

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. C2022-0001

Also in PDF C2022-0001

1. The Parties

The Complainant is Jade-E-Services Pakistan (Pvt) Limited [“Daraz”], having its office at 18th Floor, Sky Tower (A), Dolmen City, Plot # HC-3, Block 4, Scheme #5, Clifton, Karachi, Pakistan. The Complainant has initiated the Complaint vide their authorized representative, Benazir Azeem, at 18th Floor, Sky Tower (A), Dolmen City, Plot # HC-3, Block 4, Scheme #5, Clifton, Karachi, Pakistan

The Respondent’s name is D Mall with its address at 47-A, 1st Floor Hafeez Center, Lahore, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <dmall.pk>, hereinafter referred to as the Disputed Domain Name [“the DDN”]. [Vide email dated Friday 1 December 2021, PKNIC has informed DNDRC that the Disputed Domain Name was registered by D Mall with the contact name Anjum Shahzad, with its address at 47-A, 1st Floor Hafeez Center; Lahore, Pakistan.

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 18 October 2021.

The Respondent was issued a notification of the dispute along with a copy of the Complaint and a Response Form on 4 December 2021 informing the Respondent that if a Response was not received 10 days from the notification, the dispute would be proceeded ex parte. The Respondent was also issued a reminder notification. 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 Ms. Sarah Haider 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 <dmall.pk>.

PKNIC has confirmed via their email dated 1 December 2021 that the DDN was registered by the Respondent above-named and that the email address provided at the time of registration is kfrehman@msn.com.

4. Parties Contentions

A. Complainant

The Complainant's brief contentions are reproduced below:

"Dmall" is trademarked by Daraz, in several classes within Pakistan as well as most countries around the world. Hence, it is crucial for Daraz's business to acquire domain relevant to the same. In this regard, Daraz wants to purchase the Domain from its current owner. However, we are unable to find details of the owner of the Domain through the available means (i.e., through domain broker service providers' website and through pknic.net.pk). Thus we have made this complaint to you.

Therefore, the Complainant seeks the following remedies:

- To identify the current owner of the Domain; and
- To transfer the Domain's registration from the said owners to Daraz.

B. Respondent

The complaint was duly served to the Respondent, but the Respondent did not submit 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. Therefore, the Panel proceeded with the matter ex-parte.

5. Jurisdiction

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the Internet Domain Registration Policy version 4.4 (2019-08-19) and the Rules.

The Respondent applied for and was granted registration of the DDN 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 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 version 4.4 (2019-08-19) 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, and 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 DDN shall be assessed in consideration of the following criteria:

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

The Complainant has stated:

It is reiterated that “Dmall” is trademarked by Daraz, in several classes within Pakistan, as well as many countries around the world, and any domains consisting of the

said name is an infringement of our intellectual property rights, thus the Domain is being used in bad faith by its current owner.

The Respondent has not provided a substantive response to the Complainant's contention.

The Complainant has provided copies of certificates of registration issued by the Government of Pakistan indicating that it has registered the word mark "Dmall" in several classes in Pakistan. The Panel finds that the Complainant has submitted sufficient evidence that it has trademark rights in the word "Dmall". The DDN does prima facie incorporate in its entirety the registered trademark of the Complainant. In the view of the Panel, the DDN therefore infringes upon the trademark of the Complainant.

In the absence of any information provided by the Respondent, the Panel is unable to infer whether the Respondent also has rights to the term "Dmall" that would indicate that the registration of the DDN by the Respondent was bona fide.

In view of the findings of the Panel that the DDN, which incorporates a registered trademark of the Complainant in its entirety, constitutes an infringement of the trademark of the Complainant in its entirety, the Panel, relying on the findings in *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001), also finds that the registration will contravene relevant provisions of the Pakistan Penal Code.

The Panel therefore finds that the registration of the Disputed Domain Name is unlawful. 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 (2019-08-19).

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 stated that "Dmall" is trademarked by Daraz, in several classes within Pakistan, as well as many countries around the world, and any domains consisting of the said name is an infringement of our intellectual property rights, thus the Domain is being used in bad faith by its current owner.

It is an established principle that the incorporation of a Complainant's trademark in full within a disputed domain name may be sufficient to establish confusing similarity between the mark and the disputed domain name.

The Complainant has provided sufficient information, including annexing evidence of the same, that the Complainant has rights in the trademark "Dmall" in Pakistan. The addition of the ccTLD ".pk" would also not prevent the finding of confusing similarity.

The Respondent has not submitted any contention. In the absence of any valid explanation of how the DDN is not confusingly similar to the trademark of the Complainant, the Panel finds confusing similarity between the DDN and the Complainant's trademark under paragraph 4(a)(i) of the Policy.

III. Legitimate interests in a domain name

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

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

Paragraph 4(a)(ii) states that:

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

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

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

The Complainant has contended:

“Dmall” is trademarked by Daraz, in several classes within Pakistan, as well as many countries around the world, and any domains consisting of the said name is an infringement of our intellectual property rights, thus the Domain is being used in bad faith by its current owner.

The Respondent has failed to respond, and resultantly satisfy the Panel that the Respondent is commonly known by the name of “DMALL” or has any legitimate interest in the DDN.

As has been previously adopted by the discussions and findings in WIPO authorities, it is for the Respondent to rebut the allegations put forth by the Complainant after the Complainant establishes a prima facie case about the lack of legitimate interest in a disputed domain name. Also, with respect to proving rights or legitimate interests in the disputed domain name(s), it is for the Respondent to submit evidence pertaining to the same as it would be extremely difficult, if not impossible, for the Complainant to prove a negative assertion. As such, in order to satisfy the Panel that it has rights or legitimate interests to the DDN, the Respondent was obliged to respond and submit evidence with respect to the same.

The Complainant has indicated that it is in use of the name “DMALL” and has registered trademarks, demonstrating a prima facie case of legitimate interest in the DDN. The Panel notes that the DDN does not resolve to the website and there is no indication that the Respondent has been known by or is in use of the DDN.

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

IV. Registration and use in bad faith

The Complainant has made the following submission:

“Dmall” is trademarked by Daraz, in several classes within Pakistan, as well as many countries around the world, and any domains consisting of the said name is an infringement of our intellectual property rights, thus the Domain is being used in bad faith by its current owner.

The Respondent has failed to submit a response.

The Complainant and its trademark “Dmall” have been well-known and the Respondent may have known about them when registering the DDN. The Complainant has submitted that the DDN is being used in bad faith. On the other hand, the Respondent has failed to provide any information to rebut the contention of the Complainant.

The Panel finds that the Dmall mark of the Complainant had considerable popularity and was well-known for the period that the Respondent has been using the mark. The Respondent did not provide any submission that it was not aware about the Complainant or its business at the time of registration of the DDN. The Panel, therefore, in the absence of any submission to the contrary by the Respondent, finds that the DDN was registered and is being used in bad faith by the Respondent.

7. Decision

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

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

1. The Respondent’s registration of the DDN is contrary to the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19)
2. The Respondent has no legitimate interest in the DDN.
3. The DDN is identical to the Complainant’s trademark/names and registered domain names.
4. The DDN was 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 <dmall.pk> to the Complainant, as prayed, within 48 hours of receipt of this decision either by email or through the website where it will be uploaded, www.dndrc.com/cases_resolved/, whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Sarah Haider

Sole Panelist

Date: 17 March 2022