

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Accenture Global Services Limited. vs AccentureAnalytics.com.pk

Case No. C2019-0007

Also in PDF C2019-0007

1. The Parties

The Complainant is Accenture Global Services Limited, with its registered address at 3 Grand Canal Plaza, Grand Canal Street, Upper Dublin 4, Ireland. 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 AccentureAnalytics.com.pk and the point of contact is Mustafa Ali having address at 12 CCA Street 7, Floor 1, DHA Phase 4, Lahore, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <accentureanalytics.com.pk> hereinafter referred to as the Disputed Domain Name. Vide email dated 16-9-2019 PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is PAKANALYTICS having its address at 12 CCA Street 7, Floor 1, DHA Phase 4, Lahore, Pakistan and its Create Date was 8-10-2018 with an Expire Date of 8-10-2020.

3. Procedural History

DNDRC was informed of the Complaint against the Respondent as per PKNIC - Internet Domain Registration Policy, by notification from the Complainant on 10-9-2019.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 23-9-2019. 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. The Respondent submitted a response vide the Response Form dated 27-9-2019

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

PKNIC has confirmed via their email dated 16-9-2019 that the Disputed Domain Names have been registered by the Respondent above-named and that the email address provided at the time of registration is amustafa70@yahoo.com

4. Parties Contentions

A. Complainant

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

FACTUAL GROUNDS

As used herein, "Complainant" or "Accenture" includes Accenture Global Services Limited together with its affiliates, licensees and predecessors in interest. The Complainant holds intellectual property rights including extensive proprietary rights in the trade name and trade mark ACCENTURE and variations thereof, associated logos and get-ups and other trademarks (hereinafter collectively referred to as the "ACCENTURE Marks") and domain names such as inter alia "ACCENTURE.COM" (hereinafter collectively referred to as the "ACCENTURE Domain names"). The Complainant owns more than 1,000 registrations and applications for registration of the ACCENTURE Marks in over 140 countries around the world, (including Pakistan) in respect of a variety of goods and services falling in numerous classes of the International Classification of Goods and Services. The earliest registration of the ACCENTURE Marks dates back to the year 2002. A list of such select trademarks and the countries in which the Complainant maintains registrations and applications for the ACCENTURE Marks around the world is attached hereto and marked as Exhibit 4. Also attached hereto and marked as Exhibit 5 are photocopies of sample registration certificates of registrations for ACCENTURE Marks in various international jurisdictions.

Attached hereto and marked as Exhibit 6 are copies of a selection of the registration certificates issued by the Trade Marks Registry of Pakistan in respect of the ACCENTURE Marks registered in Pakistan. The Complainant is also the registered owner of the domain name "Accenture.pk" as of January 20, 2006 in Pakistan. A print-out of the PKNIC domain record which

has been downloaded from PKNIC's website www.pknict.net.pk, is attached hereto and marked as Exhibit 7.

(i) Complainant began using the mark ACCENTURE in connection with various services, including management consulting, technology services and outsourcing services, on January 1, 2001. See *Accenture Global Services Limited v. Domains By Proxy, LLC/Name Redacted* (Case No. D2013-2099) (attached as Exhibit 8) (finding that Complainant has rights in the mark ACCENTURE). Complainant has offices and operations in more than 200 cities in 56 countries.

(ii) Since January 2001, Complainant has extensively used and continues to use the mark ACCENTURE in connection with various services and specialties, including management consulting and business process services, which comprises various aspects of business operations such as data analytics, supply chain and logistics services, as well as technology services and outsourcing services, to name only a few.

(iii) To protect its trademark rights in the ACCENTURE Marks and to put others on notice of those rights, on October 6, 2000, Complainant filed a United States trademark application (Application Serial No. 76/154,620) for the mark ACCENTURE, covering computer software, pamphlets, business consulting services, financial services, computer installation services, educational services and computer consulting services, among many other goods and services. This application matured to registration (Reg. No. 3,091,811) on May 16, 2006. The following table incorporates a representative list of United States trademark registrations for the ACCENTURE mark and ACCENTURE & Design mark, and variations thereof.

See Exhibit 5 for true and correct copies of the U.S. certificates of registration for the ACCENTURE mark. These registrations are valid and subsisting, and serve as prima facie evidence of Complainant's ownership of the ACCENTURE mark and the validity of the ACCENTURE mark. Furthermore, some of these registrations are incontestable and are conclusive evidence of Complainant's exclusive right to use the ACCENTURE mark in the United States in connection with the stated goods and services. 15 U.S.C. §§ 1065 and 1115(b).

(iv) In order to help protect its trademark rights on an international basis, Complainant owns registrations for the ACCENTURE mark and ACCENTURE & Design mark in more than 140 countries. Complainant owns more than 1,000 registrations for the marks ACCENTURE, ACCENTURE & Design and many other marks incorporating the ACCENTURE brand for a variety of products and services including, but not limited to, its management consulting, technology services and outsourcing services. A representative sampling of certificates of registration for Complainant's trademark registrations in jurisdictions worldwide, including trademark registrations in Pakistan, are set forth in Exhibits 5 and 6 herein

(v) Complainant enjoys strong worldwide rights in, and recognition of, its ACCENTURE Marks. Complainant has used the ACCENTURE trademark in commerce since as early as 2001. The first U.S. trademark registration for the ACCENTURE mark dates back to 2002.

(vi) Complainant owns approximately 16 trademark applications and registrations for the ACCENTURE Marks in Pakistan. The first trademark registrations in Pakistan for the ACCENTURE Marks (reg. nos. 170872, 170875, 170874, and 170873) date back to 2001, and cover computer software for managing customer service and support functions of a business, and related materials, in Classes 9 and 16.

(vii) Complainant has developed substantial goodwill in its ACCENTURE name and its ACCENTURE Marks, as well as its official domain name, ACCENTURE.COM.

(viii) Complainant has relied on the Internet as a forum to promote and disseminate information regarding the various offerings under the ACCENTURE Marks including, but not limited to, management consulting, technology services, outsourcing services and software solutions. Complainant owns and operates the website at ACCENTURE.COM. See Exhibit 9 for a true and correct copy of the WHO IS report for the ACCENTURE.COM domain name. Complainant registered this domain name on August 30, 2000. At this website, Internet users can find detailed information about the management consulting, technology services, outsourcing, analytics and myriad other services offered by Complainant and its global offices in connection with the ACCENTURE Marks. Sample printouts from Complainant's website demonstrating use of its ACCENTURE Marks are attached hereto as Exhibit 10.

(ix) The ACCENTURE Marks have been advertised in connection with various media and have been written about in the press. Below is a list of Complainant's annual advertising expenditures worldwide since 2009.

Year	Advertising Expenditures (USD)
2009	\$77 Million
2010	\$67 Million
2011	\$66 Million
2012	\$67 Million
2013	\$69 Million
2014	\$70 Million
2015	\$67 Million

2016	\$67 Million
2017	\$69 Million

A representative sampling of Complainant's global advertisements and press clippings featuring the ACCENTURE Marks is attached hereto as Exhibit 11.

(x) Reputable brand consulting companies in the industry have recognized the ACCENTURE mark as a leading global brand. The ACCENTURE mark has been recognized in Interbrand's Best Global Brands Report since 2002, when it ranked 53rd. The ACCENTURE mark ranked 34th in the 2018 Interbrand's Best Global Brands Report, its highest ranking ever in the report. See Exhibit 12 for a true and correct copy of Interbrand's Best Global Brands 2018 Report

(xi) The ACCENTURE mark has been recognized by Kantar Millward Brown, a leading market research and brand valuation company, in its annual BrandZ – Top 100 Brand Rankings since 2006 when it was ranked 58th. In 2018, the ACCENTURE brand ranked 32nd, its highest BrandZ ranking. See, Exhibit 13 for a true and correct copy of selected pages of Kantar Millward Brown's 2018 BrandZ - Top 100 Brand Ranking.

(xii) Complainant has been recognized for its business services and brand recognition. For the past 16 years, it has been listed in the Fortune Global 500, which ranks the world's largest companies. In addition, Complainant has appeared in various other top rankings by Fortune. A chart summarizing these awards is shown below:

Year	Award
2009	Fortune 100 Most Admired Companies Ranking #49
2009	Fortune 100 Best Companies to Work For Ranking #52
2010	Fortune 100 Best Companies to Work For Ranking #84
2011	Fortune 100 Best Companies to Work For Ranking #99
2011	Fortune 100 Most Admired Companies Ranking #43
2012	Fortune 100 Most Admired Companies Ranking #49
2012	Fortune 100 Best Companies to Work For

	<i>Ranking #92</i>
<i>2013</i>	<i>Fortune 100 Best Companies to Work For Ranking #91</i>
<i>2014</i>	<i>Fortune 100 Best Companies to Work For Ranking #90</i>
<i>2014</i>	<i>Fortune 100 Most Admired Companies Ranking #45</i>
<i>2015</i>	<i>Fortune 100 Best Companies to Work For Ranking #98</i>
<i>2015</i>	<i>Fortune 100 Most Admired Companies Ranking #49</i>
<i>2016</i>	<i>Fortune 100 Best Companies to Work For Ranking #84</i>
<i>2016</i>	<i>Fortune 100 Most Admired Companies Ranking #36</i>
<i>2017</i>	<i>Fortune's Blue Ribbon Companies</i>
<i>2018</i>	<i>Fortune 100 Most Admired Companies Ranking #40</i>
<i>2019</i>	<i>The World's Most Valuable Brands #36</i>

(xiii) Complainant has received numerous awards for its business, products and services provided under the ACCENTURE Marks. A sampling of these awards is detailed in the chart below:

<i>Source</i>	<i>Award</i>	<i>Year</i>
<i>GLASSDOOR</i>	<i>No. 6 on Glassdoor's High Rated CEOs in the UK</i>	<i>2014</i>
<i>ETHISPHERE</i>	<i>World's Most Ethical Companies list</i>	<i>2008-2016</i>
<i>BARRON'S</i>	<i>No. 29 on Barron's 500</i>	<i>2015</i>
<i>DIVIDEND CHANNEL</i>	<i>Accenture was named as one of Dividend Channel's Top 25 Socially Responsible Dividend Stocks</i>	<i>2012</i>
<i>FORBES</i>	<i>Ranked No. 69 on Forbes' inaugural World's Most Powerful Brands</i>	<i>2012</i>
<i>FORBES</i>	<i>Ranked No. 79 on Consumer Perception</i>	<i>2012</i>

<i>BARRON'S 500</i>	<i>Ranked No. 139 of the 500 largest publicly traded companies</i>	<i>2012</i>
<i>Women's Business Enterprise National Council</i>	<i>Recognized as America's Top Corporations of Women's Business Enterprises List (2009-2012)</i>	<i>2012</i>
<i>FORTUNE</i>	<i>Ranked No. 23 on the North America regional list as Fortune's biennial Top Companies for Leaders list</i>	<i>2011</i>
<i>STANDARD & POOR'S S&P 500</i>	<i>Included in Standard & Poor's S&P 500</i>	<i>2011</i>
<i>FORTUNE GLOBAL 500</i>	<i>Included in the list of top 500 corporations worldwide as measured by revenue for ten consecutive years</i>	<i>2002-2011</i>
<i>MANAGEMENT TEAM 500</i>	<i>Ranked No. 44 as top 500 companies with best image in the Netherlands</i>	<i>2011</i>
<i>BRAND FINANCE'S Global 500</i>	<i>Ranked No. 157 in Brand Finance's Global 500</i>	<i>2011</i>
<i>TELEOS and THE KNOW NETWORK</i>	<i>Recognized for the thirteenth time as a Global Most Admired Knowledge Enterprise</i>	<i>2010</i>

(xiv) Complainant supports numerous social development projects worldwide in connection with the ACCENTURE Marks including, but not limited to, its SKILLS TO SUCCEED initiative, which has equipped more than 1.2 million people around the world with the skills to find a job or build a business. Information regarding Complainant's SKILLS TO SUCCEED initiative is attached hereto as Exhibit 14.

(xv) Millions of sports fans encounter the ACCENTURE Marks, as Complainant has served as the Official Technology Partner for the RBS 6 Nations Rugby Championship since 2012. Moreover, Complainant was a global umbrella sponsor of the World Golf Championships and the title sponsor of the series' season-opening event, the Accenture Match Play Championship. Information regarding Complainant's involvement in the RBS 6 Nations Rugby Championship is attached hereto as Exhibit 15.

(xvi) Complainant also has collaborated with various groups on cultural initiatives across the world. For example, it collaborated with the Louvre Museum to develop new technological programs designed to support the Louvre's initiatives to spread culture, enhance its image and reach new segments of the public. Complainant has been a concert sponsor for the Rheingau Musik Festival in Germany since 1997, which is one of Germany's premier music festivals. Information

regarding Complainant's collaboration with the Louvre Museum and sponsorship of the Rheingau Musik Festival is attached hereto as Exhibit 16.

(xvii) As a result of the above-described extensive use and promotion, the ACCENTURE Marks have become distinctive and famous globally and have enjoyed such distinctiveness and notoriety since long prior to the date on which Respondent registered the Disputed Domain Names.

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 "AccentureAnalytics.com.pk".

B. Respondent

The factual and legal grounds upon which the Complaint is unfounded are as follows:

FACTUAL GROUNDS

The Respondent contends that he is unaware of why this Complaint has been lodged by the Complainant. The Respondent has requested the Complainant to contact them via telephone. The Respondent contends that the Disputed Domain Name is not being used for any commercial purpose. The Respondent states that the Disputed Domain Name is being used as a test.

LEGAL GROUNDS

No legal grounds have been submitted by the Respondent in their response to 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. 4.4 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 Aug 7, 2007 ver. 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, dated 07-Aug-2007, 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 Aug 7, 2007 ver 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 Aug-07-2007 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 Names (which consists of the Complainant's registered and well-known ACCENTURE trade mark) 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 ACCENTURE Marks or any of them in Pakistan. Moreover, through such registration or use of the Disputed Domain Names, the Respondent intends to mislead the general public, including the Internet users in Pakistan and elsewhere, and to cause them into believing that the Disputed Domain Names/website 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 Names 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 36. 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 23 supra).

In view of the above, there is no doubt that the Domain Names and/or the Respondent contravene the provisions of the Policy Agreement and the PKNIC - Internet Domain Registration Policy (attached hereto collectively as Exhibit 37), 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, tortious 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

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 23 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 “ACCENTURE” both in Pakistan and around the world.

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 Aug 7, 2007.ver 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 Disputed Domain Name is confusingly similar to the ACCENTURE Marks

The Disputed Domain Name is highly similar to Complainant's famous ACCENTURE trademark. The only difference between the Disputed Domain Name and Complainant's ACCENTURE mark is that the Disputed Domain Name add the descriptive term "analytics," which directly describes an aspect of Complainant's business, in that Complainant provides analytics strategy and applied intelligence services to its clients. Attached hereto as Exhibit 17 are screenshots from Complainant's website demonstrating use of its marks in relation to its analytics services.

According to the WHOIS records, the Disputed Domain Names were registered on October 8, 2018, more than 17 years after Complainant first registered its ACCENTURE mark in the United States and in Pakistan.

The ACCENTURE mark is distinctive and famous. See Accenture Global Services Limited v. JCS Inc./PrivacyProtect.org (WJPO Case No. D2013-2098)(attached as Exhibit 18)(finding that Complainant demonstrated that its ACCENTURE mark has been extensively used, is well-known globally, is vested with significant goodwill and carries distinction). The ACCENTURE mark consists of a coined term and, as such, should be afforded a wide scope of protection, particularly in view of the ubiquitous nature of the brand (as demonstrated by the heavy advertising presence worldwide). See Accenture Global Services Limited v. JCS Inc./PrivacyProtect.org, supra(attached as Exhibit 18) (finding that the word "accenture" is not a descriptive or generic term but, rather, was coined by Complainant, so consumers associate this term exclusively with Complainant and its products and services owing to the international goodwill that Complainant has developed in the ACCENTURE mark over the years).

First, the addition of a ccTLD to the Disputed Domain Names is without legal significance and is otherwise "ignored" in an assessment of identity. See Accenture Global Services Limited v. Carl Mazzanti, eMazzanti Technologies (WIPO Case No. DC02017-0013) (attached as Exhibit

19) (holding that "the addition of the ccTLD '.co' to the mark to form the disputed domain name" is "generally irrelevant in assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy and thus ignored."). Second, adding a descriptive term to a trademark in a domain name fails to negate confusing similarity, especially when the descriptive term directly refers to Complainant's business, as does the term "analytics" in this case. See *Accenture Global Services Limited v. Domains By Proxy, LLC I Norman Shaaban* (WIPO Case No. D2018-0731)(attached at Exhibit 20)(finding the domain name <accenturemedia.com> confusingly similar, stating "[t]he addition of a descriptive term does not negate the confusing similarity between the Domain Name and the Complainant's ACCENTURE Mark."). Respondent's registered Disputed Domain Names are virtually identical to and are confusingly similar to Complainant's ACCENTURE mark, as well as its ACCENTURE.COM domain, and are likely to mislead, deceive and cause mistake as to the source, sponsorship, affiliation or endorsement of the Disputed Domain Name.

Finally, in assessing a likelihood of confusion between a registrant's domain name and a complainant's mark, "points of similarity are weighed more heavily than points of difference." See *Nintendo of America, Inc. v. Gray West International* (WIPO Case No. D2000-1219) (attached as Exhibit 21) (finding the domain name POKEMON-GAMES.COM confusingly similar to Complainant's POKEMON trademark); *Accenture Global Services Limited v. Whois Privacy Protection Service, Inc./Robert Green* (WIPO Case No. D2013-21 OO)(attached as Exhibit 22)(finding the domain name ACCENTURE-UK.COM confusingly similar to Complainant's ACCENTURE mark and finding that the addition of "UK" is purely descriptive and does not distinguish the domain name from the trademark). Here, Respondent's addition of the descriptive term "analytics" to the Disputed Domain Names does nothing to reduce the confusing similarity with Complainant's ACCENTURE Marks. As such, Internet users are very likely to be confused as to whether an association exists between the Domain Name and Complainant.

Furthermore, Complainant also 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; and

(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.

Copies of these abovementioned cases are attached hereto as Exhibit 23.

Based on the above submissions, there can be no doubt that the Disputed Domain Name <AccentureAnalytics.com.pk> is identical and/or confusingly similar to the ACCENTURE Marks in which 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 ACCENTURE 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 “ACCENTURE” both in Pakistan and in many other jurisdictions. 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 “. com.pk” The insertion of the suffix “. com.pk” means that the Disputed Domain Names are not identical to the mark of the Complainant. It needs to be analyzed whether the addition of “. com.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 “analytics” 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 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:

Consistent with Paragraph 4(c) of the Policy, a respondent can demonstrate a legitimate interest in a domain name by proving one of the following: (i) that before notice of the dispute, it had made demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services; (ii) it is commonly known by the domain name; or (iii) it is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the trademarks of another. See ICANN's Uniform Domain Name Dispute Resolution Policy. The Respondent in this case can demonstrate none of these criteria and, therefore, has no legitimate interest in the Disputed Domain Names.

Complainant's ACCENTURE mark is not a generic or descriptive term in which the Respondent might have an interest. Complainant's ACCENTURE Marks are globally famous and have acquired secondary meaning through Complainant's substantial, continuous, and exclusive use of the marks in connection with Complainant's goods and services.

Respondent is neither affiliated with, nor has it been licensed or permitted to use Complainant's ACCENTURE Marks or any domain names incorporating the ACCENTURE Marks. Under the Policy, Paragraph 4(a)(ii), a statement that the Respondent is not licensed or otherwise authorized to use the disputed domain name constitutes prima facie proof for the Complainant that the Respondent lacks any rights or legitimate interests in the Disputed Domain Names. See CareerBuilder, LLC v. Stephen Baker, (WIPO Case No. D2005-0251) (attached as Exhibit 24).

On information and belief, Respondent is not commonly known by the Disputed Domain Names. See Policy 4(c)(ii). Instead, it appears that Respondent has chosen to use Complainant's famous ACCENTURE trademark as part of its Disputed Domain Names to create a direct affiliation with Complainant and its business.

Furthermore, the WHOIS information for the Disputed Domain Names does not indicate that Respondent is commonly known by the Disputed Domain Names now, nor was it known prior to the date on which Respondent registered the Disputed Domain Names to trade on the value of Complainant's famous trademark. Respondent is not making a legitimate, non-commercial fair use of the Disputed Domain Names. See Policy, Paragraph 4(c)(iii).

Rather, Respondent is not using the Disputed Domain Names for any purpose at this time. Instead, the Disputed Domain Names resolve to pages that are either blank or do not otherwise direct to any content or function. Screenshots from the resulting websites at the Disputed Domain Names are attached as Exhibit 25.

*Prior panels have found that the inactive holding of a disputed domain name is neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use. See *George Weston Bakeries Inc. v. McBroom*, FA 933276 (Nat. Arb. Forum Apr. 25, 2007) (finding that the respondent had no rights or legitimate interests in a domain name under either Policy 4(c)(i) or Policy 4(c)(iii) where it failed to make any active use of the domain name) (Attached as Exhibit 26).*

*Respondent's failure to use the Disputed Domain Names to provide a bona fide offering of goods and services confirms that it does not have a right or legitimate interest in the Disputed Domain Names, particularly since Complainant has proven its rights in the Marks at issue. See *Lockheed Martin Corporation v. Nate Morley*, FA 695614 (Nat. Arb. Forum November 3, 2016) ("Complainant need only make out a prima facie case that Respondent has no rights or legitimate interests in the disputed domain name, after which the onus shifts to Respondent to rebut that case by demonstrating those rights or interests") (Attached as Exhibit 27); see also, *Kate Spade, LLC v. Darmstadter Designs*, (WIPO Case No. D2001-J 384) (finding when rights in a mark are proven, the burden then shifts to the domain holder to prove a right or legitimate interest. And the panel noted that non-use of the domain name supported a finding of a lack of right or legitimate interest) (Attached as Exhibit 28). Thus, Respondent has not used the Disputed Domain Names in connection with a bona fide offering of goods or services. See Policy 4(c)(i).*

*Complainant notes that Respondent has held the Disputed Domain Names for over ten months, and has failed to make any developments or "demonstrable preparations" to use the Disputed Domain Names with a bona fide offering of goods or services. See *Societe Air France v. Registration Private, Domains By Proxy, LLC I Name Redacted* (WIPO Case No. D2018-0005) (finding that the respondent lacked rights or legitimate interests in a confusingly similar domain name that "does not resolve to an active website") (Attached as Exhibit 29).*

*Respondent registered the Disputed Domain Names 17 years after Complainant began using its ACCENTURE mark in commerce and 18 years after Complainant had registered the domain name ACCENTURE.COM. *Charles Jourdan Holding AG v. AAIM*, (WIPO Case No. D2000-0403) (finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's*

registration; and, (3) the respondent is not commonly known by the domain name in question) (Attached as Exhibit 30).

Respondent is not making a legitimate, noncommercial or fair use of the Disputed Domain Names, and it appears that Respondent has chosen the <AccentureAnalytics.com.pk> domain name to trade off of the reputation and goodwill associated with Complainant's ACCENTURE Marks, to cause confusion amongst Internet users and Complainant's customers, and to prevent Complainant from owning the Disputed Domain Name. See Policy 4(c)(iii).

In summary, there is no indication that Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Names without intent for commercial gain. Instead, Respondent deliberately chose the Disputed Domain Names which are essentially identical to Complainant's ACCENTURE trademark and appears to be attempting to seem associated or affiliated with Complainant and its analytics business. It is clear that Respondent has no legitimate interest in the Disputed Domain Names, in view of Complainant's prior statutory and common law rights in the ACCENTURE Marks and the facts and analysis set forth above.

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 ACCENTURE 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 are 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:

The Policy establishes that, for purposes of Paragraph 4(a)(iii), "bad faith" registration and use of a domain name can be established by a showing of circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to respondent's website or other online location, by creating a likelihood of confusion with

complainant's mark as to source, sponsorship, affiliation or endorsement of respondent's website or location, or of a product or service on respondent's website or location. See Policy, Paragraph 4(b)(iv).

Respondent had constructive notice that the ACCENTURE mark was a registered trademark in the United States, Pakistan, and many other jurisdictions worldwide.

Given Complainant's worldwide reputation and the ubiquitous presence of the ACCENTURE Marks on the Internet, Respondent was or should have been aware of the ACCENTURE Marks long prior to registering the Disputed Domain Names. See *Caesars World, Inc. v. Forum LLC* (WIPO Case No. D2005-0517)(attached as Exhibit 31) (finding Respondent registered the domain name CAESARSPALACEPOKER.COM in bad faith after it knew or should have known about Complainant's trademarks); see also *Accenture Global Services Limited v. JCS Inc./PrivacyProtect.org*, supra (attached as Exhibit 18)(finding that it was unlikely that the respondent was not aware of Complainant and its ACCENTURE mark at the time the disputed domain name was registered, as Complainant demonstrated that its mark is well-known globally and is vested with significant goodwill).

As noted above, Respondent has held the Disputed Domain Names for over ten months, and has not used the domains for any legitimate purpose. It has long been held in UDRP decisions that the passive or inactive holding of a domain name that incorporates registered trademarks without a legitimate Internet purpose may indicate that the domain name is being used in bad faith under paragraph 4(a)(iii) of the Policy. See *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D2000-0003) (Attached as Exhibit 32); *Jupiters Limited v. Aaron Hall* (WIPO Case No. D2000-057 4) (Attached as Exhibit 33).

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), at section 3.3, describes the circumstances under which the passive holding of a domain will be considered to be a bad faith registration: "While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put." See *Andrey Ternovskiy dba Chatroulette v. WhoisGuard Protected, WhoisGuard, Inc. I Armando Machado* (WIPO Case No. D2018-0082) (Attached as Exhibit 34).

In the present case, Complainant has demonstrated that the ACCENTURE trademark is distinctive and well-known throughout the world, and it is highly unlikely that Respondent registered the Disputed Domain Names independently for its own purposes. A high degree of renown attaches to the Complainant's ACCENTURE mark as a result of its extensive use and promotion of the trademark in relation to its world-renowned business management consulting, technology services and outsourcing services, such that it is implausible for Respondent to have registered the Disputed Domain Names other than to trade off the reputation and goodwill of Complainant's ACCENTURE Marks. Finally, the identity of the domain name registrant is concealed. Each of these facts are indicative of the Disputed Domain Names being held passively and in bad faith. See Andrey Ternovskiy dba Chatroulette v. WhoisGuard Protected, WhoisGuard, Inc. I Armando Machado, supra; Do The Hustle, LLC v. Tropic Web (WJPO Case No. D2000-0624) ("[T]he examples [of bad faith] in Paragraph 4(b) are intended to be illustrative, rather than exclusive.") (Attached as Exhibit 35). Similar to the above referenced cases, Respondent's failure to use the Disputed Domain Names is evidence of bad faith registration and use of the Disputed Domain Names.

Given the well-known status of Complainant's ACCENTURE Marks and Complainant's registration and use of the domain ACCENTURE.COM, there is no reason for Respondent to have registered the Domain Names other than to trade off the reputation and goodwill of Complainant's Marks. See Charles Jourdan Holding AG v. AAIM, supra (Attached as Exhibit 30) (finding that the domain name in question is "so obviously connected with the Complainant and its products that it's very use by someone with no connection with Complainant suggests opportunistic bad faith.").

The Respondent on the other hand has not provided any information in support of the contention that the Disputed Domain Names have been registered or are 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 ACCENTURE at the time of registration and use of the Disputed Domain Names, especially given that the Respondent used the Disputed Domain Names to offer management consultancy, business process services, data analytics and related services which are near-identical to services offered by the Complainant using its mark ACCENTURE. Hence this Panel finds that the registration and use of the Disputed Domain Names 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 ACCENTURE 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 Names. The Respondent was afforded the opportunity to rebut the claims made forth by the Complainant, and in the abovenamed matter, the Respondent has failed to provide any substantial legal and factual grounds as evidence that their use of the Disputed Domain Name was valid under the prevailing law and regulations.

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 Names is contrary to the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.4
2. The Respondent has no legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Names are confusingly similar to the Complainant's trademark/names and registered domain names.
4. The Disputed Domain Names were 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 < accentureanalytics.com.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: 14 November 2019