

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. 2025-0007

Also in PDF C2025-0007

1. The Complainant

The Complainant is Pakistan Mobile Communications Limited, having its office at 1-A Kohistan Road, F8 Markaz, Islamabad. The Complainant has initiated the Complaint vide their authorized representative, Al Rahim Trademark & Patent Attorneys, with their address at Office No. 1 & 2, Mumtaz Centre, 15-A, Queens Road, Lahore.

2. The Domain Name and Respondent

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

PKNIC has informed DNDRC that the DDN is registered by Mr. Faisal with his address at Lahore, Pakistan and that the email address provided at the time of registration of the DDN is muhammad.faisal@gmail.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 17 December 2024 after which DNDRC completed its compliance review.

Following the completion of DNDRC procedures by the Complainant, DNDRC requested the Respondent’s details from PKNIC which were provided on 17 January 2025.

The Respondent was issued a notification of the dispute along with a copy of the Complaint and a Response Form on 20 January 2025 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 his response on the Response Form on 30 January 2025.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), DNDRC appointed Mr. Sunain Qazi 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

1. Complainant

The Complainant's brief contentions are reproduced below:

7.1. That, the Complainant is a limited company duly registered under the Companies Ordinance, 1984 (now Companies Act, 2017) and has for the past many years continued the business of providing GSM cellular mobile telecommunication services in Pakistan, Azad Jammu & Kashmir and Gilgit Baltistan. The Complainant, under the licenses granted by the Pakistan Telecommunication Authority ("PTA"), is authorized to provide GSM cellular mobile telecommunication services including Next Generation Mobile Services (3G & 4G data/internet services) ("**Telecommunication Services**"). The Complainant is a subsidiary of International Wireless Communications Pakistan Limited, a company incorporated in Malta and is a leading Telecommunication and allied Services provider in Pakistan.

7.2. That in Pakistan, the Complainant is the bona-fide adopter, prior and registered user of the trademark "**JAZZ**" and since its adoption, the same is being continuously used as a trademark and/or as a copyright by the Complainant since August 16, 2002 for the purposes of providing Telecommunication Services, who is the true, rightful, exclusive, prior, original, and bona-fide adopter, user, proprietor and owner of trademark and

copyright "**JAZZ**" or  along with other combination/composite trademarks/copyrights having the word "**JAZZ**" such as **MOBILINK JAZZ**, , **JAZZ MAIL**, **JAZZ APNA HAI**, **JAZZ LADIES FIRST**, **JAZZ OCTANE**, **JAZZ CASH**, , **JAZZ SUPER 4G**, **JAZZ TUNES**,  **JAZZ SUPER 4G**, etc. (which hereinafter are collectively referred to as the " " or " " trademarks).

7.3. That the Complainant is also the bona-fide, first ever adopter, registered proprietor and user of the trademark “” or “**JAZZ CASH**” in respect of provision of mobile wallet, mobile payments, and branchless banking services and since the year **2012** the trademark “” is being continuously used as a trademark by the Complainant, who is the exclusive, prior, original, and bonafide adopter, user and proprietor of “” trademarks.

7.4. It is pertinent to mention here that in order to protect its “**JAZZ** or ” trademarks, the Complainant has obtain the following trademark registrations:

S. No.	Trademark	App. No.	Class	Reg. Date	Status
1.	JAZZ	179756	09	16.08.2002	REGISTERED
2.	JAZZ	218395	38	13.02.2006	REGISTERED
3.	JAZZ MOBILINK	192328	16	28.02.2004	REGISTERED
4.	Jazz Octane (words)	218393	38	13-02-06	REGISTERED
5.	Jazz Ladies First (words)	223450	38	13-06-06	REGISTERED
6.		239181	38	17-07-07	REGISTERED

7.		239803	38	01-08-07	REGISTERED
8.		239802	38	01-08-07	REGISTERED
9.		241940	38	27-09-07	REGISTERED
10.	JAZZ ONE (Word)	250929	38	20-05-08	REGISTERED
12.	Jazz ki nai karobar service	257278	35	27-10-08	REGISTERED
13.	Jazz ki nai karobar service	257279	38	27-10-08	REGISTERED
14.	Jazz karobar	257280	35	27-10-08	REGISTERED
15.	Jazz karobar	257281	38	27-10-08	REGISTERED
16.		280284	38	17-03-10	REGISTERED
17.		280285	41	17-03-10	REGISTERED
18.	JAZZ (Words)	295640	09	10-02-11	REGISTERED
19.	JAZZ (Words)	295639	16	10-02-11	REGISTERED
20.	JAZZ (Words)	295638	35	10-02-11	REGISTERED
21.	JAZZ (Words)	295637	36	10-02-11	REGISTERED
22.	JAZZ (Words)	295635	38	10-02-11	REGISTERED
23.	JAZZ (Words)	295634	41	10-02-11	REGISTERED



24.		403041	09	27-11-15	REGISTERED
25.		403040	16	27-11-15	REGISTERED
26.		403039	35	27-11-15	REGISTERED
27.		403025	36	27-11-15	REGISTERED
28.		403026	38	27-11-15	REGISTERED
29.		403027	42	27-11-15	REGISTERED
30.		403034	09	27-11-15	REGISTERED

					
31		403038	16	27-11-15	REGISTERED
32.		403036	35	27-11-15	REGISTERED
33.		403035	36	27-11-15	REGISTERED
34.		403031	38	27-11-15	REGISTERED
35.		403033	42	27-11-15	REGISTERED
34.		403028	09	27-11-15	REGISTERED

					
36.		403029	16	27-11-15	REGISTERED
37.		403030	35	27-11-15	REGISTERED
38.		403022	36	27-11-15	REGISTERED
39.		403023	38	27-11-15	REGISTERED
40.		403024	42	27-11-15	REGISTERED
42.		438255	09	23-11-16	REGISTERED
43.		438254	16	23-11-16	REGISTERED
44.		438258	35	23-11-16	REGISTERED

45.		438259	36	23-11-16	REGISTERED
46.		438261	38	23-11-16	REGISTERED
47.		438262	41	23-11-16	REGISTERED
48.		478902	09	15-12-17	REGISTERED
49.		478903	16	15-12-17	REGISTERED
50.		478904	35	15-12-17	REGISTERED
51.		478905	36	15-12-17	REGISTERED
52.		478906	38	15-12-17	REGISTERED
53.		478907	41	15-12-17	REGISTERED
54.		478908	42	15-12-17	REGISTERED

55.	JAZZ SUPER 4G	500728	36	06-07-18	REGISTERED
56.	JAZZ SUPER 4G	500727	38	06-07-18	REGISTERED
57.	JAZZ SUPER 4G	500726	42	06-07-18	REGISTERED
58.	JAZZ SUPER 4G	500724	16	06-07-18	REGISTERED
59.	JAZZ SUPER 4G	500723	35	06-07-18	REGISTERED
60.	JAZZ SUPER 4G	500722	36	06-07-18	REGISTERED
61.	JAZZ SUPER 4G	500721	38	06-07-18	REGISTERED
62.	JAZZ SUPER 4G	500720	42	06-07-18	REGISTERED
63.	Jazz Cares	600295	38	22-01-21	REGISTERED
64.	Jazz Cares	600296	41	22-01-21	REGISTERED
65.	Jazz Cares	600297	42	22-01-21	REGISTERED
66.	Jazz Cares	600298	44	22-01-21	REGISTERED
67.	#JazzCares	600299	38	22-01-21	REGISTERED
68.	#JazzCares	600300	41	22-01-21	REGISTERED
69.	#JazzCares	600301	42	22-01-21	REGISTERED
70.	#JazzCares	600302	44	22-01-21	REGISTERED

*The copies of the registration certificates obtained by the Complainant for the aforementioned “JAZZ” and other. “JAZZ” composite mark are attached herewith as **Annexure B1-B70***

- 7.5. *In order to protect its trademark “JAZZ CASH”, the Complainant has obtained several trademark registrations and has also filed various trademark applications which are pending registration with the Registrar of Trade Marks, the details of which are as follows:*

Sr. No.	Trademark	Application No.	Filing Date	Class	Status
1.		409884	09	10-02-16	REGISTERED
2.		409885	16	10-02-16	REGISTERED
3.		409880	35	10-02-16	REGISTERED
4.		409881	36	10-02-16	REGISTERED
5.		409882	38	10-02-16	REGISTERED
6.		409883	42	10-02-16	REGISTERED
7.		608325	09	17-03-21	PENDING
8.		608326	16	17-03-21	PENDING
9.		608327	35	17-03-21	PENDING

10.		608328	36	17-03-21	PENDING
11.		608329	38	17-03-21	PENDING

The copies of the registration certificates obtained by the Complainant for the aforementioned “JAZZCASH” trademarks are attached herewith as Annexure C1-C11

- 7.6. That in fact, Our Client’s trademarks “**JAZZ**” and “**JAZZ CASH**” are its house hold trademarks and have become a symbol of very high-quality goods/services acquiring enormous prestige and a reputation of its own in Pakistan and across the globe, known to be emanating from the Complainant. The services provided under the Complainant’s

trademark/copyright “**JAZZ**”, “” and “**JAZZ CASH**”, “” are very popular and very much in demand and are purchased by people from all walks of life throughout the country.

- 7.7. It is pertinent to mention here that the Complainant is the registered proprietor of the

trademarks “**JAZZ CASH**” or “” since 2012 and of the “” trademarks since 2002, therefore, the same have acquired sufficient goodwill in the “**JAZZ CASH**”

and “” marks on account of immense exclusive use and registrations to readily distinguish the referred marks from the marks of any other entity. It is noteworthy to mention here that the Complainant has also filed and obtained a **copyright** for the artistic

works “” and “”.

The copy of the registration certificate obtained for the copyright of the artistic works “ ” and “ ” is also attached herewith as Annexure D1-D2

7.8. That the services bearing the “” or “” trademarks have been consistently available in Pakistan since its adoption and advertisements of such presence were also placed in the electronic, television and print media. Moreover, the Complainant is the owner of the registered domain <https://jazz.com.pk/> which hosts the Complainant’s website. The Complainant is also the owner of the registered domain <https://www.jazzcash.com.pk/> in respect of its mobile wallet, mobile payment and branchless banking services. The Complainant heavily promotes and advertises its high-quality services under the “” and “” trademarks on its abovementioned website which is accessible across the globe including Pakistan. The Complainant spends huge amounts for the promotion of its services under the trademark “JAZZ” and other combination or composite trademarks such as “” or “” which have become equally famous, well known and household trademarks and are exclusively associated with the Complainant alone.

The screenshots/print-outs of the active websites under the registered domains <https://jazz.com.pk/> and <https://www.jazzcash.com.pk/> of the Complainant are attached herewith as **Annexure E1-E2**

7.9. That the sales generated by the Complainant under its various brands/trademarks including the “JAZZ”, “” or “” trademarks are in millions and billions.

7.10. In view of the aforesaid, including extensive use of its said trademarks, the Complainant has acquired enviable and enduring goodwill and reputation across the entirety of Pakistan and over the world. The Complainant’s said trademarks are inherently distinctive, and with time, have acquired secondary significance therein. The purchasing public, the trade and the industry at large, in Pakistan, identify and distinguish the said goods and business with the Complainant under its said trademarks/labels and associate the source and origin alone with the Complainant.

7.11. That in view of the Complainant's well-known status, proprietary rights, both statutory and

in common law, in its said “” and “” trademarks, its goodwill & reputation and its copyrights, the Complainant has the **exclusive right** to the use thereof and nobody can be permitted to use the same or any other deceptively similar mark in any manner whatsoever, in relation to any specification of goods or services without the leave

and license of the Complainant. Any un-authorized use of the said “” and “” trademarks amounts to the infringement of the Complainant’s rights in its aforesaid trademarks.

7.12. By virtue of such trademark and copyright registrations that the Complainant has obtained

in Pakistan, extensive promotion and use, the said “” and “” trademarks have become extremely famous not only in Pakistan, but all over the world and

especially the said “” and “” trademarks are liable to be recognized as ‘**well-known**’ trademarks in Pakistan by virtue of the meaning ascribed to the term under Article 6 of Paris Convention and Section 86 of the Trademark Ordinance 2001 (hereinafter referred to as “**the Ordinance**”), and be provided the same level of protection as is accorded to well-known trademarks under the statute, therefore, any un-authorized

use of the Complainant’s “” and “” trademarks amounts to the infringement of the Complainant’s rights in its aforesaid trademarks.

7.13. That in the past Our Client has very zealously protected its rights in relation to the said “

” and “” trademarks against other infringing parties.

7.14. That the Complainant recently came across the unauthorized use of its registered and most

well-known “” and “” trademarks by the Respondent with their registration of the domain ‘**jazzcash.pk**’ (hereinafter referred to as the ‘**disputed domain**’) on PKNIC’s ‘Shared Registry System’. It is pertinent to mention that upon investigation it was revealed that PKNIC is responsible for the administration of the .PK domain name

space, including the operation of the DNS for the Root-Servers for .PK domains, and registration and maintenance of all .PK domain names. It was further noted that the impugned domain was registered with PKNIC by the Respondent.

The verified records of PKNIC show that the disputed domain is registered, however, it seems that the Respondent is using an ID shield which prevents the public from accessing the user (Respondent) information. The screenshot which is attached as **Annexure A** to this complaint shows that due to “current ICAN WHOIS compliance guidelines, and other privacy and security models such as General Data Protection (GDPR), the public disclosure of the user information is limited”

7.15. That such use (albeit ‘unfair use’), copying, illegal adoption on part of the Respondent of the disputed domain name was without the prior authorization of the Complainant and that the illegal adoption and unfair use of the “**JAZZCASH**” trademarks, by the registration of the disputed domain (**jazzcash.pk**), is identical to the Complainant’s registered “



” and “**Jazz Cash**” trademarks, amounting to infringement of the said registered trademarks of the Complainant. Additionally, such unlawful adoption of the registered trademarks of the Complainant will also cause confusion and deception amongst the public as to the source of origin of the disputed domain name. **The adoption of the disputed domain by the Respondent is unlawful, without any legitimate interest, in bad faith, therefore, the registration of the same is liable to be cancelled and/or transferred to the Complainant’s name.** The grounds and reasons on which the instant complaint is based are further elaborated under paragraph 8 of this complaint.

Therefore, the Complainant seeks the following remedy:

It is humbly prayed that the Disputed Domain Name shall either;

(a) be declared void and

(b) taken down from the web by cancelling its registration;

or (c) be transferred to the Complainant to protect its valuable intellectual property rights, prevent confusion, and avoid further damage to its reputation, in light of justice, fair play and equity

1. Respondent

The Respondent makes the following submissions:

5. *The Complainant had opportunity to register the domain jazzcash.pk when it was openly available to the public prior to 2020. Their failure to act during this period undermines their current claims of entitlement. Under the first-come, first-served principle governing domain registrations, the Complainant's inaction cannot retroactively invalidate the Respondent's lawful acquisition of the domain.*
6. *The Complaint lacks evidence of actual confusion, harm, or bad faith (e.g no consumer complaints, traffic diversion, or financial loss).*

The Respondent seeks the following remedy:

1. ***Dismiss the Complaint in its entirety*** and that the domain name jazzcash.pk remain under the respondent's ownership.
2. ***Order the Complainant to bear all costs*** associated with this proceeding, including administrative fees and legal attorney expenses incurred by the Respondent

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:

8.2. *It is submitted that the PKNIC Policy states that any domain that is in contravention to the conditions mentioned in **Para 1 of the PKNIC Policy** will be considered void ab initio. The Para 1 of the PKNIC Policy excludes the registration of any domain that:*

"a. infringes upon a registered tradename,

b. is not bona fide as recognized by international best practice,

c. is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ AntiTerrorism Act, 1997/any applicable criminal law, Trade Mark Ordinance 2000.

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."

*Furthermore, **Para 4 of the PKNIC Policy** also states that "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 (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.”

- 8.3. That under **Section 40(6) of the Trade Marks Ordinance, 2001** (hereinafter referred to as the “**Ordinance**”), 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. In the instant matter, the Respondent has copied the Complainant’s most wellknown and popular “**JAZZ**” and “**JAZZCASH**” trademarks by using the same term ‘jazzcash’ for the disputed domain ‘**jazzcash.pk**’. It must be noted that the Respondent is copying, adopting and unlawfully using the disputed domain name without the consent of the Complainant, who is the registered proprietor of the “**JAZZ**” and “**JAZZCASH**” trademarks, as can be evidenced by **Annexures B, C and D** (copies of trademark and copyright registration certificates of the said “**JAZZ**” & “**JAZZCASH**” marks) and clearly the Respondent has the intention to sell the domain name to some third party or back to the Complainant since the same (Respondent) is just hoarding the disputed domain name and waiting for the perfect opportunity. This is further strengthened by the fact that no website appears when launching the impugned disputed domain over the web, therefore, such inactivity in itself, amounts to use in bad faith as per settled principles of domain law. Accordingly, it can be said that disputed domain name ‘**jazzcash.pk**’ is (a) an infringement and is in contravention of the Ordinance as envisaged under Para 1 of the PKNIC Policy and (b) violates the registered tradename of the Complainant as provided under Para 4 of the PKNIC Policy.
- 8.4. It is further contented that the disputed domain name is also a derivation of the Complainant’s registered tradename as envisaged under Para 4 of the PKNIC Policy. The disputed domain name in its entirety consists of the registered tradename and trademarks (“**JAZZ**” & “**JAZZCASH**”) of the Complainant. There are no subsequent additions to the word, and neither is there any typo squatting, that could be witnessed by a change in the spelling or variation in the context of the word ‘jazzcash’. Furthermore, the word ‘jazzcash’ does not hold a generic, or a literal meaning. It is very closely associated with the provision of the services by the Complainant and hence does not refer to anything generally.

8.5. That By virtue of such trademark and copyright registrations that the Complainant has

obtained in Pakistan, extensive promotion and excessive use, the said “” and “” trademarks, have become extremely famous not only in Pakistan, but all over the world in respect of providing world-class telecommunication and other cellular services. That the said registered “JAZZ” & “JAZZCASH” are so popular and have immense goodwill that even an ordinary person recognizes any product, service or website bearing the registered “JAZZ” or “JAZZCASH” trademarks as being associated with the Complainant alone, therefore, the Respondent, by adopting, copying and unlawfully obtaining the registration of the impugned disputed domain has been involved in some activity that is not considered to be bona fide, as per the international best practice (Para 4 of the PKNIC Policy).

The Respondent has made the following submissions:

1. The domain jazzcash.pk was lawfully registered on September 7, 2020, through PKNIC, adhering to ICANN (Internet Corporation for Assigned Names and Numbers)'s UDRP (Uniform Domain-Name Dispute-Resolution Policy) and PKNIC's registration policies. The domain was publicly available at the time of registration. and no trademarks were infringed.

The Panel has reviewed the submissions of the Parties.

The Complainant contends that the DDN jazzcash.pk is infringing on the registered trademark “JAZZCASH” therefore the Panel needs to evaluate whether the DDN is in contravention of the Trademarks Ordinance, 2001. The Respondent denies the contentions and claims that the DDN was registered lawfully and that no trademark rights were infringed.

The Panel determines that the satisfaction of the criterion as stated under Para 1 and 4 of the PKNIC Policy requires the express contravention of the trademark rights by the DDN. The Panel, vide Annexure B provided by the Complainant, stands satisfied that the Complainant owns the trademark rights for “JAZZ” however it can be seen under Annexure C that the Complainant has secured trademark rights for a mark or logo that has “JAZZCASH” incorporated within it. Since the disclaimer on the certifications prohibit the use of “cash” separately from the mark, the Panel notes that the Complainant holds the trademark rights to the word “JAZZCASH” as well.

The Panel disagrees with the Respondent as the registration of the DDN goes against the PKNIC policy by using a mark that was already registered by the Complainant at the time of registration. Since the Complainant has sufficiently satisfied their trademark rights with respect to “JAZZCASH”, an exact reiteration of which is used in the DDN and the Respondent has unlawfully used the same to register the DDN, this makes the registration of the DDN unlawful under the PKNIC policy (See *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001)).

In light of the submissions made, the Panel declares that the DDN is in infringement of Complainant’s trademark. For the sake of arguments, the Panel still finds it necessary to assess and evaluate the remaining UDRP criteria.

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

The Complainant has made the following submissions:

- 8.6. *It is submitted that, under the settled principles of trademark law, registration of a trademark is its prima facie proof of validity and in view of the irrefutable evidence of registrations obtained for the “JAZZ” & “JAZZCASH” trademarks, it is the Complainant, who has the **exclusive right** to use the said trademarks in connection with web based and telecom services. Moreover, the previous decisions of this Honorable Panel have held that due to such prima facie validity of the registered mark, a rebuttable presumption that the mark is distinctive is also created in favor of the registrant, in this case, the Complainant (**EAUTO, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc., ICANN Case No. D2000-0047.**)*
- 8.7. *That the dominant and distinctive component of the disputed domain name is “jazzcash”, which is **identical** to the Complainant’s registered “JAZZ” & “JAZZCASH” trademarks. The word “jazzcash”, which is the essential element of the said Registered Trade Marks of the Complainant, has been reproduced and incorporated into the Disputed Domain Name. The thrust of the Registered Trade Marks is to convey to the reader the name/word “jazzcash” and it is this concept that makes up the Domain Name. The disputed domain name is completely identical to the readable portion of the registered “JAZZ” & “JAZZCASH” trademarks of the Complainant. When the said registered trademarks are looked at as a whole, it is clear that they are trademarks consisting of the words “jazzcash”. As the logo cannot be reproduced in domain name for the purpose of assessing the Disputed Domain Name, the logo must be disregarded (**Asset Loan Co. Pty Ltd v Gregory Rogers Case No. D2006-0300**) and (**Yell Ltd v Ultimate Search Case No. D2005-***

0091). Consequently, the Disputed Domain Name (jazzcash.pk) is identical to the registered “JAZZ” and “JAZZCASH” trademarks of the Complainant according to this test.

- 8.8. That it is settled principle that for the purpose of assessing whether the Disputed Domain Name is identical or confusingly similar to the registered “JAZZ” or “JAZZCASH” trademarks in which the Complainant has rights, the “.pk” suffix is disregarded, as it being a necessary component of the Disputed Domain Name. A cursory glance at the competing marks shows that there lies no difference between the registered “JAZZ” or “JAZZCASH” trademarks and the Disputed Domain Name. As such the use of a common word strengthens the likelihood of confusion (**Toyota Motor Sales USA v. Rafi Hamid dba ABD Automobile Buyer, WIPO Case No. D2001-0032**).
- 8.9. That the adoption and unauthorized use of the identical and impugned Disputed domain name ‘jazzcash.pk’ is an infringement of the Complainant’s registered “JAZZ” and “JAZZCASH” trademarks and such adoption and/or copying of the same will cause confusion and deception amongst the general public that such impugned/disputed domain name relates to the Complainant or its affiliates. Accordingly, in view of the above discussion it is safe to say that the Disputed Domain Name is identical and confusingly similar to the registered “JAZZ” and “JAZZCASH” trademarks pursuant to **Para 4(a)(i) of the Policy**.
- 8.10. That the Respondent’s use of the “JAZZCASH” name and mark in the Disputed Domain Name at issue erroneously leads the Complainant’s customers and customers of Complainant’s authorized ‘JAZZ’ dealers to believe that the Domain Name is somehow associated with, endorsed by or sponsored by Complainant and/or its authorized ‘JAZZ’ dealers. It is noteworthy to mention here that Administrative Panels and Arbitrators have found domain names, which incorporate well-known or famous marks to be confusingly similar in that the offending domain name is misleading. (**Nike, Inc., WIPO Case No. D2000-0167**).

The Respondent has made the following submissions:

3. The terms "Jazz and "Cash are highly generic and widely used across various industries and contexts. For instance:
- "Jazz" is commonly associated with music (e.g., Jazz Music), telecommunications (e.g. Jazz Telecom), and other unrelated fields.

"Cash" is a universal term used in financial services (e.g., Cash Loans), retail, and everyday language.

The combination of these two generic terms, "jazzcash," does not inherently or exclusively reference the Complainant's brand main brand which is Jazz only. It is a non-distinctive phrase that could apply to numerous legitimate uses unrelated to the Complainant's business.

The Panel has reviewed the submissions of the Parties.

The Complainant has contended that the DDN is identical or confusingly similar to their registered trademarks "JAZZ" and "JAZZCASH" and that the DDN is being used to cause deception and confusion among the Complainant's customers. The Respondent has contended that "JAZZ" and "CASH" are two entirely distinctive words therefore the merger of them should not be infringing on any rights and therefore be considered generic terms.

The Panel reviews and agrees with *Asset Loan Co. Ply Ltd v Gregory Rogers Case No. D2006-0300*, as cited by the Complainant to address the issue of registration of "JAZZCASH" along with the logo. Since the logo itself cannot be incorporated into the DDN, the DDN cannot be identical or entirely same with the registered trademark of the Complainant. The test for this would rely on what a reasonable bystander would see if they conduct a side-by-side analysis of the trademark and the DDN. The Panel finds a reasonable bystander would effectively look at the words of the registered trademark of the Complainant which clearly demonstrate the word "JAZZCASH" therefore the incorporation of the same in the DDN would constitute a finding of confusing similarity (See also *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS) Case No. D2003-0696*)

The Panel disagrees with the Respondent that the DDN comprises of generic terms and therefore should not be considered as confusingly similar to the DDN. Although it is agreed that in isolation, the words are distinct and pertain to different categories however, the combined use of them primarily in the Pakistan where a similar termed trademark is registered and is well known provides sufficient proof that the registration of DDN was not done on the basis of combining two generic terms. Moreover, the Respondent has also not contended as to why they have chosen to choose a combination of such generic terms so as to depict a difference between the DDN and the mark of the Complainant.

The Panel acknowledges and agrees with the principle cited by the Complainant 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 *WIPO Case No. DCO2010-0033, Oceaneering International Inc. v. Sumer Kolcak*).

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:

8.11. *That the Respondent is using the Disputed Domain Name ‘jazzcash.pk’ in which the same has **no rights or legitimate interests**. The Respondent is not a licensee and has not been authorized in any way to use the Complainant’s registered “JAZZ” or “JAZZCASH” trademarks. Furthermore, the Respondent does not make legitimate non-commercial or fair use of the Domain Name. The Respondent has no rights to or legitimate interests in the Disputed Domain Name as per **Para 4(a)(ii) of the Policy** and **Para 3(b)(ix)(2) Rules**.*

8.12. *That according to **Para 4(c) of the Policy**, evidence of rights or legitimate interests can include any one or more; (i) the use of the domain name in connection with a bona fide offering of goods or services prior to notice of the dispute, (ii) the Respondent being*

commonly known by the domain name, or (iii) legitimate non-commercial or fair use of the domain name without intent to mislead or tarnish the trademark. It is submitted that none of these criteria apply to the Respondent. The Respondent is not using the domain name in connection with any legitimate business activity, nor is the Respondent commonly known by the domain name. Furthermore, the domain name does not appear to be used for any legitimate non-commercial or fair purpose; rather, it seems to be an opportunistic attempt to take advantage of the Complainant's reputation and trademark, which is a clear indication of bad faith.

8.13. *That once prima facie evidence is presented, the burden of proof shifts to the Respondent to demonstrate their rights or legitimate interests in the disputed domain name (**De Agostini S.p.A v Marco Cialone, Case No. DTV2002-0005**). In this case, the Complainant has provided sufficient prima facie evidence that the Respondent has no legitimate rights to the domain name. In the present case, the prima facie evidence set out*

The Respondent has made the following submissions:

4. *As an individual registrant. I have consistently fulfilled all obligations under PKNIC's registration policies. including timely payment of annual renewal fees for the domain jazzcash.pk over multiple years. This demonstrates my ongoing commitment to retaining the domain for legitimate purposes.*

The domain was lawfully registered on September 7, 2020, predating any alleged trademark rights or commercial prominence of the Complainant in Pakistan.

The Panel has reviewed the submissions of the Parties.

The Complainant contends that the Respondent has no legitimate rights or interest in the DDN and refers to Paragraph 4(c) of the UDRP Policy to demonstrate the failure of Respondent to meet all of the three circumstances that can be used as evidence of rights in the DDN. The Respondent has made claims regarding the existence of legitimate rights in the DDN on the basis of the Respondent making timely payments for the renewal of DDN registration.

The Panel concurs with *De Agostini S.p.A v. Marco Cialone, Case No. DTV2002-0005*, as cited by the Complainant, that a prima facie case against the Respondent is established when the Complainant demonstrates a lack of the Respondent's legitimate interests in the disputed domain name. This shifts the burden of proof to the Respondent to demonstrate otherwise. If the

Respondent fails to submit a response, the criterion is deemed satisfied. However, if the Respondent challenges the Complainant's claims, he must sufficiently discharge the burden of proof. Accordingly, the Panel will assess whether the Respondent's contentions adequately establish the existence of legitimate rights in the DDN.

The Panel does not agree with the contention of the Respondent which attempts to demonstrate a legitimate interest or right in the DDN due to the payment of annual fee. Although WIPO has previously found a legitimate interest on such a basis in disputes such as *Zija International, Inc. v. Deep Frontier Case No. D2013-0107*, such decisions were influenced by the law of United States of America along with other circumstances that were unique to those cases and satisfied other prongs mentioned under Para 4(c) of the UDRP Policy. The Panel also considers the second contention of the Respondent being moot as the registration of the DDN by the Complainant indeed predates the registration of DDN by the Respondent, contrary to what the Respondent has stated.

According to the Policy, the Respondent must prove one of the three circumstances as laid under Section 4(c). 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 or the Respondent is making legitimate non-commercial use of the DDN.

The Complainant through his contentions has claimed that the DDN is being passively held without any advertisement, content or monetization taking place through it, therefore the DDN cannot be considered as being used for bona fide offering of goods or service. Moreover, the Panel observes that the Complainant, rather than the Respondent, is commonly associated with the DDN as the terms "JAZZ" and "JAZZCASH" are not only protected through trademark rights but are also means of reputation to the Complainant.

The Respondent would need to make a legitimate non-commercial or fair use of the DDN without an intent to deceive the consumers to establish their rights with the DDN. Since the DDN does not resolve to a webpage, the Panel refers to *BSH Home Appliances Corporation v. Michael Stanley / Michael Sipo Case No. D2014-1433* and finds that the first question is to assess to what extent is the use of Complainant's mark in the DDN permissible.

The Panel finds that simply using the Complainant's trademark in the DDN without any modifications is not allowed under the Policy. This aligns with both common sense and the Policy's purpose, which is to prevent abusive domain registrations that mislead internet users. Since the DDN prominently features the Complainant's trademark as the first thing users see, it does not qualify as fair or legitimate non-commercial use.

Consequently, the Panel finds that the Respondent has failed to satisfy to remove the burden that was shifted upon them.

The Panel determines 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:

8.14. *That the Respondent has registered the domain name in order to prevent the Complainant (owner of trademark) from reflecting the mark in a corresponding domain name (Para 4(b) (ii) of the Policy). It is submitted that the Respondent is intentionally attempting “to attract, for commercial gain, Internet users to the website under the disputed domain name (‘jazzcash.pk’) by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the website under the disputed domain name or location (Para4(b)(iv) of the Policy). It is further submitted that disputed domain name (‘jazzcash.pk’) is inactive and such inactivity indicates the malafide and bad faith on part of the Respondent that the same is holding up the domain name without any legitimate interest in it and/or to find an appropriate opportunity to resell it. It is noteworthy to mention that in Telstra Corporation Limited v Nuclear Marshmallows Case No. D2000-003 (“Telstra Case”), the Administrative Panel held that inactivity by a respondent may amount to the domain name being used in bad faith in the certain circumstances. Thus, inactivity by the Respondent in the instant matter clearly amounts to use of the disputed domain name in bad faith.*

8.15. *That the Panel highlighted two key factors in identifying passive bad faith use:*

*a. **The strong reputation of the trademark:** The Complainant has been a prominent player in the telecommunications sector in Pakistan for several years, operating under the “JAZZ” and “JAZZCASH” trademarks and enjoying wide recognition in the country. Given the prominence of the Complainant’s most popular and well-known “JAZZ” and “JAZZCASH” trademark and brands, it is highly likely that the Respondent was aware of the Complainant’s trademarks at the time of registering the domain name.*

*b. **No evidence of good faith use:** There is no evidence that the domain name **jazzcash.pk** is being used for any legitimate or good faith purpose. Instead, the domain appears to be used in an opportunistic manner to capitalize on the goodwill associated with the Complainant’s well-known “JAZZ” and “JAZZCASH” trademarks, which further suggests bad faith.*

- 8.16. *That the Respondent's registration of the Disputed Domain Name is a clear example of an attempt to exploit the Complainant's well-known "JAZZ" and "JAZZCASH" trademarks for commercial gain, with no legitimate or bona fide use of the Disputed Domain Name. The Respondent's actions can be interpreted as an opportunistic effort to benefit from the reputation and recognition of the Complainant's brand. Given the widespread recognition of "JAZZ" and "JAZZCASH" trademarks of the Complainant in Pakistan, the Respondent's use of Disputed Domain Name constitutes a form of **passive bad faith**. It is significant to mention here that the use of a domain name closely connected to a wellknown mark, with no legitimate purpose, points to bad faith (***Veuve Clicquot Ponsardin v The Polygenix Group Co. case (Case No. D2000-0163)***). Accordingly, the Respondent's use of a well-known mark for the Disputed Domain Name, with no legitimate purpose, points to bad faith on part of the Respondent. The Respondent's actions are, thus, in violation of the Policy.*
- 8.17. *That there is a well-established body of legal precedents indicating that offering a domain name for sale, whether to the Complainant or the general public, can be viewed as strong evidence of bad faith. In cases such as ***Bayerische Motoren Werke AG v. Whois Protection (Case No. D2007-1142)***, ***Debevoise & Plimpton LLP v. Marketing Total S.A. (Case No. D2007-0451)***, and ***Gulf Air v. Surash Kumer (Case No. D2007-0443)***, panels have consistently held that such actions signal an intent to exploit the domain name for commercial gain, without any legitimate connection to the trademark holder.*
- 8.18. *That there is every possibility that the Respondent may attempt to sell the Disputed Domain Name due to its clear association and nexus with the well-known "JAZZ" and "JAZZCASH" trademarks of the Complainant. Such a move would allow the Respondent to unfairly capitalize on the reputation and goodwill of the Complainant's trademark. This raises the real fear that the Respondent is engaging in opportunistic conduct and trying to profit from the well-known "JAZZ" and "JAZZCASH" trademarks of the Complainant, despite having no legitimate claim or interest in the domain name. It is submitted that should the Respondent proceed with offering the Disputed Domain Name for sale, it would be seen as a deliberate attempt to take unfair advantage of the Complainant's established **JAZZ** and "JAZZCASH" trademarks and brands for financial gain. Given the fame of the **JAZZ** and "JAZZCASH" trademarks, this act could mislead consumers and harm the Complainant's reputation, which has been built over years due to its excessive promotion, use and extensive efforts in Pakistan's telecommunications and digital payment markets.*

8.19. *That in view of the above discussion, it can clearly be seen that the Disputed Domain Name ("jazzcash.pk") was registered by the Respondent, unlawfully, in bad faith, without any legitimate interest, and is sure to cause confusion and deception amongst the general public, therefore, the Disputed Domain Name shall either (a) be declared void and (b) taken down from the web or (c) be transferred to the Complainant to protect its valuable intellectual property rights, prevent confusion, and avoid further damage to its reputation, in light of justice, fair play and equity.*

The Respondent has made the following submissions:

2. *The domain has remained passively held (no website, advertisements, or monetization) Per W/PO (World Intellectual Property Organization) Case D2000-0003 under UDRP. passive holding alone does not constitute bad faith.*

No attempts to sell, lease, or transfer the domain to the Complainant or third parties have occurred. negating any assertion of targeting or bad faith.

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 has registered and is using the DDN to exploit on the goodwill and the reputation of the Complainant whereas the Respondent denies the claims on the basis that the DDN is being passively held and is not used for any activity whatsoever.

The Panel initially notes the well-known reputation of the Complainant due to its telecommunication and mobile banking services in Pakistan. The Panel also notes that the registration of the DDN took place after the trademarks were registered by the Complainant. Therefore, given the recognition of the Complainant's mark and the registration of DDN in Pakistan, the Respondent must have known the existence of the Complainant's rights associated with it.

Subsequently, the registration of the DDN by the Respondent would provide evidence of registration in bad faith. (See *WIPO Case No. D2009-0320, Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*). The Panel notes that a simple search on the DDN at the time of registration could have revealed the existence of the Complainant's mark and the failure of the Respondent to do so would point towards bad faith (See *RRI Financial, Inc. v. Ray Chen*, WIPO Case No. D2001-1242 / *WIPO Case No. D2008-0226*)

The Panel also reviews and agrees with *Veuve Clicquot Ponsardin v The Polygenix Group Co. Case No. D2000-0163* as cited by the Complainant. The Panel reiterates that the DDN is so closely connected and identical to the famous trademark “JAZZCASH” of the Complainant that the very use of it would constitute bad faith (See also *WIPO Case No. D2009-0320, Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*).

The Panel also notes the contention of the Complainant concerning the sale of DDN pointing to evidence of bad faith, however, the sale has neither taken place nor has it been discussed, rather is a possibility put forth by the Complainant therefore, this cannot be considered as evidence of bad faith by the Respondent.

The Panel also agrees with the contention of the Respondent that passive holding of the DDN cannot always become the sole basis for finding bad faith, however, it does contribute to such a finding. As such, there is no evidence to the contrary that the DDN is registered in bad faith therefore, the mere passive holding and lack of sale offer will not prevent the finding of bad faith.

Finally, the Panel notes that the Respondent’s knowledge of the Complainant’s mark is also substantiated by the fact that they have referenced “Jazz telecommunications” in their contentions while explaining the term “jazz”, depicting that the Respondent had express knowledge of the Complainant’s existence. This further indicates that the DDN is used in bad faith.

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 submissions made by the Parties, recognizes that the “JAZZ” and “JAZZCASH” marks are registered to the Complainant and the Respondent has no legitimate rights over it. Therefore, the continuous use of the DDN pertaining 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 violates 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 <jazzcash.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: Sunain Qazi

Sole Panelist

Date: 18 February 2024