

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Google Inc. v. Youtube.PK

Case No. C2012-0004

Also in PDF C2012-0004

1. The Parties

The Complainant is Google Inc., having its office at 1600 Amphitheatre Parkway, Mountain View, CA 94043, United States of America.

The Complainant has initiated the Complaint vide their authorized representatives, M/s Irfan & Irfan Attorneys-at-law, located at 85, The Mall, Lahore, Pakistan.

The Respondent is Youtube.PK. As per the PKNIC Whois database, the Respondent's contact details are Lambi Larry Banda Singlian, PO Box 74, Abbottabad, 22010, Pakistan.

2. The Domain Name and Registrar

The domain name in dispute is <youtube.pk>, hereinafter referred to as the Disputed Domain Name and has been registered by YouTube.PK since 14th April, 2009 until 14th April, 2013.

3. Procedural History

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

The Complaint was filed with the Domain Name Dispute Resolution Center (the “DNDRC”) on 19th July, 2012.

In accordance with the PKNIC - Internet Domain Registration Policy and the Rules of ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP], paragraphs 2(a) and 4(a), DNDRC formally notified the Respondent of the Complaint via email dated 04th August, 2012 and the Respondent was asked to provide DNDRC with the Response in the format provided. The Respondent was informed that if a Response in accordance with the Rules, on the Response Form provided was not received within 7 days from the notification, the dispute would proceed *ex parte*.

The Respondent failed to submit a proper Response in the proper and specified manner and on the Response Form provided to the Respondent for ease of use. 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 *ex parte* based upon the Complaint.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), the Center appointed Ms. Fozia Umar as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules. The Panel finds that it was properly constituted.

The language of the proceedings is English.

4. Factual Background

The Disputed Domain Name has been registered by the Respondent since 14th April, 2009 up till 14th April, 2013.

5. Parties' Contentions

The Complaint contends the following:

*The Complainant is the registered proprietor of the trademark <youtube> in various countries including Pakistan. Details of collectively filed specimen copies of trademark registrations and applications filed by the Complainant for registration of the YOUTUBE mark in a number of countries across the world and also an illustrative list of YOUTUBE trade mark registration in favour of the Complainant across the world are enclosed as **Exhibit 5**.*

- i. The domain name www.youtube.pk (the “Domain Name”) is the subject of this Complaint. The present complaint has been instituted in order to protect the Complainant’s rights in the trademark and domain name*

YOUTUBE which has been unauthorizedly copied by the Respondent and registered as a domain name with PKNIC Registry. A copy of the domain records of www.youtube.pk is enclosed as Exhibit 1.

- ii. The Complainant Google Inc. is a Delaware corporation located in Mountain View, California. The Complainant's business under the name "GOOGLE" was founded by Larry Page and Sergey Brin in the year 1997. With its humble beginning, the Complainant has grown to become multi-billion dollar business under the name / mark "GOOGLE". The Complainant's primary website www.google.com, which was registered on September 15, 1997, is widely recognized as the world's largest search engine, easy-to-use free service that returns relevant results within seconds. The Complainant's mark "GOOGLE" is one of the world's best known brands almost entirely through word of mouth from satisfied users.*
- iii. In addition to Complainant's primary business of providing internet search capability, the Complainant is also engaged in providing a wide range of other products and services. More relevant to this dispute is Complainant's business of operating the popular website www.youtube.com. The associated press articles and publications from news papers showing the Complainant's wide array of applications and operations are attached as Exhibit 2.*
- iv. Launched in 2005, www.youtube.com is one of the leading online video sharing sites which allows people to easily upload and share video clips on the site and across the Internet through websites, mobile devices, blogs, and email. Additionally a wide variety of content including movies, TV clips and music videos as well as user generated content such as video blogging and short original videos are uploaded and are available on the Complainant's YouTube website. Moreover, more than 72 hours of video are uploaded to YouTube every minute and over three billion hours of video are watched each month.*
- v. According to the web ranking website www.alexa.com, Complainant's YouTube website is ranked as no. 3 on the list top 500 websites in the world today. Attached as Exhibit 3 is a printout from the independent website www.alexa.com in support of mass popularity of the YouTube website and its services.*
- vi. The mark YOUTUBE is a coined word and it was chosen by the Complainant's predecessor-in interest, YouTube, Inc., for their video sharing service in February 2005. Thereafter, www.youtube.com was launched on April 24, 2005. The Complainant, Google Inc subsequently acquired*

YouTube, Inc in November 13, 2006 and consequently gained the right to use the mark YOUTUBE. Attached marked as Exhibit 4 are copies of international press articles surrounding the first use of the trademark/domain name YouTube and the launch of its service.

- vii. The Complainant has applied for and has obtained registration of trademark YOUTUBE in a number of countries around the world including Pakistan, UAE, Kuwait, Jordan, Qatar United States of America, Argentina, Austria, Brazil, Canada, China, the European Union, Hong Kong, Japan, India, Israel, Mexico, Norway, Philippines, Singapore, South Korea, Switzerland, Taiwan and Venezuela. Furthermore, Complainant has also obtained international registration of the YOUTUBE trademark under the Madrid Protocol as granted by WIPO. Annexed as Exhibit 5 are collectively filed specimen copies of trademark registrations and applications filed by the Complainant for registration of the YOUTUBE mark in a number of countries across the world in addition to an illustrative list of YOUTUBE trademark registration in favour of the Complainant across the world. In Pakistan the YOUTUBE mark is registered in Class 38 under application no. 228932 as early as in 2006 and in class 41 under registration no. 228934.*
- viii. The Complainant submits that the technology industry has recognised the YOUTUBE services and a number of awards have been conferred upon it. Attached marked as Exhibit 6 are extracts from the Time Magazine (on-line edition) awarding YOUTUBE as the Best Invention of the year 2006. The Wall Street Journal and New York Times have also reviewed the effects on recruiting and corporate communications in 2006 with regards to YOUTUBE. The PC World Magazine has also named YouTube as the ninth of the Top 10 Best Products of 2006. The Complainant's YouTube website and the YOUTUBE mark as such has attained immense popularity across the world and the Internet users recognize and associate YouTube as a part of Google Inc. across the world.*
- ix. YouTube is localized in 43 countries across 60 languages, even in Urdu speaking countries like Pakistan. The popularity of YouTube can be gauged from the fact that 'Urdu' is amongst the 60 listed languages in which the YouTube page can be viewed. A list of countries where the Complainant owns and operates the YOUTUBE trademark/domain name is attached as Exhibit 7.*
- x. The Complainant submits that the overwhelming success of its YOUTUBE*

services has resulted in the Complainant gaining extensive goodwill and reputation in the trademark world-wide, and that on account of its extensive use and popularity, the domain name/trademark YOUTUBE has achieved the status of a 'well-known' mark.

xi. This well-known status has been recognized by other Domain Name Dispute Resolution Bodies in their various decisions in favor of the Complainant. Most recently, the Panelists in the www.youtube.ae dispute noted the well-known status of the YOUTUBE trademark. [Google Inc. V Mobitronix LLC Case No:DAE2011-0002]. Additionally, the Panelist in the www.youtube.ph dispute noted the same. [Google Inc. V PD Hosting Inc., Ken Thomas Case No:DPH2011-0004]. Attached as Exhibit 8 is a compilation of decisions passed by various Domain Name Dispute Resolution Bodies in the Complainant's favor with respect to the YOUTUBE domain name/ trademark.

xii. As per the PKNIC domain records, the Registrant registered the Domain Name www.youtube.pk on 14th April, 2009. However the domain seems to have been redirected to the Domain name www.youtubeurdu.com which imitates the Complainant's website www.youtube.com as it incorporates Complainant's well known domain name 'YouTube' and provides services similar to those of the Complainants' such as videos streaming of movies and songs. The Respondent's website further contains links that use the mark YOUTUBE, UTUBE, UTUBE PAKISTAN, YOUTUBE INDIA etc. that further shows their intention to misrepresent to consumers that their services are similar to those of the Complainant.

xiii. A separate complaint has been submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy for the Domain www.youtubeurdu.com. Attached as Exhibit 9 is a copy of snapshots of Registrant's website www.youtubeurdu.com.

Remedies Sought by the Complainant:

In accordance with paragraph 4(1) of the Policy, for the reasons described in section V above, the Complainant requests the Registrar / Administrative Panel appointed in the administrative proceeding to issue a decision that the Domain name <www.youtube.pk> be transferred to the Complainant.

Respondent's Contention:

Improper response of the Respondent:

DNDRC, vide email dated 04th August, 2012 notified the Respondent of the Complaint against them and provided them with a copy of the Complaint and a Response Form, inviting them to submit their response in accordance with the Rules and on the Response Form provided for ease of use. However, the Respondent failed to do so. The Respondent, however, sent an email dated 04th August, 2012 to DNDRC.

The Respondent has not submitted the response in accordance with the UDRP. However, for the sake of clarity and completeness, the Panel will endeavor to discuss the email he sent, even though it does not constitute a proper and appropriate response in compliance with the Rules and without prejudice to the determination and observations already made by the Panel.

The Respondent, vide his email dated 04th August, 2012 asserts the following:

Dear Sir,

I bought this domain from its old owner by giving him reasonable amount. I don't know about the copyrights of domain names. If I knew this I would never buy it. Now, I am a poor man and I have given him reasonable amount for the domain. If google wants to take it then I could not do anything but what would be of the money that I have given to its old owner. I don't own po box 72 right now as it is expired. My new postal address is:

Tanveer Sultan

Logics Web Designing

Top Floor, Rajpoot Plaza, Abbottabad.

Phone: +923009113300

I also have not received any printed material. Please send me the details in printed form so I could show them to any expert person or legal adviser.

Waiting for your response.

Tanveer Sultan

6. Jurisdiction

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2

and the Rules.

The Respondent applied for and was granted registration of the Disputed Domain Name on the basis of, 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 Name on behalf of the Complainant is regulated by the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 and the UDRP Rules. The PKNIC Policy states:

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

The Respondent applied for registration of the Disputed Domain Name 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).

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 , and hence is deemed valid, subject to inter alia paragraph 1 & 4and 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.

Therefore, for the assessment of illegality, unlawfulness or otherwise invalidity of the Application & Registration of the domain name in dispute, the application and registration of the Disputed Domain Name shall be assessed under the following aspects:

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

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

- i. Whether the Disputed Domain Name infringes upon, or is an obvious derivation of, a registered trade name / trade mark?**

The complainant has submitted that:

The Complainant is the registered proprietor of the trademark <youtube> in various countries including Pakistan. Details of collectively filed specimen copies

of trademark registrations and applications filed by the Complainant for registration of the YOUTUBE mark in a number of countries across the world and also an illustrative list of YOUTUBE trade mark registration in favour of the Complainant across the world are enclosed as Exhibit 5.

The Complainant has provided, along with annexing evidence of the same, that the Complainant has trademark registrations in favor of the trademark YouTube in several countries, for example, Pakistan, UAE, Kuwait, Jordan, Qatar United States of America, Argentina, Austria, Brazil, Canada, China, the European Union, Hong Kong, Japan, India, Israel, Mexico, Norway, Philippines, Singapore, South Korea, Switzerland, Taiwan and Venezuela. Furthermore, Complainant has also obtained international registration of the YOUTUBE trademark under the Madrid Protocol as granted by WIPO.

As submitted by the Complainant and evidence of the same annexed with the Complaint, the Complainant holds trademark registration rights to YouTube in several countries, including Pakistan whereby it is registered in Class 38 as of the date 06.11.2006, bearing trademark number 228932 and in Class 41 as of the date 06.11.2006, bearing trademark number 228934.

It can be seen that the Disputed Domain Name <youtube.pk> incorporates the registered trademark of the Complainant; YouTube in entirety. And that the same is identical to the numerous trademark registrations of the word <YouTube> held by the Complainant. In addition, the Panel finds that the whole of the domain name in dispute is confusingly similar to the above mentioned trademark registrations.

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 distinctive 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 2004-0814](#)). Therefore the Panel determines the Disputed Domain Name to be an obvious derivation of the Complainant’s registered trademark and correspondingly in obvious infringement of the same.

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, furthermore due to the lack of a proper Response from the Respondent, the Panel is required to decide the matter based upon the Complaint. The Respondent was provided electronic copies of the Complaint and the Annexures filed by the Complainant and was invited to submit a Response in accordance with the Rules on the Response Form, also provided for ease of use to the Respondent. However, the Respondent failed to avail this opportunity and failed to submit a proper Response on the Response Form and in accordance with the Rules. Also, no information in form of evidence, documentation or the like was provided to DNDRC which could be taken

into consideration while rendering this Decision. Therefore subject to the above stated observations, the Panel may well determine the Disputed Domain Name to be transferred to the Complainant, However for the purpose of completeness (but not to create any binding precedent requiring the same to be followed in the future), the Panel will also assess and determine the remaining issues as listed above.

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

It has been asserted by the Complainant, and has not been refuted by the Respondent, that the Complainant is the registered owner of the trade mark/name YouTube. The Complainant has registered its trademark and domain names world wide in order to reflect and protect the same. The facts illustrate that the entity YouTube is internationally renowned and highly recognizable. And that the same is associated with the Complainant who holds the intellectual property rights to the tradename/trademark and thereby is entitled to use it in all forms afforded by intellectual property rights legislations, inter alia, Trade Marks Ordinance, 2001 of Pakistan, which allows a trademark holder to use its trademark in corresponding domain name(s).

The Complainant has been using the trademark YouTube in providing services to the masses since 2005, well in time before the Respondent registered the Disputed Domain Name. The documentation/evidence provided by the Complainant depicts the recognition and goodwill associated with the trademark YouTube, both being on a colossal level. In light of the same, the Respondent could not help but be aware of the name YouTube. Also, the Respondent has not provided any information, data or documentation, or even contended any rights to the Disputed Domain Name nor provided any information, data or the like, in accordance with the Rules that would give any indication of lack of mala fide on part of the Respondent with respect to registration of the Disputed Domain Name. In absence of a proper Response by the Respondent and information, data, evidence, documentation or like, the Panel cannot help but observe that YouTube being the registered trademark of the Complainant, the Respondent's registration of the Disputed Domain Name corresponding with the Complainant's trademark in entirety does not appear to be bona fide. The Respondent's motives are not entirely clear and a lack or otherwise of bona fide on the Respondent's part is unclear as the Respondent, by its omission to provide any information, data, documentation etc. has not demonstrated any bona fide on its part before this Panel.

The Panel is of the view that it is highly unlikely that the Respondent would not have known of the Complainant's name, trademark and business while registering the Disputed Domain Name, and that it is not reasonably credible that the Respondent's purpose would be of a bona fide nature, as appropriation of a well known trademark of which a Respondent must have been aware, for the purposes of a domain name without authorization, is commonly a sufficient basis for a finding lack of bona fide (*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The*

Polygenix Group Co., [WIPO Case No. D2000-0163](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, [WIPO Case No. D2000-0226](#); *Société des Hôtels Méridien v. LaPorte Holdings, Inc.*, [WIPO Case No. D2004-0849](#); *Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry – Succession Saint Exupéry – D'Agay v. Perlegos Properties*, [WIPO Case No. D2005-1085](#)).

In the absence of any information, data, documentation, or the like in the proper manner, in accordance with the Rules, the Respondent has failed to demonstrate that the registration of the Disputed Domain Name is bona fide.

iii. Whether the application and/or registration of the Disputed Domain Name contravene the 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, The Electronic Transactions Ordinance, 2002, subject to which infringements of Trade Marks and Trade Names is equated with the infringement of domain names hence the provisions of the Pakistan Penal Code Act, 1860 that deal with infringement of Trade Marks, would possibly also cover domain names.

Additionally under the Pakistan Penal Code Act, 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 trademarks/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 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 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 Complainant and no 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.

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

The Complainant has contended the following:

- 1. The Complainant has used the YOUTUBE trademark/domain name continuously since well prior to April 14, 2009, the registration date for the disputed Domain Name. The Complainant owns many registrations for the mark YOUTUBE as contained in **Exhibit 5** issued prior to, or resulting from applications filed prior to April 14, 2009 including its registration in Pakistan. Each remains valid and in full force. Thus, the Complainant has rights in the YOUTUBE mark that predate the registration date of the Domain Name.*
- 2. A domain name is "nearly identical or confusingly similar" to a Complainant's mark when it "fully incorporate[s] said mark." PepsiCo. Inc. v. PEPSI SRL, D2003-0696 (WIPO Oct. 28, 2003) (holding pepsiadventure.net, pepsitennis.com, and others confusingly similar to complainant's PEPSI mark since they "incorporate[ed the] trademark in its entirety"). Here, the Domain Name www.youtube.pk incorporates the famous YOUTUBE mark in its entirety, and is identical to it. Further there have been awards in the Complainant's favor with regards to disputes over the domain*

- names containing the word YOUTUBE. See, e.g., *Google Inc. v Miller* FA0708001067791 (Nat'l Arb Forum Oct 24, 2007) (Where *youtubex.com* was found to be in bad faith and confusingly similar to the complainants domain name *youtube.com*). See also *Google Inc. V Nimbalkar*, FA0708001068746 (Nat'l Arb Forum Nov 28, 2007) (further finding that the YOUTUBE mark is "well-known and distinctive" a domain name *www.youtube.com* is confusingly similar to the Complainant's domain name).
3. The Complainant owns the Domain name www.youtube.com and the Respondent's domain name 'www.youtube.pk' is derived by incorporating the Complainant's trademark "YOUTUBE" in its entirety to attract internet users and consumers for commercial gain. Therefore, there is a likelihood of confusion, and in fact suggests that the disputed domain name refers to the Complainant or that the Respondent is associated with the Complainant which is not the case. Furthermore, it is established law to disregard the ccTLD when considering the matter of confusing similarity or obvious derivation as the addition of suffix ".pk" does not create any distinction that may eliminate the possibility of confusion by the Complainant's customers, as held in *Google Inc. v Mubarkan Pvt. Ltd* (Case No:C2012-0002) for the domain *www.gmails.pk* which was found to be similar to Complainant's trademark GMAIL.
 4. The Complainant further submits that it has not licensed or otherwise permitted the Respondent to use the "YOUTUBE" trademark, or any other trademark incorporating the "YOUTUBE" mark. The Complainant has also not licensed or otherwise permitted the Respondent to apply for or use any domain name consisting of or incorporating the "YOUTUBE" mark. See *Rediff.com India Ltd. v. Daniyal Waseem DNDRC* (Case No. C2009-0005) it was held that "Both under past UDRP decisions (see for instance *Nike, Inc. v. B.B. de Boer*, WIPO Case No. D2000-1397; and *Carolina Herrera, Ltd. v. Alberto Rincon Garcia*, WIPO Case No. D2002-0806) and under the Policy, a well-established principle is that when someone registers a domain name, it represents and warrants to the registrar that, to its knowledge, the registration of the domain name will not infringe the rights of any third party. In the case at issue, the Panel reasonably finds that since the Complainant's marks are widely known, it is unlikely that the Respondent, at the time of registration of the disputed domain name or thereafter, was not aware that it was infringing the Complainant's marks."

The Respondent has failed to provide a Response in the required manner.

The Complainant is the registered trademark holder for the trademark "YouTube" which forms the entirety of the Disputed Domain Name. The Complainant's trademark YouTube is a unique word, not holding any literary meaning, however the use of the word is arbitrarily is used in a

manner that distinguishes the services provided by the Complainant and thus makes the term YouTube inherently distinctive and closely associated and distinguishable to the Complainant. The Complainant's registration of the mark YouTube illustrated that it has exclusive rights in the same in numerous countries demonstrated by the carrying out of all reasonable methods possible to protect its registered trademark and securing intellectual property rights with respect to YouTube.

As is evident, the Disputed Domain Name reproduces the entirety of the Complainant's registered trademark and the addition of the generic ccTLD indicator ".pk" cannot be taken into consideration when judging confusing similarity. It is well-established that the incorporation of a Complainant's mark in full within a disputed domain name may be sufficient to establish confusing similarity between the mark and the disputed domain name (see *Nokia Group v. Mr. Giannattasio Mario*, WIPO Case No. D2002-0782, *The Ritz Hotel Ltd v. Damir Kruzicevic*, WIPO Case No. D2005-1137, and *Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge*, WIPO Case No. D2006-1643.)

The Complainant has produced adequate evidence of its rights in the trademark YouTube. gTLD suffix ".com" or its equivalent is an integral part of a domain name and is not considered relevant to the consideration of confusing similarity. The remainder of the Disputed Domain Name, being YouTube is the strong, distinctive and globally renowned trademark of the Complainant. (see *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1059 9th Cir. 1999; "*The intentional registration of a domain name knowing that the second level domain is another company's valuable trademark weighs in favor of likelihood of confusion.*").

Another salient feature of the Disputed Domain Name being registered by the Respondent, who has not alleged any intellectual property rights to the term YouTube, is the factor of confusing similarity. Not only is the Disputed Domain Name entirely identical to the Complainant's trademark YouTube, thereby causing internet users to be misled into believing that the Disputed Domain Name is either being run, or is endorsed, affiliated, associated or the like with the Complainant, but will also be confused as to the ownership and rights to the Disputed Domain Name and the content posted on it vesting with the Complainant, when the same is not true. Even though the rights to register the Disputed Domain Name vest with the Complainant; being the registered trademark owners of the trademark YouTube, the same is unable to register the Disputed Domain Name for itself, since registration of the same has been secured by the Respondent. The Complainant asserts that it has neither authorized, permitted nor consented to and/or approved the registration of the Disputed Domain Name by the Respondent, thereby laying to rest any doubts, confusions or the like with respect to any affiliation, relationship, association or the like between itself and the Respondent.

The Disputed Domain Name reasonably creates likelihood that individuals will be confused into thinking that the Disputed Domain Name or the related site(s) is owned, endorsed, licensed,

sponsored, or maintained by the Complainant to promote its services therefore the Complainant has established the confusing similarity of the Disputed Domain Name with its own legitimate registered trademarks.

Thus The Panel finds confusing similarity between the Disputed Domain Name and the Complainant's trademark under paragraph 4(a)(i) of the Policy.

III. Legitimate interest or rights in the Domain Name

The Complainant has contended:

- i. *The Complainant submits that there is no credible legitimate reason for the Respondent to have chosen to acquire the Domain Name. 'YOUTUBE' is not a natural word nor a common name, nor one which is a common or natural descriptor for the use which is being made of the Domain Name. The Respondent's purpose in selecting the Domain Name was plainly to use the fame of the YOUTUBE mark to generate web-traffic and to confuse internet users visiting the Respondent's site when looking for the Complainant and their famous suite of services.*
- ii. *The Respondent is not and has never been known by the YOUTUBE name or by any similar name.*
- iii. *Registration and use of the domain www.youtube.pk by the Respondent is neither bonafide nor a legitimate noncommercial or fair use of the Domain Name especially because it is redirected to the domain www.youtubeurdu.com which contains third party advertisements/links which is clearly aimed to derive unfair commercial gain by the Respondent and infringes Complainant's rights in the YOUTUBE mark. The goodwill in the YOUTUBE name rightfully belongs to the Complainant and has been improperly appropriated by the Respondent. Such conduct can never constitute a legitimate interest.*
- iv. *The Complainant submits that when the Respondent registered the disputed domain name, it was aware of the Complainant's activities, its Trademarks and its domain name "YOUTUBE" and these facts establish a prima facie case that the Respondent has no right or legitimate interest in the disputed domain name and that pursuant to the Policy the burden shifts to the Respondent to show it does have a right or legitimate interests. Please refer to Croatia Airlines d.d. v. Modern Empire Internet Ltd., [WIPO Case No. D2003-](#)*

- [0455](#) and *Clerical Medical Investment Group Limited v. Clericalmedical.com* (Clerical & Medical Services Agency), [WIPO Case No. D2000-1228](#).
- v. *On information and belief, Registrant is not commonly known by the name or nickname of the Domain Name, or any name containing Complainant's YOUTUBE Mark. Registrant's information on the domain records in connection with the Domain Name makes no mention of the Domain Name or the Mark as Registrant's name or nickname. See, Popular Enterprises, LLC v. Sung-a Jang, FA0610000811921 (Nat. Arb. Forum Nov. 16, 2006) ("[r]espondent's WHOIS information does not suggest that [r]espondent is commonly known by the <ntester.com> domain name"). Registrant's name is not mentioned on records and is referred to as youtube.pk which establishes the fact that the Respondent has tried to hide his identity. As the Domain name is plainly registered for commercial purposes, it cannot constitute a legitimate non-commercial or fair use of the Domain Name. The adoption by the Respondent of the 'YOUTUBE' domain name is plainly designed to assist it in impersonating the Complainant.*
- vi. *As such, its use of the Domain Name cannot constitute a bona fide offering of goods or services or a bonafide company name or trading name and such conduct can never constitute a legitimate interest.*

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 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, the same 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 has provided no documents or annexure as evidence to demonstrate their legitimate interest in the Disputed Domain Name 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 has nothing on record on part of the Respondent to decide Legitimate Interest in favor of the Respondent under 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.”

The onus is on the Complainant to satisfy the Panel that the Respondent does not have rights or legitimate interests in the Disputed Domain Name. The Complainant has alleged that it has not authorized the Respondent to use its registered trademark YouTube in any manner or form.

Once the Complainant has made out a prima facie case, it is for the Respondent to refute the Complainant's *prima facie* case as provided for in paragraph 4(c) of the Policy. The Respondent has not replied to the allegations made against its registration of Disputed Domain Name, in the required form; therefore the Panel may decide the matter *ex parte* based upon the Complaint and the relevant facts contained therein.

The substantive part of the Disputed Domain Name; “youtube”, incorporates the Complainant's trademark in entirety. The term YouTube was coined by the Complainant and it does not hold any literal meaning. The trademark YouTube is distinctive to the Complainant, in particular, in its provision of services associated with the trademark YouTube and the same being widely recognized, used and liked by the masses. Users of YouTube associate the same with the Complainant and are aware that it is a service formulated and being provided by the Complainant. Furthermore, the Complainant, in order to secure its rights, in particular intellectual property rights to the YouTube, has applied for and been granted trademark registrations in favor of the same across the globe, including Pakistan.

Given the fame of the YouTube mark and the popularity of the services provided by the Complainant, it is inconceivable that the Respondent was unaware of the Complainant's rights and interests prior to the registration of the Disputed Domain Name. It can, therefore, reasonably be ascertained, on the basis of the facts and documents provided by the Complainant that the Respondent did not create a fabricated name, which happened to consist of the trademark YouTube of the Complainant. The Respondent has tendered no proof to claim registration to any trademark related to the YouTube name (see *Harrice Simons Miller v. H Rheyne*, [WIPO Case No. D2004-0504](#)).

The Complainant has asserted that it has not consented to the Respondent's use of the Disputed Domain Name which incorporates its trademark YouTube in entirety. Mere registration of the Disputed Domain Name by the Respondent does not create any right or legitimate interest in the same (see *Red Bull Gmbh v. Mario Maranda*, [WIPO Case No. D2008-0941](#)). Furthermore as the Respondent is not an authorized dealer, distributor, or licensee of the Complainant, nor has it

been otherwise allowed by the Complainant to make any use of its trademarks, the use of the Complainant's registered trademark may then "*constitute a prima facie showing by Complainant of absence of rights or legitimate interest in the disputed domain name on the part of Respondent.*" (*Philip Morris Incorporated v. Alex Tsytkin*, WIPO Case No. D2002-0946).

Since the Respondent has not submitted any documentation, information, evidence, data or the like in the proper manner in accordance with the Rules, the Panel is unable to take into account any legitimate interests (if any) and/or rights to the Disputed Domain Name on part of the Respondent.

In summary, it appears that the Respondent has not been known by the Disputed Domain Name since the same has been registered by the Complainant even before the Disputed Domain Name was registered and has been used in continuity worldwide, thereby acquiring goodwill, reputation, fame and popularity that is closely associated with the Complainant and the trademark YouTube, to which the Complainant has secured intellectual property rights in several countries, including Pakistan.

The Panel, is unable to determine any rights or legitimate interests on part of the Respondent since the latter has not provided any information, documentation, evidence or the like in accordance with the Rules to demonstrate that before any notice of the Complaint to him, he was using or making demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services. Nor has the Respondent shown that it, (as an individual, business, or other organization) has been commonly known by the Disputed Domain Name, even if it had acquired no trademark or service mark rights. Furthermore, the Respondent has failed to show that it is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Accordingly, the Respondent has failed to demonstrate any rights or legitimate interests with respect to the Disputed Domain Name.

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

The Complainant has made the following submission:

- i. *The nature of services being provided by the Respondent by redirecting the domain name www.youtube.pk to the domain name www.youtubeurdu.com which contains*

*references to the services offered by the Complainant overwhelmingly supports the conclusion that the Respondent registered and is using the Domain Name in bad faith. It is submitted that the Respondent's bad faith is further exemplified by the fact that it has registered the disputed Domain Name www.youtube.pk on April 14, 2009, which is subsequent to the adoption and use of the mark YOUTUBE by the Complainant. The fame and unique qualities of the YOUTUBE mark makes it extremely unlikely that the Respondent created the disputed Domain Name independently. See, e.g., *The J. Jill Group, Inc. v. John Zuccarini d/b/a RaveClub Berlin*, FA0205000112627 (Nat. Arb. Forum July 1, 2002) ("Because of the famous and distinct nature of Complainant's mark and Complainant's J. JILL listing on the Principal Register of the USPTO, [r]espondent is thought to have been on notice as to the existence of Complainant's mark at the time [r]espondent registered the infringing <jjill.com> domain name. Thus, [r]espondent's registration despite this notice is evidence of bad faith registration"). Even constructive knowledge of a famous mark like YOUTUBE is sufficient. *Google v. Abercrombie 1*, FA0111000101579 (Nat. Arb. Forum Dec. 10, 2001) ("because of the famous and distinctive nature of Complainant's GOOGLE Mark, [r]espondent is thought to have been on notice of the existence of Complainant's mark at the time [r]espondent registered the infringing [domain name]") (re googld.com domain name).*

- ii. *The Respondent has registered the disputed Domain Name which is identical to the Complainant's well known mark and domain name. In so doing, the Respondent has intentionally attempted to attract commercial gain by misleading the Internet users of the web site and creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website (Policy, paragraph 4(b)(iv)). The commercial gain is evidenced from the fact that besides providing similar services to those of the Complainant, the domain www.youtubeurdu.com contains third party advertisements/links which is likely aimed at commercial gain for the Respondent.*
- iii. *The Respondent's choice of domain name is not accidental and has clearly been made to derive unfair monetary advantage. In support of this submission, the Complainant contends:*
 - (1) *At the time of registration of the domain name by the Respondent i.e., on April 14, 2009, the mark and domain name "YOUTUBE" was well-known and registered in several countries of the world including Pakistan. Therefore, the popularity and registration of "YOUTUBE" mark and domain name was a constructive notice to the Respondent on Complainant's rights in the "YOUTUBE" mark and name. Thus, the adoption of an identical mark/domain name by the Respondent is in bad faith.*

- (2) *The word YOUTUBE is a unique coined word, which is exclusively referable to the Complainant and the suite of services provided by the Complainant. Thus, use of words and domain name www.youtube.pk by the Respondent is clearly to align its business/services with that of the Complainant. The Complainant has made extensive use of the YOUTUBE mark for a considerable time, such that the YOUTUBE mark has acquired goodwill globally as it has contents that cater to many different age groups, languages and cultures.*
- (3) *As previously set out, the Respondent has adopted an identical mark YOUTUBE as part of the Domain Name. The entire business activity of the Respondent is to deceive the innocent trade and public by misrepresenting themselves as part of the Complainant's company or to misrepresent that their activities have been authorised, approved or sponsored by the Complainant. The Respondent has wrongfully registered the Domain Name to deceive consumers. Thus, from the circumstances, it is plain to see that the adoption of the YOUTUBE domain name was not independent but parasitic and made 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 Respondent has failed to submit a Response in the required form.

Paragraph 15(a) of the Rules instructs the Panel to “*decide a complaint on the basis of the statements and documents submitted in accordance with the policy, these rules and any rules and principles of law that it deems applicable*”.

Paragraph 4(a)(iii) of the Policy utilizes both, past and present, tenses thereby inferring that upon determining bad faith on the part of the Respondent, the Panel should consider the circumstances at the time of registration as well as the subsequent behavior of the Respondent following the registration, with regards to the Disputed Domain Name.

In absence of a proper Response on part of the Respondent and in absence of any information, data, documentation or the like in form of evidence, the Panel cannot conceive of a plausible situation in which the Respondent would have been unaware of the popularity and success of the Complainant’s services at the time of registration, especially when the trademark holds a massive fan following, usage and is widely recognized across the globe.

Taking into account the submissions made by the Complainant, supported with documentation, the Panel is of the view that it is highly unlikely that the Respondent was not aware of the Complainant, its trademark YouTube, the nature of services rendered under the head of YouTube and the massive customer base of the Complainant. In effect, the Respondent has prevented the Complainant from registering the Disputed Domain Name for itself even though a right to do so vests with the Complainant, as is afforded to it under the Trade Marks Ordinance, 2001, by virtue of its trademark registration rights for the mark YouTube. By registering the Disputed Domain Name, which incorporates the Complainant’s trademark in entirety, the Respondent has created a likelihood of users being confused and misled into believing that the Disputed Domain Name is being operated by the Complainant, which is not true. This could lead to consumers falsely believing the same being operated and offered by the Complainant. In effect, if a user is dissatisfied and/or finds out that it has been misled, it could severely affect the customer base of the Complainant, along with its image, reputation, goodwill etc. being tarnished. Also, it appears that by registering and using the Disputed Domain Name, the Respondent is encashing on the Complainant’s well established repute.

Both under past UDRP decisions (see for instance *Nike, Inc. v. B.B. de Boer*, [WIPO Case No. D2000-1397](#); and *Carolina Herrera, Ltd. v. Alberto Rincon Garcia*, [WIPO Case No. D2002-0806](#)) and under the Policy, a well-established principle is that when someone registers a domain name, it represents and warrants to the registrar that, to its knowledge, the registration of the domain name will not infringe the rights of any third party. In the case at issue, the Panel reasonably finds that since the Complainant’s marks are widely known, it is unlikely that the Respondent, at the time of registration of the Disputed Domain Name or thereafter, was not aware that it was infringing the Complainant’s mark(s).

Taking into account all of the above, and in particular, by omission of the Respondent to submit a proper Response in the required manner, the Panel is unable to determine that the Respondent did not register and is not using the Disputed Domain Name in bad faith.

Improper Response of the Respondent:

Even though the Respondent did not submit the Response in the required manner/form, the Panel has made note of it. It is clarified that this does not form a binding precedent to be used in future cases/domain name disputes brought before DNDRC.

The Respondent has raised the issue of purchasing the Disputed Domain Name from the previous registrant. However, the Respondent has not provided any details with respect to this. The PKNIC Whois Data shows that the Respondent has registered the Disputed Domain Name since 2009 until 2013. The Respondent has not provided any information, documentation, evidence, data or the like, nor submitted the Response on the proper Response Form which was provided to the Respondent.

The Respondent has also raised the issue of being unaware of intellectual property rights with respect to the Disputed Domain Name. The Panel finds it highly unlikely that the Respondent would not have known the fame, popularity and goodwill associated with the Disputed Domain Name/trademark YouTube. Furthermore, while registering a domain name, it is for the entity registering the domain name to be aware of the rights with respect to the domain name being registered.

Furthermore, the Respondent has stated that it is willing to sell the Disputed Domain Name. This clearly satisfies the first criterion of Registered and Used in Bad Faith issue.

WIPO Authorities:

The Panel, for the purpose of assessing the matter and this Decision, has taken into account, reviewed and made use of the Discussions & Findings in the WIPO Authorities mentioned and relied upon by the Complainant.

Furthermore, the Panel has also relied upon the Discussions & Findings in several WIPO Administrative Panel Decisions, inter alia:

- Swarovski Aktiengesellschaft v. Phily Helen (Case No. D2012-1208)
- Aozora Bank, Ltd. v. Hirofumi Nishioka (Case No. D2012-1221)
- VKR Holding A/S v. Stephen Batchelder (Case No. D2012-1226)
- Colgate-Palmolive Company v. DomainJet, Inc., Jack Sun (Case No. D2012-1274)
- C & J Clark International Limited v. Imogen Danzi (Case No. D2012-1280)

- Olayan Investments Company v. Janice Carver (Case No. D2012-0212)
- Karen Millen Fashions Limited v. Kally (Case No. D2012-0215)
- Roche Products Limited v. RLS Holding (Case No. D2012-0217)
- Kienbaum Consultants International GmbH v. Peter Pankovic (Case No. D2012-0222)
- Wm Morrison Supermarkets Plc v. Gavin Marriott (Case No. D2012-0225)

8. 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 Respondent has no legitimate interest in the Disputed Domain Name.
- iii. The Disputed Domain Name is identical to the Complainant's trademark/names and registered domain names.
- iv. The Respondent is making mala fide use of the Complainant's trade marks/names.
- 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 Name to the Complainant, as prayed for within 48 hours of receipt of this decision by email or it being uploaded onto the DNDRC website www.dndrc.com/cases_resolved/, whichever takes place earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Ms. Fozia Umar

Sole Panelist

Date: 15th August, 2012