

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

The Crown in the Right of the State of Queensland vs Translink.pk

Case No. C2021-0001

Also in PDF C2021-0001

1. The Parties

The Complainant is The Crown in the Right of the State of Queensland C/- The Department of Transport and Main Roads, with its registered address at The Department of Transport and Main Roads Legal Services, GPO Box 1549 Brisbane, QLD, 4001 Australia. The Complainant has initiated the Complaint vide its authorized representatives Corrs Chambers Westgarth having their office at Level 22, 567 Collins Street, Melbourne VIC 3000 Australia.

The Respondent's name is Translink Petroleum Services and the registered email address is translinkpakistan@gmail.com having address at Head Muhammad Wala Bypass Chock Multan.

2. The Domain Names and Registrar

The domain name in dispute is <translink.pk> hereinafter referred to as the Disputed Domain Name. Vide email dated 07-01-2021 PKNIC has informed DNDRC the above-mentioned Respondent details. In addition, PKNIC has informed DNDRC that the Create Date of the Disputed Domain Name was 28-05-2019 and the Expire Date is 28-05-2021.

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 10-09-2019.

The Respondent was issued notice of the dispute along with a copy of the Complaint and a Response Form on 08-01-2021. This notice was successfully delivered to the email address provided to PKNIC at the time of registration of the Disputed Domain Name, which constitutes valid notice under the Supplemental Rules. In this notice, 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 was served a reminder on 16-01-2021. The Respondent failed to provide a response within the stipulated time period.

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

PKNIC has confirmed via their email dated 07-01-2021 that the Disputed Domain Name was registered by the Respondent above-named and that the email address provided at the time of registration is translinkpakistan@gmail.com.

4. Parties Contentions

A. Complainant

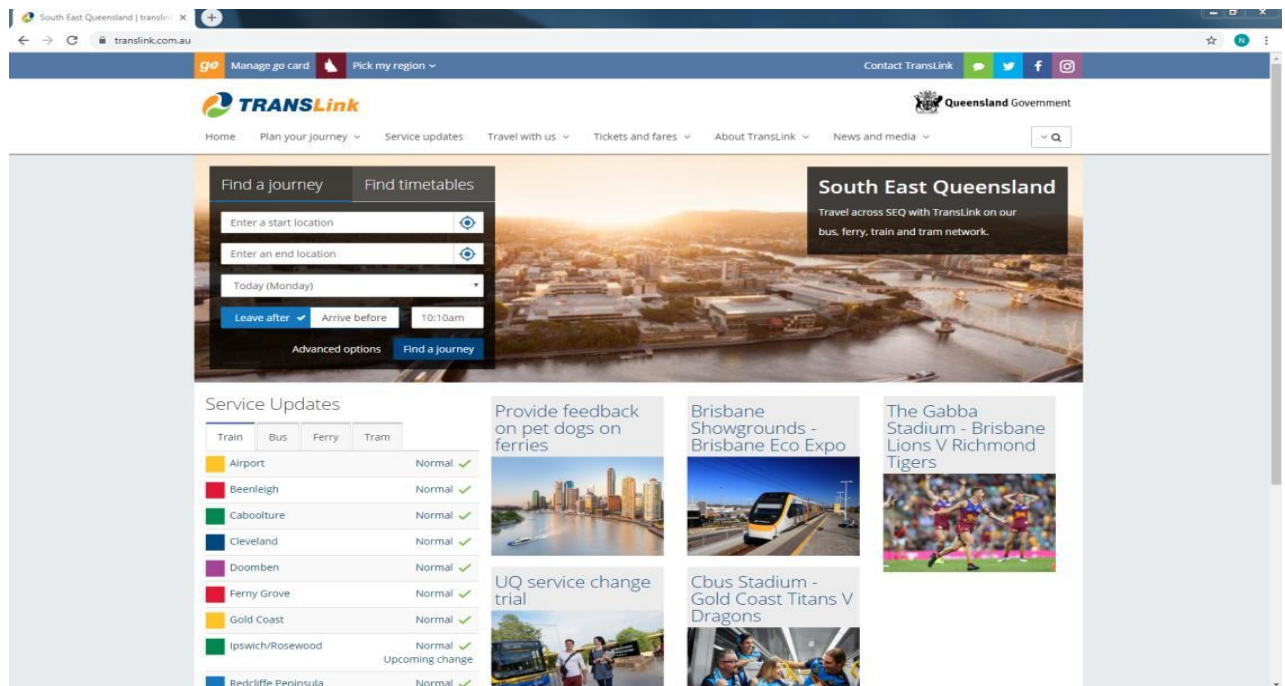
The factual and legal grounds stated in the Complaint are reproduced below:

The Complainant is a division of the Department of Transport and Main Roads of the Australian State of Queensland, with responsibility state-wide in Queensland for a wide variety of transport services, including:

- (a) buses, trains, ferries and trams across South East Queensland;*
- (b) buses in Cairns;*
- (c) buses in Mackay;*
- (d) buses in Toowoomba;*
- (e) regional services;*
- (f) demand responsive transit;*
- (g) active transport, such as cycling and walking;*
- (h) taxi regulation; and*
- (i) long distance rail, coaches and regional air.*

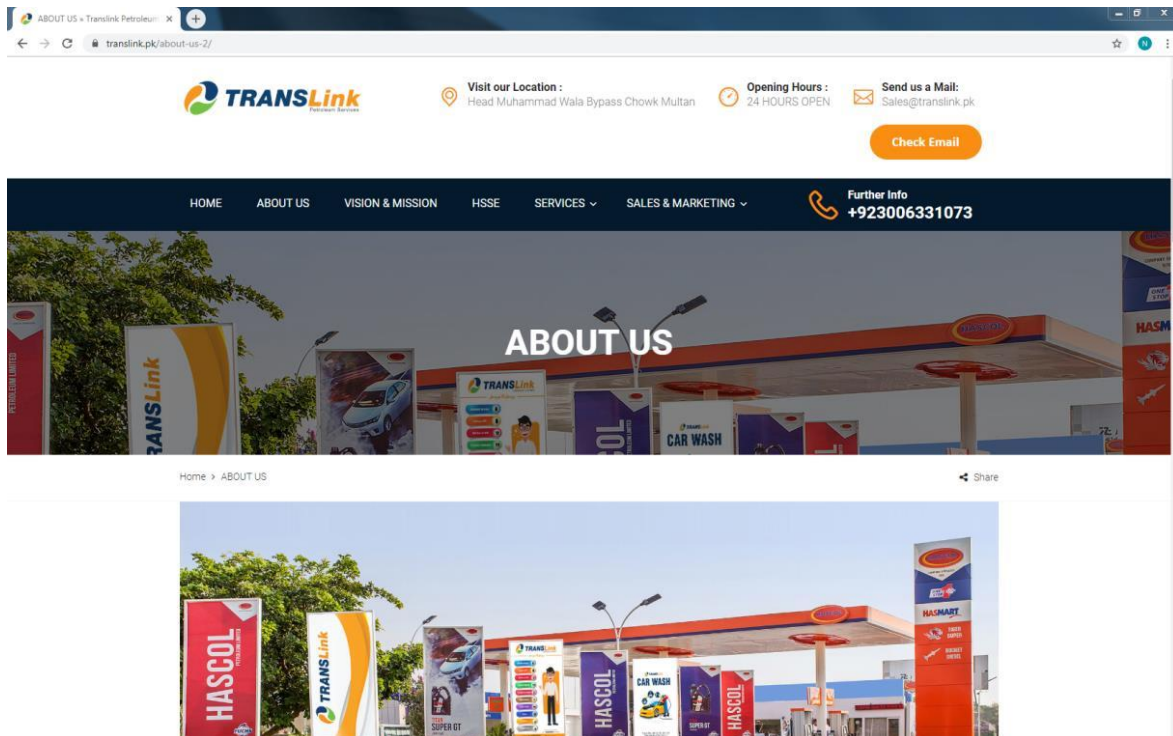
The Complainant is the owner of the registered trade marks shown above in paragraph 8.4 of this form, and at Annex 2. Since at least 2004 the Complainant has been operating under the name TRANSLINK. The Complainant is the registered owner of the domain name translink.com.au (among other registered domains, including translink.net.au, mytranslink.com.au and gotranslink.com.au). A copy of a printout of a search of the WHOIS database of Afiliis Australia Pty Ltd conducted on 2 September 2019 for translink.com.au is attached at Annex 3.

The Complainant conducts a number of its transport services, including journey planning services for the transport services listed above, through the website located the domain www.translink.com.au. Attached at Annex 4 are printouts of the Complainant's website at www.translink.com.au, an extract of which is also show below.



The Respondent's identity unknown to the Complainant as they are not provided due to "General Data Protection (GDPR), for privacy and security". The Complainant expects that this information will be revealed following the filing of this Complaint.

The Complainant is aware that the Respondent operates a website at <https://translink.pk/> (Respondent's Website). Attached at Annex 5 are a screen captures of the Respondent's Website, an extract of which is also shown below.



The Respondent purports to be a petroleum company in Pakistan, which operates fuel service stations, including car wash facilities, tyre shop, oil change services, convenience goods and rest stops.

As shown in Annex 5, the Complainant's trade marks, namely Australian TMs 959029, 1509367, and 1509368 are prominently depicted on the Respondent's Website. The Complainant did not authorise the Respondent use any of the Complainant's trade marks.

The Complainant has taken the following legal grounds:

- A. *The domain name is identical or confusingly similar to the trademarks and service marks in which the Complainant has rights (Policy, Paragraph 4(a)(i), Rules, Paragraphs 3(b)(viii), (b)(ix)(1))*
- B. *The Respondent has no rights or legitimate interests in respect of the domain name (Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2)).*
- C. *The 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)].*

Therefore, the Complainant seeks the following remedy:

In accordance with Paragraph 4(i) of the Policy, for the reasons described in Section VI above, the Complainant requests the Administrative Panel appointed in this administrative proceeding determine that <https://translink.pk/> be transferred to the Complainant.

B. Respondent

The Respondent has not submitted any response.

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 (2019-08-19) 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 (2019-08-19) and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

6. Discussion and Findings

In the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website (http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf), the Panel laid down the following four heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) and the UDRP:

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

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

- i. Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) criteria).
- ii. Identical or confusing similarity with a trademark or service in which the Complainant has rights (a UDRP criteria).
- iii. Legitimate interest in the domain name (a UDRP criteria).
- iv. Registration and use of the domain name in bad faith (a UDRP criteria).

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

The PKNIC - Internet Domain Registration Policy (2019-08-19) 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 version 4.4 (2019-08-19),

If a party claims that a domain name already registered with PKNIC violates their registered tradename, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, 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 not specifically contended that the application for and registration of the Disputed Domain Name is illegal, unlawful or otherwise invalid in terms of PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19). However, the Complainant has contended that the Disputed Domain Name infringes upon a series of Australian registered trade marks and that the registration of the Disputed Domain Name is not bona fide.

The Respondent has not submitted a Response.

The Panel has reviewed the information provided by the Complainant. It is clear that the Complainant owns the mark “TRANSLINK” and that this mark has been incorporated wholly in the Disputed Domain Name without the authorization of the Complainant. The use of this mark without authorization would, in the opinion of the Panel, constitute infringement of a registered trade mark.

In the absence of any information provided by the Respondent, the Panel is unable to infer whether the Respondent also owns the mark “TRANSLINK” which would authorize the Respondent to use said mark.

In view of the detailed information submitted by the Complainant and in the absence of a response from the Respondent, the Panel finds that the Disputed Domain Name infringes upon the trademark owned 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 (2019-08-19) 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:

It is submitted that the Disputed Domain Name is identical to the trade mark TRANSLINK in which the Complainant has rights, namely Australian TM 626387 for the word TRANSLINK in class 39, which is registered in respect of “Transport services including rail transportation of people and goods and road transportation of people and goods; storage services associated with road and rail transportation of people and goods in this class; services associated with the management and handling of both rail rolling stock and road trailers in this class” (see IP Australia extract at Annex 2).

It is submitted that the Disputed Domain Name is confusingly similar to the Complainant’s Australian trade mark registration number 959029 for <Translink logo> in class 39 which is registered in respect of “Transport services including the provision of transport related information” (see IP Australia extract at Annex 2). This trade mark (TM 959029) is a figurative trade mark comprising the word TRANSLink, which is wholly contained in the Disputed Domain Name, “translink.pk”.

Finally, we submit that the addition of a ccTLD such as .pk does not affect the assessment that a domain name is confusingly similar to a particular trade mark.

The Respondent has not submitted a Response.

It is clear to this Panel from the information provided that the Complainant owns the mark “TRANSLINK” which it has registered. 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 “.pk” The insertion of the suffix “.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 “.pk” is sufficient to negate confusing similarity with the mark of the Complainant.

The Complainant has rightly submitted that the addition of a ccTLD “.PK” is not relevant to the analysis of confusing similarity. Other than the insertion of a ccTLD, the Disputed Domain Name consists wholly of the mark belonging to the Respondent.

The Respondent has not provided any information that would demonstrate that the Respondent has any legal right to use the name “translink” in the Disputed Domain Name. The Panel has also been unable to infer such a legal right.

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:

On the information available to the Complainant at the date of submitting this Complaint, it is submitted that:

- (a) the Complainant has no awareness of the Respondent being known (let alone commonly known) by the domain name;*
- (b) the conduct described at paragraphs 5.3 and 8.6 to 8.8 above and 8.14 below make clear that any goods/services offering by the Respondent using the Disputed Domain Name is not a bone fide offering; and*
- (c) the use of the Disputed Domain Name by the Respondent, taking into account the conduct described at paragraphs 5.3 and 8.6 to 8.8 above is not legitimate non-commercial or fair use of the domain name(s), without intent for commercial gain, but rather is an idle attempt to profit from unauthorized use of Complainant’s trade marks (shown in Annex 4).*

The Respondent has not provided any information to refute the allegations of the Complainant.

The Complainant has established a prima facie that the Respondent lacks any rights or legitimate interests in the Disputed Domain Name. As has been previously adopted by the discussions and findings in WIPO Authorities, it is then for the Respondent to rebut the allegations put forth by the Complainant. Moreover, with respect to proving rights or legitimate interests in disputed domain name(s), it is for the Respondent to submit information pertaining to the same as it would be almost impossible, if not extremely difficult for the Complainant to prove a negative assertion. As such, to satisfy the Panel that it has rights or legitimate interests to the Disputed Domain Names, the Respondent was obliged to submit information with respect to the same.

In the absence of any information provided by the Respondent in support of his legitimate interest in the Disputed Domain Name, the Panel based on the information provided by the Complainant finds that the Respondent does not have rights or a legitimate interest in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

IV. Registration and use in bad faith

The Complainant has made the following submission:

The Complainant submits that the Disputed Domain Name was registered for the purpose of leveraging the Complainant's established efforts in branding and creating trade marks (show in Annex 2).

Registration of the Disputed Domain Name has the effect of preventing the Complainant (who is the owner of trade mark registrations shown in Annex 2) from reflecting its mark in a corresponding ".pk" domain name.

The Complainant is of the view that the Respondent is using the Disputed Domain Name in bad faith, including by:

*(a) using the Complainant's word mark (TM 626387) in the Disputed Domain Name itself; and
(b) using the Complainant's logo marks (TMs 959029, 1509367, and 1509368) on the Respondent's Website, which also constitutes infringement of the Complainant's copyright in those logos.*

By using the Disputed Domain Name the Respondent is intentionally attempting to attract, for commercial gain, Internet users to the Respondent's Website or other on-line location(s), by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website, for the reasons set out in paragraph 8.14 above.

Reference is made to Salvatore Ferragamo Italia S.P.A. v. Ashot Rostomian (WIPO Case No. D2000-1187), where it was held that the registration of the subject domain names, being essentially identical to the Complainant's name and mark, inevitably will affect adversely the Complainant and that absent a credible explanation for the incursion into the Complainant's rights, it is appropriate for the Administrative Panel to draw the inference that the registration was made in bad faith. Attached as Annex 6 is a copy of that decision.

Reference is also made to ITT Industries, Inc. v Katherine Kliszcz (WIPO Case No. D2000-1431) where infringement of IP rights is considered to be evidence of bad faith. Attached at Annex 7 is a copy of this decision.

In determining bad faith use, the Complainant submits that the Panel is able to take into account the Respondent's anticipated failure to provide evidence of any actual or contemplated good faith use.

The Respondent on the other hand has not provided any information in support of the contention that the Disputed Domain Names have been registered and are being used in bad faith.

The WIPO authorities submitted by the Complainant, in addition to other authorities reviewed by the Panel, clearly indicate that the infringement of the intellectual property of a complainant by a respondent is indicative of bad faith.

According to information provided by the Complainant, the Respondent has not only used the Complainant's word mark "TRANSLINK" but has also used its logo marks on the website. This indicates that the Respondent was likely aware about the Complainant, its business and its marks at the time of registration and certainly at the time of use of the Disputed Domain Name.

In the absence of any information provided by the Respondent as to actual or contemplated use in good faith, the Panel infers that the registration and use of the Disputed Domain Name by the Respondent was in bad faith.

7. Decision

Taking the 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 (2019-08-19).
2. The Disputed Domain Name is confusingly similar to the Complainant's trademark/names.
3. The Respondent has no legitimate interest in the Disputed Domain Name.
4. The Disputed Domain Name were registered and being used in bad faith.

Pursuant to Section 4 of the Policy, the Panel therefore recommends that PKNIC transfer the registration of the domain name in dispute < translink.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: 30 March 2021