

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

**Arbitration and Mediation Center**

**COMPLAINT PANEL DECISION**

**Hewlett Packard Company v. Hewlett Packard Pakistan**

**Case No. C2011-0003**

**Also in PDF C2011-0003**

**1. The Parties**

The Complainant is Hewlett Packard Company having its principle premise of business at 3000 Hanover Street, Palo Alto, California 94304-1185, U.S.A.

The Complainant has initiated the Complaint vide their authorized representatives, M/s Irfan & Irfan Attorneys-at-law, located at 85, The Mall, Lahore, Pakistan, through Mr. Hasan Irfan Khan (Advocate Supreme Court), Mr. Mueen Qamar (Advocate Supreme Court), Mr. Ahmad Farooq Malik (Barrister-At-Law) and Ms. Maria Farrukh Irfan (Barrister-At-Law).

The Respondent is Hewlett Packard Pakistan. The Whois Data shows the Address of the Respondent to be Suite 1 & 2, Building 16-C, 02nd Commercial Street Main Zamzama, DHA Phase 5, Karachi, Pakistan.

**2. The Domain Name and Registrar**

The disputed domain name is <hp.com.pk>, hereinafter referred to as the Disputed Domain Name.

**3. Procedural History**

The Complaint was filed with the Domain Name Dispute Resolution Center (the "DNDRC") on 18<sup>th</sup> April, 2011.

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 25<sup>th</sup> May, 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 07 days from the notification, the dispute would proceed *ex parte*.

The Respondent however disregarded this opportunity failed to submit the Response in the form required by section 6(1) of the Supplemental Rules of DNDRC and failed to provide a response in the required manner. Under section 5(e) of the UDRP, the Panel has the authority, in the absence of a proper response, to commence with the proceedings in

default and to determine the matter based upon the Complaint.

The 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, state that “*DNDRC may consider and issue a recommendation in the matter in accordance with its own rules for such disputes or in default of such rules apply the Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999) and/or the Rules for Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999).*” As such DNDRC applies its Supplemental Rules to these proceedings as well as the UDRP and in case of any conflict the DNDRC Supplemental Rules to the ICANN Rules for the UDRP and UDRP apply.

The DNDRC appointed Ms. Fozia Umar as the Sole Arbitrator in this matter who as sworn impartiality.

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

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

The Complainant is the registered proprietor of the trade mark “HP” in various forms and classes:

- Device with HP in Class 10 vide Registration Number 48145
- HP (Label) in Class 16 vide Registration Number 112752
- HP in Class 09 vide Registration Number 112754
- HP Label in Class 09 vide Registration Number 171505
- HP in Class 10 vide Registration Number 112753
- HP Invent in Class 02 vide Registration Number 171504
- HP in Class 16 vide Registration Number 112756
- HP in Class 16 vide Registration Number 171506
- HP Invent in Class 42 vide Registration Number 215318
- HP Invent Logo in Class 16 vide Registration Number 171507

The Complainant was granted registration of the above mentioned trademarks which are closely associated and synonymous with the Complainant’s business.

The Respondent registered the Disputed Domain Name on 09<sup>th</sup> February, 2008.

Additionally the Respondent has failed to provide DNDRC with a Response to the Complaint initiated against them in the required form by under section 6(1) of the Supplemental Rules of DNDRC despite a Notification of the same being sent by DNDRC to the Respondent providing the same with an opportunity to submit a Response.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant contends that:

*The domain name <hp.com.pk> includes the word HP, which is identical and confusingly similar as a whole to the well known trademark, service mark and house mark*

*"HP" in which the Complainant has a statutory right as well as a right in common law by virtue of long and continuous user and being the registered proprietor thereof.*

*The Respondent has no right or legitimate interest in the disputed domain name <hp.com.pk>.*

*The disputed domain name <hp.com.pk> has been registered and is being used in bad faith.*

For all the above mentioned contentions, the Complaint seeks the following Remedies:

*The Complainant requests the Administrative Panel appointed in this administrative proceeding to issue a decision that the contested domain name <hp.com.pk> be transferred to the Complainant.*

### **B. Respondent**

The Respondent failed to submit the Response in the form required by section 6(1) of the Supplemental Rules of DNDRC

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

## **6. Jurisdiction**

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 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 Aug 7, 2007 ver. 4.2 and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

## **7. Discussion and Findings**

In the 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, tortuous interference with contract or prospective business advantage, unfair competition, injuring the reputation of another, or **for the purpose of confusing or misleading a person, whether natural or incorporated.**”*

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).

It is imperative to note that the Respondent has not submitted any Response to this Complaint even though an opportunity to do the same was afforded to the Respondent by the DNDRC. Under the Policy, the Panel is empowered to proceed with the Complaint on an ex parte basis. However, relying on the WIPO Overview of WIPO Panel Views, it has been determined as to what the WIPO opines in situations where the Respondent does not submit a Response. Does it automatically grant the Complainant the Remedies it has sought in the Complaint or whether it is still obligatory for the Panel to take into account every contention put forth by the Complaint and determine whether it satisfies the Procedural matters. In this regard, the Panel has considered the WIPO view on this matter and has found that:

*4.6 Does the failure of the respondent to respond to the complaint (respondent default) automatically result in the complainant being granted the requested remedy?*

*Consensus view: The respondent's default does not automatically result in a decision in favor of the complainant. Subject to the principles described in 2.1 above with regard to the second UDRP element, the complainant must establish each of the three elements required by paragraph 4(a) of the UDRP. While a panel may draw negative inferences from the respondent's default, paragraph 4 of the UDRP requires the complainant to support its assertions with actual evidence in order to succeed in a UDRP proceeding.*

*Relevant decisions:*

*The Vanguard Group, Inc. v. Lorna Kang [D2002-1064](#),*

*Berlitz Investment Corp. v. Stefan Tinculescu [D2003-0465](#)*

The above mentioned WIPO view makes it clear that even though the Respondent has failed to avail the opportunity of submitting a Response to rebut and/or counter the

contentions of the Complainant that the latter has made against the Respondent, the same has not sought to put forth any defence and/or counterclaim, this does not imply that this omission results in an automatic transfer of the Disputed Domain Names to the Complainant. The matter has to be decided on the basis of merits and evidence submitted by the Complainant (if any) needs to be taken into account and consideration while rendering the Decision. As such, this Panel has reviewed, assessed and evaluated the Complaint and the Complainant's contentions based on the Facts provided along with the supporting documentation/evidence annexed thereto.

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

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

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

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

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

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

For the assessment of illegality, unlawfulness or otherwise invalidity of the Application & Registration in order to determine whether the application and registration of the Disputed Domain Name is ab initio illegal with respect to the following aspects in the context of which this dispute shall be assessed:

- i. Whether the Disputed Domain Name infringe upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Disputed Domain Name is bona fide?
- iii. Whether the application and/or registration of the Disputed Domain Name contravene the Pakistan Penal Code or any applicable criminal law?

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

- i. Whether the Disputed Domain Name infringes a registered trade name / trade mark?**

The Complainant has alleged that:

*The Complainant is the registered proprietor of the trademark, service mark and house mark I-IP and domain name <hp.com> worldwide including inter alia Pakistan.*

*A list of worldwide trademark registrations for the trademark and service mark HP held by the Complainant along with a few randomly selected trademark registration certificates from other countries are annexed herewith as **Annexure B**.*

The Panel has taken into account and determined the Annexures submitted by the Complainant along with the Complaint. It is clear by the Trade Mark Certificates submitted by the Complainant that the same is the owner of the Trade Mark “HP”.

As such, the Disputed Domain Name incorporates and reproduces the name “hp” in entirety. The above mentioned trade mark registrations in favor of the Complainant illustrate that by virtue of reproducing the trade mark “hp” into the Disputed Domain Name, the same is infringing the trade mark registrations. Furthermore, the Complainant has not only sought to register “hp” as a trade mark, in the jurisdiction of Pakistan but has also endeavored to register the same in other foreign/international jurisdictions as well. The Panel has evaluated each of these individually and assessed the evidence submitted by the Complainant is in support of these.

As such, taking all of the trade marks as mentioned above, it can be reasonably inferred that the trade mark “hp”. Hence, the Respondent’s act of incorporating the trade mark “hp” in the Disputed Domain Name constitutes breach of trade mark that has already been registered by a party other than the Respondent.

It is imperative to determine if being the owner of registered trade mark(s) affords the same automatic rights to a disputed domain name. In this regard, the Panel has also taken into account the Consensus View taken by WIPO in cases where there a registered trade mark is infringed:

*1.1 Does ownership of a registered trademark to which the domain name is confusingly similar automatically satisfy the requirements under paragraph 4(a)(i) of the UDRP?*

*Consensus view: If the complainant owns a registered trademark then it satisfies the threshold requirement of having trademark rights. The location of the registered trademark and the goods and/or services it is registered for are irrelevant when finding rights in a mark.*

*Relevant decisions:*

*Uniroyal Engineered Products, Inc. v. Nauga Network Services [D2000-0503](#),*

*Thaigem Global Marketing Limited v. Sanchai Aree [D2002-0358](#),*

*Consorzio del Formaggio Parmigiano Reggiano v. La casa del Latte di Bibulic Adriano [D2003-0661](#)*

It is one of the foremost and vital elements of the Policy that a domain name should not infringe a registered trade mark. The Respondent's express and implied breach of the Policy is sufficient to result in cancellation of its registration of the Disputed Domain Name. Nonetheless for the purpose of completeness (but not to create any binding precedent requiring the same to be followed in the future), the Panel will also assess and determine the remaining issues as listed above.

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

In order to determine this aspect, it is important to first determine what is meant by "bona fide". A simple, literate translation/interpretation of the terms means "good faith". However, this is not enough for the purposes of deciding whether the application and/or registration the Disputed Domain Name. The Panel opines that several factors lend weight and meaning to what constitutes "bona fide" or absence of it. Since the Disputed Domain Name has been registered by the Respondent, it would have to be determined whether the Respondent has acted in good faith in registering the same. For the purpose of assessing the Respondent's registering the Disputed Domain Name, any/all contention(s) put forth by the Respondent in this matter would have been of much assistance to the Panel. However, since the Respondent has not submitted any Response, the Panel is left with no option but to base its reasoning on reasonable inferences and discussions cited in previous precedents.

The Panel, in determining this sub issue (ii), has taken into consideration(s) the motive(s)/intention(s), purpose(s), etc that the Respondent could have had when applying for registration of the Disputed Domain Name. These (possibly) could have been to advertise its products/services, provide an online portal for sale/publication/solicitation/facilitation/rendition of the Respondent's goods and/or services. The WHOIS data of the Respondent shows the same to be a Hewlett Packard Pakistan, as such this leaves very little, if not absolutely no room for any confusion with respect to the "hp" in the Disputed Domain Name. The Panel based its opinion on the grounds that are employed while registering a domain name. This could range from incorporating a registered trade name/trade mark, reproducing a name/term that relates to the Respondent and/or its course of business etc. Any/all of such reasoning asserted by a respondent, backed up by supporting evidence carves a way for a panel to determine why a respondent chose this particular name for a domain name. However, since the Respondent has failed to submit any Response in this matter, the Panel has no information, data, evidence or anything of the like at its disposal to take into consideration while determining this Complaint and the reason why the Respondent chose to register the Disputed Domain Name. As such, the Panel is unable to determine any reason(s), the Respondent could have had in using the word "hp" while registering the Disputed Domain Name which could be construed as bona fide on part of the Respondent.

Furthermore, the Respondent could have registered the Disputed Domain Name in order to have an online presence, make itself and its goods and/or services available to the consumer(s)/customer(s), have an online trading mechanism, etc. However, a visit to the Disputed Domain Name shows that the Respondent is using the Disputed Domain Name to market the products that are similar to those of the Complainant. This is being done in absence of any authorization, consent, partnership, affiliation, association, distributorship, or any relation of the like, or any relationship between the Parties in general. This is clearly evidence of lack of bona fide on part of the Respondent while registering the Disputed Domain Name and using the same for purposes that, prima facie, constitute mala fide.

Furthermore, the word "hp" has already been registered by the Complainant. The Complainant is not a newly formed entity. It is one of the oldest and most prominent manufacturer and supplier of various products, including but not limited to: Personal Systems, Imaging and Printing, Enterprise Business, Services, HP Financial Services and HP Labs, etc. furthermore, the Complainant is not a newly founded or a recently established organization, it has been operating since 1939 internationally and had acquired Trade Mark Registration for the mark HP in Pakistan in 1967. As such, it is highly unlikely that the Respondent was not aware of the Complainant or the business of the Complainant. The Panel reasonably infers that the Respondent would have known that the trade name "hp" is already being used by the Complainant in its course of business for well over a considerably long period of time.

In this respect, it is a pertinent fact that the Respondent could not fail to be reasonably aware of the reputable nature and large customer base of the Complainant at the time when the Respondent registered the Disputed Domain Name. The Panel takes into account the WIPO decision of **Hollywood Foreign Press Association v. F.M.I. Case No. D2008-1610**, whereby it was noted that:

*“The Complainant contends that the Respondent registered the Domain Names knowing of the existence of the Complainant’s trade mark, GOLDEN GLOBE, and with a view to exploiting the Complainant’s trade mark rights, a primary claim being that the Respondent registered the Domain Names with a view to selling them at a profit. If the Complainant’s allegations are made out, such a registration could not conceivably give rise to rights or legitimate interests in respect of the Domain Names. The Panel accepts the Complainant’s unchallenged contention that it is inconceivable that the Respondent was unaware of the Complainant’s mark, GOLDEN GLOBE, when the Domain Names were registered. The Complainant has undertaken various enquiries and has found no basis upon which the Respondent could be said to have rights or legitimate interests in respect of the Domain Names. Moreover, the Respondent’s name has no obvious connection with the Domain Names and the Complainant has granted the Respondent no license in respect of the GOLDEN GLOBE trade mark. The Complainant has made out a prima facie case under this head, a case calling for an answer from the Respondent. The Respondent has not responded to the Complaint; nor did the Respondent respond to letters from the Complainant’s representative. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.”*

The above mentioned precedent reaffirms and reiterates the view taken by the Panel that there isn’t anything on record for the Panel to determine as bona fide on part of the Respondent while registering the Disputed Domain Name. The Respondent has no linkage to the registered trade name “hp” that is actually the rightful intellectual property of the Complainant. Furthermore, the Respondent is neither a licensee, nor an affiliate of the Complainant, is not in any way known by the registered trade name “hp”, and including but not limited to the above, the Respondent has not provided any information whatsoever at all to demonstrate any bona fide in its favor. As such, the Panel is left with no other inference but that there is no bona fide on part of the Respondent in registering the Disputed Domain Name.

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

Before discussing this sub issue, it is imperative to clarify the grounds and consequences of the same. It is clarified that although Pakistani law does not apply by force of law over PKNIC’s Jurisdiction it does however apply as a contractual term to the contract executed between the Respondent and PKNIC thus defines the scope and terms of use of the domain name under the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2. As such it is clarified for future disputes, Appeals and Complaints that illegality with respect to the Application and Registration and examination of Pakistani law in this context does not imply that Pakistani law has applicability or jurisdiction over PKNIC or the dispute in question. Conversely the fact that Pakistani law is included as part of the terms of the PKNIC- Internet Domain Registration Policy Aug 07, 2007, version 4.2, these terms therefore apply to PKNIC and all relevant parties by virtue of the contractual and representative clauses thus the examination of Pakistani law is undertaken to determine whether any and/or all of these terms and conditions have been breached, violated and/or if there exists any non-conformity by the applicant or PKNIC.

The relevant Pakistani legislations pertaining to registration of the Disputed Domain Name includes, inter alia, 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 Name 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 statutes, which in turn would raise significant doubt regarding the legitimacy and bona fide of the Respondent's registration of the Disputed Domain Name.

The Panel reasonably opines and infers that the Respondent's registering the Disputed Domain Name could incur liability under the above mentioned Pakistani Legislations. This, in itself, is a basis on which this Complaint could be decided. However, for the sake of completeness and procedural fairness, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

The Panel in addition to the above, has made note of the issue pertaining to email(s) sent by users, being bona fide customers/consumers of the Complainant. The Panel has taken into account another way in which the use of the Disputed Domain Name would cause confusion and would be contrary to both, the letter and spirit and public policy of the ICANN UDRP as well as the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2.

The Panel notes the manner in which any "*a reasonable bystander*" or "reasonable user" may be misled and confused when sending emails to the Disputed Domain Name, being under the impression that the same, either are or maybe that of the Complainant. A customer, seeking any of the online services being provided by the Complainant, seeking

any information, providing his own confidential information etc may be misled into sending an email 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.

The Panel shall continue to deal sequentially with the next three issues:

- (i) the domain name in dispute is identical or confusingly similar to a trademark or service mark in which the Complainant have rights; and
- (ii) the Respondents have no rights or legitimate interests with respect to the domain name; and
- (iii) the domain name has been registered and used in bad faith.

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

The Disputed Domain Name use the term “hp” in entirety as the main domain name. A bare reading of the same gives the impression that the Respondent has incorporated the Complainant’s registered trade mark “hp” in the Disputed Domain Name. The Panel opines that any consumer/customer of the Complainant would be confused into believing that the Disputed Domain Name has been registered by the Complainant. Since this is not true, it could adversely affect the repute, prestige and goodwill of the Complainant, all of which are considerably important to any corporate entity in maximizing its business prospects and keeping its customers/consumers happy and satisfied. The addition of the suffix “.pk” does not create any distinctive distinction that may eliminate the possibility of confusion by the Complainant’s users. The addition of the suffix “.pk” has not been considered to add any element of distinctiveness (see *Nokia Corporation v. Firdaus Adinegoro/Beli Hosting*, WIPO Case No. D 2004-0814).

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"):

*“The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name, with the addition of common, dictionary, descriptive, or negative terms [...] typically being regarded as insufficient to prevent threshold Internet user confusion.”*

The Complainant submits that the disputed Domain Name is confusingly similar to the name and trademark in which the Complainant has extensive rights, as the Domain Name incorporates the HP trademark in its entirety with the gTLD “.com” and ccTLD “.pk” identifier at the end.

It has been consistently held in numerous UDRP decisions that domain names are

identical or confusingly similar to a complainant's trademark "when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name", see *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, [WIPO Case No. D2000-0662](#).

Where there is the incorporation of a trademark in its entirety that has been held sufficient to establish that a domain name is identical or confusingly similar to a complainant's mark, see *Pfizer Inc. v. NA*, WIPO Case No. D2005-0072 where the infringing name <pfizerviagra.com> incorporated both the name of the manufacturer and its well-known product. In this case, the disputed Domain Name incorporates the Complainant's HP mark that is used for its products and services.

Therefore, the Panel finds that the Domain Name is confusingly similar to the Complainant's registered trademarks, in which the Complainant has rights and the Complainant has satisfied the first requirement of paragraph 4(a) of the Policy

In order to determine this aspect, the Panel has based its discussions and findings under this head on several WIPO Authorities as cited below herein:

- *Mercantil Vale Do Arinos Ltda v. Belize Domain WhoIs Service Ltd. / Direct Privacy ID 9F41A*, Case No. D2011-0611:

*B. Identical or Confusingly Similar*

*The Complainant has provided evidence of ownership of several trademark registrations consisting in the mark ORTOBOM, such as the Brazilian trademark Registration Nos. 811873382, for ORTOBOM (word mark), filed on January 28, 1985 and granted on September 22, 1987, in national class 20-15, and 814583180, for ORTOBOM (word mark), filed on December 28, 1988 and granted on November 14, 1993, in national class 40-15.*

*In view of the above, the Panel finds that the Complainant has proven that the disputed domain name is identical to the trademark in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.*

- *Société AIR FRANCE v. Sys Admin, System Admin*, Case No. D2011-0606:

*A. Identical or Confusingly Similar*

*It is well established in previous UDRP cases that, where a disputed domain name incorporates a complainant's registered trademark, this may be sufficient to establish that the disputed domain name is identical or confusingly similar for the purposes of the Policy. See *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525.*

*In view of the above, the Panel finds that the disputed domain names are confusingly similar to the Complainant's well-known registered trademark AIR FRANCE, in which the Complainant has demonstrated, to the satisfaction of the*

*Panel, that it has rights in the trademark, and has used the same commercially for many years, especially in the United States, where the Respondent is located. The first element of the Policy, therefore, has been met.*

- **Moncler S.r.l. v. Shuangying Chen, Case No. D2011-0416:**

- A. Identical or Confusingly Similar*

*Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.*

*A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant owns numerous trademark registrations, which consist of the mark MONCLER all around the world. For example: Chinese trademark registration No. 177079 – MONCLER (logo), with the registration date of May 15, 1983; Community trademark registration No. 3554656– MONCLER, with the registration date of February 11, 2005; United States trademark registration No. 0803943 – Moncler, with the registration date of February 15, 1966; and many more.*

*The result is that the Complainant has shown that the disputed domain names are identical or confusingly similar to a trademark, in which the Complainant has rights.*

- **Les Laboratoires Servier, SAS v. Myan Mar, Case No. D2011-0404 :**

- A. Identical or Confusingly Similar*

*The Complainant submits that the Domain Name is confusingly similar to the trademark in which the Complainant has extensive rights, as the Domain Name incorporates the Complainant's SERVIER trademark in its entirety with the addition of the common word "my" at the start and the gTLD ".com" identifier at the end.*

*Therefore, the Panel finds that the Domain Name is confusingly similar to the Complainant's registered trademark, in which the Complainant has rights and the Complainant has satisfied the first requirement of paragraph 4(a) of the Policy.*



- Smart Voucher Ltd T/A UKASH v. RTCLTD./Protected Domain Services  
Case No. D2011-0401:

*A. Identical or Confusingly Similar*

*According to Complainant's arguments and the exhibits attached to the Complaint, it is proved that Complainant has trademark rights over the expression UKASH.*

*The Panel finds that this similarity can mislead Internet users who search for Complainant's services and divert them to the disputed domain names.*

*The Panel, therefore, finds that Complainant has established the first condition of the paragraph 4(a) of the Policy.*

The Panel has also taken into account the Discussions and Findings in previous DNDRC cases.

- Standard Chartered PLC v. Hosting Campus Domain , Case No. C2007-0001:

*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.*

- Facebook, Inc. v. Instra Proxy Service Case No. C2009-0004:

*By registering the Domain Name which reproduces the Complainant's exact trademark and conveys the same overall visual and phonetic impression as the Complainant's mark, the Respondent has undoubtedly created confusing similarity with the Complainant's trademark. Given the enormous popularity of Facebook's services and the fame of the FACEBOOK mark it is apparent that Registrant's intention in registering the Domain Name was to misappropriate for itself - and deny to Complainant - the benefit of the reputation that Complainant has established.*

*The Domain Name is therefore identical or confusingly similar to the Complainant's FACEBOOK trademark.*

The Complainant's registered trade mark is very well associated and connected with the

services and products provided by the Complainant in their course of business.

The Disputed Domain Name contain the Complainant's trade mark in entirety and as such is identical to the Complainant's registered trade mark that the Complainant uses for the purposes of conducting its business.

The use of such a confusingly identical domain name would not only cause confusion to the user(s) and customer(s) of the Complainant but would also hinder the Complainant from registering the disputed domain name for the purposes of provision of online news and other related services in furtherance to their business thus may cause substantial, irreparable and irredeemable harm to the Complainant.

As such, basing its reasoning on the above cited precedents and the findings therein, the Panel determines that the Disputed Domain Name is identical and confusingly similar to the Complainant's trade mark.

### **III. Legitimate interest in Domain Name**

As per paragraph 4(c) the UDRP requires the Respondent's claim to be of legitimate interest and shall be :

*“proved based on ..... all evidence presented” that “shall demonstrate” the Respondent's “rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii).”*

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

The Respondent had the opportunity to demonstrate its rights or legitimate interest in the disputed domain name in accordance with paragraph 4(c) of the Policy however has not been able to do so conclusively in the opinion of this Panel due to failure to provide a Response in the required form, the Respondent have no documents or annexure as evidence to demonstrate their legitimate interest in the domain name in dispute or to substantiate their contentions that have been submitted via email and are being considered by the Panel in a limited manner for the sake of completeness alone. Thus the Panel may only decide the matter based upon the Complaint as per section 5(e) of UDRP.

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 can show 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 can demonstrate 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, in the Complaint, contends the following:

*B. The Respondent has no rights or legitimate interests in respect of the domain name;*

*a) Since the disputed domain name comprises of a well- known and famous trademark, service mark and house mark and domain name <hp.com>, it is evident that the Respondent can have no right or legitimate interest in the domain name <hp.com.pk>. Further it is apparent that the sole purpose of registering the domain name is to misappropriate the reputation associated with the Complainant's famous trademark HP.*

*b) The Respondent is not commonly known by the domain name <hp.com.pk> or HP. Further neither has the Complainant authorized nor licensed the Respondent to register or use the disputed domain name incorporating its trademark, service mark or house mark HP or authorized or licensed the Respondent to register or use the disputed domain name <hp.com.pk> or any trademark forming part of it.*

*c) Further, the Respondent's choice of the Complainant's well-known trademark HP as its domain name is totally unnecessary and the sole purpose of carrying on business through the use of the disputed domain name <hp.com.pk> incorporating the Complainant's well- known and famous trademarks is to cause confusion as to the source, sponsorship, affiliation, or endorsement of the activity being carried on through the website. Moreover, such is evident from the almost confusingly identical colour scheme, layout and formatting of the Respondent's website to that of the Complainant.*

*d) The Respondent's website <hp.com.pk> is not bonafide since the Respondent is trading on the fame and recognition of the Complainant's well-known trademark HP in order to cause initial interest confusion and bait internet users to accessing its website and force the*

*Complainant to buy the Respondent out in order to avoid said confusion as is typically the strategy of such cybersquatters.*

*Hence the Respondent has no rights or legitimate interest in the domain name <hp.com.pk>.*

By virtue of the contentions as put forth by the Complainant, along with the evidence submitted to support the same, and in absence of a Response by the Respondent, the Panel is led to determine this issue on the basis of WIPO Authorities and the claims put forth by the Complainant to which accord supporting documentation has also been annexed.

- i) that the Respondent can show demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services;

The Respondent has not submitted any information, record, data, evidence, etc in response to the Complaint, even though an opportunity to do the same was afforded by DNDRC. As such, the Panel has nothing on record to take into account on behalf/part of the Respondent while determining whether it has a legitimate interest in the Disputed Domain Name or not. In such a case, all that the Panel could do is take into consideration the information etc submitted by the Complainant and on its own initiative visit the Disputed Domain Name to see what the same was being used for. A bare visit to the Disputed Domain Name led the Panel to see that the Disputed Domain Name is being used for offering products and services that are similar to those of the Complainant. As such, it can be hardly contended that such services amount to bona fide services, since, the Respondent is not only using the registered trade mark of the Complainant, but is actually also diluting its mark by offering similar services, that could lead the customers/consumers of the Complainant to be misled into believing that the Disputed Domain Name and/or the Respondent is in any way related, affiliated, associated, etc to the Complainant, which, is not the case. The Panel determines that the services being offered by the Respondent on the Disputed Domain Name do not constitute as bona fide since the same are being done in absence of a genuine, valid, authentic way that could be supported by evidence or proof or is afforded in light of a trade mark registration.

- ii) that the Respondent has been commonly known by the domain name:

The Respondent, as per the Whois information has no association, affiliation, or any relation of any kind with the Complainant. Nor has any information been put forth by the Respondent that could be taken into account while considering whether the Respondent has been commonly known by the domain name. Since no such information has been provided by the Respondent, nor has any supporting documentation been submitted by the Respondent, the Panel is unable to determine whether the Respondent has been commonly known by the Disputed Domain Name. However, the Complainant has contended that it has not authorized the Respondent to use its registered trade mark/name. In addition to that, the Panel, also using common sense and reasonable inference is left with no other conclusion but that the Respondent has not been commonly known by the Disputed Domain Name.

- iii) that the Respondent can demonstrate 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.

Since the Respondent has not submitted any Response to the Complaint, nor has provided any sort of information, data, material, evidence, supporting documentation or the like, etc to as a counter to the contentions put forth by the Complainant, the Panel is unable to take anything of the like into consideration while determining this issue on part of the Respondent. In absence of such information, the only other options available to the Panel are to take into account the assertions made by the Complainant and the evidence put forth to support the same and use its own reasonable inferences. On both accounts, it is yielded that the Respondent is using the Complainant's well established, well known and world famous trademark, which is a commonly known brand for solutions and services offered by the Complainant. Moreover, the Panel is of the opinion that it could be highly probable that the Respondent himself is a customer of the Complainant. As such, it is highly unlikely that he was unaware of the Complainant's trademark registration of the mark "HP" and/or the fact that by registering a domain name that was not his own registered trade mark, it was actually indulging in an act that held lack of bona fide. Furthermore, the Respondent is also using the Disputed Domain Name to offer services and products similar to those of the Complainant. This is being done in absence of an authorization, consent, permission, etc from the Complainant. In addition to this, i.e. lack of consent to use its trademark by the Complainant, the latter also does not have any relationship, affiliation, endorsement, association, partnership, retailer ship, distributorship, etc with the Respondent, which makes it even more obvious on part of the Respondent that his act of registering the Disputed Domain Name and using the same for offering similar services to those of the Complainant, lacking bona fide. And since the Respondent has not submitted any Response to the Complaint in this matter, it is an omission on part of the same to proof that he has a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of the Complainant.

The Panel, in order to determine this issue based on the Discussions and Findings in WIPO authorities, has also taken into account the following WIPO Decisions:

- Bayer Aktiengesellschaft and Bayer Healthcare LLC v. PrivacyProtect.org, Domain Admin / Pantages Inc, Pantages, Case No. D2011-0201:

*B. Rights or Legitimate Interests*

*The Respondent has not provided evidence of circumstances illustrated by paragraph 4(c) of the Policy, or any other circumstances evidencing any rights to or legitimate interests in the Domain Name. Hence, the Panel finds that the Respondent has no rights or legitimate interests in the Domain Name and that the requirement of paragraph 4(a)(ii) of the Policy is also satisfied.*

- Advance Magazine Publishers Inc. v. Arena International Inc. Case No. D2011-0203:

*B. Rights or Legitimate Interests*

*Accordingly, as a result of Complainant's allegations and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has proven the second element of the Policy.*

- Group Kaitu, LLC , Darkside Productions, Inc. v. NetDirect, Case No. D2011-0220:

*B. Rights or Legitimate Interests*

*The Panel concludes that Complainants have sustained their burden of proving that Respondent has no rights or legitimate interests in the <myerosfinder.com> domain name. The evidence indicates that Respondent uses this name, which is confusingly similar to Complainants' EROS mark, in connection with an adult entertainment service that competes with Complainants. As such, it may not be held that Respondent is using the domain name in connection with a bona fide offering of goods or services. Moreover, there is no evidence that Respondent is commonly known by the domain name or that it is making a legitimate noncommercial or fair use of the name. As Complainants note, Respondent "clearly seeks commercial gain from [its] activities."*

- Smart Voucher Ltd T/A UKASH v. RTCLTD./Protected Domain Services, Case No. D2011-0401:

*B. Rights or Legitimate Interests*

*Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain names. Taking into consideration that Respondent has failed to respond to Complainant, the Panel will assume that Respondent lacks rights and legitimates interests in the disputed domain names.*

*As a matter of a fact, Complainant has made a prima facie case in support of its allegations and, due to this, the burden of proof shifts to Respondent to show that it does have rights or legitimates interests in the disputed domain names, according to paragraph 4(a)(ii) of the Policy.*

*With respect to paragraph 4(c)(i) of the Policy, there is no evidence that Respondent, before any notice of the dispute, used or prepared to use the disputed domain names or a name corresponding to the disputed domain names in connection with a bona fide offering of goods or services.*

*With respect to paragraph 4(c)(ii) of the Policy, there is no evidence that indicates that Respondent has ever been commonly known by the disputed domain names.*

*With respect to paragraph 4(c)(iii) of the Policy, Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain names*

*and has not used the disputed domain names, or a name corresponding to it, in connection with a bona fide offering of goods or services.*

*At the time the Complaint was filed, the disputed domain names directed Internet users to parking pages offering goods and services in competition with Complainant. The Panel finds that this is not a bona fide offering of goods and services.*

*So, in view of the above, the Panel finds that Complainant has established the second condition of the paragraph 4(a) of the policy.*

- **Aktiebolaget Electrolux v. Maksim, SPD CHervinchuk, Case No. D2011-0403**

*Second, the creation of the Domain Name confusingly similar to the ZANUSSI trademark; the re-creation of the look and feel of the Complainant's official website "www.electrolux.com"; and the absence of disclaimers disclosing real relationship between the parties (or more specifically, the lack of any relationship) indicates to this Panel that the Respondent knew about the Complainant's trademark and reputation, and used them to his advantage in bad faith.*

The Panel has also taken into account the Discussions and Findings in previous DNDRC Complaints:

- **Telenor v. Mohammad Tahir, Case No. C2008-0001**

*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.*

*The file contains no evidence that the use of the Domain Name meets the elements for any of the nonexclusive methods provided for in the Policy paragraph 4(c). Therefore, the Sole Panelist finds that Respondent has no rights or legitimate interest in the Domain Name pursuant to the Policy paragraph 4(a)(ii).*

- **Red Bull GmbH v. PakSys Software LLC, C2009-0003**

*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 above discussions and in absence of a Response by the Respondent, the Panel cannot establish any legitimate interest on the part of the Respondent to the

Disputed Domain Name as the Respondent is not linked to the Complainant or its business in any manner of form nor does it act on the Complainant's behalf in any capacity as the Complainant has contended that no authorization has been given to the Respondent to make use of its registered trade name or any obvious derivations of it, as part of the Disputed Domain Name.

As such, the Panel is not satisfied that the Respondent has any legitimate interest in the Disputed Domain Names.

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

In regards to the issue of bad faith the Paragraph 4(b) of the UDRP states that:

*“the following circumstances, in particular but **without limitation**, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:*

*(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or*

*(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or*

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

*(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”*

The Complainant, under this head, alleges the following:

*C. The domain name was registered and is being] used in bad faith.*

*The domain name <hp.com.pk> was created by the Respondent as early as 2008-02-09. It is pertinent to note that the Complainant offers its online service via the domain name <hp.com>. The **factum** of the argument is that the Respondent acquired the same name, in which the Complainant has a substantial interest, as it being its registered trademark, service mark and housemark HP.*

*The Respondent was aware of the commercial value and significance of the domain name <hp.com> and that is the reason the Respondent grabbed the domain name <hp.com.pk>. It is nothing but an opportunistic bad faith registration on the part of the Respondent. The Respondent thus is trying to seek illegal commercial gratification. The Complainant states that in the light of aforesaid submissions, the bad faith registration and bad faith use of the domain name <hp.com.pk> on the part of the Respondent is thus proved.*

*The Complainant submits that the Respondent, no doubt, was aware prior to the Complainant's proprietary rights and registration of the domain name <hp.com> that there was substantial reputation and goodwill associated with the Complainant's trademark, service mark and housemark HP which inures and continues to insure to the Complainant.*

*b) Further, there is a great likelihood that actual or potential unwary visitors to the Respondent's present web page <hp.com.pk> or any future web page that is resolved to this disputed domain names, will be induced to:*

- Believe that the Complainant has licensed their trademark, servicemark and housemark HP to the Respondent or authorized the Respondent to register the disputed domain name <hp.com.pk>.*
- Believe that the Respondent has some connection with the Complainant in terms of a direct nexus or affiliation with the Complainant or has been authorized by the Complainant to carry out these activities.*
- Believe that the website to which the impugned domain name <hp.com.pk> resolves to is affiliated to the Complainant or that it is the Complainant's Pakistani arm.*

*It is therefore submitted that the disputed domain name has been registered and is being used in bad faith*

The Respondent has failed to provide any information, data, documentation or the like, etc in response to the Complaint even though an opportunity to do so was provided to him by DNDRC.

As such, the Panel will take into account each sub section and discuss the same for the purposes of this Decision based on the contentions put forth by the Complainant and supported by evidence/documentation annexed thereto and the Panel's own reasonable inferences and the Discussions and Findings in the WIPO Authorities.

*(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*

As has already been mentioned, discussed, assessed and evaluated above herein, the Respondent has not submitted any Response to the Complaint. In the absence of any material, data, record, information, evidence or the like available for the Panel to consider, the latter can only deduce discussions based on reasonable inferences. As far as the Respondent's registering the Disputed Domain Name is concerned, the Panel is unable to construe any legitimate, bona fide and/or fair use that the Respondent intended or could have intended to make of the Disputed Domain Name. The Respondent has not submitted any information or data pertaining to its use of the Disputed Domain Name. Moreover, the Respondent has been using the Disputed Domain Name, in order to sell/offer products and services related to those of the Complainant. Furthermore, no information with respect to the Respondent offering to sell the Disputed Domain Name is available to the Panel. As such, the Panel is unaware of the Respondent's registering the Disputed Domain Name primarily for the purposes as envisaged in subsection (i).

*(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 has demonstrated that it has registered the trade mark "HP", which is not only registered in Pakistan but also internationally. Furthermore, the Complainant is the owner of the registered trade mark HP in several classes as has been mentioned above herein. However, by virtue of the Respondent registering the Disputed Domain using the Complainant's trade mark "HP", the Complainant, being the registered owner of the trade mark "HP" is unable to register the same in a corresponding domain name for its own purposes etc. As such, in order to advertise, publish, display, offer to sell, its products and services on the internet portal, by using the domain name on the ccTLD ".pk", the Complainant is unable to do the same since the Respondent has registered the Disputed Domain Name, the Complainant is unable to register the same for itself even though a prior right to the same arises in favor of the Complainant, such rights being afforded to the Complainant by virtue of the Trade Marks Ordinance, 2001. Even though the Complainant is the legitimate, valid and legal owner of the registered trade mark "HP" by virtue of the trade mark registrations and the statutory rights afforded to the Complainant as a result of such registrations, the Complainant is unable to enjoy and make use of the rights it is entitled to, with such obstructions, hindrances, etc being put forth by the Respondent by registering the Disputed Domain Name and depriving the Complainant the right to register the same for itself. As such, the Panel cannot reasonably infer anything but that the Respondent has registered the Disputed Domain Names to disrupt the Complainant, who is the owner of the registered trade mark "hp" to use the same for registering domain names for its own use/business purposes.

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

Since the Respondent has not submitted any Response, nor has provided any information with respect to the Disputed Domain Names, the Panel has no knowledge, data, evidence, or any information whatsoever at all as to the purpose(s) for which the Respondent has

registered the Disputed Domain Names. In such a case, the Panel is unaware of the business that the Respondent is in and/or what is the trade, profession, course of business etc of the Respondent. This further hinders the Panel from determining who/what are the competitors of the Respondent. In any case, the Respondent is not making any use of the Disputed Domain Names and this serves as a further obstacle for the Panel in determining whether or not the Respondent has registered the Disputed Domain Names for the purposes of disrupting the business of a competitor.

*(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location*

The failure on part of the Respondent to submit any Response, and thereby not rebut, challenge and/or counter any of the allegations levied against it by the Complainant, the Panel cannot be reasonably satisfied that the Respondent has registered the Disputed Domain Names for any other purpose than to attract internet users by misleading and confusing them to believe that the Respondent is affiliated to the Complainant. The Panel is led to reasonably infer that since the Complainant's trade mark is famous, well established, well reputed and recognized by the masses, it would consequent in fame and popularity for the Respondent too since the users would be confused about the true identity of the Respondent and would be unaware of the fact that there is no relationship between the Complainant and the Respondent. Furthermore, since the Complainant also manages an online news portal and provides for a website whereby the daily newspaper is available for users to read, many of the users might end up at one or more of the Disputed Domain Names, thus generating traffic and revenue for the Respondent.

The Panel has made use of the Discussions and Findings in previously decided WIPO Authorities while rendering this Decision:

- Apple Inc. v. Algernon Salois, Case No. D2011-0413:

*C. Registered and Used in Bad Faith*

*The Respondent has not submitted any evidence to rebut the Complainant's claims and assertions. In the absence of such evidence, and based on the evidence submitted by the Complainant, the Panel accepts the Complainant's contentions that the disputed domain names were registered and are being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.*

- Workman Publishing Co., Inc., Patricia Schultz v. ICE, Case No. D2011-0414:

*C. Registered and Used in Bad Faith*

*Moreover, the Panel is of the view that Registrant was aware of this name when it registered the Disputed Domain Name. From among all the infinite numbers*

*that the Registrant could have selected, it chose the number “1,000”. From among all the possible verbs that the Registrant could have selected, it chose the verb “to see”. From among all the possible objects that the Registrant could have selected, it chose the noun “places.” It is simply not credible in this case that the identity between the Mark and the Disputed Domain Name occurred by chance as a result of a good faith selection by the Respondent.*

*Having regard to the foregoing, the Panel believes that the circumstances described above support the conclusion that, under Paragraph 4(b) of the Rules, Respondent has registered and used the domain name in bad faith.*

- STL Group B.V. v. Bookstore.com, Inc. Case No. D2011-0415:

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

*In this case, there is no direct evidence as to the Respondent’s motivation in registering and then using the disputed domain name. However, as indicated in the Complaint, the Respondent’s website reverted (for at least some period) to advertisements for commercial products. There is no evidence of an objective connection between the Respondent and the term “lenco”. The Complainant states that the term “lenco” is an invented term and is, as such, a term which only has meaning in connection with the Complainant’s products. The Complainant’s registrations for LENCO substantially predate the registration of the disputed domain name. Accordingly, there is an inference that the Respondent was aware of the Complainant’s mark when it registered and then used the disputed name.*

*The Complainant has therefore established its case under paragraph 4(a)(iii) of the Policy.*

- Virgin Enterprises Limited v. Trade Out Investments Ltd/Power Brand Centre Corp, Case No. D2011-0640

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

*The Respondent is using the disputed domain name to operate a web site that provides links to various web sites offering services that compete with the Complainant’s business. The Respondent is profiting from such use through the collection of referral fees for each redirected Internet user. Such use constitutes a disruption of the Complainant’s business and is therefore evidence of bad faith registration and use pursuant to Policy, paragraph 4(b)(iii). See S. Exposure v. S. Exposure, Inc., NAF Case No. FA 94864 (finding the respondent acted in bad faith by attracting Internet users to a web site that competes with the complainant’s business); see also EBAY, Inc. v. MEODesigns and Matt Oettinger, WIPO Case No. D2000-1368 (finding that the respondent registered and used the domain name <ebay.com> in bad faith where the respondent has used the domain name to promote competing auction sites).*

*The Panel holds that the Complainant has established its burden of proving this element of the Policy.*

- Mercantil Vale Do Arinos Ltda v. Belize Domain WhoIs Service Ltd. / Direct Privacy ID 9F41A, Case No. D2011-0611:

*C. Registered and Used in Bad Faith*

*The Panel, therefore, finds paragraph 4(b)(iv) of the Policy to be applicable in this case, since the Respondents are attempting to attract Internet users to its web site for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of their site.*

*In view of the above, the Panel finds that the disputed domain name was registered and is being used in bad faith.*

Since the Complainant has been actively operating the region of Pakistan for a long period of time and has also obtained trade mark registrations of "HP", the same is suggestive of the fact that the Respondent was aware of the existence and of the business of the Complainant. The fact that the trademark of the Complainant was registered long before the registration of the disputed domain name is suggestive of bad faith on the Respondent's part. The Panel opines that the registered trade mark of the Complainant is well entrenched with the Complainant's entity and is used unstintingly, both in the print and the motion media under the control of the Complainant. The facts therefore indicate conclusively that the Complainant is a relatively well-known enterprise and that its trade mark would hence be recognized publicly and the Respondent could not help but be aware of this trade mark being associated with the Complainant as well as have knowledge of the services and products offered by the Complainant.

The Respondent has provided no evidence to demonstrate lack of bad faith, additionally since both the Parties are located within the same geographical jurisdiction, it is the Panel's view that, on the balance of probabilities, the Respondent had actual knowledge of the trademark of the Complainant and the products/services in connection with which the trademark is used by the Complainant and therefore, the registration of the Disputed Domain Names by the Respondent amounts to bad faith. As it was noted in *Herbalife International, Inc v. Surinder S. Farmaha*, WIPO Case No. D2005-0765:

*"the registration of a domain name with the knowledge of the complainant's trademark registration amounts to bad faith."*

In the current proceedings, no indication of any correspondence between the Complainant and/or any representative of Complainant, on one side, with Respondent, on the other, or similar evidence, have been determined to suggest or imply that the Complainant may have approved of or condoned the Respondent's use of their registered trade mark. Without any form of substantial evidence to indicate that the Complainant approved of or condoned the Respondent's use of their trade mark in the disputed domain name, the Panel cannot infer that such a relationship of association/affiliation existed between the

Respondent and the Complainant. (See *Tom Cruise v. Network Operations Center / Alberta Hot Rods*, WIPO Case No. D 2006-0560).

The Panel has also considered the Discussions and Findings in the previous DNDRC Cases:

- Rediff.com India Ltd. v. Daniyal Waseem, Case No. C2009-0005

*Lastly, the Complainant informed the Respondent of the infringement of its registered trademarks taking place by its registration of such a domain name via the cease and desist letter sent to the Respondent, however the Respondent failed to acknowledge or respond to the letter thereby laying further credence to the existence of bad faith on the part of the Respondent.*

*In light of these circumstances, the Panel concludes that the Respondent's registration of the domain name in this particular case satisfies the requirement of paragraph 4(a)(iii) that the domain name "is being used in bad faith" by Respondent.*

- Telenor v. Pakpoint Network, Case No. C2008-0004

*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)*

Based on the above cited precedents, discussions and findings thereof and the absence of a Response on part of the Respondent, the Panel can only reasonably infer that the Respondent has registered the Disputed Domain Names in bad faith.

## **08. Decision**

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

- i. The Respondent's registration of the Disputed Domain Name is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
- ii. The Respondents have no legitimate interest in the Disputed Domain Name.
- iii. The Disputed Domain Name is identical to the Complainant's trade mark and registered domain name.
- 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:** Ms. Fozia Umar

**Dated:** 06<sup>th</sup> June, 2011