

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

vs

Case No. C2022-0002

Also in PDF C2022-0002

1. The Parties

The Complainant is Jade E-Services Pakistan (Pvt) Limited, having its office at 18 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, Ms. Benazir Azeem, Office at 18 Floor, Sky Tower (A), Dolmen City, Plot # HC-3, Block 4, Scheme #5, Clifton, Karachi, Pakistan.

The Respondent's name is Darazexpress, with its address at Karachi, Pakistan and has not described its legal status and has nominated Mr. Abdullah Haneef as his authorized representative, with his address in Karachi, Sindh.

2. The Domain Names and Registrar

The domain name in dispute is <darazexpress.pk>, hereinafter referred to as the Disputed Domain Name. Vide email dated Wednesday, 1 December 2021, PKNIC has informed DNDRC that name of the Registrant is Darazexpress with its address in Karachi, Pakistan. The Agent through which the registration was applied is Mr. Masood Azhar. Its Create Date was 2018-05-15 and its Expire Date is 2022-05-15.

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 20 October 2021 after which DNDRC completed its initial compliance review.

The Respondent was issued 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. DNDRC awaited the submission by the Complainant of the Complaint as per the prescribed forms also available at www.dndrc.com/downloads. The Respondent filed a Response on 13 December 2021.

Based on the response, the Panel framed the following question for the Complainant: *“Does Jade e-Services Pakistan (Private) Limited have any trademark registration in Pakistan or any other jurisdiction for the word “Daraz”? If so, please provide copies of the certificates of registration.”* In its response, the Complainant confirmed that it has obtained trademark registrations for the word “Daraz” in Pakistan and in several other jurisdictions.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), DNDRC appointed Mr. Sunain Qazi as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules.

4. Parties Contentions

A. Complainant

The Complainant’s brief contentions are reproduced below:

“darazexpress” is trademarked by the Jade E-Services Pakistan (Pvt) Limited (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 services providers’ websites and through pknict.net.pk). Thus, we have made this complaint to you.

The Complainant’s legal grounds are reproduced below:

It is reiterated that “darazexpress” 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 and thus, the Domain is being used in bad faith by its current owner.

Therefore, the Complainant seeks the following remedy:

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

B. Respondent

The Respondent has taken the position that the factual and legal grounds on which the Complaint is based are unfounded. The Respondent has summarized its position as follows:

Complainant has not provided any proof regarding the three elements of the ICANN UDRP Policy. Also, at the time of purchase of the domain, no such trademark was registered and the complainant has applied for the trademark later on. We have legitimate interest in the domain name from the time we purchased as for the same we have our Facebook page created on 11th October, 2018, (facebook.com/darazexpress.pk) and Instagram account www.instagram.com/darazexpresspk. After the outbreak of COVID 19 we temporarily closed the website as we had debts to Facebook in terms of advertisements and ad campaigns and had plans to start it again. Also, the term 'Daraz' is a generic word of Urdu which is widely used in every home in Pakistan for 'Drawers' and express is also a generic word commonly used worldwide. Also, the complainant claims that they have tried to make contact with us to buy the domain from us, but no such contact was made and our contact number could have been easily found by just googling the term "darazexpress.pk" and if would have result to our Facebook and Instagram pages which have our contact number. Therefore, it seems that the complainant is trying to get the domain in bad faith to attempt to deprive a registered domain-name holder of a domain name (UDRP Rule 1) which is an abuse of the administrative proceedings.

Also, Under Paragraph 4(c)(i) of the ICANN UDRP Policy, a complainant cannot prevail if the respondent, prior to notice of the dispute, has made "use of, or demonstrable preparations to use, the domain name in connection with a bona fide offering of goods or services". According to the ICANN UDRP policy we have attached the links of our facebook and instagram pages with the same name which we have been using before the notice of the dispute.

We have spent considerable investment of money (more than Rs1,042,122.48 PKR only on Facebook ads) and time on the same name therefore we would like to keep the ownership of the domain or we are open for offers (as mentioned by the complainant that they want to purchase the domain) in terms of compensation for the time and money invested on it.

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 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 Internet Domain Registration Policy version 4.4 (2019-08-19) and the Rules:

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, 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 / trademark?
- 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:

It is reiterated that "darazexpress" 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 and thus, the Domain is being used in bad faith by its current owner.

The Respondent has stated:

Also, at the time of purchase of the domain, no such trademark was registered and the complainant has applied for the trademark later on.

The Complainant has provided copies of certificates of registration issued by the Government of Pakistan indicating that it has registered the word mark "Darazexpress" in several classes in Pakistan. The Panel finds that the Complainant has submitted sufficient evidence that it has trademark rights in the word "Darazexpress". On the other hand, the Respondent has not provided any indication that it has registered or applied for the registration of the mark "Darazexpress" in Pakistan or in any other jurisdiction. The Disputed Domain Name does prima facie incorporate in its entirety the registered trademark of the Complainant. In the view of the Panel, the Disputed Domain Name therefore infringes upon the "darazexpress" trademark of the Complainant.

Moreover, the Disputed Domain Name also incorporates the registered mark "daraz" with the addition of the generic term "express", which is descriptive of the express delivery service offered by the Complainant and does not sufficiently differentiate the Disputed Domain Name from the Complainant's mark. In the view of the Panel, the Disputed Domain Name is also an obvious derivation of the "daraz" mark 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 "Darazexpress" or "daraz" that would indicate that the registration of the Disputed Domain Name by the Respondent was bona fide, particularly given the well-known nature of the Complainant's "daraz" mark and its use for the provision of express shopping and delivery services at the time of registration of the Disputed Domain Name by the Respondent.

In view of the findings of the Panel that the Disputed Domain Name, 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 continued registration by the Respondent 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 reiterated that "darazexpress" 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 and thus, the Domain is being used in bad faith by its current owner.

On the other hand, the Respondent has submitted:

Also, at the time of purchase of the domain, no such trademark was registered and the complainant has applied for the trademark later on...

Also, the term 'Daraz' is a generic word of Urdu which is widely used in every home in Pakistan for 'Drawers' and express is also a generic word commonly used worldwide.

The Panel acknowledges previous WIPO precedents that a trademark registration in even one jurisdiction is sufficient for the purposes of establishing trademark rights. The Complainant has provided evidence that it has registered the mark "darazexpress" in Pakistan. Moreover, the Complainant, at the request of the Panel, has provided evidence that it has registered the mark "daraz" in Pakistan and several other jurisdictions.

The Disputed Domain Name clearly incorporates the registered mark "darazexpress" of the Complainant in its entirety. It is a well-established principle that the addition of the ccTLD ".pk" is insufficient to prevent a finding of confusing similarity. Moreover, the Disputed Domain Name also incorporates the registered mark "daraz" with the addition of the generic term "express", which is descriptive of the express delivery service offered by the Complainant and does not sufficiently differentiate the Disputed Domain Name from the Complainant's mark. This supports the Complainant's position with respect to the Disputed Domain Name being confusingly similar to both its "darazexpress" and "daraz" marks.

The Respondent has failed to provide any substantive response to the contention of the Complainant that the Disputed Domain Name is confusingly similar to the Complainant's marks. The contention of the Respondent that the term "Daraz" is a generic Urdu word and is commonly used worldwide cannot be accepted by the Panel, as the Complainant has provided ample evidence that it has secured trademark rights to this term in Pakistan as well as in several other jurisdictions, well before the registration of the Disputed Domain Name by the Respondent.

It is a well-established principle that the registration of a disputed domain name prior to registration of a trademark does not prevent findings of identicalness or confusing similarity. The Panel relies on Case No. D2020-3504. Although the Respondent may have registered the Disputed Domain Name prior to the registration of the trademark "darazexpress", this is not relevant for the purpose of this assessment. In any case, the Panel observes that the Complainant obtained registration to the trademark "Daraz" in 2012, well before the registration of the Disputed Domain Name.

The Panel therefore finds that the Complainant has satisfied Paragraph 4(a) of the Rules as the Disputed Domain Name is confusingly similar to its registered trademarks "Darazexpress" and "Daraz".

III. Legitimate interests in a domain name

As per paragraph 4(c), the Rules require 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:

It is reiterated that "darazexpress" 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 and thus, the Domain is being used in bad faith by its current owner.

On the other hand, the Respondent contends:

We have legitimate interest in the domain name from the time we purchased as for the same we have our Facebook page created on 11th October, 2018, (facebook.com/darazexpress.pk) and Instagram account www.instagram.com/darazexpresspk. After the outbreak of COVID 19 we temporarily closed the website as we had debts to Facebook in terms of advertisements and ad campaigns and had plans to start it again.

Also, Under Paragraph 4(c)(i) of the ICANN UDRP Policy, a complainant cannot prevail if the respondent, prior to notice of the dispute, has made "use of, or demonstrable preparations to use, the domain name in connection with a bona fide offering of goods or services". According to the ICANN UNDRP policy we have attached the links of our facebook and instagram pages with the same name which we have been using before the notice of the dispute.

It is a well-settled principle that once a complainant has made out the prima facie case, the respondent carries the burden of demonstrating it has rights or legitimate interests. In its complaint, the Complainant has alleged that the Respondent is not using the Disputed Domain Name for the bona fide offering of goods or services. The non-use of the website has also been noted by the Panel.

The Respondent has provided information that they have not been operating a business from the website at the Disputed Domain Name since the pandemic started. The Respondent has also submitted that it has been operating a Facebook page and Instagram account by the name of "Daraz Express" and has provided URLs of the same.

The Panel finds that creating social media accounts of the same name as the Disputed Domain Name does not prove legitimate interest of the Respondent in the Disputed Domain Name itself. The Respondent has also not provided any proof that they were using the Disputed Domain Name

in connection with a legitimate business before the pandemic started. The Panel has no reason to believe that the Respondent's interest in the Disputed Domain Name is legitimate.

The Panel therefore finds that the Complainant satisfies the second element of the Rules.

IV. Registration and use in bad faith

The Complaint has submitted:

It is reiterated that "darazexpress" 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 and thus, the Domain is being used in bad faith by its current owner.

The Respondent has submitted:

Also, the complainant claims that they have tried to make contact with us to buy the domain from us, but no such contact was made, and our contact number could have been easily found by just googling the term "darazexpress.pk" and if would have result to out Facebook and Instagram pages which have our contact number. Therefore, it seems that the complainant is trying to get the domain in bad faith to attempt to deprive a registered domain-name holder of a domain name (UDRP Rule 1) which is an abuse of the administrative proceedings.

We have spent considerable investment of money (more than Rs1,042,122.48 PKR only on Facebook ads) and time on the same name therefore we would like to keep the ownership of the domain or we are open for offers (as mentioned by the complainant that they want to purchase the domain) in terms of compensation for the time and money invested on it.

The Panel has taken into consideration the submission of both the Complainant and the Respondent on this issue. The mark "darazexpress" and "daraz" have been registered in Pakistan. The "daraz" mark was registered by the Complainant prior to the registration of the Disputed Domain Name and was being used to provide express shopping and express delivery services to its users. By the time the Respondent registered the Disputed Domain Name, the "daraz" mark had attained sufficient popularity, particularly in Pakistan.

In its Response, the Respondent has indicated that it is willing to sell the Disputed Domain Name to the Complainant for a sum greater than the out-of-pocket expenses incurred in connection with the purchase and maintenance of the Disputed Domain Name. .

Although the Respondent has provided an indication that it was operating a business on social media using the name “Daraz Express”, in the view of the Panel, the registration of the Disputed Domain Name incorporating the well-known mark of the Complainant “daraz” which would have been known to the Respondent, along with the addition of a generic, descriptive word “express” would indicate the existence of bad faith.

Thus, the Panel, based on the information made available, finds that the registration of the Disputed Domain Name by the Respondent was mala fide.

7. Decision

Analyzing the details provided by the Complainant, the Panel finds that the Complainant has established (i) illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (iv) identicalness or confusing similarity to the Complainant’s “daraz” and “darazexpress” marks (iii) that the Respondent lacks legitimate interest in the Disputed Domain Name (iv) that the registration and use of the Disputed Domain Name by the Respondent was 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 <darazexpress.pk> to the Complainant, as prayed, within 48hours 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: Sunain Qazi

Sole Panelist

Date: 17 March 2022