

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. 2024-0014

Also in PDF C2024-0014

1. The Parties

The Complainant is e.l.f. Cosmetics, Inc., having its office at 570 10th Street, Oakland, California 94607, United States of America. The Complainant has initiated the Complaint vide their authorized representatives, Mohammad Fazil Bharucha, Abdul Aziz, Tayseer Fazil Bharucha, Qamar Uddin, Farzana Rustom and Saira Osman Bhatti of Bharucha & Co., Intellectual Property Attorneys, with their address at F-7/1, Block 8, KDA Scheme 5, Kehkashan Clifton, Karachi – 75600, Pakistan.

The Respondent's name is Talha Baweja with their address at 7th Floor, Regent Plaza, Main Sharah-e-Faisal, Karachi, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <elfcosmetics.pk>, hereinafter referred to as the Disputed Domain Name [“the DDN”]. Vide email dated 10 July 2024, PKNIC has informed DNDRC that the DDN is registered by Talha Baweja with the contact name Talha Baweja, with their address at 7th Floor, Regent Plaza, Main Sharah-e-Faisal, Karachi, Pakistan.

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 10 July 2024 after which DNDRC completed its compliance review.

The Respondent was issued a notification of the dispute along with a copy of the Complaint and a Response Form on 26 October 2024 informing the Respondent that if a Response was not received 10 days from the notification, the dispute would be proceeded ex parte. The Respondent submitted a response on 02 November 2024.

DNDRC provided the Response Form to the Complainant on 05 November 2024 after which the Complainant submitted a rejoinder on 27 November 2024

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Mr. Willayat Ali Shah 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 <elfcosmetics.pk>.

PKNIC has confirmed via their email dated 20 October 2024 that the DDN was registered by the Respondent above-named and that the email address provided at the time of registration of the DDN is tbaweja@gmail.com.

4. Parties Contentions

1. Complainant

The Complainant's brief contentions are reproduced below:

1. *That the Complainant was founded in 2004 by makeup artist Joey Shamah and beauty expert Scott Vincent Borba. Since its foundation, the Complainant has made the best of beauty accessible to every eye, hip and face so that everyone can own their beauty without compromise.*
2. *Over the years, the Complainant has grown into an international cosmetics brand offering over 1000 beauty products worldwide. The Complainant stays true to its commitment and consistently provides trending, viral, and award-winning makeup and skincare products and stays on top of said new trends and the customers always find instant access to all the must-have products that are not only worth the hype, but are also affordable.*
3. *The Complainant's mission is to inspire and empower individuals around the world to express their unique beauty and strive to create high-quality and innovative products that are accessible to everyone. All the Complainants formulas are 100% vegan and all skin care is also free from sulfates.*
4. *That the Complainant, in order to protect its rights and interests under the trademark "e.l.f." has obtained registrations and applied for registration of the said "e.l.f." trademark and its variations including "e.l.f. Eyes Lips Face", "e.l.f. Skin" and many more in classes 3, 5, 8, 16, 18, 20, 21, 35 and 42 in many countries worldwide. The said trademarks are also*

registered as International trademark and European Union Trade Mark (EUTM). The earliest registration of "e.l.f." trademark dates back to 2003 in United States of America, the Complainants home country.

In Pakistan trademarks "e.l.f." and "e.l.f. Eyes Lips Face" (hereinafter referred as e.l.f." trademarks) are registered/pending in classes 3, 8, 21 and 35. The details of which are given below:

Regn/ No.	App.	Trademark	Class	Status
555929		E.L.F.	3	Registered
555919		E.L.F.	8	Registered
555920		E.L.F.	21	Registered
555925		E.L.F.	35	Published
555926		E.L.F. EYES LIPS FACE	3	Registered
555914		E.L.F. EYES LIPS FACE	8	Registered
555918		E.L.F. EYES LIPS FACE	21	Registered
555916		E.L.F. EYES LIPS FACE	35	Registration fee paid

The said registrations are valid and in force.

5. That the Complainant regards its trademarks as valuable assets that it seeks to maintain and protect.
6. That the Complainants "e.l.f." trademarks are widely and extensively used worldwide in the field of cosmetics.
7. That the Complainant has spent substantial amounts to promote its "e.l.f." trademarks throughout the world. As a result, people in almost all major areas of the world including Pakistan recognize and associate the said trademarks and the products bearing said trademarks with the Complainant and/or its affiliates, licensees, etc. and the said trademarks enjoy tremendous reputation and goodwill. Thereby, the said trademarks of the Complainant have become synonymous with its name and whenever and wherever, the said trademarks are referred to in relation to any good/service, the same has reference to the goods/services of the Complainants and nobody else's.

8. *That in addition to having a physical presence in the marketplace, the Complainant and the “e.l.f.” trademarks also have, an online presence where, they are easily accessible by the general public. The Complainant owns the official website www.elfcosmetics.com. The said website is also accessible to people belonging to all walks of life residing in Pakistan or in any other country.*
9. *The Complainant being the prior adopter, owner and user of the “e.l.f.” trademarks has a strong reputation and goodwill, which has rendered its products/services to gain popularity globally. The Complainants products/services showcase impeccable quality and thus it has a loyal customer base. In view of the Complainants vast presence globally, the consumers relate the said trademarks to it and as such the said trademarks have become well known marks, which are protected under the Trade Marks law in Pakistan, without requiring the use or registration of said marks in Pakistan.*
10. *That the Complainants trademark “e.l.f.” is also an integral part of its corporate name “e.l.f. Cosmetics, Inc”. Thus, the Complainants business name and trademarks are synonymous to each other.*
11. *That the Complainant came to know in late 2023 that the Respondent has adopted www.elfcosmeties.pk containing the Complainant's registered trademark “e.l.f.” as its domain name, without the permission or authorization from the Complainant. which is identical to the Complainants domain name www.elfcosmetics.com and got it registered. The word “elf” in disputed domain name is not only the Complainants registered trademark but is also the main feature of the Complainants domain name www.elfcosmetics.com and trade name “e.l.f. Cosmetics, Inc.”. The Respondent is also using the word “elf” on the products displayed/sold on its said website. Furthermore. the website also features the Complainants registered “e.l.f.” trademarks and copyrighted images including the Complainants stylized logo “e.l.f. Eyes Lips Face”.*

A copy of the Domain record for elfcosmeties.pk and website images are attached herewith as "Exhibits C and CI"

12. *The Complainant sent a legal notice dated February 9, 2024 to the Respondent for the cessation of such activities which violate the proprietary rights and interests of the Complainant. The Respondent through its legal representative sent a reply dated February 20, 2024 to the said legal notice, accepting the use of Complainant's trademark by it and requiring the Complainant to supply copies of Registration Certificates in respect of its “e.l.f.” trademarks. The Complainant sent a reply dated April 24, 2024 along with copies of Registration Certificates of the same. Upon receiving no reply from the Respondent, the*

Complainant sent a follow-up letter dated May 11, 2024, to which the Respondent has till date failed to respond and continues to infringe the proprietary rights of the Complainant.

Copies of Legal Notice dated February 9, 2024, Respondent's reply dated February 20, 2024, Complainant's reply and follow-up letter dated April 24, 2024 and May 11, 2024 respectively, courier and postal receipts and tracking reports are attached herewith as Exhibits D to D/10".

13. *The website featured on the Disputed Domain Name. by using the Complainants well-known and registered "e.l.f." trademarks and copyrighted images and contents therein, gives a false impression to the general public that the Respondent has some association or arrangement with the Complainant or its goods/services in Pakistan, which is not true. Furthermore, the general public is deceived into believing that the Respondents goods/services are offered by, managed, licensed or connected in some manner to the Complainant.*
14. *The use of domain name infringes the exclusive rights vested in the Complainant in respect of its e.l.f. trademarks and further misleads the general public, including the Internet users in Pakistan and elsewhere. leading them to believe that the Disputed Domain Name and the website mentioned above are authorized and/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 light of the cogent reasons submitted above and pursuant to the ICANN Policy, paragraph 4(i), and the PKNIC Internet Domain Registration Policy, paragraph 4. the Complainant requests the Administrative Panel in the instant matter to deregister/cancel the infringing Disputed Domain Name registration "**www.elfcosmetics.pk**" and/or transfer the same to the Complainant.*

15. Respondent

The Respondent makes the following submissions:

1. *The contents of Para 1 of the Complaint are denied for want of knowledge.*
2. *The contents of Para 2 of the Complaint are denied for want of knowledge.*
3. *The contents of Para 3 of the Complaint are denied for want of knowledge.*

4. *The contents of Para 4 of the Complaint are denied for want of knowledge. The onus lies on the Complainant to show proof of the claimed registration(s) in their favor with the Intellectual Property Organization (IPO) of Pakistan, for which the Complainant has failed to provide any supporting/attested document to the Respondent. It is submitted that in reply to the legal notice served by the Complainant to the Respondent, the Complainant had sought clarity and documentary evidence showing trademark registration of the Complainant in the classes as stated, however no such communication was received by the Respondent raising a presumption to the contrary.*
5. *The contents of Para 5 are formal in nature and merit no response, however are denied for want of knowledge.*
6. *The contents of Para 6 are formal in nature and merit no response, however are denied for want of knowledge.*
7. *The contents of Para 7 are denied for want of knowledge.*
8. *The contents of Para 8 are denied for want of knowledge.*
9. *The contents of Para 9 are denied for want of knowledge.*
10. *The contents of Para 10 are denied for want of knowledge.*
11. *The contents of Para 11 are partially admitted to the extent that the Respondent is the registered user of the domain name elfcosmetics.pk. However, the reason for adopting this domain name, was premised on the reselling model of our client, fully disclosed to all customers, of products manufactured by e.l.f. Cosmetics. The Respondent was never aware, neither credible and irrefutable evidence of such domain name being trademark protected, has been in knowledge of, or shared with the Respondent. Without prejudice nevertheless, even in such case which the Complainant must establish through sharing of proof to that effect, the Respondent reiterates that the use of such domain name does not constitute any*

infringement, concealment or misrepresentation on part of the Respondent, since the reselling model of the Respondent is fully disclosed to all customers. As such, Respondent is operating in the market place as an online retailer seller of e.l.f. Cosmetics products without claiming any association or dealership with the company, or claiming such products to be his own. The Complainant is put to strict proof to show how the Respondent's reselling model of e.l.f. products in Pakistan, without any express or implied representation of any connection with the Complainant, causes confusion and deception, dilutes any goodwill or constitutes any infringement of intellectual property rights.

12. *The contents of Para 12 are partially admitted to the extent that the Complainant sent a legal notice dated Feb 09 2024 which was replied in detail and on basis of interalia, the same contentions as raised herein. It is specifically denied that the Respondent admitted to using the Complainant's trademark, but accepted the use of the above domain name to resell products with full disclosure of the origin company and claiming no association with the same. Nevertheless, as stated in the Complaint, the Respondent sought proof of registration with the relevant IPO office in Pakistan, and all content stated therein was subject to such proof being furnished. It is categorically denied that any such replies furnishing proof of registration were served at the office of the Respondent or any follow up thereto was received, which if received would have been responded. As such, due to no such reply being received, the Respondent entertained a bonafide assumption that all issues raised by the Complainant in the legal notice were resolved and satisfied, till the filing of this Complaint.*
13. *The contents of Para 13 are vehemently denied and the Complainant is put to strict proof to show how the Respondent's reselling model of e.l.f. products in Pakistan, without any express or implied representation of any connection with the Complainant, causes confusion and deception, dilutes any goodwill or constitutes any infringement of intellectual property rights. The contents of the previous paras as restated and reiterated which may for the sake of brevity be deemed to form an integral part hereof. It suffices to state that the reselling model of the Respondent is fully disclosed to all customers and the Respondent has never in any mode or manner claimed any association with the Company raising no questions of misrepresentation or deception.*

14. *The contents of Para 14 are vehemently denied and the Complainant is put to strict proof to show how the Respondent's reselling model of e.l.f. products in Pakistan, without any express or implied representation of any connection with the Complainant, causes confusion and deception, dilutes any goodwill or constitutes any infringement of intellectual property rights. The contents of the previous paras as restated and reiterated which may for the sake of brevity be deemed to form an integral part hereof. It suffices to state that the reselling model of the Respondent is fully disclosed to all customers and the Respondent has never in any mode or manner claimed any association with the Company raising no questions of misrepresentation or deception.*

The Respondent seeks the following remedy:

The instant complaint being devoid of factual and legal grounds and due to the deficiencies highlighted above, and due to no infringement being established, may be dismissed in limine. In the alternative, subject to sharing of relevant evidences as requested herein, the Respondent requests for a detailed hearing allowing the Respondent to put forward his stance, and proof in support thereto especially to the model of his business and his bona fides in carrying out the same.

5. Jurisdiction

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the Internet Domain Registration Policy version 4.4 (2019-08-19) and the Rules.

The Respondent applied for and was granted registration of the DDN on the basis of these regulations, and has submitted to, the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) 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 Internet Domain Registration Policy version 4.4 (2019-08-19) 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 version 4.4 (2019-08-19) 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 version 4.4 (2019-08-19) 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 version 4.4 (2019-08-19),

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, and 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 DDN shall be assessed in consideration of the following criteria:

- i. Whether the DDN infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the DDN is bona fide?
- iii. Whether the application and/or registration of the DDN contravenes the Pakistan Penal Code, 1860 (the "Penal Code") or any applicable criminal law?

The Complainant has made the following submissions:

15. *The Disputed Domain Name contains the registered trademark "e.l.f." of the Complainant and as such its use without the consent of the Complainant amounts to infringement of the Complainants said "e.l.f." trademarks within the meaning of Section 40 (6) of the Trade Marks Ordinance, 2001.*
16. *It is submitted that the provisions of the Trade Marks Ordinance, 2001 are fully applicable to the case of domain names by the operation of Section 84(2) thereof.*
18. *Furthermore, the Disputed Domain Name is in violation of several provisions of Pakistani criminal law viz. Sections 480, 481, 482 and 486 of the Pakistan Penal Code, which preclude any unauthorized use of another's trademark.*
19. *Moreover, the registration of the Disputed Domain Name amounts to Spoofing, which is an offense under Section 23 of the Prevention of Electronic Crimes Act, 2016.*
22. *The Disputed Domain Name vis-à-vis the Respondent is in contravention of the Policy Agreement (as per the domain registration form) and the PKNIC Internet Domain Registration Policy, as amended, which has been incorporated by reference into the PKNIC Policy Agreement.*

The Respondent has made the following submissions:

1. *The contents of 15 are denied. The reliance on Section 40(6) of the Trade Marks Ordinance, 2001 (hereafter "Ordinance") is unfounded since the said section is only applicable to cases where a person acquires or uses a registered trademark as his domain name "with the intention of selling such domain name to another including the proprietor of the registered*

trade mark". No such allegation, of the Respondent intending to sell the domain name to any other person of the proprietor of the mark has been raised as such the relevant section is inapplicable hereto. In the instant case, the use of the domain name was bona fide and only to indicate the reselling model of the Respondent, for which also, the Complainant have yet to share proof of registration of the Trademark in such name failing which the ground will not arise at all, let alone fail at the stage of qualification.

2. *The contents of Para 16 are denied. Section 84 of the Trade Marks Ordinance, 2001 is not an independent charging provision, but merely a defining section highlighting the scope of applicability of the Ordinance to domain name. The exact prerequisite of such applicability is provided in Section 40(6) of the Ordinance which as stated above, is not applicable to the case at hand. Hence the reliance of the said section is baseless and devoid of any merit.*
4. *The contents of Para 18 are vehemently denied and the Complainant is put to strict proof thereof. Pakistan Penal Code, 1860 provides the substantive criminal law of Pakistan, the contours of whose applicability are very narrow and subject generally to a strict showing of mens rea. Without prejudice however, the relevant sections as stated in the para under reply deal with a completely different situation, where counterfeit goods are packaged with a false trademark to deceive the public. The relevant sections as a matter of example would only be applicable where Respondent would manufacture his own product, and package them under elf branding to sell them to unsuspecting members of public by showing that the same have been manufactured by elf, and not where products manufacture by elf are simply resold with complete disclosure as to the origin of such products. As such, by no stretch, the relevant sections are applicable to the matter at hand, and the reliance therein is completely misplaced.*
5. *The contents of Para 19 are vehemently denied and the Complainant is put to strict proof thereof. The use of the qualifying words, with dishonest intention at the very beginning of Section 23 of the Prevention of Electronic Crimes Act, 2016 which deals with 'spoofing' lays down the strict showing of mens rea as the basic prerequisite to the applicability of this section. This qualification is further stressed by use of words 'intended to be believed by the recipient or visitor of the website, to be an authentic source' in the said provision, and makes it non-applicable to the instant case where the reselling model of the Respondent is fully disclosed to the customers who visit and buy products from the Respondent's website.*
8. *The contents of Para 22 are denied and the Complainant is put to strict proof to refer to the specific clause of the PKNIC Registration policy/agreement that has been contravened. Without prejudice, the same shall first be subject to furnishing of credible proof of registration of trademark with the IPO Office, since as per Clause 7 of the PKNIC Policy, any claim to trade name or copyright under .PK domain name is considered valid only if it*

is registered with an official trade-name/copyright/patent office in Pakistan, or is recognized by the courts of law in Pakistan. The Respondent awaits sharing of such proof.

The Panel has reviewed the submissions of the Parties:

The Panel initially notes the sufficiency of proving that the DDN is infringing on the registered trademark of the Complainant for the purposes of satisfying this criterion. The Complainant contends that the DDN elfcosmetics.pk is infringing on the registered trademark “e.l.f.” therefore the Panel needs to evaluate whether the DDN is in contravention of the Trademarks Ordinance, 2001.

The Respondent denies the allegations and claims that its use of DDN clearly demonstrated that the Respondent was a reseller of the Complainant’s products.

It is important to address that the DDN being registered as trademark would mean that their unauthorized use in the DDN constitutes infringement. Moreover, it is also notable that the Panel only recognizes and considers the infringement of trademark rights strictly with respect to the DDN and not the content that is being displayed on the website. This raises a question as to whether inclusion of another word “cosmetics” along with the registered trademark of the Complainant “E.L.F.” would satisfy the criteria.

The Panel finds that in order for the DDN to infringe the registered trademark rights of the Complainant, the entire DDN needs to be constituted with the said trademark without any inclusion of a generic or a specific word.

In light of the submissions made, the Panel finds it insufficient to declare the infringement of Complainant’s trademark by the DDN. Therefore, the Panel finds it necessary to assess and evaluate each of the three UDRP criteria to determine whether the Complaint can be upheld.

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

The Complainant has made the following submissions:

17. *The Disputed Domain Name is identical to the “e.l.f.” trademark in which the Complainant has rights and is well known. Moreover, the unauthorized use of the Complainant’s “e.l.f.” trademarks and copyrighted images and contents, including the Complainant’s stylised logo “e.l.f. Eyes Lips Face” on the website of the Disputed Domain Name leads towards confusion and deception on the part of the general public and also amounts to infringement of the Complainant’s said “e.l.f.” trademarks under the Trade Marks Ordinance, 2001.*

The Respondent has made the following submissions:

3. *The contents of Para 17 are denied and the Complainant is put to strict proof to show how the Respondent's reselling model of e.l.f. products in Pakistan, without any express or implied representation of any connection with the Complainant, causes confusion and deception, dilutes any goodwill or constitutes any infringement of intellectual property rights. The contents of the previous paras as restated and reiterated which may for the sake of brevity be deemed to form an integral part hereof. It suffices to state that the reselling model of the Respondent is fully disclosed to all customers and the Respondent has never in any mode or manner claimed any association with the Company raising no questions of misrepresentation or deception.*

The Complainant has reiterated its claims in its rejoinder.

The Panel has reviewed the submissions of the Parties:

The Complainant has contended that the DDN is “identical” to their registered trademark which is also evident from the content of the website being operated by the Respondent however, the Panel does not agree with this submission and could not find the DDN to be identical to the Complainant's trademark.

The Respondent has not specifically addressed the contention that the DDN is identical or confusingly similar to the Complainant's registered mark. The Respondent has contended that it fully discloses to its customers that it is a reseller of the Complainant's products. However, for the purposes of assessing this UDRP criteria, the Panel is limited to assessing whether the DDN is identical or confusingly similar to the Complainant's trademark, irrespective of any clarification made by the Respondent on its website.

The Panel notes that the Complainant has proven their rights in the registered trademark “E.L.F.” by providing sufficient evidence of registrations in various classes in Pakistan therefore, the Panel relies on a well-known principle, reiterated in several WIPO cases as well as the previous DNDRC cases, where the inclusion of the registered trademark, in its entirety, into the DDN was sufficient to prove confusing similarity between the DDN and the trademark. (See *Brittania Building Society v Brittania Fraud Prevention* Case No. D2001-0505).

The Panel also observes that the DDN does not include the periods (“.”) present in the Complainant's trademark however concludes that this would not avoid a finding of confusing similarity. This conclusion is based on the principal that periods (“.”) in cannot be used in the DDN except to separate the subdomain (e.g. www), root domain (e.g. elfcosmetics) and the top-level

domain (e.g. com). As the Respondent is inherently unable to incorporate the periods from the Complainant's trademark into the DDN, the absence of these periods does not diminish the overall similarity between the DDN and the Complainant's mark.

Moreover, the Panel acknowledges the principle concerning ccTLD (for e.g., .pk) which finds that the addition of such suffix does not affect the likelihood of confusion as it is necessary requirement for the registration of the domain name itself (See L'Oréal v. Guowei Hai Gui, WIPO Case No. D2011-0775).

Based on the assessment above, the Panel concludes that the DDN is confusingly similar to a trademark in which the Complainant holds rights.

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 made the following submissions:

21. *Consequently, in light of the foregoing, the Respondent has no rights or legitimate interest in the Disputed Domain Name and that the said domain name has been registered with malafide intent and with a view to make unjustified gains by using the Complainants said “e.l.f.” trademarks, which is entirely prejudicial to the interests of the Complainant.*

The Respondent has made the following submissions:

7. *The contents of Para 21 are denied and the Complainant is put to strict proof to show how the Respondent's reselling model of e.l.f. products in Pakistan, without any express or implied representation of any connection with the Complainant, causes confusion and deception, dilutes any goodwill or constitutes any infringement of intellectual property rights. The contents of the previous paras as restated and reiterated which may for the sake of brevity be deemed to form an integral part hereof. It suffices to state that the reselling model of the Respondent is fully disclosed to all customers and the Respondent has never in any mode or manner claimed any association with the Company raising no questions of misrepresentation or deception.*

The Complainant has also submitted a rejoinder, demonstrating the Respondent's awareness with regards to the Complainant's trademark, claiming the Respondent's contention to be merely rhetoric and repetitive.

The Panel has reviewed the submissions of the Parties.

The Panel notes the contention of the Complainant that the Respondent lacks rights in the DDN whereas the Respondent rejects those claims on the basis of them not claiming any association with the Complainant. In order to establish a prima facie case against the Respondent lacking in the DDN, the Complainant merely needs to assert that the Respondent lacks such interest. It is observed that by contending the lack of rights on part of Respondent, the Complainant has established a prima facie case shifting the burden of proof to the Respondent to demonstrate otherwise. (See MicroBilt Corporation v. Greg J Michalko Case No. D2024-2212).

According to the Policy, the Respondent must prove one of the three circumstances as laid under Section 4(a)(ii). For this purpose, the Respondent should establish that they have been using the DDN for bona fide offering of goods or services before the dispute arose or the Respondent is commonly known by the DDN despite the fact that the Respondent has no trademark registered or the Respondent is making legitimate non-commercial use of the DDN.

The contention of the Respondent lies closely with the argument of offering of bonafide goods under the Policy thereby the Panel must assess whether the claim should be upheld.

According to Black's Law Dictionary, "bona fide" means "[i]n or with good faith." The Respondent has agreed that they have not been authorized by the Complainant with respect to using the DDN (which incorporates the Complainant's trademark) and yet the Respondent continues to use the same for offering of trademarked goods, evidencing the finding of bad faith, which also precludes a finding that Respondent was making a "bona fide offering of goods or

services." (See UNIVERSAL CITY STUDIOS, INC. V. G.A.B. ENTERPRISES Case No. D2000-0416)

The Panel considers the Complainant's submissions regarding their trademark rights and determines that the Complainant, rather than the Respondent, is commonly associated with the DDN. Consequently, the Respondent fails to satisfy the second element of the analysis. Furthermore, the Panel notes that the Respondent's express agreement to resell the Complainant's goods, coupled with the finding of confusing similarity, supports the conclusion that the Respondent is not making a legitimate non-commercial use of the DDN.

The Panel therefore finds that the Respondent does not have any legitimate interest in the DDN.

IV. Registration and use in bad faith

The Complainant has made the following submissions:

20. *The Disputed Domain Name was registered and is being used in bad faith, as the use of "e.l.f." trademarks and copyrighted images and contents, including the Complainant's stylised logo "e.l.f. Eyes Lips Face", on the website would suggest that the Respondent is affiliated with or has any connection with the Complainant, which is not the case.*

The Respondent has made the following submissions:

6. *The contents of Para 20 are denied and the Complainant is put to strict proof to show how the Respondent's reselling model of e.l.f. products in Pakistan, without any express or implied representation of any connection with the Complainant, causes confusion and deception, dilutes any goodwill or constitutes any infringement of intellectual property rights. The contents of the previous paras as restated and reiterated which may for the sake of brevity be deemed to form an integral part hereof. It suffices to state that the reselling model of the Respondent is fully disclosed to all customers and the Respondent has never in any mode or manner claimed any association with the Company raising no questions of misrepresentation or deception.*

The Complainant has also submitted a rejoinder, stating that the Respondent's submissions indicate that the Respondent was aware of the Complainant's trademark.

The Panel has reviewed the submissions of the Parties:

To satisfy this criterion, the Complainant is required to prove both that the DDN was registered in bad faith and used in bad faith. For this purpose, the Complainant claims that the Respondent

suggests affiliation or any connection with the Respondent whereas the Respondent relies on them being a reseller and expressly disclosing the lack of affiliation to their customers.

The Panel relies on the Policy and finds that paragraph 4(b) sets out four circumstances out of which any one can be evidence of the registration and use of a domain name in bad faith if established (See *Amazon.com, Inc. v. Wes Mayder, WeDirect, Inc. and Iclicks* Case No. D2003-0258). One of the circumstances laid down include the use of DDN by the respondent to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the complainant's mark.

Since the Panel has already established a likelihood of confusion of the DDN with the Complainant's mark, the Panel finds it difficult to avoid the finding of bad faith on the basis that the Respondent tried to capitalize on the Complainant's reputation and the goodwill by misleading users for commercial benefit without having the proper authorization or approval from the Complainant to use the DDN (See *Fenix International Limited v. Host Master, 1337 Services LLC* Case No. D2023-1050).

The Panel further acknowledges the global recognition of the Complainant's "E.L.F." trademark in relation to its skincare products, given the evidence provided by the Complainant and finds that it is highly unlikely for the Respondent to be unaware of the existence of the mark at the time of the registration of the DDN. This is also evidenced by the fact that the Respondent's sole reason to register the DDN was to resale the Complainant's products, as accepted by the Respondent, thereby making him aware of the existence of the Complainant's trademark. The Panel finds that the defense taken by the Respondent that it disclosed its reselling model to its customers is insufficient in this context.

The failure of the Respondent to obtain authorization to use the Complainant's mark in the DDN further solidifies the position that the DDN was registered and used in bad faith. Moreover, the lack of information or evidence by the Respondent, except the reiteration of them using the DDN for a reselling forum, further infers the use and registration of DDN in bad faith (See *eBay Inc vs Muhammad Akram* Case No. C2018-0009).

The Panel, therefore, finds that the DDN was registered and is being used in bad faith by the Respondent.

7. Decision

The Panel, upon the review of the information provided by the Complainant, recognizes that the "E.L.F." mark is registered to the Complainant and Respondent has no legitimate rights over it. Therefore, the continuous use of the DDN relating to the Complainant's registered trademark could

result in hinderance in exercise of the rights of the Complainant in the trademark and could also jeopardize the reputation of the Complainant by amounting to confusion regarding the ownership of the DDN.

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

1. The Respondent's registration of the DDN does not violate the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19);
2. The DDN is confusingly similar to the registered trademark of the Complainant;
3. The Respondent has no legitimate interest in the DDN;
4. The DDN was registered and is being used in bad faith.

Pursuant to Section 4 of the Policy, the Panel, therefore, recommends that PKNIC transfer the registration of the domain name in dispute < elfcosmetics.pk> to the Complainant, as prayed, within 48 hours of receipt of this decision either by email or through the website where it will be uploaded, www.dndrc.com/cases_resolved/, whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Willayat Ali Shah

Sole Panelist

Date: 10 December 2024