

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. C2022-0003

Also in PDF C2022-0003

1. The Parties

The Complainant is Jade-E-Services Pakistan (Pvt) Limited, 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 Sami Chohan with his address at Sialkot, Pakistan, and Telephone No: +92 345 0052444.

2. The Domain Names and Registrar

The domain name in dispute is <dmart.pk>, hereinafter referred to as the Disputed Domain Name [“the DDN”]. Vide email dated Friday 01 December 2021, PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is easyhostclients, Gulshan-e-Iqbal, Karachi, Pakistan, and its Create Date was 2018-06-03 with an Expire Date of 2022-06-03.

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. DNDRC awaited the submission by the Complainant of the Complaint as per the prescribed forms also available at www.dndrc.com/downloads. The Respondent submitted a Response on 8 December 2021.

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

PKNIC has confirmed via their email dated 1 December 2021 that the DDN has been registered by the Respondent named in the Complaint and that their email address is debonair.sami@gmail.com.

4. Parties Contentions

A. Complainant

The Complainant's brief contentions are reproduced below:

Jade E-Services Pakistan (Pvt) Limited ("Daraz") has already filed trademark applications for "Dmart" and the same has been accepted by the Trade Mark Registry at Karachi and are at the awaiting publication stage. Hence, it is crucial for Daraz's business to acquire all domains 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 owners of the Domain Name 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.

Therefore, the Complainant seeks the following remedies:

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

After submission of the Complaint, the Complainant, on the request of the Panel, confirmed that the Trade Marks Registry had issued certificates of registration for the trademark "DMART" to the Complainant and provided copies of the same.

B. Respondent

The complaint was duly served to the Respondent. The Respondent submitted a response on 8

December 2021 in which the Respondent made the following statements:

1. *My domain is very old and belongs to my manufacturing business. Registered in 2018.*
2. *I already have NTN in the Name of D MART, obtained in 2018.*
3. *I have Business Bank Account with TITLE of DMART with Bank Alfalah Ltd, obtained in 2018.*
4. *My Business does not require any Trademark or any registration with the SECP.*
5. *Bank Account, NTN and Domain name are important tools for my business.*

The Respondent, on the request of the Panel, provided a copy of a bank account statement in the name of “DMART”.

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 Daraz has filed trademark applications for “Dmart” in several classes and the same has been accepted, therefore, any domains consisting of this Domain Name is an infringement of our intellectual property rights and thus, the Domain is being used in bad faith by its current owner. Therefore, it is important for Daraz to obtain all domains which consist of the said Domain Name in any way whatsoever.

After submission of the Complaint, the Complainant, on the request of the Panel, confirmed that the Trade Marks Registry had issued certificates of registration for the trademark “DMART” to the Complainant and provided copies of the same.

The Respondent has rejected all the allegations made by the Complainant in this respect.

The Complainant has provided copies of certificates of registration issued by the Government of Pakistan indicating that it has registered the word mark “Dmart” in Pakistan. The Panel finds that the Complainant has submitted sufficient evidence that it has trademark rights in the word “Dmart”. 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.

The Respondent, in its Response, has submitted the NTN certificate in the name of DMart along with the bank statement of a business account in the name of DMart. The Panel, however, finds that the Respondent has not provided any evidence that it has the right to continue to use the registered trademark of the Complainant in the DDN.

Though the Respondent has provided an NTN and bank account statement in the business name of “Dmart”, the Panel is unable to infer whether the Respondent that would indicate that the Respondent had any specific legitimate interest in the DDN or 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.

II. Identical or confusing similarity to a trademark or service mark in which the Complainant has rights

The Complainant has contended the following:

Daraz has filed trademark applications for “Dmart” in several classes and the same has been accepted, therefore, any domains consisting of this Domain Name is an infringement of our intellectual property rights and thus, the Domain is being used in bad faith by its current owner. Therefore, it is important for Daraz to obtain all domains which consist of the said Domain Name in any way whatsoever.

After submission of the Complaint, the Complainant, on the request of the Panel, confirmed that the Trade Marks Registry had issued certificates of registration for the trademark “DMART” to the Complainant and provided copies of the same.

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 “Dmart” 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 mentioned in the Complaint about registering with the Trade Mark Registry and has submitted the Trade Mark Registration Certificates subsequently, which proves their legal ownership over the trademark “DMART”.

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. 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 Disputed Domain Name, the Respondent was obliged to respond and submit evidence with respect to the same.

The Respondent has provided information that the Respondent has been using the Disputed Domain Name since 2018, and has provided an NTN and, on the request of the Panel, a bank account statement in the name of “DMART”. The Panel finds that the documents provided do not demonstrate any legitimate interest in the DDN itself. The Respondent has not provided any information that suggests prior, current or any plans to use the DDN prior to notification of the Complaint.

In light of the above, the Panel finds that the Respondent does not have rights 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:

Daraz has filed trademark applications for “Dmart” in several classes and the same has been accepted, therefore, any domains consisting of this Domain Name is an infringement of our intellectual property rights and thus, the Domain is being used in bad faith by its current owner. Therefore, it is important for Daraz to obtain all domains which consist of the said Domain Name in any way whatsoever.

After submission of the Complaint, the Complainant, on the request of the Panel, confirmed that the Trade Marks Registry had issued certificates of registration for the trademark “DMART” to the Complainant and provided copies of the same.

The Respondent has failed to submit any substantial evidence to prove their right in the DDN nor any evidence to demonstrate lack of bad faith with respect to registration, particularly in the absence of the Respondent’s actual use of the DDN. In the absence of the required evidence, the Panel, therefore, in the light of documents submitted by the Complainant, 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 Dmart 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 of the case law and 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 <dmart.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: Mr. Raja Abubakar

Sole Panelist

Date: 31 March 2022