

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. C2022-0006

Also in PDF C2022-0006

1. The Parties

The Complainant is M/S Raja Sahib [“rajasahib.pk”], having its office at 32-A, Link Road, Model Town, Lahore through its authorized representative, Ammara Farooq Malik, having its office at AFMalik Law (Attorneys & International Development Consultants) 656 X, Street 22, Phase 3, DHA, Lahore, Pakistan.

The Respondent’s name is Mr. Ahmed with his address at Gulberg, Lahore.

2. The Domain Names and Registrar

The domain name in dispute is <rajasahib.pk>, hereinafter referred to as the Disputed Domain Name [“the DDN”]. Vide email dated Tuesday 21 April 2022, PKNIC has informed DNDRC that the Disputed Domain Name was registered by Mr. Ahmed, with his address at Gulberg, Lahore.

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 01 April 2022.

The Respondent was issued a notification of the dispute along with a copy of the Complaint and a Response Form on 25 April 2022 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 on 6 May 2022. 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. Sunain Qazi 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 <rajasahib.pk>.

PKNIC has confirmed via their email dated 21 April 2022 that the DDN was registered by the Respondent above-named and that the email address provided at the time of registration is altmash_2005@hotmail.com.

4. Parties Contentions

A. Complainant

The Complainant's brief contentions are reproduced below:

1. The domain names domain names <www.rajasahib.pk> & <www.rajasahib.com.pk> (the "Domain Names") are the subject of this Complaint which is being instituted on account of misappropriation of the trademark "Raja Sahib" as domain names by the Respondent.

2. The Complainant's business under the name "Raja Sahib" was founded by Javaid Riaz in the 1970s by opening a departmental store under the name and style "Raja Sahib" on the famous Mall Road of Lahore. Subsequently, after many years of establishing itself and growing into a house hold name, in year 2010, the Complainant was formally registered as a partnership firm under the Partnership Act, 1932 with the trade name M/s Raja Sahib.

Attached are:

- (i) Firm Registration Certificate - Annex – A*
- (ii) Partnership Deed - Annex A-1*
- (iii) NTN Certificate - Annex A-2*

3. With the passage of time, the Complainant has grown into a chain of departmental stores serving and playing a role in contributing to Pakistan's retail industry under the trademark and service mark "Raja Sahib". With a wide array of segmented consumer products, the Complainant is a client and business partner to almost all local and international brands in Pakistan known for mutual growth and transparency. The Complainant's provides its customers with the best experience by offering best quality commodities at the best price, be it at its stores or on its website(s). The Complainant's aim is to provide with the maximum variety of products to its customers and at present has over 30,000 products to offer.

4. Though commencing with the retail of readymade garments at Mall Road Lahore in the 1970s, the Complainant also pioneers the concept of shopping malls in Pakistan

clubbing fabrics, readymade clothing, home & kitchen appliances, utensils and décor, newborn essentials, toys and travelling essentials under one roof for its customers which are available at its stores in Lahore now operating at Link Road, Model Town, Liberty Market, Mall Road and Wapda Town. In this regard, the Complainant is a regular tax payer and is diligent and regular contributor to the public exchequer.

Attached are:

- (i) Sales Tax Returns - Annex – B*
- (ii) Income Tax Returns - Annex – B-1*

5. In addition to its physical outlets, the Complainant also offers online shopping through its website www.rajasaheb.com. The Complainant is passionate about giving its customers the ability to make their mark on the world through their sense of fashion, and the Complainant believes there is no limit to self-expression, so it offers its customers the best quality products in a variety of range in totally inexpensive prices.

Attached are: Screen shots from www.rajasaheb.com - Annex – C & C-1

6. The Complainant's domain www.rajasaheb.com, was created on 08.12.2009 and a website was launched through the said domain which is widely recognized in Pakistan and with Pakistani's living overseas.

Attached is:

Registration Proof of www.rajasaheb.com - Annex – D

7. On account of its services, the trade name, trademark, service mark and domain name "Raja Sahib" has acquired an excellent reputation. From the very beginning and down the years, the said name has consistently been associated with, and has denoted the business and services of the Complainant.

8. Since 2009, the Complainant has been using the domain name www.rajasaheb.com for its online services and e-commerce activities. The services provided have been extensively promoted by the Complainant. Today, www.rajasaheb.com has an established presence on the internet providing various retail services. Thus the trade name, trademark, service mark and domain name "Raja Sahib" has become synonymous with the goods and services of the Complainant and substantial goodwill on account of continuous, expansive and prior use of the mark "Raja Sahib" and domain www.rajasaheb.com accrue to the Complainant. For its users all over Pakistan and beyond, the words "Raja Sahib" is a distinguishable mark – a mark on which they have implicit faith and trust.

9. In furtherance of the above, the Complainant with a view to maximize the potential of its online services in Pakistan, also got purchased and registered the domain names www.rajasaheb.pk and www.rajasaheb.com.pk. This was done on 09.02.2016. The said registrations were valid till the year 2023.

Attached is: Registration Proof of www.rijasahib.pk and www.rijasahib.com.pk - Annex – E-1 to E-6

10. In September 2021, the Complainant found out that the domain names www.rijasahib.pk and www.rijasahib.com.pk stopped appearing on the PKNIC portal under the Complainant's My Domains section. Consequently, the Complainant emailed PKNIC inquiring about the same. However, it has received no response to its emails from PKNIC. The Complainant's representative also visited the offices of PKNIC many times, however its such efforts remained futile.

Attached is: Complainant's emails to PKNIC - Annex – F-1 to F-6

11. On a further search of the PKNIC portal, it was revealed to the Complainant that the domain names www.rijasahib.pk and www.rijasahib.com.pk had been registered in favour of some unknown person (reference Annex X & X-1). However both the said domains are inactive.

12. The present complaint has been instituted in order to protect the Complainant's rights in the trademark, service mark and domain name "Raja Sahib" which has been unauthorizedly copied by the Respondent and registered as domain names <www.rijasahib.pk> & <www.rijasahib.com.pk> with PKNIC Registry.

Therefore, the Complainant seeks the following remedies:

In accordance with paragraph 4(1) of the Policy, for the reasons described in section V above, the complainant requests the Registrar / Administrative Panel appointed in the administrative proceeding to issue a decision that the domain names <www.rijasahib.pk> & <www.rijasahib.com.pk> be transferred to the Complainant.

In support of its complaint, the Complaint, inter alia, relies upon the previous decisions by DNDRC of "amazonprime.pk" - C2019-0006; "amazonshop.pk" - C2019-0003; "amazonshopping.pk" - C2019-0002; "ebaypakistan.com.pk" - C20180009; "deals2buy.pk" and "deals2buy.com.pk" - C2017-0004; "carrefour.pk" - C2016-003; "olx.org.pk" - C2015-0002.

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 based on 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 and the Respondent have not submitted any contention with respect to this issue.

The Panel has conducted its own assessment and have concluded that the Complainant has provided copies of certificates of registration indicating that it has registered the word mark “RAJA SAHIB”. The Panel finds that the Complainant has submitted sufficient evidence that it has trademark rights in the word “RAJA SAHIB”. 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 “RAJA SAHIB” 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:

13. The Complainant has used the trade name “Raja Sahib” since 1970s and officially adopted the same in 2010 when the Complainant was registered as a partnership firm. Further, the Complainant also got the trademark “Raja Sahib” registered in its favour in 2007. The Complainant also obtained the www.rajasaheb.com in 2009 and has been using the same as its website since then. Lastly, the Complainant also purchased the domain names <www.rajasaheb.pk> & <www.rajasaheb.com.pk> in 2016. All such adoption and use predates the registration date for the disputed domain names which was done in year 2021. Thus, the Complainant has rights in the trade name, trade mark, service mark and domain names comprising of “Raja Sahib”.

14. The Complainant owns the domain names <www.rajasaheb.pk> & <www.rajasaheb.com.pk> and the Respondent is an infringer and a cyber squatter who has registered the same in his favour with mala fide intent so as to block the Complainant from using the same and in doing so has blatantly infringed upon the intellectual property rights of the Complainant. The Respondent’s current non-use of the domain names is irrelevant for the purposes of establishing infringement. In fact, such non-use establishes that the Respondent has registered the infringing domain names with an aim to cash upon the same. Even otherwise, if the Respondent initiates any use of the said domain names, the same would be with an intent to cause confusion and deception and any such business activity shall be illegal as the same

would be to dupe the general public to believe that the services so offered emanate from the Complainant.

Therefore, the disputed domain names are identical to the Complainant's mark/domain "Raja Sahib".

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 "RAJA SAHIB". 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:

15. The Complainant submits that there is no credible legitimate reason for the Respondent to have acquired the domain names <www.rajasahib.pk> & <www.rajasahib.com.pk>. The Respondent's purpose in selecting the domain names is plainly to use the fame of the "Raja Sahib" trade name, trade mark and service mark to generate web-traffic and to confuse internet users (in the event the Respondent launches a site) when looking for the Complainant and their famous suite of services.

16. Registration (and likely use) of the domain names <www.rajasahib.pk> & <www.rajasahib.com.pk> by the Respondent is neither bonafide nor a legitimate noncommercial or fair use of the domain names. The goodwill in the trade name, trade mark, service mark and domain names "Raja Sahib" rightfully belongs to the Complainant and has been improperly appropriated by the Respondent. Such conduct can never constitute a legitimate interest.

17. The Complainant submits that when the Respondent registered the disputed domains name, it was aware of the Complainant's activities, its trade name, trade mark, service mark and domain names <www.rajasahib.pk> & <www.rajasahib.com.pk> and these facts establish a prima facie case that the Respondent has no right or legitimate interest in the disputed domain names and that pursuant to the Policy the burden shifts to the Respondent to show it does have a right or legitimate interests.

The Respondent has failed to respond, and resultantly satisfy the Panel that the Respondent is commonly known by the name of "rajasahib.pk" 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, 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 "RAJA SAHIB" 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 a website that uses the name “RAJA SAHIB”, 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:

18. It is the Complainant’s belief that the Respondent does not ever intend to use the domain names <www.rajasahib.pk> & <www.rajasahib.com.pk> and is acting as a cyber-squatter, which in itself is enough to establish bad faith. It is submitted that the Respondent’s bad faith is further exemplified by the fact that it has registered the said domain names on 03.02.2021, which is subsequent to the adoption and use of the mark “Raja Sahib” by the Complainant. First, the fame and unique quality of services under the “Raja Sahib” mark make it extremely unlikely that the Respondent created the domain names independently. Even constructive knowledge of a famous mark like “Raja Sahib” is sufficient.

19. The Respondent has registered the domain names which in the first place were under the proprietorship of the Complainant to begin with. Regardless the said domain names are identical to the Complainant’s mark and domain. In so doing, the Respondent shall be (in the event it launches any websites through the said domain names) intentionally attempt to attract for commercial gain internet users to any such websites, by intentionally misleading them and creating a likelihood of confusion with the Complainants’ trade name, trademark, service mark and domain name as to the source, sponsorship, affiliation, or endorsement of any such websites (Policy, paragraph 4(b)(iv)).

20. The Respondent’s choice of domain name is not accidental and has clearly been made to derive unfair monetary advantage. In support of this submission, the Complainant contends:

(1) At the time of registration of the domain names by the Respondent, the mark and domain name “Raja Sahib” was well-known and registered in Pakistan as a trade name, trademark and domain name. Therefore, the popularity and registration of “Raja Sahib” mark and domain name was a constructive notice to the Respondent on Complainant’s rights in the “Raja Sahib” mark and name. Thus, the adoption of an

identical mark/domain name by the Respondent is in bad faith.

(2) The Complainant has made extensive use of the “Raja Sahib” mark for a considerable time, such that the “Raja Sahib” mark has acquired goodwill in favour of the Complainant

The Respondent has failed to submit a response.

The Panel finds that the “RAJA SAHIB” 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 “RAJA SAHIB” 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 cancel the registration of the domain name in dispute <rajasahib.pk>, 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: Sunain Qazi

Sole Panelist

Date: 06 June 2022