

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. C2022-0004

Also in PDF C2022-0004

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 and has described its legal status as that of a Private Limited Company. The Complainant has initiated the Complaint vide their authorized representative, Benazir Azeem, 18th Floor, Sky Tower (A), Dolmen City, Plot # HC-3, Block-4, Scheme #5, Clifton, Karachi, Pakistan.

The Respondent is websitedesign.pk with its address at Lahore, Pakistan and has described its legal status as that of an individual and has nominated Ms. Manila Arshad as its authorized representative, with her address House No. 26, Sadaat Street. Street Number 8, Islam Pura, Lahore, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is < darazmall.pk >, hereinafter referred to as the Disputed Domain Name. Vide email dated Friday 1 December 2021, PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is Manila Arshad, House No. 26, Sadaat Street. Street Number 8, Islam Pura, Lahore, Pakistan and its Create Date was 2018-12-14 with an Expire Date of 2022-12-14.

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.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 04 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 initially asked for an extension to file a response which was granted to them. The Respondent filed a Response on 7 February 2022.

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 “DarazMall”? 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 “DarazMall” in Pakistan and the Complainant also provided copies of the certificates of registration of the trademark claimed by them.

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

PKNIC has confirmed via their email dated Wednesday, 1 December, 2021 that the Disputed Domain Name has been registered by the Respondent named in the Complaint and that their email address is jaedad@gmail.com.

4. Parties Contentions

A. Complainant

The Complainant’s brief contentions are reproduced below:

Darazmall 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 pknic.net.pk). Thus, we have made this complaint to you.

The Complainant's legal grounds are reproduced below:

It is reiterated that the "Darazmall" 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 name is being used in bad faith by its current owner.

Therefore, the Complainant seeks the following remedy:

- (1) To identify the current owner of the Domain; and*
- (2) To Transfer the Domain's registration from the said owners to Daraz.*

B. Respondent

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

DarazMall means a Long Mall (Lamba Mall), like Umar Daraz, Gaysoo Daraz. Daraz and Mall both words are common in Public use, and they are in the Urdu Dictionary. PUBLICLY COMMON USE WORDS CAN NOT BE MADE A TRADE WORK. But in the developing countries like Pakistan where CORRUPTION AND BRIBES EXIST, ANY THING CAN HAPPEN. People over there by using any means get the work done. Domain Name according to ICANN rules, Space is not allowed. Daraz Mall can only has a domain name DarazMall.com, DarazMall.net etc etc. There are tens of extensions and going to be hundreds. HENCE THE COMPLAINT IS UNFOUNDED.

The Respondent further stated its position as follows:

The Complainant wants to purchase this domain name as mentioned in the Complaint (item 7), I am ready to sell DarazMall.pk domain name for US\$110,000/- (US One hundred and ten thousand dollars). We as a Team spent a lot of time and resources for Planning and Working for this Project.

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 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, 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 stated:

It is reiterated that the “Darazmall” is trademarked by the Jade E-Services Pakistan (Pvt) Limited (Daraz) in several classes within as well many countries around the world, and any domains consisting of the said name is an infringement of intellectual property rights and thus, the domain is being used in bad faith by its current owner.

The Respondent has submitted as follows:

Respondent stated that the words Daraz and Mall are common in public use and cannot be made a Trade Work. Hence, this mark has been acquired through illegal means. Hence the Complaint is unfounded.

The Complainant has provided copies of certificates of registration issued by the Government of Pakistan indicating that it has registered the word mark “DarazMall” in several classes in Pakistan. The Panel finds that the Complainant has submitted sufficient evidence that it has trademark rights in the word “DarazMall”. On the other hand, the Respondent has not provided any indication that it has registered or applied for the registration of the mark “DarazMall” 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 “DarazMall” trademark of the Complainant.

Moreover, the Disputed Domain Name also incorporates the registered mark “daraz” with the addition of the generic term “mall” which describes the type of services provided by the Complainant, 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 with an addition of a descriptive word (“mall”).

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 “DarazMall” 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 Complaint has submitted the following:

It is reiterated that the "Darazmall" 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 name is being used in bad faith by its current owner.

The Respondent has submitted:

Respondent stated that the words Daraz and Mall are common in public use and cannot be made a Trade Work. Also, the term 'Daraz' is a generic word of Urdu which is widely used in every home in Pakistan. Hence, this mark has been acquired through illegal means. Hence the Complaint is unfounded.

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 “DarazMall” in Pakistan. Moreover, the Complainant, at the request of the Panel, has also provided evidence that it has registered the mark “daraz” in Pakistan in the year 2012.

The Disputed Domain Name clearly incorporates the registered mark “DarazMall” 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 descriptive term “mall”. The addition of this descriptive term also does not sufficiently differentiate the Disputed Domain Name from the Complainant’s registered “daraz” mark. This supports the Complainant’s position with respect to the Disputed Domain Name being confusingly similar to both its “DarazMall” 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 already secured trademark rights to this term in Pakistan as well as in several other jurisdictions.

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 “DarazMall”, 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 “DarazMall” and “Daraz”.

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:

It is reiterated that the “Darazmall” 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 name is being used in bad faith by its current owner.

On the other hand, the Respondent contends:

Respondent stated that the words Daraz and Mall are common in public use and cannot be made a Trade Work. Also, the term ‘Daraz’ is a generic word of Urdu which is widely used in every home in Pakistan. Hence, this mark has been acquired through illegal means. Hence the Complaint is unfounded. Further, the Respondent is also accepting the offer of sale of Disputed Domain Name.

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 this case, the Respondent failed to provide any information related to its legitimate interest in the Disputed Domain Name. Further, the Respondent also failed to provide the evidence of using the Disputed Domain Name for the bona fide offering of goods or services.

The Respondent has not provided any proof that they were using the Disputed Domain Name in connection with a legitimate business.

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

IV. Registration and use in bad faith

The Complainant has made the following submission:

It is reiterated that the “Darazmall” 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 name is being used in bad faith by its current owner.

The Respondent on the other hand has submitted as follows:

Respondent stated that the words Daraz and Mall are common in public use and cannot be made a Trade Work. Also, the term ‘Daraz’ is a generic word of Urdu which is widely used in every home in Pakistan. Hence, this mark has been acquired through illegal means. Hence the Complaint is unfounded. Further, the Respondent says that if the Complainant wants to purchase this domain name then the Respondent is ready to sell it for US\$110,000/- as the Respondent Team spent a lot of time and resources for planning and working for this Project.

The Panel has taken into consideration the submission of both the Complainant and the Respondent on this issue. The mark “DarazMall” and “daraz” have been registered in Pakistan. The “daraz” mark was registered by the Complainant in 2012, prior to the registration of the Disputed Domain Name. The addition of the descriptive word “mall” indicates the type of services that are being provided by the Complainant (i.e. shopping). By the time the Respondent registered the Disputed Domain Name, the “daraz” mark had attained sufficient popularity, particularly in Pakistan even if “Darazmall” was trademarked after the registration of the Disputed Domain Name. It is therefore unlikely that the Respondent was unaware about the Complainant and its “daraz” mark at the time of registration. 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 “Mall” would indicate the existence of bad faith.

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. This is an indication of bad faith. Reference can be made to WIPO case no D2018-2106 the facts of which are similar to our case at hand.

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 perceives that the “DarazMall” 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 Disputed Domain Name is contrary to the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19)
2. The Respondent has no legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Name is identical to the Complainant’s trademark/names and registered domain names.
4. The Disputed Domain Name 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 < darazmall.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: Abdul Razzak Surahio

Sole Panelist

Date: April 27, 2022