

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

TCS E.COM (PRIVATE) LIMITED vs BLUE SKY INTERNATIONAL

Case No. C2017-0006

Also in PDF C2017-0006

1. The Parties

The Complainant is TCS E.COM (Private) Limited having its office at 101-104, Civil Aviation Club Road, Jinnah International Airport, Karachi 75202 Pakistan. The Complainant has initiated the Complaint vide their authorized representatives, Ms. Julie Ismail, Attorney at Law at Khursheed Khan & Associates, 47 Modern CHS Tipu Sultan Road Karachi 75530 Pakistan.

The Respondent's name is Blue Sky International with its address at Defence View, Phase I, Karachi, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <yayvo.pk>, hereinafter referred to as the Disputed Domain Name. Vide email dated Friday 19 July 2017, PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is Dizyn, 3; Block # 54; PHA D-Type, Islamabad, ICT, Pakistan and its Create Date was 2015-06-09 with an Expire Date of 2019-06-09.

3. Procedural History

DNDRC was informed of the Complaint against the Respondent as per PKNIC - Internet Domain Registration Policy, by notification from the Complainant on 17 July 2017.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 24 July informing the Respondent that if a Response was not received 7 days from the notification, the dispute would be proceeded ex parte. DNDRC awaited the submission by the Complainant of the Complaint as per the prescribed forms also available at

www.dndrc.com/downloads. The Respondent failed to provide a response within the stipulated time period.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), DNDRC appointed Mr. Yasser Latif Hamdani as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules.

Factual Background

The domain name upon which the Complaint is based is <yayvo.pk>.

PKNIC has confirmed via their email dated 19th July 2017 that the Disputed Domain Name has been registered by the Respondent named in the Complaint and that their email address is dizyn1@gmail.com.

4. Parties Contentions

A. Complainant

The Complainant provides:

Complainant is a member of well renowned TCS Group (a leading courier and logistics group of companies established in 1983 in Pakistan) and owns the e-commerce divisions YAYVO.COM and SENTIMENTS EXPRESS as its main business lines within the TCS Group, offering unique customer experiences for online shoppers, as well as walk-in customers at over 750+ TCS Express Centers nationwide. These divisions are backed by the reliable system of logistics owned by TCS Group. Annexed hereto and marked Annexure "E" is a copy of the TCS Group's corporate profile.

The complainant officially launched the online marketplace YAYVO.COM through the website www.yayvo.com on 1 September 2015 (the "YAYVO Website"). Annexed hereto and marked Annexure "F" contains copies of a random selection of articles which appeared in leading local newspapers and media forums relating to the launch of YAYVO Website in September 2015. The YAYVO Website offers more shopping convenience to online shoppers in Pakistan and around the world. The YAYVO Website offers a wide range of leading local and global brands, including electronic gadgets, mobile phones, fashion apparel for men and women, home décor and lifestyle goods, books, edible items and much more. Every product on the YAYVO Website is original, and is packed and shipped with an official warranty, backed by the TCS Group's delivery promise. The "YAYVO" brand has since been one of the core brands of the complainant and acquired substantial reputation and goodwill.

The brand “YAYVO” was chosen by the founders of TCS Group prior to the launch of YAYVO Website in 2015. Annexed hereto and marked Annexure “G” is a copy of the WHOIS record for the complainant’s principal domain name “yayvo.com”, which was created on 1 October 2014.

The YAYVO.COM marketplace is available as a website as well as a mobile device application on major mobile applications platforms, such as iOS and Android (collectively, the “YAYVO Marketplace”). By way of example, as at January 2017, there have been 50,000 plus downloads of the application for Android.

The YAYVO Marketplace has become increasingly popular in Pakistan and as per the market intelligence available with the complainant, the YAYVO Marketplace is now established as No. 2 e-commerce website in Pakistan after Daraz.pk. Furthermore, the nationwide strength of TCS Group’s logistics network has provided the YAYVO Marketplace an edge over other competitors in the industry.

As at January 2017, the YAYVO Marketplace has had listings for over 140 thousand products in 15 major product categories such as women’s fashion, men’s fashion, mobiles and tablets, beauty and grooming, soghaat, books, computing, school and education, entertainment, appliances, home and living, kids and baby, health and sports, superstore, and others. Annexed hereto and marked Annexure “H” contains sample excerpts extracted from the YAYVO Website.

The complainant has been able to generate substantial revenues through operating the YAYVO Marketplace. During the first financial year 2015-2016 alone, the YAYVO Marketplace generated over Rs. 175 million in revenue and it is anticipated that those revenues will triple by the year 2017.

The country-wide reputation of the complainant’s YAYVO trade mark has been enhanced and reinforced through extensive and innovative advertising and promotional support. Since the launch of YAYVO Marketplace, the complainant has expended significant time, resources and effort in advertising, promoting sales and marketing the YAYVO trade mark, and as a result, it has acquired substantial reputation and goodwill in the YAYVO trade mark. In this connection, the complainant regularly conducts promotion and sales events, as well as seasonal sales for the promotion and marketing of the YAYVO Marketplace. Also, there is significant online presence on the social media in relation to the complainant’s “YAYVO” trade mark and the YAYVO Marketplace. The complainant hosts various websites such as Facebook page, Twitter and Instagram accounts, YouTube channel, Pinterest account and a blog at <http://yayvo.com/blog/> for promoting businesses under the complainant’s trade mark and the YAYVO Marketplace which have generated

extensive fame and reputation among the complainant's customers and other Internet users.

The complainant has also conducted extensive online and offline marketing including, via advertisements in newspapers, on television, radio, Internet, billboards in all major cities in Pakistan, a morning show in collaboration with PTV News, re-branding of TCS courier vehicles with "YAYVO" insignia. In addition, the "YAYVO" brand is also prominently displayed on the facade of the complainant's office building located at Khayaban-e-Ittehad in DHA, Karachi. Annexed hereto and marked Annexure "I" contains copies or photographs of sample advertisements relating to the YAYVO trade mark.

In addition to the common law rights acquired and enjoyed by the complainant over the YAYVO trade mark through its extensive use, marketing and high quality of services and products, the complainant has also taken active steps to secure registration of the YAYVO trade mark. In particular, the complainant owns following registrations as well as pending applications for the YAYVO trade mark, in a variety of forms, in respect of a wide range of services and products in Pakistan, since at least as early as 25 May 2015.

The Complainant's main contentions are reproduced below:

- A. The Disputed Domain Name is confusingly similar to the mark Yayvo, in which Complainant has rights;*
- B. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and*
- C. The Disputed Domain Name has been registered and is being used in bad faith.*

Therefore, the Complainant seeks the following remedy:

In accordance with ICANN Policy, paragraph 4(i), and PKNIC - Internet Domain Registration Policy, paragraph 4, for the reasons described in paragraphs 7 and 8 above, the complainant requests the Administrative Panel appointed in this proceeding to issue a decision that the disputed domain name "yayvo.pk" be transferred to the complainant.

B. Respondent

The Respondent has not submitted any response to DNDRC.

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

5. 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 these regulations, 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.

6. Discussion and Findings

In the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website (http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf), the Panel laid down the following four heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy, dated 07-Aug-2007, version 4.2 and the UDRP:

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 mark 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 decision of the dispute shall be addressed with respect to the following aspects:

- 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 of the Application & Registration

The PKNIC - Internet Domain Registration Policy Aug-07-2007 version 4.2 states that it creates an exception for, and thus excludes the registration of a domain name that:

- a. *infringes upon a registered tradename,*
- b. *is not bona fide as recognized by international best practice,*
- c. *in the opinion of PKNIC, 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.*

As per the PKNIC - Internet Domain Registration Policy Aug-07-2007, version 4.2,

If a party claims that a domain name already registered with PKNIC violates their registered tradename, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is a contravention 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, PKNIC reserves 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 purpose of assessing illegality, unlawfulness or otherwise invalidity of the Application & Registration of the Disputed Domain Name, the application and registration of the Disputed Domain Name shall be assessed in consideration of the following criteria:

- 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, 1860 (the "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 stated:

“YAYVO” is a unique brand name and an invented word, made up by combining two arbitrary words of Urdu language “Yay” and “Vo” which if loosely translated to English, would mean “This” and “That” respectively. The mark as a whole does not convey any particular meaning. The complainant’s trade mark has been used in different forms which does not alter the overall identity of the mark (the “YAYVO trade mark”)...

It is inevitable that through the complainant’s extensive use, publicity and several trade mark registrations/ applications in Pakistan, as well as high quality of services and products offered under the YAYVO trade mark, the complainant’s YAYVO trade mark has become distinctive of and is exclusively identifiable with the complainant’s services and products alone. The said trade mark has as such, enjoyed and continues to enjoy substantial reputation throughout Pakistan. Thus, the complainant has extensive proprietary rights and overwhelming goodwill in the YAYVO trade mark country-wide, and it would be just and proper for this Panel to protect the same.

The National Arbitration Forum in its decision dated 8 December 2009 in the case of Yarnmarket Inc. v. yarndexforyarn (Claim Number: FA0910001288402) held that “Traditionally, a registration of mark with the USPTO warrants a finding of established rights in a mark. However, the registration of the <yarndexforyarn.com> domain name antedates the filing date of Complainant’s YARNDEX mark. Under Policy ¶ 4(a)(i) registration of a trademark is not necessary to establish that Complainant has rights in the mark. See McCarthy on Trademarks and Unfair Competition, § 25:74.2 (4th ed. 2002) (The ICANN dispute resolution policy is “broad in scope” in that “the reference to a trademark or service mark „in which the complainant has rights’ means that ownership of a registered mark is not required—unregistered or common law trademark or service mark rights will suffice” to support a domain name complaint under the Policy); see also Great Plains Metromall, LLC v. Creach, FA 97044 (Nat. Arb. Forum May 18, 2001) (“The Policy does not require that a trademark be registered by a governmental authority for such rights to exist.”)” (see Annexure “K”).

Further, and without prejudice to the aforesaid, the grant of registration for the complainant’s various trade mark applications for “YAYVO” brand by the Pakistan Trade Marks Registry (within whose jurisdiction the respondent is based) is prima facie evidence of the validity of the YAYVO trade mark, of the complainant’s ownership of the said trade mark, and of the complainant’s exclusive right to use the said trade mark in commerce for or in connection with the services and/or goods specified in the applications/registrations. The respondent is neither affiliated with nor authorised by the complainant to use the said trade mark (including any variation thereof).

The Complainant has included in the Complaint a list of different marks which have been registered in Pakistan in different classes including the word “YAYVO”, as well as different logo representations of “YAYVO” and “YAYVO.COM” and has also annexed scanned copies of registrations issued by the Pakistan Trade Marks Registry.

The Respondent has not provided any information whatsoever with respect to the Disputed Domain Name and as such, no data is available to the Panel to consider on the part of the Respondent.

It is apparent that the Disputed Domain Name incorporates in its entirety the registered trademarks of the Complainant “YAYVO” which have been registered in several different classes. Thus the Disputed Domain Name infringes upon and is an obvious derivation of a registered trade name/trade mark of the Complainant.

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.

Hence, the Panel may well determine, on this criteria alone, that the Disputed Domain Name should 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 sub-issues as identified above.

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

The Complainant contends that the Disputed Domain Name resolves to a direct competitor of the Complainant which has resulted in the misdirection of customers and potential customers from the website of the Complainant to that of a direct competitor. Moreover, the Complainant has submitted that the Respondent has attempted to sell the Disputed Domain Name to the Complainant for USD 12,000, which in the view of the Panel is well in excess of the out-of-pocket costs with respect to the Domain Name. This suggests that the registration of the Disputed Domain Name by the Respondent was not bona fide. Thus, the Panel finds that the registration of the Disputed Domain Name by the Respondent was not bona fide.

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

Prior to discussing this sub-issue, it is pertinent to clarify the grounds for examining relevant Pakistani law provisions. Although Pakistani law does not apply by force of law over PKNIC’s

jurisdiction, by operation of the PKNIC- Internet Domain Registration Policy Aug 07, 2007 version 4.2, it is necessary to examine provisions of the Penal Code and other applicable criminal laws. It is in this spirit and for this purpose alone that the following provisions of Pakistani law are being analyzed. The ordinances, and the sections mentioned herein below, have been discussed at length in *Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001)*.

Trade Marks Ordinance, 2001

40. Infringement of registered trade mark.-

(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without consent of the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.

4. Domain name not to be misleading as to character or significance.- *(1) A domain name shall not be registered if the public is liable to mislead as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a domain name.*

Electronic Transactions Ordinance, 2002 (“ETO”)

3. Legal recognition of electronic forms.—

No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness.”

Penal Code

Of Trade, Property and Other Marks

478. Trade mark.

A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this Code the expression “trade mark” includes any trade mark which is registered in the register of trade marks kept under the Trade Marks Act, 1940 (V of 1940)

Upon a study of the above-quoted sections of the Trade Marks Ordinance, 2001 and the Penal Code, the Panel is of the view that the infringement of Trade Marks and Trade Names have been equated with domain names under Pakistani law. Therefore, the provisions of the Penal Code dealing with Trade Mark infringement appear to apply to domain names.

Moreover, according to Section 3 of the ETO, all material, instruments that would otherwise be in writing or in physical form, if generated or made available in electronic form would attract the provisions of the same sections of the Penal Code or any other applicable law had the material been in physical, written or in printed form. The Penal Code, therefore, by the operation of Section 3 of ETO, equally applies to transactions, publications or materials including the use of any trade mark or trade name made available in any electronic form on the internet through the use of a domain name.

By continuing the registration of the Disputed Domain Name by a person who is other than the owner, holder or authorized user of the trade mark or trade name, the registrant would be an aider, abettor, encourager and co-conspirator and also liable to criminal offences.

479. Property mark.

A mark used for denoting that movable property belongs to a particular person is called a property mark.

480. Using a false trade mark.

Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.

As such, if a person other than the owner, rightful holder or authorized user of the trade mark or trade name uses the Disputed Domain Name, if possibly linked to any service or goods, it may constitute an offence under the Penal Code.

481. Using a false property mark.

Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.

482. Punishment for using a false trade-mark or property mark.

Whoever uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.

As decided in *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001), the use of a false property mark (which includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages) with the reasonable

expectation that people would be misled to believe that the trade mark or trade name or domain name belongs to a person to whom it does not belong may also constitute an offence under the Penal Code.

The Panel, therefore, is of the view that the Respondent's registration of the Disputed Domain Name which appears to infringe the trademark(s) of the Complainant may attract the above-mentioned provisions of the Trade Marks Ordinance, 2001, Penal Code and ETO. The Panel may decide this Complaint on this basis alone. However, for the sake of completeness and procedural fairness, but not to create a binding precedent, 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 to a trademark or service mark in which the Complainant has rights

The Complainant has contended the following:

The National Arbitration Forum in its decision dated 22 December 2011 in the case of Google Inc. v. Goldberg Client Services, Inc. (Claim Number: FA1111001414431) held that "The threshold consideration of confusing similarity is determined at the level of the involved trademark and the involved disputed domain name and is determined by way of a simple comparison of the two. For purpose of making the comparison, generic top-level domain identifiers and minor variations, such as the addition or subtraction of a single character, are ignored.". See Islewoth Land Co., v. Lost in Space, SA, FA 117330 (Nat. Arb. Forum Sept. 27, 2002) ("[I]t is a well-established principle that generic top-level domains are irrelevant when conducting a policy ¶4(a)(i) analysis.")" (see Annexure "L"). See also Google Inc. v. Youtube.PK, Case No. C2012-0004 (DNDRC) (finding that the youtube.pk domain name is confusingly similar to the complainant's YOUTUBE mark because the addition of suffix ".pk" to the complainant's mark does not negate the confusingly similar aspect of the domain name, which is an obvious derivation and as such, infringement of the complainant's registered trade mark).

The disputed domain name "YAYVO.PK" consists of the complainant's trade mark "YAYVO" in its entirety followed by the country code top-level domain (ccTLD) ".PK". It will be noted that the additional feature '.PK' in the disputed domain name is a geographical identifier representing Pakistan and a necessary element of all Internet country code top-level domains registered in Pakistan and hence, its use is insignificant as a source identifier. Furthermore, its addition to the word "YAYVO" (which is the complainant's well known trade mark) is in fact suggestive of the complainant's business operations in Pakistan. Moreover, since the complainant is engaged in Internet-based

businesses and offers online shopping and retail services falling inter alia in class 35 via the YAYVO Website at www.yayvo.com and the YAYVO Marketplace, the adoption, use and/or registration of the disputed domain name consisting of the term “YAYVO.PK” in relation to the same or similar services has a direct and obvious relationship to the complainant’s business and its unauthorised use will inevitably confuse and misdirect Internet users to the respondent’s domain name, website or business. In other words, the term ‘.PK’ clearly relates to the complainant’s Internet-based businesses in Pakistan and as such, the addition of the said feature does not reduce but indeed enhances the identity or confusing similarity of the disputed domain name with the complainant’s YAYVO trade mark.

As mentioned above, the respondent is using the “yayvo.pk” domain name, which is identical and as such, confusingly similar to the complainant’s prior registered and well known YAYVO trade mark, to redirect the same to a competitor’s website which sells or offers for sale services and products identical or similar to those offered under the complainant’s mark. Such use disrupts the complainant’s business and constitutes bad faith registration and use pursuant to ICANN UDRP ¶ 4(b)(iii). In this connection, reliance is placed on Lance Lambros v. William Brown, FA0310000198963 (Nat. Arb. Forum November 19, 2003) (finding that the respondent registered a domain name primarily to disrupt its competitor when it sold similar goods as those offered by the complainant) (see Annexure “V”); also, see Vapor Blast Mfg Co. v. R & S Technologies, Inc., FA0102000096577 (Nat. Arb. Forum Feb. 27, 2001) (finding that the respondent’s commercial use of a confusingly similar domain name suggests that the respondent lacks rights or legitimate interests in the disputed domain name) (see Annexure “W”).

Clearly, the respondent is using a confusingly similar copy of the well known YAYVO trade mark to divert the customers of complainant to its competitor’s website, thus creating a likelihood of confusion as to the source, sponsorship, affiliation and endorsement of its website.

On the other hand, the Respondent has not provided any information, and has not refuted the contention put forth by the Complainant with respect to its trademark.

Based on the information provided by the Complainant, it appears to the Panel that the Disputed Domain Name incorporates in its entirety the entirety of the trademark belonging to the Complainant. It is a settled principle that incorporation of a mark in its entirety in a domain name is sufficient for the purposes of establishing confusing similarity. It is also a well-established principle that the mere addition of a gTLD suffix “.com” or its equivalent (e.g. .com.pk) is not relevant to the consideration of confusing similarity as it is an integral part of a domain name. This is also supported by precedents submitted by the Complainant.

The Panel is unable to infer that the Respondent is commonly known by the Disputed Domain Name in the absence of any response provided by the Respondent. The Panel therefore finds confusing similarity between the Disputed Domain Name and the Complainant's trademark under paragraph 4(a)(i) of the Policy.

III. Legitimate interests in a domain name

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

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

Paragraph 4(a)(ii) states that:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Complainant has contended:

The respondent, Blue Sky International, has no connection whatsoever with the name “YAYVO”, nor any variant thereof. In other cases in which the respondent has claimed that it is commonly known by a particular name, it has been held that the respondent “must provide adequate extrinsic proof that a corresponding group of consumers, e.g. Internet users, who are likely to access that party's web site, associates that domain name with that party rather than with the trade mark owner...” See Peter Frampton vs. Frampton Enterprises, Inc., WIPO D2002-0141 (April 17, 2002) and cases cited therein (see Annexure “Q”).

Respondent will not be able to provide this proof. Furthermore, the complainant asserts that its allegations of illegitimacy combined with the respondent's bad faith conduct are sufficient to demonstrate a lack of respondent's rights. In a similar case involving

complainant Cable News Network (“CNN”), the panel therein held that “[i]t is beyond any credibility to consider the Respondent’s adoption of the term ‘CNN’ or the trade name ‘CHANNEL NEWS NETWORK’, given the existence of the Complainant’s CNN Mark and its trade name ‘CABLE NEWS NETWORK’ to be simply coincidental. It was not.” Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al., FA0208000117876 (Nat. Arb. Forum December 16, 2002). The said panel went on to acknowledge the “heavy burden that would be placed on complainants if, in support of their cases of illegitimacy, each of those complainants were to be impressed with a burden of providing detailed proof of any lack of rights or legitimate interests on behalf of their respondents.” Id. (see Annexure “R”)

Here, the complainant has full rights to the YAYVO trade mark, the respondent in all likelihood has no rights or legitimate interest in relation to the disputed domain name.

Moreover, given the distinctive nature of the complainant’s YAYVO trade mark, its prior domain name registration for “yayvo.com” and several trade mark registrations/applications comprising or consisting of the word “YAYVO”, along with the complainant’s country-wide fame and repute, it would be nearly impossible for the respondent ever to claim to be “commonly known by” the name “YAYVO” or any derivative of the YAYVO trade mark. Thus, UDRP Policy ¶ 4(c)(ii) is inapplicable to the respondent. In this connection, the complainant refers to the earlier decisions by various panels, namely, Nike, Inc. v. B. B. de Boer, D2000-1397 (WIPO December 21, 2000) (“finding no rights or legitimate interests where one “would be hard pressed to find a person who may show a right or legitimate interest” in a domain name containing Complainant’s distinct and famous NIKE trademark) (see Annexure “S”); Compagnie de Saint Gobain v. Com-Union Corp, D2000-0020 (WIPO March 14, 2000) (finding no rights or legitimate interest where Respondent was not commonly known by the mark and never applied for a license or permission from Complainant to use the trademarked name) (see Annexure “T”); Dell Inc. v. Harry Ron, FA1309001518221 (Nat. Arb. Forum October 2, 2013) (finding that a complainant’s contention that the respondent had no permission to use the mark contained in the disputed domain name tends to support a finding that the respondent is not commonly known by the domain name at issue) (see Annexure “U”).

On the other hand, the Respondent has not provided any information, and has not refuted the contention put forth by the Complainant with respect to the Respondent not having any legitimate interest in the Disputed Domain Name.

The Panel finds that the Respondent does not appear to have any connection with the name YAYVO or the Disputed Domain name. Moreover, the registered mark of the Disputed Domain

Name, YAYVO, is a distinctive mark and is difficult to envisage, particularly given that no response has been received from the Respondent, that the Respondent is “commonly known by” the name “YAYVO” or any derivative of the name “YAYVO”. The Complaint has also provided considerable evidence of the popularity of the Complainant’s trademarks within Pakistan since its registration in 2015. Moreover, the Panel has no evidence that the Respondent had undertaken demonstrable preparations to use the Disputed Domain Name, or are commonly known by the Disputed Domain Name, or are making legitimate noncommercial or fair use of the Disputed Domain Name.

In the absence of any information provided by the Respondent in support of his legitimate interest in the Disputed Domain Name, the Panel based on the information provided by the Complainant finds that the Respondent does not have rights or a legitimate interest in the Disputed Domain Names pursuant to paragraph 4(a)(ii) of the Policy.

Registration and use in bad faith

The Complainant has made the following submission:

The disputed domain name redirects the user to the online shopping website www.daraz.pk, which is a direct competitor of the complainant and offers exactly the same services and products as those of the complainant. Annexed hereto and marked Annexure “M” is a printout from Redirect Detective tool showing the full redirect path of the URL yayvo.pk, which ends at the complainant’s competitor website www.daraz.pk. Also annexed hereto and marked Annexure “N” contains sample excerpts extracted from the Daraz.pk website.

Such use, at its core, generates commercial gain for the respondent and/or its associate and third-party beneficiary, Daraz.pk, by intentionally and misleadingly diverting users (both customers and potential customers) away from patronizing the complainant’s site to patronizing the Daraz.pk website. Confusion is likely to result from a consumer perception of an apparent relationship, affiliation or connection between the complainant and the respondent and/or Daraz.pk when in fact no such relationship, affiliation or connection exists. This, in turn, clearly tarnishes the complainant’s mark. Such use, while commercial in nature, is certainly not bona fide within the meaning of paragraph 4(c)(i) of the ICANN UDRP as well as the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2, and hence is illegitimate. See, e.g., item Industrietchnik GmbH v. Kevin Caulfield, WIPO Case No. D2015-0725 (finding that the Respondent’s registration and use of the disputed domain name for redirecting Internet users, including customers and potential customers of the Complainant, to the website of a company which directly competes with the Complainant, constitutes bad faith registration and use) (see Annexure

“O”). Also, see, along these lines, *Pakistan Herald Publications (Pvt.) Ltd. v. Ask4Solutions*, DNDRC Case No. C2011-0005, and *Google Inc. v. Youtube.PK*, DNDRC Case No. C2012-0004.

The complainant’s YAYVO trade mark is well known throughout Pakistan, and a substantial reputation subsists and has for many years subsisted in respect of the said trade mark of the complainant on account of substantial use and advertising of the said trade mark throughout Pakistan. Therefore, and given the repute and distinctive character of the complainant’s YAYVO trade mark, the unauthorised adoption, domain name registration and use by the respondent of the disputed domain name (which is identical and as such, confusingly and deceptively similar to the complainant’s YAYVO trade mark) in respect of competing services and/or products also causes dilution of the complainant’s well known YAYVO trade mark.

*The respondent has also attempted to sell the disputed domain name to the complainant for a sum of US \$12,000, which the complainant believes far exceeds the respondent’s out of pocket costs. It is therefore evident that the respondent registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (or one of complainant’s competitors). As a rule, a respondent’s general offer to sell a disputed domain name for an excess of out-of-pocket costs is evidence of bad faith under ICANN UDRP as well as the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2. See *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, WIPO Case No. D99-0001 (finding that the respondent used the domain name in bad faith because he offered to sell the domain name for valuable consideration in excess of any out-of-pocket costs) (see Annexure “P”). Also, see *Google Inc. v. Youtube.PK*, DNDRC Case No. C2012-0004.*

Clearly, the subsequent adoption, domain name registration and use of the disputed domain name by the respondent is without the complainant’s permission, consent, authorisation or license. The complainant believes that the respondent has deliberately and intentionally adopted the disputed domain name to disrupt the complainant’s business. It is inevitable, that the disputed domain name is nearly identical and is deceptively and confusingly similar to the complainant’s prior registered and well known YAYVO trade mark. Such conduct of the respondent is illegal, unfair, unjustified, and clearly, takes advantage on the complainant’s prior established goodwill and reputation. Such adoption is without due cause and is not only likely to give the respondent and its associate or third-party beneficiary Daraz.pk an unfair advantage, but also calculated to cause damage to the complainant by way of loss of business, reputation and goodwill and dilution of its well known trade mark. The conduct of the respondent as aforesaid

constitutes the actionable wrongs of infringement, passing off and unfair competition under the provisions of Trade Marks Ordinance 2001 in Pakistan.

The Respondent has not provided any information or evidence to demonstrate lack of bad faith with respect to registration and use of the Disputed Domain Name.

It is an established principle that the use of a domain name for redirecting customers or potential customers of a person having legitimate interest in a domain name to the website of a direct competitor constitutes bad faith registration and use of that domain name. The Complainant has contended that the Disputed Domain Name resolves to a direct competitor of the Complainant which is misdirecting customers and potential customers from patronizing the website of the Complainant to that of a direct competitor. Moreover, the Complainant has submitted that the Respondent has attempted to sell the Disputed Domain Name to the Complainant for USD 12,000, which in the view of the Panel is well in excess of the out-of-pocket costs with respect to the Domain Name. This in itself evidences “bad faith” for the purposes of the Policy.

In the absence of any response from the Respondent, the Panel infers that the Complainant has provided sufficient information in support of the contention that the Disputed Domain Names were registered and used in bad faith by the Respondent. The Panel thus finds that the registration and use of the Disputed Domain Names by the Respondent was in bad faith.

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 the following WIPO Administrative Panel Decisions in addition to those mentioned in the decision:

- Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Universal City Studios, Inc., supra
- CBS Broadcasting, Inc. v. Gaddoor Saidi, WIPO Case No. D2000-0243,
- Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525
- Nokia Group v. Mr. Giannattasio Mario, WIPO Case No. D2002-0782
- The Ritz Hotel Ltd v. Damir Kruzicevic, WIPO Case No. D2005-1137
- Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge, WIPO Case No. D2006-1643

- NB Trademarks, Inc. v. Domain Privacy LTD and Abadaba S.A., WIPO Case No. D2008-1984
- The South African Football Association (SAFA) v. Fairfield Tours (Pty) Ltd, WIPO Case No. D2009-0998

7. Decision

Analyzing the details provided by the Complainant, the Panel perceives that the “YAYVO” mark has been registered by the Complainant, hence the Complainant reserves crucial interest in such mark. Usage of these marks by the Respondent could endanger the reputation that the Complainant has worked hard at building and maintaining and result in confusion as to the registrant of the Disputed Domain Name.

Taking all of the case law and discussion above into consideration, the Panel concludes and decides that:

1. The Respondent’s registration of the Disputed Domain Name is contrary to the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2
2. The Respondent has no legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Name is identical to the Complainant’s trademark/names and registered domain names.
4. The Disputed Domain Name was registered and being used in bad faith.

Pursuant to Section 4 of the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2, and Section (i) of the Policy, the Panel therefore recommends that PKNIC transfer the registration of the domain name in dispute <yayvo.pk>, as prayed within 48 hours of receipt of this decision by email or its being uploaded on to DNDRC’s website www.dndrc.com/cases_resolved/, whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Yasser Latif Hamdani

Sole Panelist

Date: 14 August 2017