.15 of the PECO 2009. The punishment under this legislation is not simply limited to fines and could also amount to imprisonment.

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

In the opinion of the Panel this criteria has been sufficiently proven by the Complainants and no supporting evidence to the contrary has been tendered by the Respondent. However this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

## **I. Identical or confusing similarity with a trademark or service in which the Complainant has rights**

The Complainant is the registered trade mark holder of the trade mark/trade name Express. 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. 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. D2004-0814).

The trade mark “Express” 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 website/domains registered by the Complainant. The Respondent has reproduced the Complainant’s registered mark in entirety into the disputed domain name. As such, giving rise to a high probability to the users of the Complainant being confused and misled into believing

that the disputed domain name belongs to the Complainant, is being used by the Complainant. So much so, the Complainant's users might also be misled into thinking that there is a relationship between the Complainant and the Respondent. There might arise in the Complainant's users mind, the assumption that there exists an association, affiliation, relationship or the like between the Complainant and the Respondent, when in fact there is none. Moreover, the integral part of the disputed domain name, being "express" is a registered trade mark of the Complainant, to which the Complainant acquired statutory rights before the disputed domain name was registered by the Respondent, incorporating the mark "Express" in full.

The domain name in dispute <express.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.

In WIPO Domain Name Decision Administrative Panel Decision Radio Systems Corporation v. Media Plus Solutions, Kenneth Yap Case No. D2010-0801, it was held:

*A. Identical or Confusingly Similar*

*The disputed domain name incorporates the PETSAFE Trademark as well as the PETSAFE BARK CONTROL Trademark. As previously established in several UDRP decisions including the Oki Data Americas Inc., and Turkcell Iletisim Hizmetleri A.S., supra, cited by the Complainant which the Panel adopts, when a domain name reproduces the Trademark in its entirety, it is confusingly similar to the Trademark as it is the case in the present circumstances. The addition of generic top level ".com" domain to the Trademark PETSAFE BARK CONTROL does not diminish in any respect the similarity or confusion between the disputed domain name and the PETSAFE BARK CONTROL Trademark of the Complainant. The Panel finds that the disputed domain name is confusingly similar to the PETSAFE Trademarks and identical to the PETSAFE BARK CONTROL Trademark.*

*The first criterion has been met.*

In WIPO Domain Name Decision Administrative Panel Decision Viajes Iberojet, S.A. v. Reserved for Customers, MustNeed.com Case No. D2010-0802 it was held:

*A. Identical or Confusingly Similar*

*It is well established that the specific top level of a domain name such as ".com," ".net" or ".org" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar. See Rollerblade, Inc. v. Chris McCrady, [WIPO Case No. D2000-0429](#); Iconcard S.p.A. v. Linecom, [WIPO Case No. D2005-1115](#).*

*The Panel finds that the Domain Name is identical to the IBEROJET Mark in which the Complainant has prior rights, and that the Complainant has thus established the first element of its claim, pursuant to paragraph 4(a)(i) of the Policy.*

In WIPO Domain Name Decision Administrative Panel Decision Sommerpine Books LLC v. Henton Enterprises, Hank Roberts Case No. D2010-0805, it was held:

*A. Identical or Confusingly Similar*

*The disputed domain names consist of Complainant's common law marks PRINTERS ROW BOOKS and CHICAGO RARE BOOKS, to each of which have been appended the gTLD suffix <.com>, <.net>, and <.org>. Accordingly, the Panel finds that the disputed domain names are identical to trademarks in which Complainant has rights.*

In WIPO Domain Name Decision Administrative Panel Decision Cantor Fitzgerald Securities, Cantor Index Limited v. Cantor Index Case No. D2010-0807 it was held:

*A. Identical or Confusingly Similar*

*Paragraph 4(a)(i) of the Policy is satisfied when a complainant is able to prove two necessary elements: first, that the complainant has rights in a trademark or service mark, and second, that the domain name in dispute is identical or confusingly similar to the trademark or service mark on which the complainant relies.*

*Accordingly, the Panel finds that Respondent's Domain Name is confusingly similar to Complainant's CANTOR marks, and therefore the condition of paragraph 4(a)(i) is fulfilled.*

In WIPO Domain Name Decision Administrative Panel Decision Emirates Group Headquarters v. Domain Discreet / Ahmed Bin Subaih Case No. D2010-0811 it was held:

*A. Identical or Confusingly Similar*

*The Panel agrees that the disputed domain name <emiratesholidays.com> is identical to the EMIRATES HOLIDAYS marks in which Complainant has rights.*

*The Panel concludes, therefore, that Complainant has established the first element of paragraph 4(a) of the Policy. Since the Panel finds that the disputed domain name is identical to trademarks of Complainant, it is unnecessary to address Complainant's second argument that the disputed domain name is confusingly similar to Complainant's EMIRATES trademarks.*

In the DNDRC Decision *Standard Chartered PLC v. Hosting Campus Domain Case No. C2007-0001* it was held that:

*As such the operative part of the disputed domain name would simply be “standardchartered” which when compared with the Standard Chartered Domain Names and the Standard Chartered Registered Trade Marks and Trade Mark Applications the Domain Name under dispute “<[standardchartered.pk](http://standardchartered.pk)>” is not only*

*confusingly similar but also identical.*

*As discussed above the registration of the domain name would in addition to confusing reasonable users of web browsers would also confuse users of email who could easily be confused by sending and receiving emails to and from the Domain Name under dispute “<[standardchartered.pk](mailto:standardchartered.pk)>”.*

*As such the Panel finds that paragraph 4(a)(i) of the Policy is established.*

In the DNDRC Decision Case No. C2008-0004 Telenor v. Pakpoint Network it was held that:

*B. Identical or Confusingly Similar*

*The contested domain name <djuice.pk> contains as its distinctive part the designation “djuice”, which is identical to Complainants distinctive trademark Djuice The Panel finds that the conditions in paragraph 4(a)(i) of the Policy are therefore fulfilled.*

In the DNDRC Decision Case No. C2009-0003 RED BULL GmbH v. PakSys Software LLC it was held that:

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

*Therefore the use of this domain name by any other party than the Complainant would not only 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 in furtherance to its business thus causes substantial and irredeemable harm to the Complainant. Consequently, the Panel finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.*

From the above discussed precedents and the requirements laid out in the Policy, it appears that the Respondent has incorporated the Complainant’s tradename in entirety. The Respondent contends that the Complainant’s registered trademark/trade name “Express” is generic and hence his using the same does not constitute mala fide. If the Complainant makes a prima facie case that the Respondent has no rights or legitimate interests, and the Respondent fails to show one of the three circumstances under Paragraph 4(c) of the Policy, then the Respondent may lack a legitimate interest in the domain name, even if it is a domain name comprised of a generic word(s). Factors a panel should look for when determining legitimate use would include the status and fame of the mark, whether the respondent has registered other generic names, and what the domain name is used for (a respondent is likely to have a right to a domain name "apple" if it uses it for a site for apples but not if the site is aimed at selling computers or pornography).

In WIPO Arbitration and Mediation Center Administrative Panel Decision 402 Shoes, Inc. dba Trashy Lingerie v. Jack Weinstock and Whispers Lingerie Case No. D2000-1223 it was held:

*The question as to whether a mark is or has become generic such that the Complainant should not be seen to have "rights" in respect of the mark used or and/registered has been presented to a number of Panels. The concurring opinion, filed herewith, notes the minority view in the existing decisions under the Policy regarding the propriety and the wisdom of analyzing defenses that Complainant's alleged trademark was or is descriptive or generic. The majority here adhere to the minority position that such defenses are beyond the purview of the Panel. We believe that the courts or regulatory authorities are better able to grapple with the question of the generic nature of words and phrases, and the acquisition of secondary meaning. In addition, the summary nature of the procedures under the Rules is not adequate to develop the proof necessary to make an informed decision on these issues. Therefore, the majority here accepts the registered trademark as prima facie evidence of the existence of the mark without analysis of Respondent's assertions that the TRASHY LINGERIE mark is descriptive or generic and without analyzing secondary meaning.*

In WIPO Arbitration and Mediation Center Administrative Panel Decision *Classmates Online, Inc. v. John Zuccarini, individually and dba RaveClub Berlin* Case No. D2002-0635 it was held:

*There is authority that a panel absolutely lacks authority to ignore a valid USPTO registration. *Christie v. Porcaro*, [WIPO Case No.D2001-0653](#); *Hola S. A. v. Idealab*, [WIPO Case No.D2002-0089](#) ("It is not for the Panel to decide whether registration of the marks should or should not have been granted. The holding of a registered mark is sufficient for the purposes of the Policy*

In WIPO Arbitration and Mediation Center Administrative Panel Decision *Emmanuel Vincent Seal trading as Complete Sports Betting v. Ron Basset* Case No. D2002-1058 it was held:

*Respondent, however, does appear to dispute that Complainant has any rights in the term "Cultured Stone," contending that the term is generic. The Panel notes, however, that Complainant owns a registration for the mark CULTURED STONE and that such registration carries with it a presumption that the mark is valid, i.e., not generic. Giving due deference to the determination of the United States Patent and Trademark Office, the administrative agency charged with responsibility for determining the registrability of marks, and in the absence of any evidence to the contrary, the Panel concludes that Complainant has rights in the mark CULTURED STONE.*

In order to determine legitimate use of a generic term, the factors that would be taken into consideration would include the status and fame of the mark, whether the respondent has registered other generic names, and what the domain name is used for (a respondent is likely to have a right to a domain name "apple" if it uses it for a site for apples but not if the site is aimed at selling computers or pornography). The Panel will analyse each of the above

mentioned elements:

- *status and fame of the mark*

The mark “Express” is a legally, officially and validly registered trademark/tradename of the Complainant. Not only is it closely associated with the Complainant’s offering of services related to news, media and information, but is also widely recognised throughout Pakistan as well as internationally. The status of the mark is that it has been registered with the TradeMark Registry, Pakistan and is not pending any objection(s) or the like. Furthermore, if there had been any objection to the mark being generic and hence unable to be registered, it would/should have been raised within two (02) months of the advertisement of the application for registration by the Trade Mark Registry. Furthermore, it is for the Respondent to satisfy the Panel that it satisfies such a requirement. No evidence/supporting document(s) has been provided by the Respondent in support of his claim that his use of the term “Express” in the disputed domain name is not mala fide on his part for the reason that the term is a generic one. In order for such a claim to succeed, the onus is on the Respondent to show the status and the fame of the mark. However, no evidence/proof to this accord has been submitted by the Respondent. As such, in absence of the same, it is reasonable for the Panel to infer that the Respondent has failed to meet this criterion.

- *whether the respondent has registered other generic names*

The Respondent has not provided any evidence/proof to this accord and as such it is reasonable for the Panel to infer that the Respondent has failed to meet this criterion.

- *what the domain name is used for*

Screen shots of the content on the disputed domain name does not show any active activity taking place. The disputed domain name is being used simply as a parking page, with all tabs/hits leading back to the same page, hence depicting inactivity. The Respondent, in his Response contends:

*Respondent contends that it has made demonstrable steps to develop content for its websites located at the Domain Name at issue here. Since the Respondent registered the name, it has developed its website which is live and is in the process of developing the further content sections for the websites.*

*Respondent used the domain name <express.pk> for a significant period of time for business purposes, thus further highlighting his rights and legitimate interests in the title. Also the respondent has spent considerable investment of money and time on the domain name. Respondent alleges that at all times his business was entirely unrelated to that carried on by Complainant*

However, no evidence to the same has been annexed by the Respondent. Neither does the

content on the disputed domain name expressly state that the website is under construction, nor does it give a forecast of upcoming activities; anything that could give illustration of preparation of further content on the website. Furthermore, the Respondent's claim that it has used the disputed domain name for a significant period of time for business purposes, falls short of being supported by evidence. As such, in light of failure of providing evidence on Respondent's part as well as Panel's own analysis of the "use" of the dispute domain name, the Panel can reasonably infer that the Respondent has failed to establish a valid use of the domain name and as such fails to satisfy this criterion as well.

It has been held in previous WIPO Authorities (mentioned above) that it is not for a Panel to decide whether a mark is generic or not, if the same has been registered by an authority entrusted with the task of registration. In this case, the trademark/tradename "Express" has been registered by the Complainant with the Trade Mark Registry, Pakistan. As such, it does not fall within the Panel's ambit to refuse a validly and officially registered trademark/tradename. And/or to treat a registered mark as generic or descriptive and deny the Complainant use of its trademark/tradename as a domain name.

The Panel's analysis of whether the disputed domain name is confusingly similar to Complainant's tradename includes but is not limited to its comparison of the appearance, spelling, sound, and other objective characteristics of the domain name and mark, without regard to the content of the site. Accordingly, the Complainant has succeeded in establishing the confusing similarity. The domain name in dispute reasonably creates likelihood that individuals will be confused into thinking that the domain name or the related site is owned, endorsed, licensed, sponsored, or maintained by the Complainant to promote their services which is not the case at all.

In light of the above mentioned authorities as precedents, facts and accompanying discussions, the Panel has arrived at the conclusion that the contested domain name <express.pk> contains as its distinctive part the designation "express", which is identical to Complainant's distinctive trademark Express. The Panel finds that the conditions in paragraph 4(a)(i) of the Policy are therefore fulfilled.

## **II. 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.”*

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 Panel, in pursuit of rendering this Decision would discuss and analyze findings related to each element of the Paragraph:

*(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;*

Even though the Respondent, in the Response submitted alleges that he has made preparations to use the disputed domain name for business related activity, no such activity can either been seen on the disputed domain name; in form of a disclaimer/banner sating “website under construction/coming soon” etc. Nor has the Respondent supported his contention of using the disputed domain name vide any evidence/supporting documentation. 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 proof or documentation to assert the legitimacy of their claim upon the disputed domain name. In absence of such evidence/proof, it is only reasonable for the Panel to infer that the Respondent’s claim that he has plans to use the disputed domain

name in a legitimate manner is baseless. The Respondent alleges that he has legitimate interest in the dispute domain name since sentimental and personal value has been attached to the phrase “lacks rights and legitimate interests”. The Panel, in considering this cannot reasonably infer exactly what sentimental and personal values are attached to the disputed domain name on part of the Respondent since no activity can be seen on the disputed domain that could be associated with either personal or sentimental values, or even both. In considering whether a legitimate interest is vested in the disputed domain name, the Respondent has to show and support with evidence that he has made preparations, which are not only alleged but are also demonstrable in nature, to use the disputed domain name for a bona fide offering of goods and/or services. In this case, the Panel cannot see any offering of goods and/or services on the disputed domain name. Not only are all the links/tabs inactive but hits to the same reverts the user back to the same page. Furthermore, nowhere on the dispute domain name can it be seen that the webpage is under construction, or a disclaimer about future/further activity. To this effect, the Respondent’s claim that he intends to use the disputed domain name falls short of weight. The Respondent has withheld the dispute domain name since 2006. It has been a good four years since the disputed domain name was registered. And still, no activity can be seen on the same. In this respect, the Panel cannot come to any other conclusion but the Respondent has been unable to satisfy this element of the requirements under the Paragraph.

*(ii) that the Respondent has been commonly known by the domain name;*

The Respondent, in the Response submitted contends that he has proof of having commonly been known as <express.pk> from Bank, friends and business affiliates. The Panel cannot be satisfied to this in absence of proof/evidence submitted by the Respondent. In any case, even in absence of any evidence annexed by the Respondent to support his contention, the Panel, in its reasonable inference cannot help but not be satisfied on the issue that the Respondent has been commonly known by the domain name. This is so since the Respondent is a private individual and not a corporation, company, entity or the like with the tradename “Express” as is the case with the Complainant. Even though the Respondent purports to be commonly known by the disputed domain name amongst friends, business affiliates and a bank, no evidence to prove this has been submitted. As such, the Panel is not satisfied on this issue. Furthermore, the Respondent also contends that from such business dealings, the Respondent can be assumed to have rights and a legitimate interest in the disputed domain name. Even though the Respondent mentions “such business dealings” no further detail(s), clarification(s), evidence/proof or the like has been provided by the Respondent to help the Panel in knowing what business dealings the Respondent is placing its claim on. The content on the disputed domain name does not give any illustration of business dealings. So much so, there is no prospective activity on the disputed domain name that could help the Panel in understanding that any business activity is taking place on the disputed domain name.

The Respondent also alleges the following:

*Under Paragraph 4(c)(ii) of the ICANN UDRP Policy, a complainant cannot prevail if the respondent have been commonly known by the domain name. The Respondent*

*argues that he should prevail because: (1) the term "Express" are generic terms for describing Respondent's services to be marketed at the express.pk Web site; (2) that, as a result, his decision to register the domain name was not in bad faith; (3) he has been discussing and developing the website and business over the past 4 years with various companies and individuals; and (4) his use constitutes "fair use."*

The Panel shall now discuss each of the arguments put forth by the Respondent:

*(1) the term "Express" are generic terms for describing Respondent's services to be marketed at the express.pk Web site;*

It has already been discussed above in light of facts and previous WIPO authorities that it is not for a Panel to decide whether a mark is generic or not, especially in the case where such a mark is a validly registered trademark/tradename. In this case, the Complainant has successfully registered the mark "Express" with the Trade Mark Registry of Pakistan. As such, it is not for the Panel to now disregard a registered trademark and treat it as a generic or descriptive term. Furthermore, the Respondent has not detailed exactly what services it is offering vide the disputed domain name since there is no provision of services at all. The disputed domain name is being used to host a parking page whereby a search engine and various links appear. However, hits to all such links/tabs results in the user being directed back to the same page hence illustrating lack of any activity on the disputed domain name. Nor has the Respondent given any description, details or any information regarding himself or any service(s) being provided vide the disputed domain name. As such, the Panel cannot conclude that the disputed domain name is being used by the Respondent to describe any services being offered on the same.

*(2) that, as a result, his decision to register the domain name was not in bad faith;*

The Respondent simply contends that his decision to register the domain name was not in bad faith. However, no evidence has been provided to support the claim. In any case, the Panel cannot reasonably infer any bona fide on the Respondent's part since the disputed domain name not only incorporates a registered trademark/tradename of an entity different from the Respondent, but also that the disputed domain name is not being used to offer any bona fide goods and/or services at all. In addition to this, there is neither any disclaimer/banner expressly stating that future activities are soon to be launched, nor does the webpage on the disputed domain name give any indication of any preparatory activities with respect to the same. As such, again, the Panel is not satisfied that the Respondent's registration of the disputed domain name lacks mala fide.

*(3) he has been discussing and developing the website and business over the past 4 years with various companies and individuals;*

The Respondent argues that he has been discussing and developing the website and business over the past 04 (four) years with various companies and individuals. However, no

evidence/proof to support this claim has been provided by the Respondent. The Respondent has not annexed any correspondence, communication, invoicing, plans or anything of the like that would/could give indication of his discussions and developments related to the disputed domain name. Even though the Respondent has held the disputed domain name over the past four years, no progress can be seen on the disputed domain name. The Panel has been regularly checking the disputed domain name since the Complaint was filed and has not seen anything change on the disputed domain name. Hence, the Panel cannot reasonably infer or be satisfied that the Respondent has been developing the disputed domain name. Nor has the Respondent based his claim of discussions with various companies and individuals on any documentary/admissible evidence/proof. In absence of such evidence/proof, the Panel is unable to give weight to the Respondent's above mentioned claim.

*(4) his use constitutes "fair use.*

The Respondent argues that his use constitutes "fair use". However, the Panel is unable to decipher what the disputed domain name is being "used" for. As for now, the disputed domain name is merely being used to host a parking page with a search engine and several inactive tabs/links. The Respondent has also not provided any evidence/proof to this aspect of his claim. In absence of such evidence and on the basis of Panel's own observation of the disputed domain name, the Panel is not satisfied that the Respondent's use of the disputed domain constitutes "fair use".

In light of the above mentioned and discussed facts and arguments proposed by the Respondent, the Panel reasonably holds that the Respondent has failed to meet and satisfy the criteria of this subsection of the Paragraph.

*(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 disputed domain name is being used to host a parking page with a search engine and several inactive tabs/links. The Respondent is not using the disputed domain name to offer any goods and/or services. Even if it plans on doing so, no evidence to either has been provided by the Respondent. The Panel is unable to establish any legitimate interest on the part of the Respondent to the disputed domain name as the Respondent is neither using the disputed domain name for any activity at all, nor is he 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 "Express" as part of the disputed domain name.

As such, 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.

In WIPO Arbitration and Mediation Center Administrative Panel Decision PHD Group Pty Ltd, Barrett Property Group Pty Ltd., Barrett Property Group Western Region Pty Ltd., BPS Group Pty Ltd., BPG Access Pty Ltd., RSS Property Holdings Pty Ltd. v. Abedellatif Shatila Case No. D2010-0812 it was held:

*B. Rights or Legitimate Interests*

*Complainant asserts that Respondent does not have any rights or legitimate interests in the Domain Name because: (1) Respondent is not commonly known by the PORTER DAVIS mark nor does he have any registered trademarks or business names incorporating that mark; and (2) Respondent is making a commercial use of the Domain Name by offering it for sale for a minimum of USD\$1,200 on the website "AfterNic DLS Domain Listing Service" ([http://domainersadvantage.afternic.com/?page\\_id=661](http://domainersadvantage.afternic.com/?page_id=661)) via a link to this website from the website associated with the Domain Name. Respondent does not contest the former allegation or the evidence of record supporting the latter allegation.*

*Respondent claims that he is making a legitimate noncommercial use of the Domain Name, without intent for commercial gain and he denies attempting to attract Internet users to his website or creating a likelihood of confusion. Those conclusory claims do not rebut Complainants' prima facie case and other evidence of record showing: (1) Respondent is not commonly known by the PORTER DAVIS Mark nor does he have any registered trademarks or business names incorporating that Mark; (2) Respondent is making a commercial use of the Domain Name by selling it for a minimum of USD\$1,200; (3) Respondent has registered a confusingly similar domain name that wholly incorporates the dominant portion (PORTER DAVIS) of Complainants' marks; and (4) Respondent adopted the Domain Name <porterdavis.com> for its website and prominently displays the Domain Name on its website where it maintains links to a variety of products and services including those akin to Complainants' (e.g., House And Land Packages, Home Buying, Buy A Home, Real Estate Commercial) likely for click through revenue.*

*The Panel therefore concludes that Respondent does not have any rights or legitimate interests in the PORTER DAVIS Mark, thus, Complainants have satisfied paragraph 4(a)(ii) of the Policy.*

In WIPO Arbitration and Mediation Center Administrative Panel Decision Varian Medical Systems Inc. v. Private Case No. D2010-0815 it was held:

*B. Rights or Legitimate Interests*

*Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent, were it to have made one, to the disputed domain name under paragraph 4(c) of the Policy.*

*The Complainant has never authorized the Respondent to utilize its VARIAN or VARIAN MEDICAL SYSTEMS marks in conjunction with any of the products or services with which the Complainant uses those marks, nor does the Complainant apparently have any relationship, affiliation or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's*

*marks or one confusingly similar thereto in connection with the identical or even similar goods and services to those currently provided by the Complainant, as recited in any of its trademark registrations, might likely violate the exclusive trademark rights now residing with the Complainant.*

*Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.*

In WIPO Arbitration and Mediation Center Administrative Panel Decision LEGO Juris A/S v. Heihachi.net, Heihachi Ltd WHOIS-PROTECTION Case No. D2010-0821 it was held:

*B. Rights or Legitimate Interests*

*The Complainant has made a prima facie showing the Respondent has no rights or legitimate interests in the disputed domain names, and that the Respondent has never been licensed or authorized by the Complainant to use the LEGO mark or the disputed domain names. Moreover, it does not appear that the Respondent is commonly known by the disputed domain names or that the Respondent is making a legitimate noncommercial or fair use of the disputed domain names. The Respondent has failed to come forth with any demonstration of rights or legitimate interests in the disputed domain names.*

*The Panel accordingly determines that the Respondent has no rights or legitimate interests in the disputed domain names*

In WIPO Arbitration and Mediation Center Administrative Panel Decision Imprebanca S.p.A. v. Ars Media Group S.r.l. Case No. D2010-0823 it was held:

*B. Rights or Legitimate Interests*

*There is no evidence that Respondent has any right or legitimate interest in or to the name "Imprebanca" and its related domain names. Nothing in the web sites into which the four domain names resolve supports a different conclusion. Additionally, Respondent has elected not to reply to Complainant's contentions, thus leaving the Panel deprived of any counter-argument.*

*Accordingly, the Panel finds that the second element under paragraph 4(a)(ii) of the Policy is satisfied*

In WIPO Arbitration and Mediation Center Administrative Panel Decision Clearwire Legacy LLC v. DomainsByProxy.com/The Christian Party Case No. D2010-0828 it was held:

*C. Rights or Legitimate Interests*

*It is undisputed that there was no direct contractual relationship between the Complainant and the Respondent and that the Complainant never authorized the Respondent to use a domain name incorporating the Complainant's marks.*

*The Panel finds that the second element of the Policy has been established.*

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.

In the DNDRC Decision in Standard Chartered PLC v. Hosting Campus Domain Case No. C2007-0001 it was held that:

*Para 4(a)(ii) and Para 4(c) of the UDRP Policy read with Para 3(b)(ix)(2) of the Rules for the U(DRP)*

*Paragraph 4(c) of the UDRP (Policy) provides that evidence of one or more of the following shall demonstrate a respondent's rights or legitimate interests to a domain name:*

- a. Before any notice to the respondent of the dispute, the respondent's 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*
- b. The respondent (as an individual, business, or other organization) had been commonly known by the domain name; or*
- c. The respondent is making a 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.*

*Hence, in all respects, inter alia from the contents of the Complaint, the Response and the facts disclosed before this Panel, as well as the discussion above, the Complainants' assertion that the Respondent has no rights or legitimate interest in the domain name stands satisfied.*

In the DNDRC Decision Case No. C2008-0004 Telenor v. Pakpoint Network it was held that:

*C. Rights or Legitimate Interests*

*According to the Complaint, it has not licensed or otherwise permitted Respondent to use its trademark or to apply for any domain name incorporating the mark.*

*The Complainants have established a prima facie case that the Respondent has no rights or legitimate interests in the domain name. The Respondent has not rebutted this and the way the Respondent has been using and is still using the contested domain name (djuice.pk) does not support a finding of rights or legitimate interests.*

*Consequently the Panel finds that the conditions in paragraph 4(a)(ii) of the Policy, with reference to paragraph 4(c) of the Policy, are also fulfilled.*

*The Policy paragraph 4(c) allows three nonexclusive methods for the Sole Panelist to conclude that it has rights or a legitimate interest in the Domain Name:*

*(i) evidence of use of, or demonstrable preparations to utilize, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services*

*In the present case, the Sole Panelist cannot confer any such activity by the Respondent. Even though the domain name in dispute is being used by the Respondent, it is not being done so for a bona fide provision of services. This is evidenced by the fact that the Respondent is using the domain name in dispute to transfer the user to other links, to various other domains that offer various web based cellular services.*

*(ii) the Respondent has been commonly known by the domain name, even if there has been no acquisition of the trademark or service mark rights.*

*The Respondent has provided no response to the allegations of the Complainant, even though an invitation to submit a response was sent to them, as per the Rules.*

*Therefore, the Sole Panelist finds that Respondent has no rights or legitimate interest in the Domain Names pursuant to the Policy paragraph 4(a) (ii).*

In the DNDRC Decision Case No. C2009-0003 RED BULL GmbH v. PakSys Software LLC it was held that:

*III. 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).”*

*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). 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.*

*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 trademarks/names 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. Accordingly, the Panel finds that Paragraph 4(a) (ii) of the Policy is satisfied.*

Based on the present record, the above noted discussions and the applicability of the above

mentioned precedents to the facts of this case, the Panel finds that Respondent has no rights or legitimate interests with regard to the disputed domain name.

### **III. 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 Panel opines that the name of the Complainant and the trade mark “Express” 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 “Express” 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 “Express” 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 is using the disputed domain name simply as a parking page, and is not offering any goods/services vnde the disputed domain name.

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 "Express". 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).

*(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*

The Respondent, in his Response expressly alleges that:

*We would like to maintain our ownership of express.pk as we have invested significant time and money developing the website and business and we are commonly known as express.pk, or we would like compensation for the time and money invested in the business and domain.*

Even though the Respondent alleges that h has invested time and money in developing the website and business and that he is commonly known by the disputed domain name, no evidence to the same has been submitted by the Respondent. Furthermore, no activity on the disputed domain name gives any indication or illustration that could form basis of the Respondent's contention that substantial time and money has been spent on the disputed domain name. The Panel cannot reasonably conclude or even infer that any such investment of either of the resources, being time or money has been made by the Respondent. And if it has been, then the same has not been supported by any documentary evidence by the Respondent. Furthermore, the Respondent, in remedies sought, is clearly claiming compensation for the time and money invested in the business and the disputed domain name. Again, in absence of any evidence/documentary proof to this effect, the Panel is not satisfied of any such investments made by the Respondent. Furthermore, the fact that the Respondent is at one instance alleging personal and sentimental values attached to the disputed domain name and in another instance claiming compensation for the time and money spent on the disputed domain name is indication of lack of bona fide on the Respondent's part.

*(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*

The Respondent is not the owner of the registered trademark/tradename “Express”. The Respondent has not provided any evidence/documentary proof to enable the Panel to either reasonably infer or conclude that the Respondent did not register the disputed domain to prevent the Complainant from using the mark “Express” in a corresponding domain name. nor has the Respondent provided any information, clarification or any description which would enable the Panel to assume that the Respondent has not been engaged in a pattern of registering domain names that incorporate others’ registered trademarks/tradenames. As such, the Panel is not satisfied that the Respondent did not register the disputed domain name to obstruct the Complainant from registering the disputed domain name for its own use.

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

Again, the Respondent has not submitted any detailed information, evidence and/or documentary proof to enable the Panel to assume, reasonably infer or conclude that the Respondent did not register the domain name primarily for the purpose of disrupting the business of a competitor. So much so, the Respondent has not even disclosed exactly what kind of business it is involved in, what business dealings it has with affiliates, what it plans to do on the disputed domain name etc. The brief information provided by the Respondent is quite vague and lacks substantive crux with respect to the kind of business the Respondent is involved in or the purpose of using this particular mark “Express” while registering the domain name. As such, in absence of details, information, evidence and documentary proof by the Respondent, the Panel is not satisfied that the Respondent registered the domain name for anything but disrupting the business of a competitor.

*(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 Respondent has not provided any information, details, evidence or documentary proof to show/illustrate that it has been known by the mark “Express”. However, the Complainant is not only widely recognized, but is also well known throughout Pakistan as well as in international market. Anybody looking for the Complainant on the internet portal, who comes across the disputed domain would most likely be confused that the disputed domain name/Respondent is an affiliation, sponsorship, endorsement or the like of the Complainant, when no such affiliation, endorsement or sponsorship exists between the Parties. The Complainant has not authorized the Respondent to use its registered trademark/tradename in any manner whatsoever at all. As such, the Panel cannot reasonably infer/be satisfied that the

Respondent did not register the disputed domain to intentionally attempt to attract, for commercial gain, Internet users to the disputed domain site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name.

In conclusion, the Panel finds that the third test under paragraph 4(a) has been not been successfully established by the Respondent.

In WIPO Arbitration and Mediation Center Administrative Panel Decision Brigitte Poulin, Jean-Guy Poulin v. Ggot, Ltd. Case No. D2010-0834 it was held:

*C. Registered and Used in Bad Faith*

*The Respondent's use of the Disputed Domain Name is apparently for domain monetization unconnected with any bona fide supply of goods or services by the Respondent. The PPC business model in this case, is that the Respondent passively collects click-through revenue generated solely from the Complainants' goodwill and Internet users' inaccurate guessing of the correct domain name associated with the Complainants' 78 POULIN RACING stock-car driving team, such guessing made harder in this case by virtue of the Complainants prior ownership and use of the Disputed Domain Name. Exploitation of the reputation of a trademark to obtain click-through commissions from the diversion of Internet users is a common example of use in bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous decisions. (See: L'Oréal, Biotherm, Lancôme Parfums et Beauté & Cie v. Unasi, Inc, [WIPO Case No. D2005-0623](#); Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., [WIPO Case No. D2000-0163](#) and Hoffmann-La Roche Inc. v. Samuel Teodorek, [WIPO Case No. D2007-1814](#)).*

*This Panel finds that the Respondent has taken the Complainants' trademark 78 POULIN RACING and incorporated it in the Disputed Domain Name without the Complainants' consent or authorization, for the very purpose of capitalizing on the reputation of the trademark by diverting Internet users to a PPC web page containing pornography and links to pornography for commercial gain.*

*Accordingly, the Panel finds that the Complainants have satisfied the requirements of paragraph 4(a)(iii) of the Policy.*

In WIPO Arbitration and Mediation Center Administrative Panel Decision Revlon Consumer Products Corporation v. IONE Inc. Case No. D2010-1000 it was held:

*C. Registered and Used in Bad Faith*

*Complainant must demonstrate bad faith registration and use of the Domain Name.*

*In this case, Respondent knowingly used Complainant's widely-known trademark, without Complainant's authorization, in registering and using a Domain Name that was clearly intended to exploit Complainant's considerable goodwill in the mark—a Domain Name in which Respondent has not established that it has rights or*

*legitimate interests. Such scenarios have been held sufficient to constitute bad faith registration and use.*

*The Panel concludes that there was bad faith in the registration and use of the Domain Name and that Complainant has thus proved the third and final element of its case.*

WIPO Arbitration and Mediation Center Administrative Panel Decision BlackRock Institutional Trust Company, N.A. v. Investors FastTrack Case No. D2010-1038 it was held:

*D. Registered and Used in Bad Faith*

*The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See, Telstra Corporation Limited v. Nuclear Marshmallows, [WIPO Case No. D2000-0003](#). The overriding objective of the Policy is “to curb the abusive registration of domain names in the circumstances where the registrant is seeking to profit from and exploit the trademark of another”. Match.com, LP v. Bill Zag and NWLAWS.ORG, [WIPO Case No. D2004-0230](#).*

*Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.*

In WIPO Arbitration and Mediation Center Administrative Panel Decision The American Automobile Association Inc. v. Insurance Express.com Inc., Gene Graceffo Case No. D2010-0196 it was held:

*Used In Bad Faith*

*The Panel also finds that the Respondent used the Disputed Domain Name in bad faith. It is well-established that using a domain name which incorporates a trademark to offer the products of competitors of the trademark owner is likely to cause confusion among consumers as to the source of products or to confusingly suggest sponsorship by the trademark owner. See e.g., Six Continent Hotels, Inc. v. The Omnicorp, [WIPO Case No. D2005-1249](#); Exel Oyj v. KH Trading, Inc., [WIPO Case No. D2004-0433](#).*

*For all of the foregoing reasons, this Panel finds that the Complainant has proven that the Respondent registered and is using the disputed domain name in bad faith. Therefore, the Panel is convinced that the Complainant has proven the third and final element of the Policy.*

In WIPO Arbitration and Mediation Center Administrative Panel Decision Telephone Communications Ltd. v. Golan Thomas Case No. D2010-0187 it was held:

*C. Registered and Used in Bad Faith*

*The disputed domain name is virtually identical to the Complainant's trademark. Previous WIPO panels ruled that in such circumstances “a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic*

*from the Complainant's site to the Respondent's site". See: [Edmunds.com, Inc v. Triple E Holdings Limited, WIPO Case No. D2006-1095](#). To this end, prior WIPO panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to a registered trademark may be evidence of bad faith under paragraph 4(b)(iv) of the UDRP. See [Humana Inc. v. Cayman Trademark Trust, WIPO Case No. D2006-0073](#); [Edmunds.com, Inc. v. Ult. Search Inc., WIPO Case No. D2001-1319](#).*

*It is therefore the finding of the Panel that the Respondent registered and is using the disputed domain name in bad faith.*

In the DNDRC Decision in [Standard Chartered PLC v. Hosting Campus Domain Case No. C2007-0001](#) it was held that:

*Hence, in case any of the elements above are satisfied before the Panel, it would constitute evidence of bad faith on part of the Respondent. It may also be noted that these elements are not exclusive and are "without limitation" and further elements evidencing or demonstrating bad faith may be satisfactory for a finding of Registration in bad faith by a Respondent.*

*As such the Panel finds that on multiple counts the Respondent has been found to have registered the domain name in dispute under bad faith therefore satisfying also the third requirement under the UDRP.*

In the DNDRC Decision Case No. [C2008-0004 Telenor v. Pakpoint Network](#) it was held that:

#### *D. Registered and Used in Bad Faith*

*Considering all the facts and evidence, the Panel therefore finds that the requirements of paragraph 4(a)(iii) of the Policy are also fulfilled in this case.*

*The Domain Name is therefore so obviously connected with such a well-known name that its very use by someone with no connection with the industry suggests opportunistic bad faith*

*The Domain Name comprises of the term "djuice", which is identical to the Complainant's Djuice trade name. The Panel considers that the Djuice trademark has a well established reputation and is well known throughout the world. The Panelist finds it is reasonable to conclude that only someone who was familiar with the Djuice trademark could have registered the Domain Name.*

*Actual or constructive knowledge of the Complainant's rights in the Trademarks is a factor supporting bad faith. See [Expedia, Inc. v. European Travel Network, D2000-0137 \(WIPO April 18, 2000\)](#). Therefore the Panelist finds that the Domain Name was registered in bad faith.*

In the DNDRC Decision Case No. [C2009-0003 RED BULL GmbH v. PakSys Software LLC](#) it was held that:

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

*Therefore, given the Complainant's numerous trademark/name rights for "REDBULL" or "RED BULL" and its wide reputation, it is difficult to conceive of a plausible circumstance in which the Respondent could legitimately use the domain name in dispute. Thus the Panel finds that the third test under paragraph 4(a) has been established successfully by the Complainant.*

Based on the present record, the above noted discussions and the applicability of the above mentioned precedents to the facts of this case, the Panel finds that Respondent has registered and is using the disputed domain name in bad faith.

**WIPO Authorities relied upon by the Respondent:**

The Respondent claim that he had rights and legitimate interests and that his registration of the disputed domain name is not in bad faith. Furthermore, that, since the Respondent registered the disputed domain before the Complainant's trademark "Express" was registered and as such the earlier good transaction cannot later become bad faith if the other company was not within reasonable contemplation of the Respondent. The Respondent has sought to base this contention on the WIPO Authority *Aspen Grove Inc. v. Aspen Grove*, D2001-0798.

The Panel has reviewed the mentioned authority and the discussions and findings in the same. Applying those onto the current case, the Panel would hereby discuss the authority and consider its validity with respect to this Decision.

- *Aspen Grove Inc. v. Aspen Grove*, D2001-0798

In the above noted authority it was held:

*Legitimate Rights or Interests*

*The Respondent has answered the Complainant's contentions on this point by showing it has used the disputed domain name as an e-mail address for the Clark family (the Response, Exhibit 3).*

*The Panel agrees with the Respondent that using a domain name as an e-mail address, a use that began several years before the Complainant's company even came into existence, is a legitimate right and interest under the Policy.*

It is pertinent to note that in the above mentioned citation and the discussion and findings under the head of legitimate rights or interests, the Panel agreed with the Respondent's counterclaim as the Respondent had showed so. Implying that, the Respondent had supported its claim with documentary evidence. This is not so in the current case before this Panel since the Respondent has neither annexed any documentation nor supported any/all of its claim(s),

contentions(s), counterclaim(s) with any evidence at all. As such, the Panel cannot reasonably infer existence of any such legitimate rights or interests in favor of the Respondent in absence of any proof put forth by the Respondent.

*Registered and Used in Bad Faith*

*For its part, the Respondent has shown that it registered the disputed domain name some two years before the Complainant was incorporated and perhaps began doing business using the disputed domain name.*

*The Panel finds that it would have been impossible for the Respondent to have been in bad faith vis-à-vis the Complainant when the Respondent registered the disputed domain name since the Complainant did not exist at the time the Respondent registered the disputed domain name. Furthermore, the Panel does not find bad faith obtains simply because, as here, the Complainant offers the Respondent far more than the Respondent paid for the disputed domain name and the Respondent asks for an even larger sum.*

*The Panel finds the Complainant has failed to meet its burden under the Policy at 4(a)(iii).*

The discussions and findings under this head in the above mentioned authority are not relevant to the facts of the current Complaint since the Complainant did exist at the time when the disputed domain name was registered. Furthermore, not only was the Complainant existing at the time of the registration of the disputed domain name, but also had acquired trademark rights to the mark Express as discussed above. Furthermore, the Complainant has not offered to obtain the disputed domain name from the Respondent at all, rest alone for a higher price. In fact, it is on the contrary, implying that it is the Respondent who has offered to sell the disputed domain name in consideration for the time and money that he has incurred with respect to the disputed domain name. As such, the above mentioned citation is not relevant in this case since the facts do not match and in any case, the Respondent has not annexed any documentary evidence to support his claim(s), contention(s), and counterclaim, as was the case in the Authority relied upon by the Respondent.

The Respondent had also charged the Complainant with reverse domain name hijacking. In this regard, the Respondent has based his accusation against the Complainant on the following WIPO Authorities:

- Aspen Grove, Inc. v. Aspen Grove, Case No. D2001-0798
- NetDeposit, Inc. v. NetDeposit.com, Case No. D2003-0365

In Aspen Grove, Inc. v. Aspen Grove, Case No. D2001-0798, it was held:

*7. Reverse Domain Name Hijacking*

*The Respondent contends the Complainant brought this Complaint in bad faith in an attempt illicitly to gain possession of the disputed domain name. The Respondent contends the Complainant was well aware there was no basis for requesting a domain name transfer under the Policy.*

*The Panel notes that we have found the Complainant did not demonstrate it had trademark rights in the disputed domain name. The Panel also recalls that the Respondent demonstrated rights in the disputed domain name that have been recognized by many previous ICANN panels. And finally, the Panel notes yet again that the Respondent registered the disputed domain name some two years before the Complainant came into existence and thus could not have been in bad faith at registration relative to the Complainant. Based on this fact pattern, the Panel believes it appropriate to issue a finding that the Complainant has attempted reverse domain name hijacking, i.e. the Complaint was unfounded and was brought in bad faith as this is prohibited in the Rules at 15(e):*

In the above mentioned citation, the facts show that the complainant in that case had not put forth any trademark registrations. This is not so in this case, whereby the Complainant, in this case, had demonstrated its valid and official trademark registrations with respect to the mark Express registered with the Trade Mark Registry of Pakistan. Furthermore, in the citation relied upon by the Respondent, the respondent, in that case had demonstrated rights in the disputed domain name. The Panel reiterates that no such rights, either in common law or in actual have been demonstrated by the Respondent in this case. In the authority relied upon by the Respondent, the respondent in that case had registered the disputed domain name before the complainant had come into existence. This is not so in this case, where, not only was the Complainant existing and operating at the time when the disputed domain name was registered, but had also applied for the trademark registration of the mark Express, which was officially and validly granted to the Complainant subsequently. As such, the Panel in this case cannot base its Decision on the facts/findings in the above mentioned citation since the Panel cannot reasonably infer the facts in both the cases to be same and as such cannot reasonably apply the findings of that citation onto this Complaint. Hence, the Panel is not satisfied that the Respondent's allegation of Complainant's reverse domain hijacking is of any substance.

In *NetDeposit, Inc. v. NetDeposit.com*, Case No. D2003-0365, it was held:

*D. Reverse Domain Name Hijacking*

*The Respondent contends the Complainant brought this Complaint to harass the Respondent because it refused to sell the disputed domain name to the Complainant for the Complainant's high offer of US\$100. The Panel agrees with the contention. Per paragraph 15(e) of the Rules, the Panel finds this Complaint was brought in bad faith and constitutes an abuse of Policy proceedings.*

The finding under the head of reverse domain hijacking does not apply onto the current case since the Panel is unable to infer any relevance and matching of facts, in some degree at least if

not entirely. In the above mentioned citation, the complainant in that case had offered to obtain the disputed domain name from the respondent in that case for a higher amount. This is not the case in this Complaint, where the Complainant has not made any offer to obtain the disputed domain name from the Respondent. Hence, the Panel is unable to entertain the discussion and finding under the head of reverse domain hijacking in the authority relied upon by the Respondent and as such cannot reasonably hold that the Complainant has been engaged in a reverse domain hijacking as alleged by the Respondent.

The Respondent contends that it has a legitimate right to use the domain name based on grounds that it has made “use of, or demonstrable preparations to use, the domain name in connection with a bona fide offering of services”. In this regard, the Respondent relies on *SFX Entertainment, Inc. v. Phillip Cushway*, Case No. D2000-0356.

In the above mentioned citation, it was held:

*The Panel determines, however, that Respondent has rights or legitimate interests in respect of the domain name. In particular, the Panel finds that the evidence, including the sworn declaration of Alan Forbes (see Exhibit D of Response), supports a determination that, prior to commencement of the instant dispute, Respondent began demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services, within the meaning of para 4.c.(i) of the Policy..*

The Panel cannot reasonably be satisfied, hold or conclude that the Respondent has rights or legitimate interests in the disputed domain name, as was found in the above mentioned citation, since, inter alia, the Respondent has not annexed any documentary evidence with respect to his preparation(s) to use the disputed domain name, as was the case in the above mentioned Authority. In that case, the respondent in that case had submitted evidence, along with a sworn affidavit, which is not the case in this Complaint, where the Respondent has not supported his claim, contention with any evidence/proof at all. In particular, with respect to Respondent’s claim that he has invested time and money in planning and developing the content to be placed on the disputed domain name. The Panel cannot reasonably infer, be satisfied, conclude and/or decide/hold that the Respondent has made “use of, or demonstrable preparations to use the disputed domain name” since no evidence to support the same has been put forth/submitted by the Respondent.

The Respondent also alleges that at all times his business was entirely unrelated to that carried on by the Complainant. In this regard, the Respondent relies on *Warm Things, Inc., Inc. v. Adam S. Weiss*, Case No. D2002-0085 whereby it was held:

*Respondent has stated without contradiction by Complainant that from 1998 until mid-2000, it used the domain name to point to a website on which it offered products and services. As such, Respondent has shown that before notice of this dispute, which Complainant states did not occur until March 2000, Respondent had used the domain name in connection with a bona fide offering of goods or services.*

The Panel cannot reasonably apply this discussion/finding in the above mentioned citation with respect to the use of the disputed domain name by the Respondent, since the Respondent has not tendered any proof/evidence of any use/business activity with respect to the disputed domain name. The Respondent, in this case, alleges that he used the disputed domain name for a significant period of time for business purposes; however, no documentary evidence supporting this contention has been submitted by the Respondent. As such, the Panel cannot be reasonably satisfied and/or hold that the Respondent has rights and legitimate interests in the disputed domain name vide its use of the same in a bona fide manner. Furthermore, the Panel visited the disputed domain name and did not come across any activity taking place on the same. As mentioned and discussed earlier in this Decision, the disputed domain name is being used to host a parking page with inactive links/tabs. Even though the Respondent has repeatedly contended that he has invested time and money, has sentimental values attached to the disputed domain name, has planned and discussed business related activities with business affiliates, no evidence to support either/all of these has been put forth by the Respondent. As such, in absence of any proof to the like, the Panel cannot reasonably infer, hold and/or decide that the Respondent's claim of having rights and legitimate interests with respect to the disputed domain name holds any substance.

Furthermore, the Respondent alleges that since he registered the disputed domain name, he has been in the process of developing further content sections for the website and that in order to test these new sections, the Respondent has developed a series of "test sites". The Respondent contends that while the general public would be unable to see the test websites, the Respondent is able to access these test sites in order to develop further sections with respect to the disputed domain name. The Panel notes that the Respondent has not submitted any documentary proof with respect to this contention. Neither has the Respondent submitted any description of what business activity he wishes to pursue on the disputed domain, nor has he annexed any screen shots of the test sites in order for the Panel to take the same into consideration while rendering this Decision.

As can be seen, the Respondent is at pains to state that they are not using but are going to use the domain name for some business activity. What this business activity is has not been mentioned or explained by the Respondent. No facts relating to or describing the business related activity to be pursued on the dispute domain name have been disclosed, demonstrated, tendered nor proved. Any/all contentions put forth by the Respondent cannot be accepted by the Panel since no evidence or even facts demonstrating use or preparation for use of the same have been provided or proved by the Respondent. Nor can it be accepted by the Panel that the use of a registered trade and service name and mark can be justified by using it to attract customers to what is a confusingly similar and identical domain name. The fraudulent, passing-off and breach of trade mark law have already been examined by the Panel and therefore, do not need repeating but can simply be read here for the sake of brevity as including the reasons for rejecting the claims of the Respondent above in general and in particular with the regard to the failure by the Respondents to demonstrate or prove bona fide preparations for use of the domain name.

## **8. Decision**

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

- i. The Respondent's registration of the disputed domain name <express.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 <express.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/](http://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 (Sole Panelist):** Barrister Samay Shams

**Dated:** 01<sup>st</sup> October, 2010