

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

**Arbitration and Mediation Center**

**COMPLAINT PANEL DECISION**

**La-Z-Boy Incorporated v. LA-Z-BOY (Pvt.) Ltd**

**C2011-0004**

**Also in PDF C2011-0004**

**1. The Parties**

The Complainant is La-Z-Boy Incorporated, having its principle premise of business at 1284 North Telegraph Road, Monroe, Michigan 48162, United States of America.

The Complainant has instituted the Complaint through its Authorized Representative, M/s Khursheed Khan & Associates located at 47 Modern CHS, Tipu Sultan Road, Karachi-75350, Pakistan.

The Respondent is LA-Z-BOY (Pvt.) Ltd. The WHOIS date shows the address of the Respondent to be 13-A, Al-Kibria Shopping Centre, C.P. Berar Housing Society, Block 7-8 Karachi.

**2. The Domain Name and Registrar**

The disputed domain names are <la-z-boy.com.pk> and <lazyboy.com.pk>, hereinafter referred to as the Disputed Domain Names.

**3. Procedural History**

The Complaint was filed with the Domain Name Dispute Resolution Center (the “DNDRC”) on 08<sup>th</sup> December, 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 5<sup>th</sup> January, 2011 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 the Response on 11<sup>th</sup> January, 2011.

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.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), the Center appointed Mr. Mustafa Syed as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules. 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 <lazyboy.com.pk> on 20<sup>th</sup> March, 2007 and the disputed domain name <la-z-boy.com.pk> on 21<sup>st</sup> July, 2009.

#### **5. Parties’ Contentions**

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

The Complainant has made the following assertions:

- i. The manner in which the disputed domain name is identical to the trade marks or service marks in which the Complainants hold rights.*

*That the Complainants are one of the leading international companies trading in a variety of goods and services for high quality furniture, accessories and particularly recliners all over the world. The Complainants are the creators, first adopters and users of the trade mark that they have successfully used for their company and their products for many years in a large number of countries worldwide, including in Pakistan. That although the Complainants’ company is based in United States of America, the export of their **La-a-boy** trade marked products is made to a number of countries outside United States of America, including Pakistan.*

*That the Complainants adopted the **La-z-boy** trade mark in 1929 in connection with reclining chairs, and has become one of the most recognized brands in the furniture industry the world over. The Complainants have a direct presence in Pakistan through their authorized local distributors, both in Lahore and Karachi.*

*That for the purpose of legal protection of their worldwide popular trade mark **La-z-boy**, the Complainants obtained trade mark registrations in a number of countries where their products enjoy both high sales, and goodwill. It is pertinent to mention here that the Complainants have registered several variations of their mark **La-z-boy**, including **LAZBOY**, **LA-Z-BOY**, **LAZY BOY** and **LA-Z-GIRL**.*

*That the disputed domain is not only confusingly/deceptively similar to the Opponents' **La-z-boy** trade mark but is also confusingly similar in sound and phonetics which makes the former potentially devious.*

*That the Complainants trade name also incorporates their internationally acclaimed trade mark **La-z-boy** which has become the identity of the Complainants. The disputed domain is virtually identical to the Complainants' said distinctive trade mark/trade name.*

*Furthermore, none of the above referred trade marks belonging to the Respondents are common English words as they have been intelligently coined and therefore are inherently distinctive to distinguish the Complainants from other players in the business.*

- ii. ***The Respondents have no bonafide use in the disputed Domain name [la-z-boy.com.pk](http://la-z-boy.com.pk) (the "Policy" adopted by ICANN; Provision 4(b)(ii)).***

*The fact that the Respondents have not put into use the impugned website whereas they have registered the same with the Registrar abovementioned on March 20, 2007, is a clear indication that the Respondents have merely blocked the said domain name with the sole intention to prevent the owner of the trade mark or service mark (being the Complainants) from reflecting the mark in a corresponding .cc domain name.*

- iii. ***The Respondents have no legitimate Interests or Rights in the disputed Domain name [la-z-boy.com.pk](http://la-z-boy.com.pk) (the "Policy" adopted by ICANN; Provision 4(b)(iv)).***

*To the Complaints' knowledge, the Respondent has no legitimate use of the disputed domain mentioned hereinabove and never had any intention to do so. The Respondent is merely using the domain names which are confusingly similar to the **La-z-boy** trade marks in order to attract, for commercial gain, Internet users to the Respondents' web site by creating a likelihood of confusion with the Complainants' marks as to the source, sponsorship, affiliation, or endorsement of the Respondents' web site.*

## **B. Respondent**

The Respondent countered the Complainant's contentions by submitting the following:

*Respondent company LA-BOY Pvt Ltd. are registered with the securities and exchange commission of Pakistan and respondent acquired the legal rights as per provisions of companies ordinance 1984 for the company name LA-Z-BOY Pvt Ltd. respondent has the sole and exclusive rights to use the above company name La-z-boy to the manufacture, sales, import, export, hire and etc. Complainant very well know that any attempt to use the above company name of respondent in any manner whatsoever without that explicit permission of respondent's will be an offence and express violation of law , tantamount to passing off and unfair competitive Practice*

*Complainant company trade mark is not registered in Pakistan and their company is also not registered in Pakistan ,Complainant submitted application for the trade mark registration in the last month of 2009 , at a time when Respondent trade marks are already published in trademark general 2008, and now complainant application are on pending at trade mark registry Pakistan.*

*Respondent Both trade marks L A Z Y B O Y & L A Z B O Y already has been published In trademark general 2008 respondent applied for both of these trade marks in 2007 ,Complainant claimed that L A Z Y B O Y & L A Z B O Y are same words this is not correct ,Complainant submitted application in 2009 at trade mark registry for L A Z B O Y not for the L A Z Y B O Y that's why respondent trying to create confusion between two different words.*

*Respondent Company La-z-boy Private Limited also registered with the CBR and paying all Government of Pakistan Taxes.*

*Complainant Company neither registered with SECP and neither their Trade mark registered in Pakistan. And now they are busy to create evidence of their presence in Pakistan.*

*The respondent company LA-Z-BOY Pvt Ltd. is incorporated and Registered with the SECP and La-z-boy Pvt Ltd. are very famous in Pakistan and also in all over the world .attached herewith is a copy of search conducted at SECP and also attached herewith is a copy of incorporation certificate by SECP (EXHIBIT 9 )*

*SECP is an org of govt of Pakistan. (www.secp.gov.pk)*

*La-z-boy Pvt Ltd. use their websites domain names for selling their branded products & correspondence on e-mail with their customers ,respondent use these websites since several years, respondent have their authorized dealers in Pakistan since several years those are selling LA-Z-BOY PVT LTD . Products in Pakistan following are LA-Z-BOY PVT LTD. authorized dealers :-*

*1, American Furniture SMC Pvt Ltd. 2, Samad international (Exhibit 10 )*

*Respondent have been Registered following Domains Since Several years:-*

*1,la-z-boy.com.pk 2,lazyboy.com.pk 3, lazyboyonline.co.uk 4,la-z-boy.ru*

*Trade mark registry Pakistan already accepted the respondent trade marks registration application and provided application nos. 234486 and 234485 and published respondent both trade marks in trademark general 2008*

*The trade marks of Respondent company La-z-boy Pvt Ltd. (LA-Z-BOY & LA-ZY-BOY ) are already published in trade mark general no. 695 attached herewith copy of trade mark general (**EXHIBIT-2**)*

*Complainant file a complaint at the DNDRC at a time when respondent trademarks registration applications are on last stage of registration at Trademark registry office in Pakistan to giving support to his weak position at trademark registry Pakistan complainant filed this complaint at DNDRC.*

*Complainant must be very well aware with La-z-boy Pvt Ltd. websites since several years ago*

*Why not complainant files complaint at Domain Name Dispute Resolution Centre Pakistan Before? LA-Z-BOY Private limited . websites has been registered several ago*

*For the DNDRC convenience, the respondent cite case decided by DNDRC (Television Media Network (Pvt.) Ltd v. Mohammed Khan Case No. C2010-0002)*

In addition to the above, the Complainant submitted a Rejoinder to the Respondent's Response to which the Respondent submitted its own Rejoinder. The Panel has taken into consideration the contentions made in these Rejoinders submitted by both Parties individually. Furthermore, the Arbitrator, exercising his discretionary power to request for additional information, requested the Complainant to submit the same. Such additional information, as submitted by the Complainant has also been taken into account while rendering this Decision.

**Remedies Sought:**

The Complainant has sought the following Remedy:

*That the disputed domain be transferred to the Applicants or the said domain be revoked.*

The Respondent has sought the following Remedy:

*That the Complainant Complaint refused.*

## **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**

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

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

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

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

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

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

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

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

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

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

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

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

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

*business advantage, unfair competition, injuring the reputation of another, or for the purpose of confusing or misleading a person, whether natural or incorporated.”*

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

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

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

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

### **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 Disputed Domain Names is ab initio illegal the following aspects in the context of this dispute are to be assessed:

- i. Whether the Disputed Domain Names infringe upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Disputed Domain Names is bona fide?
- iii. Whether the application and/or registration of the Disputed Domain Names contravene 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:*

5. *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)*
6. *Identical or confusing similarity to a trademark or service in which the Complainant has rights (a UDRP criteria)*
7. *Legitimate interest in Domain Name (a UDRP criteria)*
8. *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 Disputed Domain Names infringe upon, or are an obvious derivation of, a registered trade name / trade mark?**

Prior to assessing the above mentioned issue in light of this matter, it is imperative to note that the Complainant does not have a trade mark registration for the trademark “La-z-Boy” as yet. The Complainant has applied for the same at the Trade Marks Registry, Government of Pakistan, vide application number 274135 on 29<sup>th</sup> October, 2010. As such, the Complainant has taken steps to ensure protection of its intellectual property rights.

Since the Complainant does not have a registered trade mark, the primary issue to be considered would be whether domain name rights extend to unregistered marks. In order to seek assistance in this regard, the Panel has reverted to WIPO and WIPO Authorities with respect to domain name disputes concerning domain name rights in corresponding trademarks which are unregistered.

The WIPO Consensus View with respect to domain name rights in favor of unregistered trademarks is:

*Consensus view: The complainant must show that the name has become a distinctive identifier associated with the complainant or its goods or services. Relevant evidence of such "secondary meaning" includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition. The fact that the secondary meaning may only exist in a small geographical area does not limit the complainant's rights in a common law trademark. For a number of reasons, including the nature of the Internet, the availability of trademark-like protection under passing-off laws, and considerations of parity, unregistered rights can arise for the purposes of the UDRP even when the complainant is based in a civil law jurisdiction. However, a conclusory allegation of common law or unregistered rights (even if undisputed) would not normally suffice; specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required. Some panels have also noted that in cases involving claimed common law or unregistered trademarks that are comprised of descriptive or dictionary words, and therefore not inherently distinctive, there may be a greater onus on the complainant to present compelling evidence of secondary meaning or distinctiveness. Some panels have noted that the more obvious the viability of a complainant's claim to common law or unregistered trademark rights, the less onus there tends to be on that complainant to present the panel with extensive supporting evidence. However, unless such status is objectively clear, panels will be unlikely to take bald claims of trademark fame for granted.*

The WIPO Consensus View could be taken as guidance with respect to determining the kind of consideration to be allocated with respect to rights in unregistered trademarks demonstrates that in such cases, it is for the Complainant to support his assertions pertaining to the rights in

the disputed domain names with substantial evidence of use. Another important assistance that could be derived from the above mentioned Consensus View taken by WIPO is that a higher standard of proof is levied on the Complainant in cases of unregistered trademarks that comprise of descriptive or dictionary words. In such cases, obviously the Complainant would have to provide substantial evidence with respect to such unregistered trademarks. As such, the Panel, for the purposes of rendering this Decision has taken into account the evidence put forth by the Complainant that was annexed with the Complaint submitted.

The primary issue is whether the Complainant has protectable rights in the mark/name to which it contends that the Disputed Domain Names are confusingly similar. In this case, the Complainant has applied for trade mark “LAZBOY” and as such the registration process has been initiated and is under process. As a consequence, the questions arise as to (i) whether the Policy applies to unregistered trademarks and (ii) whether the mark at issue has acquired sufficient distinctiveness through use and promotion to identify the source of this particular service with Complainant.

With regard to the first aspect, it is undisputed and accepted practice, that paragraph 4(a)(i) of the Policy refers merely to a “*trademark or service mark*” in which the complainant has rights, and does not expressly limit the application of the Policy to a registered trademark or service mark. Further, the WIPO Final Report on the Internet Domain Name Process (*The Management of Internet Names and Address: Intellectual Property Issues*, April 1999), from which the Policy is derived, does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names. It is therefore open to conclude that the Policy is applicable to unregistered trademarks and service marks. This is further reiterated and reinforced by the WIPO Consensus View which was also followed in several WIPO Administrative Panel Decisions, whereby disputed domain name(s) were transferred to the Complainant even though the latter did not have a registered trademark. This illustrates the broader interpretation of the Policy and the mechanism whereby disputed domain name(s) are corresponding to unregistered trademarks and yet the Complainant successfully obtains the remedy that is prayed.

As far as the second aspect is concerned, it is pertinent to note that the trade name “La-z-Boy” is closely associated to the Complainant’s business of furniture. Not only has the Complainant been using this trade name for well over a substantial period of time in Pakistan, but has also been known by this tradename in foreign/international jurisdictions. In this regard, the Complainant has applied for registration of the trade mark in Pakistan. The Complainant has been using the trade name La-z-Boy since 1929 for the purposes of its business with respect to furniture and in particular recliners. The Complainant has not only used the trade name for its business purposes in print, but has also made use of the same on the internet portal and has registered its primary domains on the gTLD .com and used the same along with ccTLDs in order to provide for an online advertisement, publication, services etc. This demonstrates the Complainant’s intentions to use the domain names for its business purposes and as such the importance of the domain names corresponding with its trade name was tantamount to the Complainant. Furthermore, the Complainant went ahead to protect its trade name by applying for the registration of the same at the Trade Marks Registry, Pakistan in the year 2010 which is pending before the Registry. Bearing in mind the customer base that the Complainant has built and is providing the above mentioned products and services to, the Panel, on the basis of the evidence provided, determines that the tradename is not only

important to the Complainant, but is in fact closely associated with recognition customer loyalty and provision of services via internet (online services). Thus, the registration under a similar/confusingly similar domain name by the Respondent may not only confuse the existing customer(s) of the Complainant looking for the Complainant's website but may also cause new customers being misled into believing that the Disputed Domain Names are also being operated by the Complainant.

Furthermore, the Complainant has also been successful in acquiring other domain names that are corresponding to its trade name, which, as record shows, had also been registered by a member of the Respondent company. The Complainant, aggrieved by the domain name registrations by a party other than itself had initiated the matter at the National Arbitration Forum and was successful in obtaining the disputed domain names for itself.

The fact that in this case, the Complainant has not as yet obtained the registration of the trade mark "La-z-boy" in its favour as the same is pending at the Registry, it does not preclude a finding that it has established trademark or service mark rights in that name for the purpose of the Rules. This is by virtue of a fundamental principle of trademark law is that rights in a trademark can be acquired through use, and such rights exist even though the trademark may not be registered. This is further reinforced by the Complainant's use of the trade mark "La-Z - boy" for over a substantial period of time.

In order to determine whether the Complainant has common law trademark rights in its trade name), the Panel notes that common law trademark and service mark rights exist when a party proves that there is enough goodwill and reputation in and to a name and sufficient association of the same with the party itself, no matter how strong or weak those trademark and service mark rights may be or whether use of the same is restricted to a particular jurisdictional boundary or geographical limits. This has been reiterated and provided for by the WIPO Consensus View as mentioned above herein.

The Panel reasonably finds that the Complainant has bona fide rights to the disputed domain name since the same is closely associated with its recognition in the market and is used as a commonly known entity for furniture, which is further reiterated and reinforced by the customer loyalty that is vital to the Complainant's brand recognition, sales, profits etc. In addition to this, the Panel notes that the Disputed Domain Names incorporate the Complainant's trade name in its entirety. Numerous panel decisions under the Policy have regarded that as a compelling indicator that the domain name at issue is confusingly similar to the complainant's mark.

The issue under consideration here is whether or not the disputed Domain Name is confusingly similar to the Complainant's tradename. In coming to a conclusion in this aspect, the Panel first notes the approach to the confusing similarity issue which was adopted by the panel in *Research in Motion Limited v. One Star Global LLC*, [WIPO Case No. D2009-0227](#), where the domain name <unofficialblackberrystore.com> was held to be confusingly similar to the complainant's BLACKBERRY mark. The panel in *Research in Motion Limited* took the view that the confusing similarity requirement in paragraph 4(a)(i) of the Policy sets a fairly low threshold test, which is concerned only to establish that the complainant has sufficient rights to give it *standing* to bring the complaint (citing *Aubert International SAS and Aubert France SA*

*v. Tucows.com Co.*, [WIPO Case No. D2008-1986](#)). This Panel respectfully agrees with that approach.

Using the above mentioned precedents as guidance, it can be reasonably inferred that the Disputed Domain Names are not just similar to the Complainant's trade mark but are in fact identical to the trade name of the Complainant who have Common law rights in the trade name which has been reproduced in entirety into the Disputed Domain Names.

A fundamental principle of trademark law is that rights in a trademark can be acquired through use, and such rights exist even though the trademark may not be registered. Therefore, given that the Complainant has been using its trade name in association with its business for a number of years, even though the same is not officially registered as yet and the process is underway at the Registry.

The Complainant has been using its trade name "La-z-boy" since 1929 till present and the fact that it has never changed/altereD/modified its trade name is clear indication of the Complainant's goodwill and reputation associated with the Complainant. Not only that, but the same is widely recognized and well renowned with its trade name and the services being rendered by the Complainant. The Complainant is providing services which are exclusively associated with the Complainant by its customers. This illustrates the importance of the Disputed Domain Names for the Complainant. The Complainant has contended that the term La-z-boy is not a literate word and does not hold a dictionary meaning, but in fact is an intelligently coined term, for the use of its business and a trade name which has afforded the Complainant distinctive familiarity, repute, customer loyalty and sales by its largely based clientele. In order to support their contention, the Complainant has relied upon a WIPO Authority, which the Panel has reviewed. This further reinforces the importance of the Disputed Domain Names to the Complainant. In addition to this, the same also reasonably paves way to the Complainant establishing its rights to the Disputed Domain Names, as shall be further discussed herein this Decision.

Furthermore it is established law to disregard the ccTLD when considering the matter of confusing similarity or obvious derivation, as the addition of the suffix ".pk" does not create any distinction that may eliminate the possibility of confusion by the Complainant's customers (see *Nokia Corporation v. Firdaus Adinegoro/Beli Hosting*, [WIPO Case No. D 20040814](#)). Therefore the Panel determines the Disputed Domain Names to be an obvious derivation of the Complainant's trade name.

As per paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2, if a Complainant simply establishes this one criterion of infringement upon a registered trade mark/name, the registration would be deemed illegal and unlawful and for all purposes invalid. In addition to this, the fact that the Respondent has failed to submit a Response to the DNDRC even when an opportunity to do so was provided to him, the Panel is required to decide the matter based upon the Complaint on an ex parte basis. Therefore subject to the above stated discussion, the Panel may well determine the domain name in dispute to be transferred to the Complainant. However for the sake of brevity, clarity and completeness (but not to create any binding precedent requiring the same to be followed in the future), the Panel will also assess and determine the remaining issues as listed above.

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

The Complainant has made use of its trade name La-z-boy which has been reproduced and incorporated in entirety into the Disputed Domain Names. Furthermore, the Complainant has used the same trade name to offer its products throughout the world. 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 furniture, recliners etc, but also uses the internet to offer online services. Thus, in order to safeguard its trade name on the ccTLD of .pk as well, the Complainant sought to register domain names on the .pk ccTLD but is unable to do so since the same has already been registered by the Respondent.

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. The Respondent has contended that it has registered the company La-z-boy Pvt Ltd in Pakistan at the Securities Exchange Commission of Pakistan since 1984 and that it has also sought to register the trade mark at the Trade Marks Registry, Pakistan for the same prior to the Complainant's application. The Respondent has annexed its application for registration of the said trade mark along with the Response. Furthermore, the Respondent has alleged that it is the rightful owner and has exclusive rights to use the trade mark La-z-boy for its own business purposes. The Panel, in order to assess why it is that the Respondent sought to register the Disputed Domain Names/trade mark which is identical and confusingly similar to that of the Complainant, sought additional information from the Complainant with respect to their contention that "*the LA-Z-BOY trade marks are coined terms, any such use by the Respondent must be a knowing, deliberate action made in bad faith*". In response to the same, the Complainant submitted emails that were exchanged between the Complainant and the Respondent, from which it transpired that the Respondent had actually been a distributor for the Complainant. It appears from the email exchange between the Complainant and the Respondent that the Complainant had not been satisfied by the Respondent's services and as such was considering employing other distributor(s). This leads the Panel to reasonably infer that the Respondent was not only well aware of the Complainant's business, existence, trade mark, trade name, course of trade, etc, but had in fact been a part of it too. The Panel is left with no other inference but that the Respondent is a disgruntled ex distributor of the Complainant, who, sought to hijack the market in the jurisdiction of Pakistan and in particular the furniture market, and used the same trade mark as the Complainant, even though it was pretty well versed about the Complainant and its business in Pakistan as well as internationally. This further leads the Panel to opine that the Respondent's act of registering the Disputed Domain Names lacks bona fide, since it was done, apparently, in an attempt to solicit business for itself on the basis of causing confusion with the Complainant's trade name.

Furthermore, the Respondent has not used the Disputed Domain Names for any specific purpose that could be linked to an actual course of trade, business, etc, and/or be associated with the Respondent's contentions that it has been using the trade name in Pakistan for a long period of time. The Respondent has not been using the Disputed Domain Names for any bona fide non commercial use. 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 Disputed Domain Names 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 Disputed Domain Names 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.

The Panel in addition to the above, has made note of the issue pertaining to email(s) sent by users, being bona fide customers/consumers of the Complainant. The Panel has taken into account another way in which the use of the Disputed Domain Name would cause confusion

and would be contrary to both, the letter and spirit and public policy of the ICANN UDRP as well as the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2.

The Panel notes the manner in which any “*a reasonable bystander*” or “reasonable user” may be misled and confused when sending emails to the Disputed Domain Name, being under the impression that the same, either are or maybe that of the Complainant. A customer, seeking any of the online services being provided by the Complainant, seeking any information, providing his own confidential information etc may be misled into sending an email address corresponding to the Disputed Domain Name, considering either/all of them to be that of the Complainant. In such a manner, not receiving a response, or his confidential information being misused, or any other confusion being created in a customer’s mind would not only affect the customer loyalty that forms an asset for the Complainant but might also endanger the Complainant’s sales/profits/revenue that the Complainant earns from its customer base. The confusing similarity and in fact identical nature of the way in which the Complainant’s registered trademark is used would lead to confidential messages being received by the Respondent. This situation would be similar to the one that arose in the famous case commonly known as the One In A Million Judgment before the Supreme court of the Judicature In the Court of Appeal (Civil Division) On Appeal from the High Court of Justice Chancery Division, UK. The Judgment identified the likelihood that the sending of such emails would lead to substantial confusion which would be detrimental to business of an established business with legitimate interest in the use of the domain name. The Court also came to the conclusion that the act of registration of confusingly similar domain name would constitute passing-off:

*It is accepted that the name Marks & Spencer denotes Marks & Spencer Plc and nobody else. Thus anybody seeing or hearing the name realises that what is being referred to is the business of Marks & Spencer Plc. It follows that registration by the appellants of a domain name including the name Marks & Spencer makes a false representation that they are associated or connected with Marks & Spencer Plc. This can be demonstrated by considering the reaction of a person who taps into his computer the domain name marksandspencer.co.uk and presses a button to execute a "whois" search. He will be told that the registrant is One In A Million Limited. A substantial number of persons will conclude that One In A Million Limited must be connected or associated with Marks & Spencer Plc. That amounts to a false representation which constitutes passing-off.*

*Mr Wilson submitted that mere registration did not amount to passing-off. Further, Marks & Spencer Plc had not established any damage or likelihood of damage. I cannot accept those submissions. The placing on a register of a distinctive name such as marksandspencer makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill in the name. Such persons would not know of One In A Million Limited and would believe that they were connected or associated with the owner of the goodwill in the domain name they had registered. Further, registration of the domain name including the words Marks & Spencer is an erosion of the exclusive goodwill in the name which damages or is likely to damage Marks & Spencer Plc. I also believe that domain names comprising the name Marks & Spencer are instruments of fraud. Any realistic use of them as domain names would result in passing-off and there was ample evidence to justify the injunctive relief granted by*

*the judge to prevent them being used for a fraudulent purpose and to prevent them being transferred to others.*

This case represents good law even today and was upheld finally in Appeal by the Court of Appeal. As such similarly, in this case the registration of the Disputed Domain Name by the Respondent would also constitute passing-off and a contravention of the criteria (i), (ii) and (iii) of paragraph 1 of the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2.

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

The Complainant contends the following:

- i. The manner in which the disputed domain name is identical to the trade marks or service marks in which the Complainants hold rights.*

*That the Complainants are one of the leading international companies trading in a variety of goods and services for high quality furniture, accessories and particularly recliners all over the world. The Complainants are the creators, first adopters and users of the trade mark **La-a-boy** that they have successfully used for their company and their products for many years in a large number of countries worldwide, including in Pakistan. That although the Complainants' company is based in United States of America, the export of their **La-a-boy** trade marked products is made to a number of countries outside United States of America, including Pakistan.*

*That the Complainants adopted the **La-z-boy** trade mark in 1929 in connection with reclining chairs, and has become one of the most recognized brands in the furniture industry the world over. The Complainants have a direct presence in Pakistan through their authorized local distributors, both in Lahore and Karachi.*

*That for the purpose of legal protection of their worldwide popular trade mark **La-z-boy**, the Complainants obtained trade mark registrations in a number of countries where their products enjoy both high sales, and goodwill. It is pertinent to mention here that the Complainants have registered several variations of their mark **La-z-boy**, including **LAZBOY, LA-Z-BOY, LAZY BOY** and **LA-Z-GIRL**.*

*That the disputed domain is not only confusingly/deceptively similar to the Opponents' **La-z-boy** trade mark but is also confusingly similar in sound and phonetics which makes the former potentially devious.*

*That the Complainants trade name also incorporates their internationally acclaimed trade mark **La-z-boy** which has become the identity of the*

*Complainants. The disputed domain is virtually identical to the Complainants' said distinctive trade mark/trade name.*

*Furthermore, none of the above referred trade marks belonging to the Respondents are common English words as they have been intelligently coined and therefore are inherently distinctive to distinguish the Complainants from other players in the business.*

Even though the Complainant does not have a trade mark registration for the trade name La-z-boy in Pakistan as yet, since the same is pending at the Registry, it does have trade mark registrations for such a trade name/mark internationally. As for the trade mark registration in Pakistan, the Complainant has applied for such registrations, which are currently pending at the Registry. However, it has been discussed above and found that even when a Complainant does not have a valid trade mark registration, WIPO's Consensus View and the Policy extends to unregistered trade marks too, which, inter alia, are afforded common law trade mark protection.

As such, for the purposes of assessing this head, the Panel would disregard the issue of registered trade mark and apply its reasoning and analogy as if the trade mark was indeed registered. This is so, since the WIPO grants that the Policy does not distinguish between registered/unregistered marks.

In this regard, it appears that the Respondent has incorporated the mark of the Complainant in entirety in the Disputed Domain Names. Even though the Respondent has applied for trade mark registration for itself too, it has been discussed above that such registration on part of the Respondent lacks bona fide.

The Complainant is the trade mark holder of the trade mark/trade name La-z-boy internationally and is the applicant of such a mark in Pakistan. 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 "La-z-boy" is very well associated and connected with the services and products offered by the Complainant. The same being furniture. The Respondent has reproduced the Complainant's trade mark in entirety into the Disputed Domain Names. As such, giving rise to a high probability to the users of the Complainant being confused and misled into believing that the Disputed Domain Names belong 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 anymore (even though apparently such a relationship has existed in the past). Moreover, the integral part of the disputed domain name, being "la-z-boy" is a registered trade mark of the Complainant internationally and which it has been using since 1929, to which the Complainant acquired statutory rights before the disputed domain name was registered by the Respondent, incorporating the mark "la-z-boy" in full and common law rights in Pakistan, by

virtue of using the same trade name in the jurisdiction of Pakistan for selling furniture and recliners that are exclusively associated with the Complainant vide the trade name La-z-Boy.

The Disputed Domain Names contain the Complainant's trade mark in entirety thus is confusingly similar to the Complainant's 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 online services and other related services in furtherance to their business thus causes substantial and irredeemable harm to the Complainant.

In Emmanuel Vincent Seal trading as Complete Sports Betting v. Ron Basset Case No. D2002-1058, it was held:

***A. Identical or Confusingly Similar***

*it is clear from many, many prior decisions that the reference to "rights" in Paragraph 4(a)(i) of the Policy includes both registered and unregistered trademark rights.*

In assessing identity and confusing similarity for the purposes of paragraph 4(a)(i) of the Policy it is acceptable for the generic domain suffix to be ignored.

The Panel finds that the Domain Name is identical or confusingly similar to a trade mark in which the Complainant has common law rights.

In *Farouk Systems, Inc. v. Chen Guoqiang, Case No. D2010-0005* it was held that:

***A. Identical or Confusingly Similar***

*Based on the documents submitted by the Complainant, the Panel is satisfied that the Complainant has proven that it is the owner of the trademark CHI. The distinctive part of the disputed domain names <chiflatirononline.com> and <chiflatironstore.com> is the word "chi", which is identical to the Complainant's distinctive trademark CHI. As numerous prior UDRP panels have held, the fact that a domain name wholly incorporates a complainant's registered mark may be sufficient to establish identity or confusing similarity for purposes of the Policy, despite the addition of other words to such marks, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark CHI, in which the Complainant has rights.*

Also taken into consideration is the WIPO Authority *Oki Data Americas, Inc. v. ASD, Inc.*, [WIPO Case No. D2001-0903](#); *Lilly ICOS LLC v. The Counsel Group, LLC*, [WIPO Case No. D2005-0042](#).

In *Banco Bradesco S.A. v. Marciano Martins, Case No. D2010-0201*, it was held that:

***A. Identical or Confusingly Similar***

*For all of the foregoing reasons, the Panel rules that the domain names <bradescoalteras.biz> and <bradescointerbanking.biz> are confusingly*

*similar to the Complainant's name and mark BRADESCO.*

It was held in *Cath Kidston Limited v. Value-Domain Com, Case No. D2010-0203* that:

***A. Identical or Confusingly Similar***

*The disputed domain name includes "cathkidston," which consists of the two parts "cath" and "kidston." Connecting the two distinctive parts of "Cath Kidston" does not dispel the confusing similarity between the domain name and the trademark. Neither does the use of lower case, especially as capital letters are not permitted in domain names. The Panel finds that the disputed domain name is therefore confusingly similar to the Complainant's trademark. It is well-established that domain name suffixes, in this case ".net," are disregarded for the purpose of this comparison.*

*The Panel concludes that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights.*

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 Complainant's 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/mark in entirety. It is even more apparent that the tradename/mark is not a generic/literate word, but is in fact a term coined by the Complainant for the exclusive use in its course of business of furniture. The Panel's analysis of whether the Disputed Domain Names are 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 Panel's analysis of whether the Disputed Domain Names are 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 Disputed Domain Names are identical to Complainant's distinctive trademark La-z-boy. 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 Complainant has contended the following:

- i. ***The Respondents have no bonafide use in the disputed Domain name la-z-boy.com.pk (the "Policy" adopted by ICANN; Provision 4(b)(ii)).***

*The fact that the Respondents have not put into use the impugned website whereas they have registered the same with the Registrar abovementioned on March 20, 2007, is a clear indication that the Respondents have merely blocked the said domain name with the sole intention to prevent the owner of the trade mark or service mark (being the Complainants) from reflecting the mark in a corresponding .cc domain name.*

The Respondent has denied all the assertions put forth by 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;*

The Respondent has been the registrant of the disputed domain name <lazyboy.com.pk> since 20<sup>th</sup> March, 2007 and the disputed domain name <la-z-boy.com.pk> since 21<sup>st</sup> July, 2009. However, the Respondent has not put to the Disputed Domain Names to any specific, particular, identifiable bona fide non-commercial use. The Respondent, in his Response, has not raised any issue(s), information, data, evidence or the like that pertains to the use of the Disputed Domain Names by the Respondent.

In light of such a failure on part of the Respondent to explain, inform, support with evidence, the reason(s)/use(s) for which the Disputed Domain Names were registered and/or why the Respondent has been using/not using the Disputed Domain Names for an identifiable, bona fide, non-commercial use, the Panel does not have any information, record, data or the like to

determine that there is any bona fide offering of goods or services on part of the Respondent with respect to the Disputed Domain Names.

(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 by the trade name La-z-boy, and that it has extensively advertised such reputation and association. However, while assessing the evidence put forth by the Respondent, the Panel was unable to decipher as the propensity of the Respondent being known by such a trade name. The evidence submitted by the Respondent is incomplete and hence cannot be taken into consideration on merits and probity. Furthermore, the Respondent has not provided any information which relates to its customer base, the distinctive nature of its being well known in the market, any documentation/evidence that would enable the Panel to infer that the Respondent has been commonly known by the trade name La-z-boy.

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 Names are not being used for any identifiable, specific, bona fide, non-commercial use, which could be correlated with a bona fide commercial gain on part of the Respondent, nor has the Respondent submitted any information, data, documentation, etc in light of it using the Disputed Domain Names for any such purpose. Moreover, as has been discussed above, it appears that there existed a relationship between the Complainant and the Respondent. As such, it is the Panel's opinion that the Respondent registered the Disputed Domain Names in order to attract business to itself on cost of the Complainant and the customer base that the Complainant had established based on its own trade and course of business. The Panel opines that the Respondent has not rendered any information, data, documentation, evidence or the like, etc, which could be taken into account while assessing this head. Since the Respondent is not making any use of the Disputed Domain Names that could be identified and/or be pointed to a particular, specific use, for example online provision of services, the Panel, due to lack/unavailability of information, data, evidence and the like is unable to determine any such use on part of the Respondent.

As such, the Panel cannot hold the Respondent to be making legitimate non-commercial or fair use of the Disputed Domain Names, 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 Names.

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 Names.

### **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 Complainant asserts the following:

- i. **The Respondents have no legitimate Interests or Rights in the disputed Domain name la-z-boy.com.pk** (the “Policy” adopted by ICANN; Provision 4(b)(iv)).

*To the Complaints’ knowledge, the Respondent has no legitimate use of the disputed domain mentioned hereinabove and never had any intention to do so. The Respondent is merely using the domain names which are confusingly similar to the **La-z-boy** trade marks in order to attract, for commercial gain, Internet users to the Respondents’ web site by creating a likelihood of confusion with the Complainants’ marks as to the source, sponsorship, affiliation, or endorsement of the Respondents’ web site.*

The Respondent denies all contentions put forth by the Complainant.

The Panel shall assess each individual sub section for the purposes of rendering this Decision.

*(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 Panel is not clear as to why the Respondent registered the Disputed Domain Names, since the purpose(s) for registering the same have not been specifically, expressly and/or factually been submitted by the Respondent, along with supporting documentation for such assertions.

The Panel, however, based on the information, data, documentation available, and on its own reasonable inferences, is not left with any other reasonable finding but that the Respondent has not offered to sell the Disputed Domain Names to the Complainant, if this is the case, then the Panel is unaware of the same.

*(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 Complainant is the holder of the trade mark registrations in favor of La-z-boy mark internationally and has applied for the same in the jurisdiction of Pakistan as well. However, the Complainant is unable to register the Disputed Domain Names with corresponding mark, since the same have been registered by the Respondent. However, the Respondent alleges and has put evidence to the like, that it has also applied for trade mark registration for the mark La-z-boy. As such, both the Parties do not have express statutory trade mark rights afforded to them by virtue of the Trade Marks Ordinance, 2001. In such a situation, the Panel resorts to the concept of common law trade mark rights and assess the issue based on the same. The Complainant has contended and put forth evidence to support the same, that it has substantial clientele and customers, both internationally as well as Pakistan, who recognize and relate the trade mark La-z-boy to them. The Respondent, however, has contended that it has gained popularity and advertised massively in the newspapers about its existence, and put some exhibits to support the same. However, the evidence so submitted is incomplete and hence the Panel is unable to assess the same on merit and is unable to attach any weight to such evidence.

The Complainant has also contended and put forth evidence to the same accord, that the Respondent, and an individual member of the Respondent company had registered other domain names on other TLDs that were contested by the Complainant and successfully won by the Complainant at the National Arbitration Forum.

The above mentioned fact illustrates that the Respondent has not only registered the Disputed Domain Names, on a .pk ccTLD which incorporate the trade mark of the Complainant in entirety but has also made use of other TLDs to register domain names corresponding to the Complainant's trade mark. This reflects the Respondent's pattern of engaging in such an activity on a regular basis and thus the Panel reasonably opines that this is suggestive of lack of bona fide on part of the Respondent.

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

The Respondent has not put forth any information, data, documentation, etc or the like, in order to demonstrate its lack of mala fide and actual bona fide, in particular to illustrate that the Respondent has not registered the Disputed Domain Names for the purpose of disrupting the business of a competitor. Furthermore, the Respondent has not disclosed, nor annexed any information, documentation etc that would reflect the purpose(s) for which it registered the Disputed Domain Names. In such a case, the Panel reasonably opines that the Respondent did register the Disputed Domain Names to disrupt the business of the Complainant. The Panel, as discussed above, is of the view that the Respondent is not only well aware of the Complainant's existence and the latter's use of the trade mark, the Respondent was actually involved in business with the Complainant, which was then revoked by the Complainant. So much so, the Complainant had also served upon the Respondent a Cease and Desist Notice on the Respondent, thereby calling upon the Respondent to cease their use of the trade name La-z-boy. This is illustrative of the lack of bona fide on part of the Respondent in registering the Disputed Domain Names which incorporate the Complainant's trade mark in entirety.

As such, the Panel is unable to rule that the Respondent did not register the Disputed Domain Names for the purpose of disrupting the business of a competitor, in this case being the Complainant.

*(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 put forth any information, data, record, evidence or the like, etc, which could/would demonstrate that the Respondent has not registered the Disputed Domain Names with the intention to attract, for commercial gain, the internet users to the Disputed Domain Names by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Names.

In absence of such information, etc, the Panel is unable to assess the purpose(s), intention(s) of the Respondent in registering the Disputed Domain Names, and in particular, the lack of mala fide on part of the Respondent. It appears that there existed a relationship between the Complainant and the Respondent, of which both the Parties were naturally aware. As such, the Respondent's act of registering the Disputed Domain Names, right after the relationship was revoked by the Complainant is clear indication of lack of bona fide on part of the Respondent.

Furthermore, the Respondent has not put forth any information, nor annexed any relevant/properly constituted evidence to the like, which could/would lend any weight, support or the like in favor of it and/or assist the Panel in assessing as to why the Respondent registered the Disputed Domain Names, and in particular, finding that it did not register the Disputed Domain Names to intentionally attempt to attract, for commercial gain, Internet users to the Disputed Domain Names by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Names.

The Panel, based on information and data made available to it, reasonably finds that the Complainant is a widely known and well reputed manufacturer, supplier, etc of furniture, not only abroad, but also in Pakistan, and as such, it has been using the trade name La z-boy for well over a substantive amount of time. This shows that the trade name of the Complainant is well associated with its customer/clientele who recognize and relate the trade name La-z-boy to be that of the Complainant. The Respondent's act of registering the Disputed Domain Names has not only prevented, obstructed and halted the Complainant from registering the same for their own use, but has also endangered the goodwill, reput and wide based clientele of the Complainant, which constitutes any company's intangible asset. As such, any user of the Complainant, while searching for their online presence in Pakistan, would end up at the Disputed Domain Names and incorrectly assume the same to be belonging to the Complainant. Furthermore, if such a user emails on a corresponding email address, seeking information, business, placing order(s), or anything of the like, and/or put in his/her confidential information in the email, mistakenly presuming it to be the Complainant's email address, such information/email would end up with the Respondent, who would not be the intended recipient

of the email. This could substantially endanger not only the business of the Complainant, but also result in disclosure of confidential information of a user to an unintended recipient. As such, this merely construes of way(s) in which the Respondent's act of registering the Disputed Domain Names can cause harm/losses etc to the Complainant and whereby an innocent user would mistakenly presume a relationship to exist between the Complainant and the Respondent, which is not the case presently.

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 Pelephone 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 Names in bad faith.

## **8. Decision**

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

- i. The Respondent's registration of the Disputed Domain Names is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
- ii. The Respondent has no legitimate interest in the disputed domain name.
- iii. The Disputed Domain Names are confusingly similar to the Complainant's trade mark.
- 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 Disputed Domain Names 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):** Mr. Mustafa Syed

**Dated:** 29<sup>th</sup> July, 2011