

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

AIH General Merchandise UG (haftungsbeschränkt) & Co. KG vs Sheraz Ahmed

Case No. C2019-0001

Also in PDF C2019-0001

1. The Parties

The Complainant is AIH General Merchandise UG (haftungsbeschränkt) & Co. KG having its office at 10117 Berlin, Germany. The Complainant has initiated the Complaint vide their authorized representative, Sheikh Brothers having its office at 601, Al Ameera Centre, Shahrach-e-Iraq, Saddar, Karachi, Pakistan.

The Respondent's name is Sheraz Ahmed with his address at stated address at Bahawalpur, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <jumia.pk>, hereinafter referred to as the Disputed Domain Name. Vide email dated Monday, 8 October 2018, PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is Jumia, Bahawalpur, Pakistan and its Create Date was 2018-02-02 with an Expire Date of 2020-02-02.

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 02 August 2018. After initial review of the complaint by DNDRC, the Complainant completed the remaining formalities and intimated the same to DNDRC on 12 September 2018. On 14 September 2018, DNDRC wrote the PKNIC requesting PKNIC to provide complete details of the Respondent / Registrant of the Disputed Domain Name. On 08 October 2018, PKNIC provided complete details of the Respondent to DNDRC.

DNDRC issued notification of the dispute along with a copy of the Complaint and a Response Form to the Respondent on 08 October 2018 informing the Respondent that if a Response was not received 10 days from the notification, the dispute would be proceeded ex parte. On 12 October 2018, DNDRC issued a reminder of the notification. The Respondent failed to provide a response within the stipulated period.

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

Factual Background

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

PKNIC has confirmed via their email dated 08 October 2018 that the Disputed Domain Name has been registered by the Respondent specified in this decision, and that their email address is jumiapk.com@gmail.com

4. Parties Contentions

A. Complainant

The Complainant has provided detailed information regarding its use of the Jumia brand and Mark. According to the information provided by the Complainant, the Complainant is the owner of the domain name <jumia.com> which is being used in connection with an online e-commerce website. The Complainant has provided several statistics to demonstrate that the Jumia brand is a well-known mark associated with the Complainant.

The Complainant's main contentions are summarized below:

- A. The registration of the Disputed Domain Name by the Respondent is illegal and invalid being in violation of different provisions of the Trade Marks Ordinance, 2001.
- B. The Respondent has registered the Disputed Domain Name which is identical or confusingly similar to a trademark or service mark in which the Complainant has rights ie Trade Mark/Domain Name JUMIA.

- C. The Respondent has registered the Disputed Domain Name without any legitimate interest in the Disputed Domain Name.
- D. The Respondent has registered and used the Disputed Domain Name in bad faith.

Therefore, the Complainant seeks the following remedy:

“The Complainant prays that PKNIC be directed to transfer the domain name jumia.pk to them.

The Complainant alternatively prays that the domain name jumia.pk be challenged/revoked/expunged.”

B. Respondent

The Respondent has not submitted any response to DNDRC.

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

5. Jurisdiction

The Panel’s jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the Rules.

The Respondent applied for and was granted registration of the Disputed Domain Name on the basis of these regulations, and has submitted to, the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

6. Discussion and Findings

In the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website (http://www.dndrc.com/cases_resolved/pdf/c2007-0001)

[0001.pdf](#)), the Panel laid down the following four heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy, dated 07-Aug-2007, version 4.2 and the UDRP:

1. *Illegality, unlawfulness or otherwise invalidity of the Application & Registration (a criteria in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 in addition to the criteria of the UDRP)*
2. *Identical or confusing similarity to a trademark or service mark in which the Complainant has rights (a UDRP criteria)*
3. *Legitimate interest in Domain Name (a UDRP criteria)*
4. *Registration and use in bad faith (a UDRP criteria)*

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

- i. *Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 criteria).*
- ii. *Identical or confusing similarity with a trademark or service in which the Complainant has rights (a UDRP criteria).*
- iii. *Legitimate interest in the domain name (a UDRP criteria).*
- iv. *Registration and use of the domain name in bad faith (a UDRP criteria).*

I. Illegality, unlawfulness or otherwise invalidity of the Application & Registration

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

- a. *infringes upon a registered tradename,*
- b. *is not bona fide as recognized by international best practice,*
- c. *in the opinion of PKNIC, a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,*
- d. *has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law),*
or
- e. *in the opinion of PKNIC is not appropriate for registration.*

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

If a party claims that a domain name already registered with PKNIC violates their registered tradename, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, PKNIC reserves the right to cancel, or transfer the domain to the claiming party as per the ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.

Therefore, for the purpose of assessing illegality, unlawfulness or otherwise invalidity of the Application & Registration of the Disputed Domain Name, the application and registration of the Disputed Domain Name shall be assessed in consideration of the following criteria:

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

The Panel will deal with each of these sub-issues sequentially below.

i. Whether the Disputed Domain Name infringes upon, or is an obvious derivation of, a registered trade name / trade mark?

The Complainant has stated that the JUMIA mark is a well-known mark of the Complainant, and that the Complainant is the owner of the domain name / trademark “Jumia.com”. The Complainant has also annexed details of 87 marks incorporating the word “JUMIA” that it has applied for or obtained registrations of in different jurisdictions. According to the information provided by the Complainant, the trademark registrations have been obtained as early as the year 2012.

The registered trademark “JUMIA” appears to be incorporated in its entirety in the Disputed Domain Name <jumia.pk> and thus the Disputed Domain Name appears to infringe upon, or is at the least an obvious derivation of the registered trade mark.

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

The Panel therefore finds that the Disputed Domain Name <jumia.pk> incorporates the registered trade mark of the Complainant in its entirety, and that such an infringement constitutes an infringement of the trademark registrations of the word JUMIA that are held by the Complainant.

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

The Complainant has been offering its services under the trade mark JUMIA in a number of countries since 2012, well before the Respondent registered the Disputed Domain Name in 2018. By the time the Respondent registered the Disputed Domain Name, according to the information provided by the Complainant, the Complainant had established itself in 14 African countries with over 1.2 billion customers.

The Complainant has rightly stated that the word JUMIA does not have any ordinary meaning in both the English and Urdu language dictionaries, so in the absence of any response from the Respondent, the Panel is unable to reasonably assume or infer bona fide on part of the Respondent with respect to the Respondent's intentions/reasons for using the word "JUMIA" to register a domain name.

Hence, the Panel finds that the Respondent has failed to demonstrate that the registration of the Disputed Domain Name is bona fide.

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

Prior to discussing this sub-issue, it is pertinent to clarify the grounds for examining relevant Pakistani law provisions. Although Pakistani law does not apply by force of law over PKNIC's jurisdiction, by operation of the PKNIC- Internet Domain Registration Policy Aug 07, 2007 version 4.2, it is necessary to examine provisions of the Penal Code and other applicable criminal laws. It is in this spirit and for this purpose alone that the following provisions of Pakistani law are being analyzed. The ordinances, and the sections mentioned herein below, have been discussed at length in *Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001)*.

Trade Marks Ordinance, 2001

40. Infringement of registered trade mark.-

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

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

Electronic Transactions Ordinance, 2002 (“ETO”)

3. Legal recognition of electronic forms.—

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

Penal Code

478. Trade mark.

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

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

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

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

479. Property mark.

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

480. Using a false trade mark.

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

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

481. Using a false property mark.

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

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

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

As decided in *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001), the use of a false property mark (which includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages) with the reasonable expectation that people would be misled to believe that the trade mark or trade name or domain name belongs to a person to whom it does not belong may also constitute an offence under the Penal Code.

The Complainant has also identified several of the above-mentioned provisions of the Trade Marks Ordinance, 2001 to have been infringed by the Respondent when registering the Disputed Domain Name.

The Panel, therefore, is of the view that the Respondent's registration of the Disputed Domain Name may attract the above-mentioned provisions of the Trade Marks Ordinance, 2001, Penal Code and ETO. The Panel may decide this Complaint on this basis alone. However, for the sake of completeness and procedural fairness, but not to create a binding precedent, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

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

The Complainant has contended that the disputed Domain Name identical or confusingly similar to trademarks in which the Complainant has rights. In support of this contention, the Complainant has provided details of 87 trademarks (and trademark applications) that incorporate the word "JUMIA".

The Respondent, by not providing a response, has failed to refute the contentions put forth by the Complainant with regard to the trademark of the Complainant. It is an established principle that the incorporation of a Complainant's trade mark in full within a disputed domain name may be sufficient to establish confusing similarity between the mark and the disputed domain name (see *Nokia Group v. Mr. Giannattasio Mario*, WIPO Case No. D2002-0782, *The Ritz Hotel Ltd v. Damir Kruzicevic*, WIPO Case No. D2005-1137).

It is apparent that the Disputed Domain Name reproduces the trademark owned by the Complainant in its entirety. The Complainant has provided information that shows that the Complainant has rights in the trademark reproduced in the Disputed Domain Name. In the absence of any information provided by the Respondent, the Panel reasonably opines that this renders the Disputed Domain Name confusingly similar to the trademark of the Complainant under paragraph 4(a)(i) of the Policy.

III. Legitimate interests in a domain name

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

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

Paragraph 4(a)(ii) states that:

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

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

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

The Complainant has contended that the Respondent has registered the Disputed Domain Name without any legitimate interest in the same. According to the Complainant, the word “JUMIA” does not have any ordinary meaning in either the English or Urdu language dictionaries, and thus it is for the Respondent to rebut the absence of legitimate interest in the Disputed Domain Name or the JUMIA mark.

The Respondent has not submitted a Response, nor has it provided any information, annexures, evidence, documentation or the like to support its registration of the Disputed Domain Name or to assert a legitimate interest in the Disputed Domain Name. There is no evidence before the Panel that suggests that the Respondent was known, let alone well-known, by the Disputed Domain Name or the JUMIA mark.

As has been previously adopted by the discussions and findings in WIPO Authorities, it is for the Respondent to rebut the allegations put forth by the Complainant. Also, with respect to proving rights or legitimate interests in a disputed domain name, it is for the Respondent to submit evidence pertaining to the same as it would be almost impossible, if not extremely difficult for the Complainant to prove a negative assertion. As such, in order to satisfy the Panel that it has rights or legitimate interests to the Disputed Domain Name, the Respondent was obliged to submit evidence with respect to the same.

In the absence of any information provided by the Respondent in support of his legitimate interest in the Disputed Domain Name, the Panel based on the information provided by the

Complainant finds that the Respondent does not have rights or a legitimate interest in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

IV. Registration and use in bad faith

The Complainant has contended that the registration and use of the Disputed Domain Name by the Respondent is in bad faith and is not bona fide. At the time the Disputed Domain Name was registered, the Complainant had established a reputation as a leading e-Commerce provider in the Africa region. Though the Complainant had not launched services in Pakistan, the brand name may have been known to the Respondent at the time of the registration.

Though the Complainant has contended that the Respondent is using the Disputed Domain Name to offer services that are identical to those offered by the Complainant under its JUMIA brand, the Panel has observed that the website resolved by the Disputed Domain Name is currently inactive. However, the WIPO Overview 3.0 provides: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding." (Section 3.3, WIPO Overview 3.0).

The Respondent has chosen not to respond to Complainant's allegations. It has previously been held in WIPO authorities that the Respondent's failure to respond to the Complaint supports an inference of bad faith (*The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. D2009-0610).

Given the above, the Panel finds that the registration and use of the Disputed Domain Name by the Respondent is in bad faith.

7. Decision

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

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

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

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

Arbitrator: Mr. Abbas Lotia

Sole Panelist

Date: 15 January 2019