

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. 2025-0003

Also in PDF C2025-0003

1. The Complainant

The Complainant is The Aga Khan University/AKU, having its office at Stadium Road, P.O. Box 3500, Karachi 74800, Pakistan. The Complainant has initiated the Complaint vide their authorized representative Mrs. Sana Shaikh Fikree of Vellani & Vellani Advocates, with their address at 148, 18th East Street, Phase I, Defence Officers' Housing Authority, Karachi-75500, Pakistan.

2. The Domain Name and Respondent

The domain name upon which the Complaint is based is <aku.edu.pk>, hereinafter referred to as the Disputed Domain Name [“the DDN”].

PKNIC has informed DNDRC that the DDN is registered by Asim Ismail, with their address at St 9 A, block 7, Gulshan-e-Iqbal, Karachi and that the email address provided at the time of registration of the DDN is asim_ismail@yahoo.com.

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 October 2024 after which DNDRC completed its compliance review.

DNDRC requested the Respondent’s details from PKNIC to which PKNIC provided the requested details on 12 December 2024.

The Respondent was issued a notification of the dispute along with a copy of the Complaint and a Response Form on 12 December 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 was issued a reminder to file the Response Form on 17 December 2024.

The Respondent submitted the Response Form on 18 December 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

4. Parties Contentions

(a) Complainant

The Complainant's brief contentions are reproduced below:

- (i) *The Complainant is part of Aga Khan Development Network, a group of private international development agencies, founded by His Highness the Aga Khan, which work in the developing countries of Asia and Africa.*
- (ii) *Founded in 1983 as Pakistan's first private university, the Complainant is one of the leading institutions in Pakistan's higher education sector. The Complainant educates thousands of students each year, generates new knowledge to solve problems that affect millions of people, and raises standards and aspirations in the countries in which it works.*
- (iii) *Today, the Complainant is deeply rooted in six countries in Asia, Africa and Europe, namely, Pakistan, Kenya, Tanzania, Uganda, Afghanistan and the United Kingdom.*
- (iv) *Set out below are some of the facts concerning the national and global reach of the Complainant's activities in the relevant sectors and the milestones that have been achieved through sheer hard work and some projects which the Complainant intends to undertake in the upcoming years:*
 - *Complainant is home to 3,600 students and its over 20,000 alumni hold leadership positions in locally and globally renowned institutions from Karachi to New York City.*
 - *With 7 hospitals and 350 outreach health centers, the Complainant cares for more than 2 million patients annually, making it one of the largest private health care providers in Pakistan and East Africa.*
 - *In recent years, the Complainant has been ranked among the leading universities in Asia, Africa and, in some subjects, the world.*

- *From achievements in research and development to quality in academics and healthcare, the Complainant has earned recognition both nationally and internationally.*
- *Over the next half-decade, the Complainant intends to expand its academic offerings, launching close to a dozen new degree programs in fields ranging from data sciences to teacher education.*
- *Complainant intends to build new research capacity in fields, such as, mental health and climate change.*

Attached hereto and collectively marked as Exhibit 6 are copies of the pages downloaded from the Complainant's website, <https://www.aku.edu>, containing the historical details of the Complainant, from its inception till to date. Also attached hereto and collectively marked as Exhibit 7 are copies of press releases published by the Complainant from time to time informing the general public about the milestones achieved and the upcoming projects of the Complainant. Also attached hereto and collectively marked as Exhibit 8 are copies of the pages downloaded from the Complainant's website, <https://www.aku.edu>, containing details of the numerous awards and accolades received by the Complainant. It will be pertinent to note that the Complainant in most occasions has been referred to as "AKU".

- (v) *Since its inception in 1983, Complainant has made extensive use of the name and trademark AKU in relation to educational and healthcare services and associated materials and merchandise. Over the years, Complainant has designed and developed various logos, all featuring the name and trademark AKU substantially and prominently. Attached hereto and collectively marked as Exhibit 9 are images of merchandise, featuring the name and trademark AKU, either alone or in conjunction with other design elements.*
- (vi) *Each of the AKU Trade Marks contains the feature "AKU" as the principal element of the mark and/or design. Furthermore, as mentioned earlier, the feature "AKU" forms an acronym for the corporate name of the Complainant, Aga Khan University.*
- (vii) *Complainant has made extensive use of the AKU Trade Marks, particularly, the combination and trademark AKU, and has advertised the said marks through the Internet, including on its website, <https://www.aku.edu>. The Complainant is also active on various social media platforms, including but not limited to Facebook, X, Instagram, YouTube and LinkedIn, where millions of students and people at large view and benefit from Complainant's content, featuring the AKU Trade Marks, particularly, the combination and trademark AKU. Attached hereto and collectively marked as Exhibit 10*

are copies of the pages downloaded from some of the above-referenced social media platforms.

- (viii) As a result of continuous and extensive use of the AKU Trade Marks, particularly, the combination and trademark AKU, spanning over the past four decades, the general public of Pakistan have come to associate the AKU Trade Marks, and particularly, the combination and trademark AKU, exclusively with Complainant.*
- (ix) Apart from the common law rights enjoyed by the Complainant in respect of the AKU Trade Marks, the Complainant has actively obtained registrations (or made applications) for the AKU Trade Marks in countries, including, but not limited to, Kenya, Tanzania, Uganda and Pakistan [please refer to Exhibits 3, 4 and 5]. The AKU 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 AKU Trade Marks in connection with its registered products and services and in connection with associated marketing and promotional activities, such as, in domain names and its websites.*
- (x) In addition, Complainant owns a domain name containing the feature and trademark “AKU”, namely, aku.edu. Ownership details of the said domain name as downloaded from the Internet are attached hereto as Exhibit 11.*
- (xi) The Complainant is thus the exclusive proprietor of the valuable rights enjoyed by it in respect of the AKU Trade Marks (particularly, the combination and trademark AKU), in a number of countries, including Pakistan, and, as such, the use of the AKU Trade Marks or any of them or any variation by any company or person in those countries, including a Pakistani educational institute or person, without the permission, consent or authorization of the Complainant is bound to be dishonest and only motivated by an attempt to deceive or confuse the public into believing that such institute or person’s business or services 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.*
- (xii) The Respondent, without permission or authorisation from the Complainant, has on 27 July 2024 secured a domain name registration for “aku.edu.pk” (i.e., the Disputed Domain Name) [see Exhibit 1], which consists of nothing more than the Complainant’s name and trademark, AKU, in its entirety.*
- (xiii) The Disputed Domain Name is linked to a website, <https://aku.edu.pk>, which website displays information with regard to Al-Kawthar University, allegedly located at ST-9,*

Block 7, Gulshan-e-Iqbal, Main University Road, Opposite Safari Park, Karachi, and allegedly engaged in the provision of educational services.

- (xiv) In August 2024, the Complainant received a number of enquiries from prospective students and members of the general public with regard to the Disputed Domain Name and the corresponding website, <https://aku.edu.pk>. The Complainant, in order to raise their legitimate concerns and reservations with regard to the above discovery, sent an email dated 13 August 2024 to the Respondent. Attached hereto and marked as Exhibit 12 is the copy of the concerned email by Mr. Mustafa Hussian, Regional Head of the Complainant, to Mr. Amir Butt, Director Marketing of the Respondent.*
- (xv) Thereafter, the Complainant proceeded to send a formal cease-and-desist letter to the Respondent. Attached hereto and marked as Exhibit 13 is the copy of the cease-and-desist letter dated 22 August 2024.*
- (xvi) Thereafter, the Complainant sent copies of the registration certificates pertaining to AKU Trade Marks, vide email dated 23 August 2024. Attached hereto and marked as Exhibit 14 is the copy of the concerned email.*
- (xvii) Respondent sent a response to the Complainant's cease-and-desist letter, referring to the Respondent's discussions with Mr. Mustafa Hussian and asking the Complainant to "provide copyright documentation pertaining to the domain name". In the same letter, it will be pertinent to note that the Respondent has stated as follows:*

Quote

It is important to note that we have made significant investments in our marketing initiatives to establish the brand equity of Al-Kawthar University, with "aku.edu.pk" being a central element of our marketing strategy". As a result, we have observed a substantial increase in traffic to our website and online admission portal further elevating the stakes associated with this domain"

Unquote

Attached hereto and marked as Exhibit 15 is the copy of the Respondent's response letter dated 24 August 2024.

- (xviii) Thereafter, the Complainant entered into discussions with the Respondent wherein the Complainant once again reiterated their concerns and the basis on which the Complainant claims to own rights in respect of the AKU Trade Marks. During such discussions, the Respondent agreed to relinquish use of the Disputed Domain Name. The*

Complainant sent emails dated 29 August 2024 and 2 September 2024 confirming the above agreement. Attached hereto and marked as Exhibit 16 are copies of the referenced emails.

- (xix) Thereafter, Complainant sent another letter to the Respondent, highlighting Complainant's registrations and extensive and continuous (uninterrupted) use of the AKU Trade Marks, and particularly, the combination and trademark AKU, in Pakistan and elsewhere during the past 40 years. As per the above referenced discussions, the Complainant provided an undertaking to the Respondent. Attached hereto and marked as Exhibit 17 is the copy of the Complainant's letter dated 4 September 2024, along with the undertaking printed on a stamp paper.*
- (xx) Thereafter, a number of messages and voice notes were exchanged between Mr. Mustafa Hussian (of Complainant) and Mr. Amir Butt (of Respondent) through WhatsApp on 11 September 2024, wherein the Complainant reminded the Respondent about their agreement to cease use of the Disputed Domain Name. However, Mr. Amir Butt of the Respondent refused to comply with the earlier agreement. Attached and marked as Annexure 18 is the screenshot of the concerned messages.*
- (xxi) Transcript of the voice note sent by Mr. Amir Butt to Mr. Mustafa Hussian, is set out below.*

“Assalam-o-Alaikum, Mustafa Sahab. Hope you are doing well. Sorry, actually, I was busy with my internal meetings previously, so I did not get a chance to talk to you. So, Mustafa Sahab in this connection, in regard to the URL and in regard to the contract which you shared with me. I had a discussion with my legal department, and we had also evaluated your registration of the brand, the document which you shared with me. So we have come to know that this brand registration of AKU does not apply on digital assets. So right now this URL, aku.edu.pk is basically our owner equity. So we can sit together and if you want to buy this domain, so we can talk. Otherwise, this is our ownership and legally there is no implication on us that we leave it. So if you want to buy it, so we can discuss, we can sit together and we can talk. Thank you very much.”

Attached and marked as Annexure 19 is the OGG file containing the downloaded audio of the concerned voice note.

- (xxii) Lastly, the Complainant had a meeting with the Respondent on 20 September 2024, wherein the Respondent once again refused to honor its earlier agreement and reiterated its desire to sell the Disputed Domain Name to the Complainant.*

(xxiii) *Thus, the Respondent is holding the Disputed Domain Name registration [see Exhibit 1] and the corresponding email addresses, such as, info@aku.edu.pk, careers@aku.edu.pk and training@aku.edu.pk, and the website, https://aku.edu.pk, which email addresses and website are being used for the benefit of the Respondent, allegedly engaged in the provision of educational services, without any permission or authorization from the Complainant, all of which infringe the exclusive rights vested in the Complainant in respect of the AKU 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 addresses 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.*

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 “aku.edu.pk” be transferred to Complainant.

(b) Respondent

After thoroughly reviewing the details of the case, we have decided to transition to a different domain, as we believe this approach would be in the best interests of all parties involved.

To ensure a smooth and orderly transition, we request a transactional period of at least one month to migrate our operations and associated services from aku.edu.pk to the new domain. This time frame will help us minimize disruption to our stakeholders and ensure continuity of service.

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 DDN, 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:

(xxv) The unauthorised adoption and registration by the Respondent of the Disputed Domain Name (consisting of the feature AKU, which is exclusively associated with the Complainant and in respect of which Complaint owns extensive proprietary rights in Pakistan and elsewhere) constitute inter alia the actionable wrongs of infringement, passing-off and unfair competition. By such adoption and registration, the Respondent infringes the exclusive rights vested in the Complainant in respect of the AKU Trade Marks or any of them in Pakistan, and also passes off its business, website, domain name and/or email addresses as and for the business, website, domain name and/or email addresses of the Complainant and further unfairly competes with the Complainant's business and/or the AKU Trade Marks or any of them. Moreover, through such registration or use of the Disputed Domain Name, the Respondent intends to mislead the general public, including the Internet users in Pakistan and elsewhere, and to cause them into believing that the Disputed Domain Name, website, email addresses and/or Respondent's business is authorised or controlled by the Complainant or persons having a connection with the Complainant, which is not the case.

(xxvi) *The unauthorised adoption, registration and/or use by the Respondent of the Disputed Domain Name further falls within the prohibition of the provisions of the Trade Marks Ordinance 2001 and the Pakistan Penal Code 1860, including, in particular, sub-section (6) of section 40 of the Trade Marks Ordinance 2001; clause (1) of paragraph 4 of Third Schedule to the Trade Marks Ordinance 2001; and sections 480, 481, 482, 483, 485 and/or 486 of the Pakistan Penal Code 1860. Text of these provisions is attached hereto as Exhibit 26. Furthermore, in this regard, the 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 – copy attached as Exhibit 22).*

(xxvii) *In view of the above, there is no doubt that the Disputed Domain Name and/or the Respondent contravene the provisions of the Policy Agreement and the PKNIC - Internet Domain Registration Policy (attached hereto as Exhibits 27 and 28 respectively), which provide inter alia that:*

- (a) *The applicant for registration of a domain name at the time of making the application expressly represents, agrees and warrants as follows: -*
- *applicant's statements in the application are true and the applicant has the right to use the domain name as requested in the application;*
 - *applicant has a bona fide intention to use the domain name on a regular basis on the Internet;*
 - *the use or registration of the domain name by the applicant does not interfere with or infringe the right of any third party in Pakistan, with respect to trade mark, service mark, trade name, company name or any other intellectual property right; and*
 - *applicant is not seeking to use the domain name for any unlawful purpose, including, without limitation, tortuous interference with contract or prospective business advantage, unfair competition, injuring the reputation of another, or for the purpose of confusing or misleading a person, whether natural or incorporated.*
- (b) *The applicant of a domain name at the time of making the application certifies that, to his or her knowledge, the use of the domain name does not violate trade mark or other statutes.*

The Respondent has intentionally registered and used the Domain Name violating the Policy Agreement and the PKNIC - Internet Domain Registration Policy.

(xxviii) It will be noted that the DNDRC Panel in Standard Chartered PLC v. Hosting Campus Domain (Case No. C2007-0001, dated 30 August 2007) (see Exhibit 22) has found that if a complainant simply establishes that the respondent's domain name infringes upon the complainant's registered trade name or trade mark, this renders the respondent's domain name to be illegal, unlawful and invalid and further constitutes an adequate ground for the transfer of the domain name to the complainant

The Respondent has not contended that the DDN is legal, lawful or valid.

The Panel has reviewed the submissions of the Parties:

The Complainant has contended that the use of "AKU" by the Respondent in the DDN is in contravention of the exclusive trademark rights of the Complainant in accordance with the Trademarks Ordinance 2001 and has cited the decision of DNDRC Panel in Standard Chartered PLC v. Hosting Campus Domain (Case No. C2007-0001).

The Panel notes that the Complainant has provided ample evidence of its trademark rights through their registered marks expressly highlighting the words "AKU" in several jurisdictions including in Pakistan vide Exhibit 3 and 4. According to the long-standing principle, it is sufficient for the Complainant to prove an explicit contravention of their registered trademark by the DDN.

The Panel, while being satisfied of the Complainant's rights in the logo comprising the words "AKU", also emphasizes the disclaimers highlighted on all the registration certificates issued by the Trade Marks Registry of Karachi where it is explicitly mentioned that the registration of the said mark would not give the registrant any right over the exclusive use of either "A", "K" or "U" either separately or as a whole. Therefore, the use of the words "AKU" as a whole by the Respondent cannot serve as conclusive evidence of an infringement in the Complainant's trademark rights.

The Panel determines that while the Complainant has provided sufficient evidence of its ownership of the trademark "AKU", their submission falls short in addressing the contravention of their trademark by the DDN.

Given the lack of submission by either Party, the Panel finds that there is insufficient information to conclusively determine whether this PKNIC criterion has been satisfied. Consequently, it is necessary to evaluate whether each of the UDRP criteria has been fulfilled to determine the Complainant's rights over the DDN.

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

The Complainant has made the following submissions:

(xvii) *The facts and evidence provided in paragraphs 7 and 8(i) to (x) above clearly demonstrate that the AKU Trade Marks and, particularly, the combination and trademark, AKU, are the exclusive property of the Complainant, who has the prima facie prior rights to use the AKU Trade Marks, particularly, the combination and trademark AKU, in relation to inter alia educational services and associated merchandise in Pakistan and elsewhere.*

(xviii) *The Disputed Domain Name consists of the name and trademark AKU, which name and trademark is an acronym for the Complainant's corporate name, i.e., Aga Khan University, and forms an essential element of the Complainant's registered domain name, aku.edu and Complainant's prior registered and well-known AKU Trade Marks. The Disputed Domain Name in fact consists of nothing more than the Complainant's name and trade mark AKU in its entirety.*

As stated by the WIPO Panel in Dr. Ing. H.c.F. Porsche AG v. Vasilij Terkin (Case No. D2003-0888, dated 6 January 2004 - copy attached as Exhibit 20), a domain name that wholly incorporates a complainant's registered trade mark is sufficient to establish confusingly similarity. The addition of the suffix/ccTLD ".PK" is an irrelevant distinction based on the findings of the WIPO Panel in the following cases, namely: BIC Deutschland GmbH & Co KG v. Paul Tweed (WIPO Case No. D2000- 0418, dated 20 June 2000; Zwiesel Kristallglas AG v. WWW Enterprise Inc. (Case No. D2005-1223, dated 23 January 2006); LG Chemical Ltd v. ChangHwan, OH (Case No. D2000-0889, 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 21.

It is also important to note that WIPO has stated in its publication titled 'WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Ed' that "If the complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights"; "[t]he location of the trademark ... and the goods and/or services for which it is registered, are all irrelevant for the purpose of finding rights in a trademark under the first element of the UDRP." The WIPO publication titled 'WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Ed' is available on the following link, <https://www.wipo.int/amc/en/domains/search/overview3.0/>.

Furthermore, Complainant relies on the analysis and findings of the DNDRC Panel in (i) Standard Chartered PLC v. Hosting Campus Domain (Case No. C2007-0001, dated 30 August 2007); (ii) Pakistan Herald Publications (Private) Limited. v. Averroes Sapertise Management (Case No. C2011-0001, dated 30 March 2011); (iii) Google Inc. v. Starcom Systems (Case No. C2013-0004, dated 21 September 2013); and (vi) Full Fortune Intellectual Limited v. Owais-ul-Wara (Case No. C2023-0003, dated 1 August 2023). Copies of these cases are attached hereto as Exhibit 22.

(xxiv) Based on the above, there can be no doubt that the Disputed Domain Name incorporates the Complainant's name and trademark AKU, in which Complainant has prior registered and (unregistered) common law rights and as such, the Disputed Domain Name is identical and confusingly similar to the Complainant's AKU Trade Marks.

The Respondent has not contended that the DDN is not identical or confusingly similar to the Complainant's mark.

The Panel has reviewed the submissions of the Parties:

The Complainant has contended that the registration of the mark containing the letters “AKU” grants due protection from trademark infringement of the use of “AKU” in the DDN. The Complainant demonstrates the use of their registered trademark in its entirety in the DDN claiming the DDN to be identical and confusingly similar to the Complainant's mark, which is sufficient to satisfy this criterion.

The Panel reviews and agrees with the cited case *Dr. Ing. H.c.F. Porsche AG v. Vasiliy Terkin* (WIPO Case No. D2003-0888) as cited by the Complainant whereby it was held that the DDN that wholly incorporates a Complainant's registered mark may be sufficient to establish confusing similarity for purposes of the UDRP. This principle is also reiterated in several WIPO cases as well as the previous DNDRC decisions, 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 highlights that despite the lack of Complainant's right in the exclusive use of the letters “AKU” as a whole, their registration of the mark having “AKU” as the central component along with the DDN constituting the entirety of these letters would be considered sufficient to satisfy this criterion.

For the purposes of determining the existence of a suffix/ccTLD .pk, the Panel agrees with the cited case *BIC Deutschland GmbH & Co KG v. Paul Tweed* (WIPO Case No. D2000- 0418) and

finds that the suffixes such as .com or .pk are irrelevant when finding confusing similarity between the DDN and the Complainant's mark.

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:

- (xx) 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 Disputed Domain Name is redirected to a website, <https://aku.edu.pk>, which website promotes business activities of the Respondent. The Complainant has neither authorized nor allowed 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 has no affiliation with the Complainant.

The Complainant believes that the Respondent has adopted and falsely obtained registration of the Disputed Domain Name with intentions to benefit from the accrued reputation and goodwill subsisting in the AKU Trade Marks. Such intentions are clearly evident from Respondent's statements made under letter dated 24 August 2024 and voice notice of 11 September 2024. The Complainant further believes that the Respondent has never been known by the Disputed Domain Name nor has it ever been known by the AKU Trade Marks or any other name containing the combination and trademark AKU. 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 AKU Trade Marks, particularly, the combination and trademark AKU owned by Complainant, since at least 1983.

Respondent is clearly not making a legitimate, non-commercial or fair use of the Disputed Domain Name. Through the use of the Domain Name (which consists of the Complainant's famous trade mark AKU) the Respondent is intentionally attempting, or abetting, to attract the general public including Complainant's students and the Internet users to the corresponding website (which website promotes the business activities of the Respondent), by creating a likelihood of confusion with the AKU 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, legitimate or non-commercial use.

The Respondent has not contended that they have legitimate interests in the DDN.

The Panel has reviewed the submissions of the Parties.

The Complainant relies on sub-paragraph 4(c) of the Policy and contends that the Respondent fails on all three grounds that would assist the Respondent in finding a legitimate interest on his part which includes the bona fide offering of goods and services, being commonly known by the DDN or a legitimate non-commercial or fair use of the DDN.

The Panel highlights the principle followed by various WIPO and DNDRC Panels where the contention of the Complainant was that the Respondent lacks rights in the DDN establishes a prima facie case against the Respondent. Thereafter, the burden of proof shifts to the Respondent to demonstrate otherwise and the failure of the Respondent to do so would deem the Complaint to have satisfied lack of legitimate interest (See *MicroBilt Corporation v. Greg J Michalko* WIPO Case No. D2024-2212).

The Panel also notes the initial submission of the Respondent via email to DNDRC where the Respondent agreed to transition their activities to a different domain name instead of submitting the Response Form and contending their legitimate interests in the DDN thereby further reinforcing the lack thereof.

The Panel is therefore satisfied 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:

- (xxi) *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 AKU Trade Marks, and particularly, the combination and trademark AKU via the Complainant's trade mark registrations in Pakistan (as well as in other countries around the world); and must have had actual knowledge that the AKU Trade Marks and particularly, the combination and trademark AKU, were used by the Complainant in relation to educational and healthcare services for the past four decades, due to the fame and popularity of the AKU Trade Marks. Notwithstanding this knowledge and complete lack of authorization, Respondent intentionally registered the Disputed Domain Name containing the famous AKU trade mark, without authorization, for use in relation to its website, <https://aku.edu.pk> (which website is used to promote the business activities of the Respondent in the education sector) and corresponding email addresses namely, info@aku.edu.pk, careers@aku.edu.pk and training@aku.edu.pk. As stated by the WIPO Panel in Kraft Foods (Norway) v. Fredrik Wide and Japp Fredrik Wide (Case No. D2000-0911, dated 23 September 2000 – copy attached as Exhibit 23), 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”.*
- (xxv) *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 students” - see SGS Societe Generale de Surveillance S.A. v. Inspectorate (WIPO Case No. D2000-0025, dated 17 March 2000 - copy attached as Exhibit 24); especially since the Disputed Domain Name and the corresponding website ,<https://aku.edu.pk>, is used to promote the business activities of*

the Respondent in the education sector in Pakistan. As noted, the Respondent is not an affiliate of the Complainant. Furthermore, a student who checks a “whois” database, or visit the corresponding website, may adopt the mistaken belief that Respondent has an affiliation with the Complainant based on its registration of a domain name and the corresponding email addresses and website that contains the AKU name or mark.

(xxvi) 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 WIPO Panel in Red Bull GmbH v. Harold Gutch (Case No. D2000-0766, dated 21 September 2000 – copy attached as Exhibit 25), 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.

(xxvii) It will be pertinent to note that the Respondent has, through its letter dated 24 August 2024 and voice note sent on 11 September, admitted that the usage of the Disputed Domain Name (consisting of the Complainant’s prior, registered and well-known trademark AKU) has resulted in an increase in the number of people visiting the corresponding website. As such, the Disputed Domain Name has enabled and will continue to enable the Respondent to earn profits to which they are not in equity or good conscience entitled to and has unjustly enriched the Respondent at Complainant’s expense.

(xxiv) Furthermore, given the Complainant’s prior established goodwill and proprietary rights in the AKU Trade Marks, the registration of the Disputed Domain Name by the Respondent and retention of the Disputed Domain Name 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 contended that the registration and use of the DDN is not in bad faith.

The Panel has reviewed the submissions of the Parties.

The Complainant relies on Paragraph 4(b) of the Policy and associated decisions of the previous Panels to support his contention regarding finding of registration and use of the DDN in bad faith by the Respondent. The Complainant claims that the Respondent aims to exploit the goodwill and reputation of the Complainant and to lure away their customers for commercial purposes.

The Panel firstly notes that the trademark of the Complainant containing the letters “AKU” is distinctive and well-known in various jurisdictions, particularly in Pakistan. This makes it highly unlikely that the Respondent registered the DDN without being aware of the Complainant's trademark, especially when the Respondent intended to provide identical services as to what the Complainant is commonly known for. This has also previously served as the contributing factor to the finding of bad faith at the time of registration (See *Compagnie Générale des Etablissements Michelin v. World Industrial*, WIPO Case No. D2019-0553).

Since a finding of confusingly similarity is already established, the Panel reviews and relies on the cited case *SGS Societe Generale de Surveillance S.A. v. Inspectorate* (WIPO Case No. D2000-0025) and finds that the Complainant ignored the existence of Complainant's rights in the letters “AKU” to disrupt the business of the Complainant and to divert the customers to themselves which also serves as evidence of bad faith.

Moreover, Paragraph 4(b)(1) of the Policy specifies that an indication of registration of the DDN primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant is sufficient to be considered as evidence of the registration and use in bad faith. In this context, the Panel refers to the conversation held on 11 September 2024 as submitted by the Complainant vide Exhibit 19 where the Respondent expressly raises the possibility of the Complainant purchasing the DDN. This, along with the email from the Respondent to DNDRC and other submissions provided by the Complainant under this criterion, firmly establishes to the Panel that the registration and use of the DDN lack good faith.

In light of the above-mentioned findings, the Panel concludes 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 trademark containing the letters “AKU” 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 DDN <aku.edu.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: 20 January 2025