

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

**Arbitration and Mediation Center**

**COMPLAINT PANEL DECISION**

**Erreà Sport S.p.A. vs Fox-tech Computer Center**

**Case No. C2017-0008**

**Also in PDF C2017-0008**

**1. The Parties**

The Complainant is Erreà Sport S.p.A., having its office at Via G. di Vittorio 2/1, Frazione San Polo 43056 - Torrile (Parma), Italy. The Complainant has initiated the Complaint vide their authorized representative, Mrs. Sana Shaikh Fikree, Vellani & Vellani Advocates, 148, 18th East Street. Phase I, Defence Officers' Housing Authority, Karachi-75500.

The Respondent's name is Fox-tech Computer Center with its address at Khadim Ali Road, Sialkot, Pakistan.

**2. The Domain Names and Registrar**

The domain name in dispute is <errea.pk>, hereinafter referred to as the Disputed Domain Name. Vide email dated Tuesday 26 September 2017, PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is FOX-TECH COMPUTER CENTER, Khadim Ali Road, Sialkot, Pakistan and its Create Date was 2017-01-13 and its Expire Date was 2019-01-13.

**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 Friday 8 September 2017.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 26 September 2017 informing the Respondent that if a Response was not received 10 days from the notification, the dispute would be proceeded ex parte. DNDRC

awaited the submission by the Respondent of the Response as per the prescribed forms also available at [www.dndrc.com/downloads](http://www.dndrc.com/downloads). The Respondent did not file a Response.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Mr. Abbas Lotia 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 <errea.pk>.

PKNIC has confirmed via their email dated 26 September 2017 that the Disputed Domain Name has been registered by the Respondent named in the Complaint and that their email address is [foxtech786@gmail.com](mailto:foxtech786@gmail.com)

## **4. Parties Contentions**

### **A. Complainant**

The Complainant provides:

*The Complainant and its affiliated companies are world famous designers, manufacturers and/or sellers of a diverse range of technical-athletic apparel and accessories, all of which are sold under or by reference to the ERREA Trade Marks.*

*The Complainant was founded in Italy in the year 1988 by its current president, Mr. Angelo Gandolfi. Mr. Angelo Gandolfi, with his considerable experience as a professional soccer player and a manager of a soccer team and his keen attention to details, produced the first ERREA brand technical apparel in '1988. In a short time ERREA Trade Marks were seen on a number of sports clubs. From junior leagues to some of the most famous and respected clubs in Italy and around the world, from basketball to soccer, to volleyball, rugby and other sports, who chose the Complainant as their technical partner Attached hereto and collectively marked as Exhibit 8 are copies of the pages downloaded from the Complainant's website, <http://en.errea.com/> containing the historical background of their business. Also attached hereto and collectively marked as Exhibit 9 are copies of Complainant's product brochures and catalogues showing use of the ERREA Trade Marks in relation to Complainant's business and products.*

*A variety of the ERREA Trade Marks have since 1988 been and continue to be used extensively in many countries throughout the world, by the Complainant and its affiliated companies. The Complainant believes that, between 1988 and 2016, the Complainant has generated many millions of Euros in revenue from sale of technical-athletic apparel and accessories bearing the ERREA Trade Marks during that period. In 2016, the total worldwide operating revenue of the Complainant was approximately Euros 52,706,043. Furthermore, the Complainant spent about Euros 789,386 on advertising and promotional activities in connection with the ERREA Trade Marks in 2016. Attached hereto as Exhibit 10 is the statement signed by the principal officer of the Complainant which includes a breakdown of the sales of technical-athletic apparel and accessories bearing the ERREA Trade Marks and the advertising expenditure incurred by the Complainant in connection with the ERREA Trade Marks between 2008 and 2016.*

*The growth of the Complainant's business worldwide has been significant and impressive. The Complainant's technical-athletic apparel and accessories bearing the ERREA Trade Marks are currently available at and from 2,000 retail stores in more than 80 countries around the world. As of 15 June 2017, there are over 1,500 retail stores operating in Europe and over 10 retail stores and resellers operating in the United States of America, including, South America, and, in general, thousands of stores/resellers in over 30 different countries around the world, including, a number of the retail stores in the Middle East countries, Asian countries and African countries, all selling ERREA brand technical-athletic apparel and accessories. Attached hereto as Exhibit 11 is a list of countries in which the Complainant's technical-athletic apparel and accessories are being sold under the ERREA Trade Marks. Attached hereto as Exhibit 12 are copies of invoices showing sales made by the Complainant of its technical-athletic apparel and accessories to the above referenced retail stores, and all such invoices clearly and prominently display the ERREA Trade Marks, particularly, the ERREA logo.*

*The Complainant extended its international market directly towards Pakistan. Since 2011, the Complainant has outsourced the production of its technical-athletic apparel and accessories bearing the ERREA Trade Marks to a Sialkot based company, Talon Sports (Private) Limited. Since 2011, the turnover of ERREA brand technical-athletic apparel and accessories produced in Pakistan is as follows:*

<i>Years</i>	<i>Turnover in Pakistan in Euros</i>
<i>2013</i>	<i>more than 200,000</i>
<i>2014</i>	<i>more than 250,000</i>
<i>2015</i>	<i>more than 650,000</i>
<i>2016</i>	<i>more than 700,000</i>

*Attached hereto as **Exhibit 13** is the statement signed by the principal officer of the Complainant which includes a breakdown of the volumes of technical-athletic apparel*

*and accessories produced in Pakistan by Talon Sports (Private) Limited for the Complainant. Attached hereto as Exhibit 14 are copies of invoices issued by Talon Sports (Private) Limited to the Complainant showing production and supply of technical athletic apparel and accessories to the Complainant.*

*The Complainant has expended significant time, resources and efforts and millions of Euros in advertising, promoting and establishing the goodwill of the ERREA Trade Marks in relation to technical-athletic apparel and accessories. In recent years, Complainant has advertised its ERREA Trade Marks in newspapers and magazines and other media. Copies of a random selection of such advertisements which were published during 1996 to 2016 are attached hereto as Exhibit 15.*

- In the past 30 years, the Complainant has grown unrestrained and has achieved a number of milestones, some of which are briefly discussed below:*
- In 1994, the Complainant became the official team wear partner for Middleborough FC [a professional association football club based in Middleborough, North Yorkshire, England].*
- During 1993 - 1995, the Complainant participated in some of the sector's major trade fairs both in Italy and abroad, boosting its brand awareness and visibility.*
- In 2005, the Complainant launched the 30 wear line on the market, a special technical-underwear range designed to help and improve athletic performance through its seamless technology and more innovative yarns.*
- In 2007, the Complainant became the first company in Europe operating in the sportswear sector to obtain Oeko-Tex Certification. This certification ensures that all the Complainant's products do not release those harmful or carcinogenic substances that, given their low cost, are often used by other fabric manufacturers.*

*Kindly refer to Exhibit 8 which includes pages downloaded from the Complainant's website containing the historical background of the Complainant wherein the above mentioned milestones have been listed and discussed.*

*The Complainant has sponsored some of the most prestigious teams/players participating in some of the most significant sports events around the world, ranging from FIFA World Cup to FIA Formula One World Championship. In the recent past, the Complainant sponsored the official team wear for the football team of UAE participating in the AFC Asian Cup held in Qatar. List of the abovementioned sponsorships of the Complainant is attached hereto as Exhibit 16.*

*Apart from the common law rights enjoyed by the Complainant in the ERREA Trade Marks, the Complainant has actively obtained registrations for the ERREA Trade Marks in various countries around the world [see Exhibits 5, 6 and 7]. The first registration of the trade mark ERREA SPORT was obtained in 1988 in Italy. In Pakistan, the registrations for the ERREA Logo dates back to 27 March 1999. The ERREA Trade Marks mentioned above clearly antedate the registration or any use of the Disputed Domain Name and are in full force and effect. The Complainant therefore has the prima facie exclusive prior right to use the ERREA Trade Marks throughout the world and at the very least throughout Pakistan, in connection with its registered products and in connection with associated marketing and promotional activities such as in domain names and its websites.*

*Each of the ERREA Trade Marks contains the feature "ERREA" as the principal element of the mark and/or design. Furthermore, the feature "ERREA" forms an essential part of the trade name of the Complainant, Errea Sport S.p.A., and of a number of other related companies of the Complainant, including, Errea Sport Brasil, with registered office at Av Vereador Toaldo Tulia 81/01, Santa Felicidade Curitiba (Brasil) and Errea sport u.s.a. Inc., with registered office at 535, Madison Avenue, 4th Floor, New York, USA.*

*In addition, Complainant owns numerous domain names containing the feature "Errea" and the combination "ErreaSports". A list of the abovementioned domain names along with the ownership details as downloaded from the Internet are attached hereto as Exhibit 17.*

*The Complainant is thus the exclusive proprietor of the valuable rights enjoyed by it in respect of the ERREA Trade Marks, in a number of countries around the world, including Pakistan, and, as such, the use of the ERREA Trade Marks or any of them or any variation by any company or person in those countries, including a Pakistani company or person, without the permission, consent or license of the Complainant is bound to be dishonest and only motivated by an attempt to deceive or confuse the public into believing that such company or person's business and the associated services and/or products are related to or associated with the Complainant in some or the other manner. Further, such use will constitute infringement of the exclusive rights vested in the Complainant as aforesaid.*

*The Respondent, without permission or authorization from the Complainant, has on 13th January 2017 secured a domain name registration for "errea.pk" (that is, the Disputed Domain Name under the subject complaint) [see Exhibit 1], which consists of nothing more than the Complainant's ERREA trade mark in its entirety.*

*The Disputed Domain Name is linked to a website. [www.errea.pk](http://www.errea.pk), which website displays information with regard to an entity trading under the infringing name, Errea Sports, allegedly located at 620/5 Street No 1, Prem Nagar, Sialkot 51310, Pakistan and*

*allegedly engaged in the manufacturing and marketing of sportswear. In the recent past, the Complainant has been informed by its distributors (based in Australia and UK) that a Pakistani entity allegedly trading under the name and style, Errea Sports, has approached them via emails for a potential business arrangement with them with regard to the production and supply of sportswear. Copies of the emails sent by Errea Sports (based in Sialkot) to the Complainant's distributors are attached hereto as Exhibit 18. In this regard, rest assured that the Complainant will be taking all possible actions against the Sialkot based entity, Errea Sports, to prevent infringement of its registered rights in the name and trade mark ERREA in Pakistan.*

*The Complainant discovered, firstly, the domain name "erreasports. corn" and, secondly, after having received the emails from the Sialkot based entity, Errea Sports, [see Exhibit 18), the Complainant discovered the Disputed Domain Name. While the first domain name is registered in the name of Rizwan Ghafoor of Errea Sports with GODADDY.COtv1, LLC, the later one (that is, the Disputed Domain Name) is registered in the name of the Respondent. Complaints are being filed by the Complainant against the registration of both domain names, respectively in front of WIPO and in front of DNDRC.*

*The Respondent is holding the domain name registration for "errea.pk" [see Exhibit 1] and the corresponding email address such as, info@errea.pk and the website, vwww.errea.pk, which email address and website (as it appears) are being used for the benefit of the infringing company, Errea Sports, allegedly engaged in the manufacturing and marketing of sportswear under the infringing name and mark ERREA, without any permission or authorisation from the Complainant, all of which infringe the exclusive rights vested in the Complainant in respect of the ERREA Trade Marks and further mislead the general public, including the Internet users in Pakistan and elsewhere, and cause them into believing that the Disputed Domain Name and corresponding email address and website mentioned above are authorised or controlled by the Complainant or persons having a business connection with the Complainant, which is not the case.*

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 paragraph 8 above, Complainant requests the Administrative Panel appointed in this administrative proceeding to issue a decision that the Domain Name "errea.pk" be transferred to 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](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:

*The facts and evidence provided in paragraphs 7 and 8(i) to (xii) above clearly demonstrate that the name ERREA and ERREA Trade Marks or any of them are the exclusive property of the Complainant, who has the prima facie prior registered right to use the name ERREA and EEREA Trade Marks in relation to inter a/ia sportswear and related accessories throughout the world, including in Pakistan.*

*The Disputed Domain Name consists of the component ERREA, which is the registered trade mark of the Complainant in Pakistan and forms the principal element of the trade name of the Complainant and its related companies and of the various domain names owned and registered by the Complainant and/or its related companies. The Disputed Domain Name in fact consists of nothing more than the Complainant's name and trade mark ERREA in its entirety.*

The Complainant has included in the Complaint a list of Trademarks which have been registered in various countries included in Pakistan in different classes including the word “ERREA”, and has also annexed scanned copies of registrations including those issued by the Pakistan Trade Marks Registry.

The Respondent has not provided any information whatsoever with respect to the Disputed Domain Name including any information about any trademarks held by the Respondent relating to the word “ERREA”, 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 “ERREA”. Given this, it appears that 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 has submitted:

*The Respondent, without permission or authorization from the Complainant, has on 13th January 2017 secured a domain name registration for "errea.pk" (that is, the Disputed Domain Name under the subject complaint) [see Exhibit 1], which consists of nothing more than the Complainant's ERREA trade mark in its entirety.*

*The Disputed Domain Name is linked to a website. [www.errea.pk](http://www.errea.pk), which website displays information with regard to an entity trading under the infringing name Errea Sports, allegedly located at 620/5 Street No 1, Prem Nagar, Sialkot 51310, Pakistan and allegedly engaged in the manufacturing and marketing of sportswear. In the recent past, the Complainant has been informed by its distributors (based in Australia and UK) that a Pakistani entity allegedly trading under the name and style, Errea Sports, has approached them via emails for a potential business arrangement with them with regard to the production and supply of sportswear.*

*The Respondent is holding the domain name registration for "errea.pk" [see Exhibit 1] and the corresponding email address such as, [info@errea.pk](mailto:info@errea.pk) and the website, [www.errea.pk](http://www.errea.pk), which email address and website (as it appears) are being used for the benefit of the infringing company, Errea Sports, allegedly engaged in the manufacturing and marketing of sportswear under the infringing name and mark ERREA, without any permission or authorization from the Complainant, all of which infringe the exclusive rights vested in the Complainant in respect of the ERREA Trade Marks and further mislead the general public, including the Internet users in Pakistan and elsewhere, and cause them into believing that the Disputed Domain Name and corresponding email address and website mentioned above are authorized or controlled by the Complainant or persons having a business connection with the Complainant, which is not the case.*

It appears that the Respondent has very recently registered the Disputed Domain Name in its name. The Complainant has provided detailed information including documents showing that the

Disputed Domain Name is being used by the Respondent for a purpose similar to the business of the Complainant. In addition, the Complainant has submitted that the “ERREA” mark is well-known and thus it appears unlikely to the Panel that the Respondent would not be aware of this at the time of registration of the Disputed Domain Name.

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 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 facts and evidence provided in paragraphs 7 and 8(i) to (xii) above clearly demonstrate that the name ERREA and ERREA Trade Marks or any of them are the exclusive property of the Complainant, who has the prima facie prior registered right to use the name ERREA and*

*EEREA Trade Marks in relation to inter alia sportswear and related accessories throughout the world, including in Pakistan.*

*The Disputed Domain Name consists of the component ERREA, which is the registered trade mark of the Complainant in Pakistan and forms the principal element of the trade name of the Complainant and its related companies and of the various domain names owned and registered by the Complainant and/or its related companies. The Disputed Domain Name in fact consists of nothing more than the Complainant's name and trade mark ERREA in its entirety.*

*As stated by the WIPO Panel in Dr. Ing. H.c.F. Porsche AG v. Vasiliy Terkin (Case No. 02003-0888, dated 6 January 2004 - copy attached as Exhibit 19), a domain name that wholly incorporates a complainant's registered trade mark is sufficient to establish confusingly similarity. The addition of the suffix/ccTLO ".PK" is an irrelevant distinction based on the findings of the WIPO Panel in the following cases, namely: 8/C Deutsch/and GmbH & Co KG v. Paul Tweed (WIPO Case No. 02000-0418, dated 20 June 2000; Zwiesel Krista/lg/as AG v. WWW Enterprise Inc. (Case No. 02005-1223, dated 23 January 2006); LG Chemical Ltd v. ChangHwan, OH (Case No.02000-0889, dated 25 September 2000); and Rosemary Conley Diet and Fitness Clubs Limited v. Nikolina Bartels-King (Case No. D2006-1401, dated 18 January 2007). Copies of these cases are attached hereto as Exhibit 20*

*Furthermore, in this regard, Complainant relies on the analysis and findings of the DNDRC Panel in Standard Chartered PLC v. Hosting Campus Domain (Case No. C2007-0001, dated 30 August 2007), Pakistan Herald Publications (Private) Limited. v. Averroes Sapertise Management, Case No. C2011-0001, dated 30 March 2011 and Google Inc. v. Starcom Systems, Case No. C2013-0004, dated 27 September 2013. Copies of these cases are attached hereto as Exhibit 21.*

*Based on the above, there can be no doubt that the Disputed Domain Name is identical*

*and/or confusingly similar to the ERREA Trade Marks in which the Complainant has prior exclusive rights.*

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.

### **III. Legitimate interests in a domain name**

The Complainant has contended:

*Pursuant to ICANN Policy, sub-paragraph 4(c), a respondent may show rights in the domain name by its (1) use or preparations to use the domain name in connection with a bona fide offering of goods or services prior to notice of the dispute; (2) being commonly known by the domain name; or (3) legitimate non-commercial or fair use.*

*The Respondent fails on all counts as discussed below:*

*The Respondent's Disputed Domain Name is redirected to a website, which website promotes the infringing business activities of Errea Sports Sialkot. The Complainant has neither authorized nor licensed the Respondent to register the Disputed Domain Name and/or to use, or facilitate the use of, the Disputed Domain Name in relation to the offending website. The Respondent and/or Errea Sports, Sialkot, have no affiliation with the Complainant or any of its related companies.*

*The Complainant further believes that the Respondent has never been known by the Disputed Domain Name nor has it ever been known by the ERREA Trade Marks or any other name containing the word ERREA. Thus, Respondent has not registered the Disputed Domain Name to make a bona fide offering of any goods or services. The Respondent has misappropriated the ERREA Trade Marks owned by Complainant. Respondent is clearly not making a non-commercial, fair use of the Disputed Domain Name. Through the use of the Domain Name (which consists of the Complainant's famous trade mark ERREA) the Respondent is intentionally attempting, or abetting, to attract the general public including Complainant's customers and the Internet users to the corresponding website (which website promotes the infringing business activities of the infringing company, Errea Sports, Sialkot), by creating a likelihood of confusion with the ERREA Trade Marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's Disputed Domain Name and the corresponding website. As a result, Respondent's use cannot constitute a fair, non-commercial use.*

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 Disputed Domain name and does not have any connection to the well-known and registered mark of the Complainant “ERREA”. The Complainant has not provided any license or other form of authorization to the Respondent to register or use the Disputed Domain Name. The Complainant has submitted information in support of its contention that the Respondent is attempting to abstract the general public including customers of the Complainant to the website corresponding to the Disputed Domain Name which is resulting in substantial confusion for users of the internet and customers of the Complainant in particular. Thus the Panel also finds that the use of the Disputed Domain Name also does not constitute fair, non-commercial use.

Moreover, 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.

#### **IV. Registration and use in bad faith**

The Complainant has made the following submission:

*Sub-paragraph 4(b)(ii) of the ICANN Policy allows for a finding of bad faith when the registration was acquired to prevent a trade mark owner from reflecting the mark in a corresponding domain name. When Respondent acquired the Disputed Domain Name, it had constructive knowledge of the ERREA Trade Marks via the Complainant's trade mark registrations in Pakistan (as well as in numerous other countries around the world); and must have had actual knowledge that the ERREA Trade Marks were used in relation to sportswear and related accessories for years prior to its registration, due to the fame of the ERREA Trade Marks and particularly, due to the availability of ERREA brand sportswear in Sialkot, Pakistan. Notwithstanding this knowledge and complete lack of authorization, Respondent intentionally registered the Disputed Domain Name containing the famous ERREA trade mark, without authorization, for use in relation to a website (which website is used to promote the infringing business activities of Errea Sports, Sialkot) and corresponding email addresses. As stated by the WIPO Panel in Kraft Foods (Norway) v. Fredrik Wide and Japp Fredrik Wide (Case No. 02000-0911,*

*dated 23 September 2000 - copy attached as Exhibit 22), the fact "that the Respondent chose to register a well-known mark to which he has no connections or rights indicates that he was in bad faith when registering the domain name at issue".*

*ICANN Policy, sub-paragraph 4(b)(iii), allows a finding of bad faith if the registration is primarily for the purpose of disrupting the business of a competitor. Respondent's action in registering the Disputed Domain Name is likely to deprive the Complainant of "the chance to be contacted by prospective customers" - see SGS Societe Generale de Surveillance S.A. v. Inspectorate (WIPO Case No. D2000-0025, dated 17 March 2000 - copy attached as Exhibit 23); especially since the Disputed Domain Name and the corresponding website (which website promotes the infringing business activities of Errea Sports, Sialkot) and the corresponding email addresses would pass off as a legitimate, authorized website and email addresses of the Complainant in Pakistan. As noted, neither the Respondent nor Errea Sports, Sialkot, are authorized licensees of the Complainant. Furthermore, a customer who checks a "whois" database may adopt the mistaken belief that Respondent has an affiliation with the Complainant or its licensees based on its registration of a domain name and the corresponding email addresses and website that contains the EEREA name or mark.*

*ICANN Policy, sub-paragraph 4(b)(iv), furthermore allows a finding of bad faith where the respondent intentionally attempts to attract, for commercial gain, Internet users to its 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 the web site. The VVIPO Panel in Red Bull GmbH v. Harold Gutch (Case No. 02000- 0766, dated 21 September 2000 - copy attached as Exhibit 24), found that the use of the domain name by respondent therein would lead visitors to the belief that the domain name was affiliated with the complainant. therefore making the registration alone equal to use in bad faith. In sum, Respondent's registration and use of the Disputed Domain Name has been in bad faith.*

*Furthermore, given the Complainant's prior established goodwill and proprietary rights in the ERREA Trade Marks, the registration of the Disputed Domain Name by the Respondent is clearly in bad faith with an attempt to misappropriate and cash on and to trade unfairly upon the reputation and goodwill enjoyed by the Complainant.*

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.

The use of the Disputed Domain Name by the Respondent for a similar line of business suggests the existence of bad faith by the Respondent who only recently registered the Disputed Domain Name despite the popularity of the “ERREA” mark.

Moreover, the Complainant has submitted that in the recent past, the Complainant has been informed by its distributors (based in Australia and UK) that a Pakistani entity allegedly trading under the name and style, Errea Sports, has approached them via emails for a potential business arrangement with them with regard to the production and supply of sportswear. The Complainant has provided information that suggests that the Disputed Domain Name was being used for the benefit of Errea Sports. This in the view of the Panel suggests that the Respondent was well-aware of the “ERREA” mark at the time of registration of the Disputed Domain Name. Thus registration of the Disputed Domain Name in itself evidences “bad faith” for the purposes of the Policy.

In the absence of any response from the Respondent, the Panel 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.

**7. Decision**

Analyzing the details provided by the Complainant, the Panel perceives that the “ERREA” trademark has been registered by the Complainant in various countries including Pakistan, hence the Complainant reserves crucial interest in such mark. Usage of this mark 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/name and registered domain name.
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 <errea.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/](http://www.dndrc.com/cases_resolved/), whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

**Arbitrator: Mr. Abbas Lotia**

**Sole Panelist**

**Date: 20<sup>th</sup> October 2017**