

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Amazon Technologies, Inc. vs Amazonprime.pk

Case No. C2019-006

Also in PDF C2019-006

1. The Parties

The Complainant is Amazon Technologies, Inc. having its office at Nevada Corporation, 410 Terry Ave. N. Seattle, Washington 98109, USA. The Complainant has initiated the Complaint vide its authorized representatives Mr. Kazim Raza Abbasi and Mr. Muhammad Asad A&A Associates having their office at Room # 306-307, Asad Chamber, Shumbonath Street, Saddar, Karachi, Pakistan.

The Respondent's name is Amazonprime.pk, with its address in Lahore.

2. The Domain Names and Registrar

The domain name in dispute is <amazonprime.pk>, hereinafter referred to as the Disputed Domain Name. Vide email dated 6 September 2019, PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is It&M Solutions through their contact Tariq Shah, with a registered office at M-40, First Floor, Gold Mine Plaza, Ichra, Lahore, Pakistan and its Create Date was 21-11-2017 with an Expire Date of 21-11-2019.

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 2 September 2019.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 11 September 2019. In this notification, the Respondent was informed that if a Response was not received 10 days from the notification, the dispute would be proceeded ex parte. DNDRC issued reminder notifications to the Complainant on 19 September 2019. The Respondent failed to submit a response within the stipulated period

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Rafay Baakza 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 <amazonprime.pk>.

PKNIC has confirmed via their email dated 6 September 2019 that the Disputed Domain Name has been registered by the Respondent above-named and that the email address provided at the time of registration is <tareqsh.shaw@gmail.com>

4. Parties Contentions

A. Complainant

The factual and legal grounds stated in the Complaint are reproduced below:
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FACTUAL GROUNDS

- (i) *The Complainant operates in the business of electronic commerce and cloud computing and is one of the global leaders in the field of online shopping and providing an online marketplace offering for sale (either directly or through third party vendors) a diverse range of products, including but not limited to, books, consumer electronics, sporting goods, gourmet foods and groceries, including its own branded products and services provided under inter alia, AMAZON, PRIME and AMAZON PRIME trademarks .The Complainant is the proprietor of the well-known AMAZON Marks by virtue of worldwide registrations of the AMAZON Marks including logos and other associated AMAZON trademarks (such as PRIME and AMAZON PRIME).*
- (ii) *The Complainant's website "amazon.com" (located at the URL "http://www.amazon.com") is one of the most popular retail websites and enjoys millions of visitors a day from countries around the world, including Pakistan. The AMAZON Marks are among the most recognized brand names worldwide, both on the Internet and or otherwise. Some of the well-known goods and services developed by the Complainant include inter alia, ECHO, ALEXA, PRIME VIDEO and AMAZON PRIME, all of which are sold under or by reference to the AMAZON Marks.*
- (iii) *Amazon.com Inc. was founded by Jeff Bezos on 5 July 1994 and today is the largest internet retailer in the world in terms of revenue and market capitalization. The website "amazon.com" started as an online bookstore and later diversified to sell video downloads/streaming, MP3 downloads/streaming, audiobook, downloads/streaming,*

software, video games, electronics, apparel, furniture, food, toys, and jewellery, and allowed small scale manufacturers and retailers a platform to make their products available to the world. Amazon further produces consumer electronics goods such as Kindle e-readers, Fire tablets, Fire TV, and Echo under their own brand name and is one of the world's largest provider of cloud infrastructure and also sells certain low-end products under its in-house brand Amazon Basics. Attached hereto and collectively marked as Exhibit 8 are copies of the pages downloaded from Amazon.com's website "www.amazon.com" and other websites containing the historical background of the business. Also attached hereto and collectively marked as Exhibit 9 are copies of the Complainant's business, products and services offered online showing extent of use of the AMAZON Marks on amazon.com.

- (iv) The AMAZON Marks have, since at least as early as 1994, been and continue to be used extensively in many countries throughout the world by the Complainant and or its affiliates/subsidiaries. Amazon generated, between the years 2015 and 2018 substantial amounts in revenue (as shown below) from the conduct of the online business under the AMAZON Marks and from the sale of services and goods bearing the AMAZON Marks during that period. Amazon's products bearing the AMAZON Marks are currently available around the world including in Pakistan through its website "www.amazon.com" and the growth of Amazon's business worldwide has been significant and impressive. Attached hereto and marked as Exhibit 10 are copies of Amazon's Annual Report to the Securities Exchange Commission, USA covering the financial years 2015, 2016 and 2017 respectively that show the international net sales figures as follows:

Year	Annual Sales in USD
2015	\$35.418B
2016	\$43.983B
2017	\$54.297B

Also attached hereto and marked as Exhibit 11 is a list of countries in which Amazon delivers goods and provides services under the AMAZON Marks.

- (v) Amazon has recently extended its international presence by also offering goods and services directly in Pakistan. Also attached hereto and marked as Exhibit 12 are screenshots of goods and services that are eligible for shipping and delivery in Pakistan.

- (vi) *Far-reaching advertising and promotional efforts by the Complainant and its associated companies have further established and enhanced the reputation of the AMAZON brand and marks. Over the years various Amazon branded products have been advertised or featured online and in various international magazines and AMAZON is listed as a valuable global brand. These include publications such as the The Economist, Forbes, Fortune, Bloomberg Business Week, Money, The New Yorker, Newsweek, People, Time, Vanity Fair, Rolling Stone, Entertainment Weekly, Playboy, Esquire, Good Housekeeping and Sports Illustrated as well as in Best Global Brands, The Global Top Hundred, Brand Finance 100 Global, www.interbrand.com. As a result of extensive advertising, use and commercial success, the AMAZON Marks have created enormous monetary value, become famous, and it is currently ranked as the world's most valuable brand after being consistently ranked as one of the most well-known and recognizable brands globally for several years. The AMAZON Marks are symbols of the Complainant's reputation and valuable goodwill, and have become, through extensive use and advertising, famous and well-known marks throughout the world, including in Pakistan, and represent assets of incalculable value to the Complainant. Amazon's worldwide expenditures on advertising and other promotional costs since 2010, which currently consist of primarily online advertising, are shown in the table below:*

Year	Advertising Expenditure
2010	\$890 million
2011	\$1.4 billion
2012	\$2.4 billion
2013	\$3.1 billion
2014	\$3.3 billion
2015	\$3.8 billion
2016	\$5 billion
2017	\$6.3 billion
2018	\$8.2 billion

- (vii) *In addition, the Complainant and its associated and/or affiliated companies own several other top level domain names incorporating the "AMAZON" trademark, including but not limited to 'amazon.com', 'arnazon.com.pk', 'amazon.ca', 'amazon.com.au', 'amazonshopping.shop', 'amazon.in', 'amazon.co.in', 'amazon.fr', 'amazon.de', 'amazon.it', 'amazon.co.jp', 'amazon.com.mx', etc. which clearly evidences the Complainant's international presence. Ownership details of these domain names as*

available at the relevant registrar's website are attached hereto and marked as Exhibit 13.

- (viii) *Most of the AMAZON Marks contains the word "Amazon" as the principal element of the mark and/or logo. Furthermore, the word "Amazon" forms an essential part of the trade name of the Complainant and of a number of other associated companies/subsidiaries of Amazon.*
- (ix) *The Complainant is the exclusive proprietor of the valuable rights enjoyed by it in respect of the AMAZON Marks, which registrations clearly pre-date any use of the Disputed Domain Name, in a number of countries around the world, including Pakistan, and as such, the use of the AMAZON Marks or any of them or any variation by any company or person in those countries, including a Pakistani company or person, without the permission, consent or license of the Complainant is bound to be dishonest and only motivated by an attempt to deceive or confuse the public into believing that such company or person's business and the associates services and/or products are related to or associated with the Complainant in some or the other manner and will constitute infringement of the exclusive rights vested in the Complaint or its affiliates.*
- (x) *The Respondent, without any permission or authorisation from the Complainant, has on 21 November 2017 secured a domain name registration for "amazonprime.pk" (the subject Disputed Domain Name) [see Exhibit 1]. which consists of the Complainant's AMAZON and PRIME Trade Mark in its entirety with generic cc TLD. Furthermore, the Respondent's Disputed Domain Name is redirected to the web site <https://www.amazonprime.pk>, through which website the Respondent promotes the infringing business activities by offering online shopping services in Pakistan using the well-known AMAZON Marks of the Complainant's. [Please refer to Exhibits 1 and 2].*
- (xi) *The website, www.amazonprime.pk, displays information with regard to an entity trading under an infringing name, 'Amazon Prime', allegedly located at Lahore, Pakistan and further claiming to be affiliated with the Complainant, which is hereby expressly stated as being untrue, and engaged in the same business as that of the Complainant in connection with online shopping, i.e. offering services for the delivery of goods sold by the Complainant. The Respondent's website, by using the well-known AMAZON Marks of the Complainant and further falsely claiming affiliation with the Complainant gives a false impression to the Complainant's customers in Pakistan that the Respondent has some association or arrangement with the Complainant for the delivery of the Complainant's goods and services in Pakistan, which is not true. In this*

regard, rest assured, Amazon will be taking all possible actions against the Respondent to prevent infringement of its registered rights in the name and trade mark AMAZON and AMAZON.COM in Pakistan.

- (xii) *The Respondent continues to unauthorizedly hold the registration for the Disputed Domain Name "amazonprime.pk" [see Exhibit 1] and are to date operating the corresponding email address 'sales@amazonprime.pk' and the website, www.amazonprime.pk, the use of all of which infringe the exclusive rights vested in the Complainant in respect of the AMAZON Marks. The use of the aforementioned email address and website (as it appears) are being used for the benefit of the Respondent's infringing business, amazonprime.pk, which, as per their website, claims to be and is engaged in the unauthorized delivery of products being sold by the Complainant in Pakistan, while the Respondent has not been engaged by the Complainant, nor has any association or relationship with the Complainant. The use of the infringing domain name infringes the exclusive rights vested in the Complainant in respect of the AMAZON Marks and further misleads the general public, including the Internet users in Pakistan and elsewhere, leading them to believe that the Disputed Domain Name and the corresponding email address and website mentioned above are authorised and/or controlled by the Complainant or persons having a business connection with the Complainant, which is not the case..*

LEGAL GROUNDS

- A. *The Disputed Domain Name is identical or confusingly similar to the trademarks and service marks in which the Complainant has rights [ICANN Policy, para. 4(a)(i); ICANN Rules, para. 3(b)(ix)(1)].*
- B. *The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name [ICANN Policy, para. 4(a)(ii), 4(c); ICANN Rules, para. 3(b)(ix)(2)].*
- C. *The Disputed Domain Name was registered and is being used in bad faith [ICANN Policy, paras. 4(a)(iii), 4(b); ICANN Rules, para. 3(b)(ix)(3)].*
- D. *The Disputed Domain Name vis-a-vis Respondent contravenes the provisions of the Policy Agreement [which is a part of the domain registration form) and the PKNIC - Internet Domain Registration Policy, as amended lately on 7 August 2007, ver. 4.2 [which is incorporated by reference into the PKNIC Policy Agreement].*

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 to de-register/cancel the infringing domain name registration of "amazonprime.pk".

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 Version 4.4 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 Version 4.4 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 PKNIC - Internet Domain Registration Policy Version 4.4 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 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 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 4.4,

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 Complainant has stated:

The unauthorized adoption and registration by the Respondent of the Disputed Domain Name (which consists of the Complainant's registered and well-known AMAZON and PRIME trade marks) 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 AMAZON Marks or any of them in Pakistan, and also passes off its respective business, website, domain name and/or email address as and for the business, website, domain name and/or email address of the Complainant or its affiliated companies and further unfairly competes with the Complainant's business and/or the AMAZON 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 lead them to believe that the Disputed Domain Name, website, email address and/or business is authorised or controlled by the Complainant or persons having a business connection with the Complainant, which is not the case.

The unauthorized 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 23. 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 18 supra).

In view of the above, there is no doubt that the disputed domain name and/or the Respondent contravenes the provisions of the Policy Agreement and the PKNIC - Internet Domain Registration Policy (attached hereto collectively as Exhibit 24), 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.

(c) The Respondent has intentionally registered and used the Domain Name violating the Policy Agreement and the PKNIC - Internet Domain Registration Policy. In this regard before approaching the Honourable DNDRC Tribunal the Complainant through it lawyers approached PKNIC on the basis of its registered prior rights in the AMAZON Trade Marks for resolution of the matter whereupon the complainant was directed to approach the DNDRC forum. Hence the subject complaint is being filed upon such direction by PKNIC in Pakistan.

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 18 supra) 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.

This Panel has reviewed the extensive information provided by the Complainant to demonstrate the illegality, unlawfulness or otherwise invalidity of the application and registration of the Disputed Domain Name, including the provisions of the Pakistan Trade Marks Ordinance, 2001 and the Pakistan Penal Code 1860. It is clear to this Panel from the information provided that the Complainant owns registered trademarks of the mark “AMAZON” both in Pakistan and around the world, which constitutes the primary part of the Disputed Domain Name.

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

In view of the detailed information submitted by the Complainant and in the absence of any response from the Respondent, the Panel finds that the Disputed Domain Name is an obvious derivation of the marks in which the Complainant enjoys rights, and that the application and registration of the Disputed Domain Name was illegal. As correctly submitted by the Complainant, 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 Version 4.4.

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

The Complainant has contended the following:

The facts and evidence provided in paragraphs (i) to (ix) above clearly demonstrate that the name Amazon and the AMAZON Marks or any of them are the exclusive property of the Complainant, who prima facie has the prior registered right to use the name Amazon and the AMAZON Marks in relation to inter alia online shopping and related web-based services and products, throughout the world, including in Pakistan. The WIPO/ICANN panelists have also found that the AMAZON trademark is well-known and famous and upheld the Complainant's rights in respect of the AMAZON Marks in a number of earlier UDRP cases, such as Amazon.com Inc. and Amazon Technologies Inc. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)/Mike Tyson (Case No. 02017-2508, dated 31 January 2018), Amazon.com, Inc., Amazon Technologies, Inc., Amazon Europe Core S.a.r.l. v. Koroush Amini (Case No. 02017-0427, dated 20 April 2017) in which cases the panel was of the view that the use of the Complainant's well-known and famous trademark AMAZON is likely to deceive users of the disputed domain name in respect of an association with the Complainant, and Amazon.com, Inc. and Amazon Technologies, Inc. v. Vedran Hochberger

(Case No. 2017-2382 dated 26 January 2018) in which case the panel was of the view that "AMAZON is a famous trademark with widespread international recognition and goodwill."

Furthermore, the National Arbitration Forum has held in the case titled *Amazon Technologies, Inc. v. Global Service Box Prime S.L.*, FA1806001791557 (Nat. Arb. Forum July 4, 2018) that the AMAZON Mark has become "one of the most recognized marks around the world" and that AMAZON and AMAZON PRIME are "famous trademarks") and in the case titled *Amazon Technologies, Inc. v. Bruguier I Adsholics*, FA1804001784455 (Nat. Arb. Forum May 25, 2018) has held that "Complainant owns the mark PRIME and uses it in conjunction with its well-known online retail store. The mark is famous". In the case of *Amazon Technologies, Inc. v. German Ramirez I Elite Cleaning Concepts, LLC*, FA1901001826462 (Nat. Arb. Forum February 17, 2019) also, the National 12 Arbitration Forum has held that "Complainant owns the marks AMAZON.COM and PRIME and uses them to provide online retail services. The marks are famous." Copies of the aforementioned decisions are attached hereto as Exhibit 15.

The disputed domain name consists of the components AMAZON and PRIME, both of which are registered trademarks of the Complainant in Pakistan. The name/mark AMAZON forms the principal element of the trade name of the Complainant and its associated/affiliated companies and of the various domain names owned and registered by the Complainant and/or its associated/affiliated companies such as Amazon.com Inc. As stated by the WIPO Panel in *Dr. Ing. H.c.F. Porsche AG v. Vasi/iy Terkin* (Case No. 02003-0888, dated 6 January 2004 [copy attached to Exhibit 19 supra], a domain name that wholly incorporates a complainant's registered trade mark is sufficient to establish confusing similarity, in this respect we invite your kind attention to the case titled *Janus Int'l Holding Co. v. Rademacher*, 02002-0201 (WIPO Mar. 5, 2002) wherein WIPO held that "Panel decisions have held that registration of a mark is prima facie evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive. Respondent has the burden of refuting this assumption".

The additional element '.PK' is insufficient to negate the confusing similarity between Respondent's domain name and Complainant's famous mark, especially where the same is merely a ccTLD. Reliance is placed on the following cases wherein the use of an additional feature (such as a ccTLD) does not make the domain name in dispute sufficiently distinct from the trademarks of the complainants: *Hewlett-Packard Dev. Co. L.P. v. Surya Tech.*, FA0708001059665 (Nat. Arb. Forum Oct. 2, 2007) ("the addition of the gTLD are not sufficient to differentiate a domain name from a known mark"); *Dell Inc. v. Protection of Private Person I Privacy Protection*, FA1606001681432 (Nat. Arb. Forum Aug. 1, 2016) ("A TLD (whether a gTLD, sTLD or ccTLD) is disregarded under a Policy 1J 4(a)(i) analysis because domain name syntax requires TLDs"); *BIC Deutsch/and GmbH & Co KG v. Paul Tweed* (WIPO Case No. 02000-0418, dated 20 June

2000; Zwiesel Krista/lg/as AG v. WWW Enterprise Inc. (Case No. 02005-1223, dated 23 January 2006); LG Chemical Ltd v. ChangHwan, OH (Case No. 02000-0889, dated 25 September 2000); and Rosemary Conley Diet and Fitness Clubs Limited v. Nikolina Bartels-King (Case No. 02006-1401, dated 18 January 2007). It is also important to note that WIPO has stated in its publication titled 'WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Ed. under paragraphs 1.2.1 and 1.12 that "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case"; Where the complainant's trademark is recognizable within the disputed domain name, the addition of other third-party marks (i.e., <mark1+mark2.tld>), is insufficient in itself to avoid a finding of confusing similarity to the complainant's mark under the first element of the UDRP."

Further, as held by the DNDRC itself in the recent decision of Amazon Technologies, Inc. vs Amazon Shopping (Case No. C2019-0002) in favour of the present Complainant, "It is well-established that the addition of a cc TLD ".PK" is not relevant to the analysis of identicalness or confusing similarity." Copies of these decisions/cases are attached hereto as Exhibit 16.

The Complainant also relies on the decision of the WIPO Arbitration and Mediation Center in Asset Loan Co. Pty Ltd v Gregory Rogers (Case No. 02006-0300) wherein it was held that " ... when comparing a domain name and a trademark for the present purposes, the exercise must involve only a straight comparison of the two names without regard to the contents of the website to which the contentious domain name resolves". In support of the foregoing, the panel also referred to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions where it said at 1.2 that:

"1.2 Is the content of a web site relevant in determining confusing similarity?

Consensus view: The content of a website (whether it is similar or different to the business of a trademark owner) is irrelevant in the finding of confusing similarity. This is because trademark holders often suffer from "initial interest confusion", where a potential visitor does not immediately reach their site after typing in a confusingly similar domain name, and is then exposed to offensive or commercial content. The test for confusing similarity should be a comparison between the trademark and the domain name to determine the likelihood of confusion".

A copy of the abovementioned case has been attached hereto and marked as Exhibit 17.

Furthermore, the also Complainant relies on the analysis and findings of the Pakistan DNDRC Panel in the following matters:

- (a) *in the matter of Standard Chartered PLC v. Hosting Campus Domain (Case No. C2007-0001, dated 30 August 2007) wherein it was held that irrespective of the contents of the website or the goods and services offered on the website, as long as the domain name in dispute is confusingly similar or identical to the trade mark in question, the use of the domain name would be an infringement of the registered trademark;*
- (b) *In the matter of Pakistan Herald Publications (Private) Limited. v. Averroes Sapertise Management, (Case No. C2011-0001, dated 30 March 2011) wherein it was held that on account of the popularity and goodwill subsisting in the complainant's trademark 'DAWN', and the fact that trademark registrations had been obtained not just in Pakistan but in various countries around the world was sufficient to show that the domain name registration had been obtained in bad faith and on the basis of inter alia the same the complaint was allowed and the domain name registration was cancelled;*
- (c) *In the matter of Google Inc. v. Starcom Systems, Case No. C2013- 0004, dated 21 September 2013 wherein it was held that upon evidence of mala fide intention on the part of a registrant of a domain name is sufficient ground to cancel the registration of the domain name and that it is the duty of the respondent to rebut any of the contentions made by the proprietor of the registered trademark.*

Copies of these abovementioned cases are attached hereto as Exhibit 18.

Based on the above submission, there can be no doubt that the Disputed Domain Name “amazonprime.pk” is identical and/or confusingly similar to the AMAZON Trade Marks in the Complainant has prior exclusive rights.

The Respondent has not submitted any response to the submission of the Complainant that the Disputed Domain Name is confusingly similar to the AMAZON mark in which the Complainant has rights.

It is clear to this Panel from the information provided that the Complainant owns registered trademarks of the mark “AMAZON” both in Pakistan and in many other jurisdictions, and that the Complainant is also the owner of the registered trademarks of the mark “PRIME” in many other jurisdictions, and that the trademark “PRIME” has been filed for registration in Pakistan as well. The Panel must consider whether the Disputed Domain Name is identical or confusingly similar to the registered marks of the Complainant.

The Disputed Domain Name incorporates the mark of the Complainant followed by “prime.pk”. The insertion of the suffix “prime.pk” means that the Disputed Domain Name is not identical to the mark of the Complainant. It needs to be analyzed whether the addition of “prime.pk” is sufficient to negate confusing similarity with the mark of the Complainant.

It is well-established that the addition of a ccTLD “.PK” is not relevant to the analysis of identicalness or confusing similarity. The Complainant has relied on several cases that support the contention that the insertion of the word “prime” also does not take away from identicalness or confusing similarity. The Panel is of the view that the mere addition of a generic term that is descriptive of the business of the Complainant – and by which the Complainant is well known all over the world including in Pakistan - does not take away from the confusing similarity of the Disputed Domain Name to the mark of the Complainant.

Though the Disputed Domain Name wholly incorporates the mark of the Complainant, the Respondent has failed to refute the allegation that the Disputed Domain Name is confusingly similar to the mark of the Complainant. Hence, the Panel finds that the Disputed Domain Name is confusingly similar to the mark of the Complainant.

III. Legitimate interests in a domain name

The Complainant has contended:

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

*The Respondent's Disputed Domain Name is redirected to a website, which website promotes the infringing business activities of **Amazon Prime/AmazonPrime.pk**, Lahore and the landing page for the disputed domain displays the AMAZON and PRIME Marks prominently. The Complainant has neither authorized nor licensed the Respondent to register the Disputed Domain Name and/or to use, or facilitate the use of, the Disputed Domain Name in relation to the offending website. The Respondent has no affiliation with the Complainant or any of its related companies.*

*The Complainant further believes that the Respondent has adopted and falsely obtained registration of the disputed domain name '**amazonprime.pk**' with mala fide intentions to ride on the accrued reputation and goodwill subsisting in the AMAZON and PRIME trademarks of the*

Complainant. Thus, Respondent has not registered the Disputed Domain Name to make a bona fide offering of any goods or services, rather misleading the internet users into believing that there is some association with the Complainant and to benefit from the accrued goodwill and reputation in the AMAZON and PRIME trademarks. The Respondent has therefore misappropriated the AMAZON Marks owned by the Complainant.

The Respondent is clearly not making a non-commercial, fair use of the Disputed Domain Name. Through the use of the Domain Name (which consists of the Complainant's famous trade marks AMAZON and PRIME) the Respondent is intentionally attempting to attract the general public, including the Complainant's customers and the Internet users to the corresponding website (which website promotes the infringing business activities of the Respondent, by creating a likelihood of confusion with the AMAZON Marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's Disputed Domain Name and the corresponding website. As a result, the Respondent's use cannot constitute a fair, noncommercial use.

On the other hand, the Respondent has failed to provide any information in support of the contention that the Respondent has a legitimate interest in the Disputed Domain Name.

The Complainant has stated that the Respondent was not authorized or licensed to use the Complainant's mark AMAZON and PRIME in the Disputed Domain Name or on the website to which the Disputed Domain Name resolves. This Panel has reviewed the materials submitted by the Complainant that show the Respondent was using the Disputed Domain Name to mislead users of the internet into believing that the website to which the Disputed Domain Name resolves was in some way affiliated with the Complainant.

Hence, this Panel finds that the Respondent does not have a legitimate interest in the Disputed Domain Name.

IV. Registration and use in bad faith

The Complainant has made the following submission:

Sub-paragraph 4(b)(ii) of the ICANN Policy allows for a finding of bad faith when the registration was acquired to prevent a trade mark owner from reflecting the mark in a corresponding domain name. When Respondent acquired the Disputed Domain Name, it had constructive knowledge of the AMAZON Marks via the Complainant's trade mark registrations and use in Pakistan (as well as in numerous other countries around the world); and therefore, had actual knowledge that the AMAZON Marks were used in

relation to online shopping, internet store and related services for years prior to its registration, due to the fame of the AMAZON Marks. Notwithstanding this knowledge and complete lack of authorization, Respondent intentionally registered the Disputed Domain Name containing the famous AMAZON and PRIME trademarks, without authorization, for use in relation to a website used to promote the infringing business activities of the Respondent, and a corresponding email address. As stated by the WIPO Panel in Kraft Foods (Norway) v. Fredrik Wide and Japp Fredrik Wide (Case No. 02000-0911, dated 23 September 2000 - copy attached as Exhibit 19), 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".

Further, as held by the DNDRC itself in the recent decisions in favour of the present Complainant (copies attached as Exhibit 20): Amazon Technologies, Inc. vs Domeinent Cargo and Logistics (Case No. C2019-0003), " ... this Panel finds that it is unlikely that the Respondent was not aware about the Complainant's mark AMAZON at the time of registration and use of the Disputed Domain Name, especially given that the Respondent used the Disputed Domain Name to offer online shopping, internet store and related services which are near-identical to services offered by the Complainant using its mark AMAZON. Hence this Panel finds that the registration and use of the Disputed Domain Name by the Respondent is in bad faith." and Amazon Technologies, Inc. vs Amazon Shopping (Case No. C2019-0002), " ... this Panel finds that it is implausible that the Respondent was not aware about the Complainant's mark AMAZON given that the Respondent used the Disputed Domain Name to offer online shopping, internet store and related services which are near identical to services offered by the Complainant using its mark AMAZON. Hence this Panel finds that the registration and use of the Disputed Domain Name by the Respondent is in bad faith."

ICANN Policy, sub-paragraph 4(b)(iii), allows a finding of bad faith if the registration is primarily for the purpose of disrupting the business of a competitor. Respondent's action in registering the Disputed Domain Name is likely to deprive the Complainant of "the chance to be contacted by prospective customers" - see SGS Societe Generale de Surveillance S.A. v. Inspectorate (WIPO Case No. 02000-0025, dated 17 March 2000 – copy attached as Exhibit 21); especially since the Disputed Domain Name and the corresponding website (which promotes the infringing business activities of the Respondent) and the corresponding email address would pass off as a legitimate, authorized website and email address of the Complainant in Pakistan. As noted, the Respondent is not an authorized licensee of the Complainant and is therefore falsely claiming association with the Complainant on its infringing website under the Disputed

Domain Name. Furthermore, a customer who checks a WHOIS database may adopt the mistaken belief that Respondent has an affiliation with the Complainant or its licensees based on its registration of a domain name and the corresponding email address and website that contains the AMAZON and PRIME trademarks.

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 online 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. 02000-0766, dated 21 September 2000 - copy attached as Exhibit 22), found that the use of the domain name by the Respondent therein would lead visitors to the belief that the domain name was affiliated with the Complainant, therefore making the registration alone equal to use in bad faith. In sum, Respondent's registration and use of the Disputed Domain Name has been in bad faith.

Furthermore, given the Complainant's prior established goodwill and proprietary rights in the AMAZON Marks, the registration of the Disputed Domain Name by the Respondent is clearly in bad faith with an attempt to misappropriate and cash on and to trade unfairly upon the worldwide reputation and goodwill enjoyed by the Complainant. (The Pakistan Herald Publications (Private) Limited. v. Averroes Sapertise Management, (Case No. C2011-0001, dated 30 March 2011 copy attached as Exhibit 18 supra).

The Respondent on the other hand has not provided any information in support of the contention that the Disputed Domain Name has been registered or is being used in bad faith.

After reviewing the information submitted by the Complainant, this Panel finds that it is unlikely that the Respondent was not aware about the Complainant's mark AMAZON and PRIME at the time of registration and use of the Disputed Domain Name, especially given that the Respondent used the Disputed Domain Name to offer online shopping, internet store and related services which are near-identical to services offered by the Complainant using its mark AMAZON and PRIME. Hence this Panel finds that the registration and use of the Disputed Domain Name by the Respondent is in bad faith.

7. Decision

After analysis of the Complaint (and supporting information) and the Response, the Panel has found that the AMAZON mark has been registered by the Complainant and that the PRIME mark

has been filed for registration with the Trade Mark authorities in Pakistan, and has faced no objection to date, hence the Complainant reserves crucial interest in such mark(s). 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 Version 4.4
2. The Respondent has no legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Name is confusingly similar 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 Version 4.4, and Section 4 of the Policy, the Panel therefore recommends that PKNIC transfer the registration of the domain name in dispute <amazonprime.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: Rafay Baakza

Sole Panelist

Date: 30 October 2019