

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

The Halal Guys, Inc. vs Web Bizline, Inc.

Case No. C2019-0009

Also in PDF C2019-0009

1. The Parties

The Complainant is The Halal Guys, Inc. with its registered address at 10-02, 34th Avenue Astoria, New York 11106, United States of America. The Complainant has initiated the Complaint vide its authorized representatives Qamar Uddin, Abdul Aziz, Miss. Farzana Rustom, Miss Saira Osman Bhatti, Bharucha & Co., Intellectual Property Attorneys having their office at F-7/1, Block 8, KDA Scheme 5, Kehkashan Clifton, Karachi – 75600, Pakistan.

The Respondent's name is Web Bizline Inc and the point of contact is Kashif Yaqoob having address at Defence Phase 2, Karachi.

2. The Domain Name and Registrar

The domain name in dispute is <thehalaguys.com.pk> hereinafter referred to as the Disputed Domain Name. Vide email dated 10-12-2019 PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is Web Bizline Inc, having its address at Defence Phase 2, Karachi and its Create Date was 2018-08-28 with an Expire Date of 2020-08-28.

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 15-10-2019.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 23-10-2019. 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 through email on 24-10-2019.

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

PKNIC has confirmed via their email dated 10-12-2019 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 isnhosting@gmail.com.

4. Parties Contentions

A. Complainant

The Complainant's contentions as stated in the Complaint are stated below:

The instant Complaint is based on the trademark "THE HALAL GUYS" registered under No.410397 in Class 43 in Pakistan. The said trademark has been registered in Class 43 with a description of goods as follows:

"Restaurant services; fast food restaurant services; restaurant services provided mobile food carts; being services included in class 43"

The Complainant is the registered proprietor of the said mark in Pakistan since 2016.

The copy of the Registration Certificate is attached along with this Complaint and marked as "Exhibit A"

The Complainant is also the registered proprietor of the trademark "THE HALAL GUYS" and the trademark "THE HALAL GUYS GYRO and CHICKEN (logo)" (depicted below) in various countries throughout the world.

The current list of the countries in which trademark applications have been filed and trademark registrations have been granted for the trademark "THE HALAL GUYS" and the trademark "THE HALAL GUYS GYRO and CHICKEN (logo)" and some registration certificates are attached along with this Complaint and marked as Exhibits "B" to "B/17"

The Complainant has taken the following factual grounds:

1. *That the Complainant is a world renowned international restaurant chain specializing in Halal food products.*
2. *That the Complainant first began its business as a mobile food cart vendor in New York in the year 2000 under the name "THE HALAL GUYS".*
3. *As a result of its reputation and popularity, the Complainant was able to establish itself as a restaurant and now operates several such restaurants and outlets, which are owned by it.*
4. *That the Complainant is going global, with over 200 new restaurants worldwide. The Complainant has expanded its business model by adopting licensing and franchising agreements in many jurisdictions across the world so as to develop its brand internationally. At present, the Complainant has franchise agreements in many locations across the United States of America, as well as Malaysia, Philippines, Canada and Indonesia. At present, Complainant has over 200 restaurants in development worldwide, and many opened locations.*
5. *That in order to safeguard its interest in the trade mark "THE HALAL GUYS", the Complainant has obtained registration thereof in many jurisdictions across the world including Pakistan in 2016. The details of the said registration are given below:*

Regn. No.	Trade Mark	Class
410397	THE HALAL GUYS	43

The said registration is valid and in force.

6. *That the Complainant has also applied for registration of the trade marks "THE HALAL GUYS GYRO and CHICKEN (logo)" and "CART & CUSTOMER (logo)" under application Nos. 517120 and 517121 both in Class 43 in Pakistan, details of which are as follows:*
7. *That the Complainant regards its trademarks as valuable assets that it seeks to continually maintain and protect.*
8. *In addition to Complainant's registrations and applications in Pakistan, Complainant is the registered proprietor of trademark "THE HALAL GUYS" and "THE HALAL GUYS GYRO and CHICKEN (logo)" and have also filed trademark applications in various countries. Many more filings are anticipated.*

9. Furthermore, Complainant owns the domain name *thehalalguys.com*
10. That the trade marks "THE HALAL GUYS", "THE HALAL GUYS GYRO and CHICKEN (logo)" and "CART & CUSTOMER (logo)" of the Complainant are widely and extensively used in many countries of the world and have acquired tremendous popularity and immense goodwill amongst the trading community and general consumers for their standard and quality and whenever or wherever said marks appear or are used, they denote that the services provided or offered are by the Complainant and nobody else's.
11. That the Complainant carries out intense advertisement and publicity of its services under the trade marks "THE HALAL GIJYS", "THE HALAL GUYS GYRO and CHICKEN (logo)" and "CART & CUSTOMER (logo)" in many countries of the world and as such, the services provided or offered by the Complainant on account of their good quality are known and demanded by the said name. As a result, trading circles as well as the general public recognize them as trademarks of the Complainant and the services having originated from the Complainant and nobody else's. The Complainant's services under the aforesaid trademarks command high respect in the markets internationally.
12. By virtue of worldwide registrations, extensive use and wide publicity in many countries of the world, the Complainant's marks for a number of years, its services using trademarks "THE HALAL GUYS" and "THE HALAL GUYS GYRO and CHICKEN" (logo) are very popular across the world and have become well-known marks for restaurant services.
13. That the term "THE HALAL GUYS" also constitutes the corporate name of the Complainant who is the provider of restaurant and fast food services, included in Class 43. Thus, the Complainant's business name and trade mark are synonymous to each other.
14. That the Complainant's came to know in late 2018 that the Respondent is using its registered trade mark "THE HALAL GUYS" on a restaurant and also registered the disputed Domain Name in its name on August 28, 2018, without the permission or authorization from Complainant. Therefore the Complainant sent a legal notice dated January 8, 2019 to the Respondent for the cessation of such activities which violated the proprietary rights and interests of the Complainant. The said Legal Notice was received by the Respondent.

15. *The Respondent has till date failed to respond to the Legal Notice and continues to infringe the proprietary rights of the Complainant.*
16. *The website featured on the disputed Domain Name falsely displays the words "coming soon" while the Respondent is using the said website on its menu cards and trading under the infringing name "THE HALAL GUYS" located in Karachi, Pakistan, and is engaged in the same business as that of Complainant in connection with restaurant services.*
17. *The website featured on the disputed Domain Name, by using the well-known trade mark "THE HALAL GUYS" gives a false impression to the general public that the Respondent has some association or arrangement with the Complainant or its services in Pakistan, which is not true. Furthermore, the general public is deceived into belief that the Respondent's goods/services are offered by, managed, licensed or connected in some manner to the Complainant.*
18. *The use of the infringing domain name infringes the exclusive rights vested in the Complainant in respect of its trade mark "THE HALAL GUYS" 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 website mentioned above are authorized and/or controlled by the Complainant or persons having a business connection with the Complainant, which is not the case.*
19. *That the Complainant addressed a letter to PKNIC on April 13, 2019 informing it the wrongful registration of the Disputed Domain Name and on receipt of an email from PKNIC advising to initiate domain name dispute at DNDRC. Consequently, the Complainant has now filing this complaint to adjudicate on this matter.*

The legal grounds taken by the Complainant have been summarized below:

- A. The registration of the Disputed Domain Name by the Respondent is in violation of provisions of Pakistani law.
- B. The Disputed Domain Name is identical or confusingly similar to the trademark and service marks in which the Complainant has rights.
- C. The Disputed Domain Name was registered and is being used in bad faith.
- D. The Respondent has no rights or legitimate interests in the Disputed Domain Name.

Therefore, the Complainant seeks the following remedy:

In light of the cogent reasons submitted above and pursuant to the ICANN Policy, paragraph 4(i), and the PKNIC - Internet Domain Registration Policy, paragraph 4, the Complainant requests the Administrative Panel in the instant matter to deregister/cancel the infringing Disputed Domain Name registration "www.thehalalguys.com.pk" and/or to transfer the same to the Complainant.

B. Respondent

The Respondent in its Response has taken the following position:

We are Web Hosting Service Providers and We registered This domain name for our customer in Pakistan

We have ask them For resolution of this disputed domain name and they are not intrested in this domain name now

kindly close this Dispute and transfer this domain name to complainant

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 contended that the Disputed Domain Name infringes upon the trade mark of the Complainant registered in Pakistan under number 410397. The Complainant has annexed a copy of a certificate of registration in support of the Complainant’s contention that it has trade marked “The Halal Guys” in Pakistan.

The Panel has reviewed the Complainant’s contention and supporting documentation which demonstrates that the Complainant has rights to the trademark “The Halal Guys” in Pakistan vide its aforementioned registration. The Respondent has not provided a substantive response to the Complainant’s contention. The Disputed Domain Name does prima facie incorporate in its entirety the registered trademark of the Complainant, and thus the Disputed Domain Name infringes upon the trademark of the Complainant.

Separately, the Complainant has contended that the registration of the Disputed Domain Name by the Respondent is not bona fide and contravenes applicable criminal laws. The Complainant has referenced Section 480, 481, 482 and 486 of Pakistan Penal Code and Section 23 of Prevention of Electronic Crimes Act, 2016. The Respondent has not refuted the contention of the Complainant that the registration of the Disputed Domain Name contravenes the referenced provisions of local law.

The Panel has reviewed the sections referenced by the Complainant, and has found that the registration of the Disputed Domain Name, which incorporates the registered trademark of the Complainant in its entirety, appears to contravene Section 480, 481, 482 and 486 of Pakistan Penal Code. However, Section 23 of Prevention of Electronic Crimes Act, 2016 which criminalizes the writing, offering, making available, distribution or transmission of malicious code through an

information system with the intent to cause harm to any information system or data, appears to be unrelated to the registration of the Disputed Domain Name by the Respondent.

In summary based on the preceding analysis, the Panel finds that the registration of the Disputed Domain Name by the Respondent was illegal. 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 that the Disputed Domain Name is identical or confusingly similar to a trademark owned by the Complainant. The Complainant has submitted a copy of a certificate of registration issued by Pakistan with number 410397 for the mark “The Halal Guys”. The Respondent has not provided any response to the Complainant’s contention that the Disputed Domain Name is identical to the mark owned by the Complainant.

The Panel has reviewed the Complainant’s contention and supporting documentation which demonstrates that the Complainant has rights to the trademark “The Halal Guys” in Pakistan. It is evident that the Disputed Domain Name “thehalaguys.com.pk” incorporates in its entirety the registered mark of the Complainant. It is well-established that the mere addition of a suffix (TLD) is not sufficient to render a disputed domain name unidentical or dissimilar from a mark.

Since the Disputed Domain Name wholly incorporates the mark of the Complainant, the Panel finds that the Disputed Domain Name is identical to the mark of the Complainant.

III. Legitimate interest in a domain name

The Complainant has contended that the Respondent does not have any rights or legitimate interest in the Disputed Domain Name, and that the Disputed Domain Name has been registered with mala fide intent with a view to make unjustified gains, which is entirely prejudicial to the interest of the Complainant. The Respondent in its response has accepted that its customer does not have any interest in the Disputed Domain Name, and have requested that the dispute be closed and the Disputed Domain Name be transferred to the Complainant.

The Panel thus finds that the Respondent does not have any rights to or any legitimate interest in the Disputed Domain Name.

IV. Registration and use in bad faith

The Complainant has contended that the registration and use of the Disputed Domain Name by the Respondent is in bad faith. The Complainant contends that the website intends to give a false impression to the general public that the Respondent has some form of association or arrangement with the Complainant, which according to the Complainant is not the case. The Complainant has already provided detailed information about the popularity and fame of the Complainant's mark, which the Complainant has used significant capital to advertise globally.

The Respondent on the other hand has not provided any information to oppose the contention that the Disputed Domain Name has 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 "The Halal Guys" at the time of registration and use of the Disputed Domain Name. 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 Halal Guys" mark has been registered by the Complainant, hence the Complainant reserves crucial interest in such mark. Usage of these marks by the Respondent could endanger the reputation that the Complainant has worked hard at building and maintaining and result in confusion as to the registrant of the Disputed Domain Name. The Respondent has accepted that its customer does not have an interest in the Disputed Domain Name and has agreed to transfer of the Disputed Domain Name to the Complainant.

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

1. The Respondent's registration of the Disputed Domain Name is contrary to the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.4
2. The Respondent has no legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Name is confusingly similar to the Complainant's trademarks and 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, the Panel therefore recommends that PKNIC transfer the registration of the domain name in dispute <thehalalguys.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: Malik Muhammad Ehsan

Sole Panelist

Date: 4 January 2019