

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. C2023-0003

Also in PDF C2023-0003

1. The Parties

The Complainant is Full Fortune Intellectual Limited, hereinafter referred to as “Hey Dude”, having its office at 6/F, The Annex, Central Plaza, 18 Harbour Road, Hong Kong. The Complainant has initiated the Complaint vide their authorized representative, David S. Lipkus, at 2300 Yonge Street, Suite 1600, Toronto, Ontario M4P1E4.

The Respondent’s name is Owais-ul-Wara with his address at North Karachi, Karachi, Pakistan. The Respondent has responded to the Complaint vide their authorized representative, Zubair Behlim with his address at ZM Global, F.B. Industrial Area, Block 22, Gulberg Town, Karachi, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <heydude.pk>, hereinafter referred to as the Disputed Domain Name [“the DDN”]. Vide email dated Thursday 11 May 2023, PKNIC has informed DNDRC that the Disputed Domain Name was registered by Owais-ul-Wara with the contact’s name Owais-ul-Wara, with his address at North Karachi, Karachi, 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 23 March 2023.

The Respondent was issued a notification of the dispute along with a copy of the Complaint and a Response Form on 15 May 2023 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 18 May 2023. The Respondent provided a response on 21 May 2023.

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 on is <heydude.pk>.

PKNIC has confirmed via their email dated 11 May 2023 that the DDN was registered by the Respondent above-named and that the email address provided at the time of registration is owaisulwara@gmail.com.

4. Parties Contentions

A. Complainant

The Complainant's brief contentions are reproduced below:

The Complainant's trademark registration is pending in Pakistan in Class 25 and is in the final stages of the registration process. The Complainant has a trademark application (advertised) in Pakistan for HEY DUDE (logo), filed on January 22, 2021, under application number 600254 for use in association with goods in Class 25. The trademark was advertised in March 2022. Further, and without limitation, "HEY DUDE" (and variations of the Hey Dude logo) is trademarked by the Complainant, in several countries around the world, including the United States and Canada. It is crucial for the Complainant's business to acquire domains relevant to the same. A copy of the Trademark Application from the Trade Marks Registry, Intellectual Property Organization – Government of Pakistan and notice of Advertisement, as well as details relating to additional trademark registrations owned by the Complainant in other countries has been provided for your perusal. In this regard, HEY DUDE requests that the Domain Name registration be transferred from the current owner to the Complainant. However, we are unable to find true and correct details of the owner of the Domain through the available means. Additionally, the email correspondence between the Complainant and PKNIC Staff dated October 7, 2022 has also been provided. Additional correspondence thereafter between the owner of the domain and the Complainant is also included.

Therefore, the Complainant seeks the following remedy:

- *To transfer the Domain's registration from the current owner(s) to the Complainant.*

B. Respondent

The Respondent's brief response is reproduced below:

We confirm that a complaint has been received regarding the heydude.pk domain. However, we deny the allegations made in the complaint in their entirety.

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:

Since its formation in 2008, the Complainant has used and registered several of its marks in the United States and throughout the world. See Annex “E” (Declaration of Heike Bhonsle). The Complainant is engaged in the manufacture and distribution of footwear in association with one or more of the HEY DUDE Trademarks globally as early as 2009. As a result of such use, customers in the United States and worldwide have come to associate the HEY DUDE mark with Complainant’s lightweight, high quality, and comfortable products. As mentioned above, the Complainant owns numerous trademark registrations worldwide, demonstrated at Annex “C”, and has developed considerable goodwill in the HEY DUDE trademarks.

The Complainant is known for their innovative casual footwear for men, women and youth and offers a broad portfolio of reliable and stylish footwear. Since its inception in 2008 through 2021, Hey Dude has sold more than 25 million pairs of shoes in more than 30 countries around the world. Complainant also owns a number of domain name registrations which wholly incorporate Complainant’s HEY DUDE marks, including, but not limited to: (1) heydude.com, (2) heydudeshoes.com, (3) heydudeshoesusa.com, (4) heydude.asia, and (5) heydude.com.pk. True and correct copies of information reproduced from DomainTools WHOIS databases regarding the Complainant’s Hey Dude domain name registrations are attached as Annex “F”. Also attached at Annex “F” is a full list of more than 250 domains owned by the Complainant. Since their registration, Complainant has used and continues to use these domain names in connection with its various websites, which provide information about Complainant and its products and services as well as offer its products for sale.

The Complainant’s registrations for the HEY DUDE trademarks are prima facie evidence of validity of the mark, and establish Complainant’s rights for purposes of the Policy. The Complainant owns registrations for the HEY DUDE mark in several countries worldwide

other than the United States and Pakistan, as demonstrated at Annex “C”. See Annex “G”: Logitech International S.A. vs Logitech Case No. C2019-0004; Metropolitan Life Insurance Company v. Robert Bonds, FAFA0612000873143 (Nat. Arb. Forum Feb. 16, 2007) (finding that a registration adequately trademark demonstrates a complainant’s rights in a mark). Additionally, the Complainant can demonstrate its rights in the mark by evidencing registration by the USPTO and an ICANN panel is not empowered to disturb that determination. (American Airlines, Inc. v. Insane Entertainment, LLC c/o Adam Maysonet, FA 1065242 (Nat. Arb. Forum Oct. 7, 2007).

The Complainant has used the HEY DUDE mark continuously in connection with the advertising, offering for sale, and sale of its various products in the United States and elsewhere, including Pakistan. HEY DUDE products are distributed in Pakistan at various shops and department stores, including but not limited to, the Shoe Box, BEST FIT Department Store, Brand Land and Megabrand. Additionally, in Pakistan, consumers can purchase HEY DUDE merchandise online through a number of approved third party e-commerce vendors, including but not limited to, AK Galleria (akgalleria.com), JOMO.pk, Superfeet.pk and Shopping Bag PK (www.shoppingbag.pk). See Annex “E”.

Complainant’s use of the HEY DUDE trademarks has resulted in millions of customers worldwide. See Annex “E”. These figures speak to the commercial strength of the HEY DUDE trademark, which has been used prominently, continuously, and substantially exclusively in connection with Complainant. The HEY DUDE marks are well known and recognized and have been for many years. Over these years, Complainant has expended millions of dollars in advertising and promoting its products under its HEY DUDE trademark in a variety of media throughout the world, including print and online social media activity. See Annex “E”.

Complainant has also advertised its HEY DUDE marks through the Internet, including on the websites associated with its domain name referenced above. The Complainant is also active on various social media platforms, including but not limited to Facebook, Instagram, YouTube and TikTok, Twitter and Pinterest where millions of consumers and users engage with the Complainant’s content. The Complainant’s advertising reaches a vast range of consumers: by way of example, since Complainant’s www.heydudeshoesusa.com website first launched, it has received millions of visitors seeking information about Complainant’s HEY DUDE products. See Annex “E”. The Complainant promotes the HEY DUDE trademarks on shoes and other goods and distributes its products in more than 30 countries and in thousands of stores worldwide. See Annex “E”. Through Complainant’s extensive promotional efforts, advertising expenditures and sponsorship activities, Complainant has

been successful in educating the public to associate the HEY DUDE trademark with Complainant's products long before the date the Respondent registered the Disputed Domain Name.

In addition to infringing upon a registered trademark, the Complainant submits that the Disputed Domain Name is an obvious derivation of their registered company name and is not bona fide as recognized by international best practice.

The Respondent has stated:

The complaint is unfounded based on the following factual and legal grounds:

a) Ownership and Intent: We registered the heydude.pk domain with the intention of establishing our own brand. Although we switched to a different name for our brand and sought a potential buyer for the domain, we were not aware of any trademark registration in our country against the heydude.pk domain.

b) Price Negotiation: While we did engage in discussions with a potential buyer who expressed interest in purchasing the domain at \$4000, the transaction did not materialize due to disagreement among our partners regarding the price. The cancellation of the transaction was not based on any knowledge of a trademark registration against the domain.

c) Lack of Bad Faith: We operated in good faith throughout the process and had no knowledge of any conflicting trademark rights. There was no intention to infringe upon or exploit the rights of any third party. Any communication with the potential buyer was solely for the purpose of negotiation and selling the domain in a legitimate manner.

d) Upon realizing that the trademark associated with the heydude.pk domain is registered by another company, we promptly took action to remove the webpage offering the domain for sale. We acknowledge the importance of respecting intellectual property rights and have taken steps to ensure compliance with trademark regulations. As a result, the webpage for selling the domain has been removed to avoid any further confusion or potential infringement.

The Complainant has provided, in Annexure C, information regarding their registration of the trademark issued by the Government of Canada, China, Hong Kong, Indonesia, Israel, Philippines, South Korea, Switzerland, Taiwan, United Kingdom, and United States. The Complainant has

also submitted their application for registration in Pakistan, submitted on 30 January 2021, under class 25. The Panel finds that the Complainant has submitted sufficient evidence that it has trademark rights in the words “Hey Dude”. 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 has not provided any information to rebut the position of the Complainant.

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:

The trademark on which this Complaint is based is HEY DUDE. Complainant’s numerous federal trademark registrations and widespread use, advertising, and promotion of the HEY DUDE marks since 2008 sufficiently establish rights in the mark pursuant to UDRP para. 4(a)(i). See Annex “H” (LEGO Juris. A/S v. Besnard, FA1201001423428 (Nat. Arb. Forum Feb, 22, 2012)); see also Annex I (State Farm Mutual Automobile Insurance Co. v. wy c/o company, FA1104001382897 (Nat. Arb. Forum May 31, 2011) (finding that a USPTO registration is sufficient evidence “even though Respondent resides or operates in a country outside the United States”)); see also Renaissance Hotel Holdings, Inc. v. Renaissance Cochin, FA07030000932344 (Nat. Arb. Forum Apr. 23, 2007)).

Respondent’s domain name <heydude[.]pk> incorporates Complainant’s HEY DUDE trademark in its entirety. A Disputed Domain Name by incorporating the registered trademark of the Complainant in its entirety has been deemed an obvious derivation of a trademark. Moreover, it is established law to disregard the ccTLD when considering the

matter of confusing similarity or obvious derivation as the addition of suffix ".pk" does not create any distinction that may eliminate the possibility of confusion by the Complainant's customers, as held in Google Inc. v Mubarkan Pvt. Ltd (Case No:C20120002) for the domain www.gmails.pk which was found to be similar to the trademark GMAIL of Google Inc. See Annex "J"; see also Annex "N", Travelscape, LLC vs Travelocity Pakistan, Case No. C2017-0005 and paragraph 1 of the PKNIK.

Accordingly, Respondent's domain name is identical to Complainant's mark in which they have rights.

The Respondent has stated:

The complaint is unfounded based on the following factual and legal grounds:

- a) Ownership and Intent: We registered the heydude.pk domain with the intention of establishing our own brand. Although we switched to a different name for our brand and sought a potential buyer for the domain, we were not aware of any trademark registration in our country against the heydude.pk domain.*
- b) Price Negotiation: While we did engage in discussions with a potential buyer who expressed interest in purchasing the domain at \$4000, the transaction did not materialize due to disagreement among our partners regarding the price. The cancellation of the transaction was not based on any knowledge of a trademark registration against the domain.*
- c) Lack of Bad Faith: We operated in good faith throughout the process and had no knowledge of any conflicting trademark rights. There was no intention to infringe upon or exploit the rights of any third party. Any communication with the potential buyer was solely for the purpose of negotiation and selling the domain in a legitimate manner.*
- d) Upon realizing that the trademark associated with the heydude.pk domain is registered by another company, we promptly took action to remove the webpage offering the domain for sale. We acknowledge the importance of respecting intellectual property rights and have taken steps to ensure compliance with trademark regulations. As a result, the webpage for selling the domain has been removed to avoid any further confusion or potential infringement.*

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 as established in *Compagnie Générale des Etablissements Michelin v. World Industrial, LNQ*, WIPO Case No. D2019-0553.

The Complainant has provided sufficient information, including annexing evidence of the same, that the Complainant has rights in the trademark "HeyDude" in different jurisdictions and has applied for the trademark license of "HeyDude" in Pakistan. The addition of the ccTLD ".pk" would also not prevent the finding of confusing similarity.

The Respondent have failed to provide any proof or any argument refuting the Complainant's claim that there is any confusing similarity between the registered DDN.

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:

The Complainant's first use and first registration of its HEY DUDE mark predate any use Respondent may have made of <heydude[.]pk> as a trade name, domain name, mark, or common name.

Additionally, Complainant registered the domain name and began operating its websites at heydudeshoes.com and heydudeshoesusa.com, several years before Respondent registered the domain name in dispute in this case. The Respondent was likely aware of Complainant's domain names and web sites associated with same before it registered the Disputed Domain Name because Complainant's sites were operational, and thus easily accessible to Respondent, at the time Respondent registered the Disputed Domain Name. Further and without limitation, the Complainant also filed a trademark application for HEY DUDE (logo) with the Intellectual Property Organisation Trade Marks Registry (Government of Pakistan), on January 22, 2021 (see Annex "C"). The Disputed Domain Name was registered on September 22, 2021 (see Annex "B"). Moreover, the Respondent is not affiliated with the Complainant in any way. The Complainant has not authorized the Respondent to use and register its trademarks and service marks, or to seek the registration of any domain name incorporating said mark. Because Complainant's federal registrations and common law use likely predates Respondent's domain name registration, and because the Respondent is charged with constructive knowledge of Complainant's HEY DUDE multiple trademark registrations, in Pakistan and other jurisdictions. Respondent has no proprietary rights, or legitimate interests, in the Disputed Domain Names. The HEY DUDE trademark has become a distinctive identifier that is associated with the Complainant and its goods and services. Respondent's registration of a domain name wholly incorporating a confusingly similar and distinct mark is not supported by legitimate interests. See Annex "K". (Hewlett Packard Co. v. Inversiones HP Milenium C.A., FA0203000105775 (Nat. Arb. Forum, Apr. 12, 2002) ("Furthermore, based on the fame of Complainant's HP mark it would be very difficult for Respondent to show that it had rights and legitimate interests in the Disputed Domain Names. Any use by Respondent of the <hpmilenium.com> domain name, confusingly similar to the Complainant's mark...for its own commercial gain...").

Respondent also has no proprietary rights or legitimate interest in "HEY DUDE" because the Respondent is not using the domain name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use. The Respondent has no proprietary rights or legitimate interest in "HEY DUDE" or the <heydude[.]pk> domain name because the Respondent is not commonly known by these names. See Annex "L" (La-Z-Boy Inc v. Iqbal, FA1010001355601 (Nat. Arb. Forum, Dec. 21, 2010) ("The Panel determines that Complainant's assertions combined with the WHOIS registrant information indicate that Respondent is not commonly known by the <la-z-boy.us> domain name under Policy para.

4(c)(iii)"); see also *L'Oreal v. Mole*, FA1203001435940 (Nat. Arb. Forum, May 7, 2012) ("The Panel finds that the WHOIS information bears no nominal similarity to the <lorealprofessionnel.us> domain name, providing evidence that Respondent is not commonly known by the Disputed Domain Name within the meaning of Policy para. 4(c)(iii)").

Further, Complainant has not authorized or licensed the Respondent or anyone to use or register the domain name which incorporates Complainant's HEY DUDE marks. See also Annex "M" (*Hard Rock Café Int'l (USA), Inc. v. Bouzianis*, FA1306001507576 (Nat. Arb. Forum, Aug. 5 2013) ("as the respondent was not authorized to register domain names featuring the complainant's mark and failed to submit evidence that it is commonly known by the domain name [...] the Panel holds that Respondent is not commonly known by the [...] domain names under Policy para. 4(c)(iii)").

For the reasons discussed herein, Respondent has no rights or legitimate interests in the Disputed Domain Name.

The Respondent has stated:

The complaint is unfounded based on the following factual and legal grounds:

- a) Ownership and Intent: We registered the heydude.pk domain with the intention of establishing our own brand. Although we switched to a different name for our brand and sought a potential buyer for the domain, we were not aware of any trademark registration in our country against the heydude.pk domain.*
- b) Price Negotiation: While we did engage in discussions with a potential buyer who expressed interest in purchasing the domain at \$4000, the transaction did not materialize due to disagreement among our partners regarding the price. The cancellation of the transaction was not based on any knowledge of a trademark registration against the domain.*
- c) Lack of Bad Faith: We operated in good faith throughout the process and had no knowledge of any conflicting trademark rights. There was no intention to infringe upon or exploit the rights of any third party. Any communication with the potential buyer was solely for the purpose of negotiation and selling the domain in a legitimate manner.*
- d) Upon realizing that the trademark associated with the heydude.pk domain is registered by another company, we promptly took action to remove the webpage offering the domain*

for sale. We acknowledge the importance of respecting intellectual property rights and have taken steps to ensure compliance with trademark regulations. As a result, the webpage for selling the domain has been removed to avoid any further confusion or potential infringement.

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 but they failed to do so.

The Complainant has indicated that it is in use of the name “HEYDUDE” and has registered trademarks in multiple jurisdictions and it has not granted permission to the Respondent to use its trademark, demonstrating a prima facie case of legitimate interest in the DDN as has previously been decided in LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master, WIPO Case No. D2010-0138.

The Panel notes that the DDN does not resolve to a website using the name of the DDN, rather it resolves to the hosting provider’s webpage and there is no indication that the Respondent has been known by or is in use of the DDN.

The Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name. The burden of proof therefore shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Domain Name.

The Panel notes that the Respondent has provided statements that are minimal in content and not accompanied by any form of contemporaneous evidence specifically supporting it. The Panel finds that the Respondent has not met its burden of proof and 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:

Respondent registered and is using the disputed domain in bad faith based on the following circumstances which demonstrate bad faith registration and use under the Policy. Many internet users rely on the web browser's URL to seek information about authorized sources of information, the brand and merchandise associated with the brand. The Complainant has no control over the use of the domain name using its primary intellectual property, HEY DUDE. By registering and using the Disputed Domain Name, the respondent has intentionally attempted to attract Internet users to its website, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website and any information that may be shared on the website

The Disputed Domain Name resolves to a warning page (reproduced at Annex "A") that states the following:

Deceptive site ahead. Google Safe Browsing recently detected phishing on heydude[.]pk. Phishing sites pretend to be other websites to trick you. Attackers on heydude[.]pk may trick you into doing something dangerous like installing software or revealing your personal information (for example, passwords, phone numbers, or credit cards).

When users bypass the warning page, detailed above, the website landing page offers the website for sale, as demonstrated below and included at Annex "A". Per the correspondence provided and attached as Exhibit "D" the e-mail below was not used by the Registrant when negotiating the sale of heydude[.]pk.

From: PKNIC Staff <noreply@pknict.net.pk>

Sent: Friday, October 7, 2022 6:30 PM

To:

Subject: heydude . pk

Due to our privacy policy, we do not disclose the registrant's information to the public. However, if you wish we can forward your message and contact email to the domain owner, but they would not have any obligation to reply.

If this works for you, please reply with a text message (a few lines) and we will send it exactly as is (if approved) to the domain focal person. Your message should include your own email, phone, etc so they can contact you if they want.

Thank you

The Complainant submits that the Respondent's registration of the Domain Name was done to prevent the Complainant from registering the Domain Name and was acquired for the purpose of selling the domain name for valuable consideration in excess of any out-of-pocket expenses and/or in an attempt to generate financial gain by creating a likelihood of confusion with the Complainant's mark, and therefore satisfies the Policy.

As mentioned above, included at Annex “D”, and summarized herein, the Complainant - through the use of an anonymous acquisition company - attempted to purchase the Disputed Domain Name and contacted the PKNIC Staff. The Complainant offered to pay the Registrant \$4,000.00 USD in exchange for heydude[.]pk. Information and payment details were sent by the Registrant (identified as “Owais ul wara” owaisulwara@gmail.com - the contact email to the domain owner as provided by PKNIC). On October 17, 2022, the Registrant confirmed that they initiated the “domain transfer process” at the price of \$4,000.00. On October 25, 2022, correspondence was sent to the Registrant to transfer and update the ownership of heydude[.]pk as the proper transfer of funds had been initiated by the Complainant. On January 6, 2023, the Registrant responded, after multiple attempts were made by the Complainant to finalize the transfer, and stated that their “partner is not agree to sell the domain on this price. I tried to convince him again & again but he refused to do so.” On January 18, the Complainant confirmed that the agreement was binding and the funds had already been wired – as detailed in the previous correspondence. On January 30, 2023, the Registrant requested \$10,000.00 for heydude[.]pk, “Actually, my partner wants to sell this domain on \$10,000 and I don't think you're going to interested on this price. So, I believe we should cancel this transaction.” The transaction was subsequently cancelled, and no transfer was made.

*The Registrant did not engage in good faith commercial negotiations. The parties agreed on the sale of the Disputed Domain Name for the price of \$4,000.00 and after ignoring the Complainant’s requests to complete the transfer, the Registrant decided to increase the sale price to \$10,000.00, a sum that is 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 and the Registrant registered the Disputed Domain Name with the intention of offering it for sale for an exorbitant price. See Annex “P”, *Dubizzle Limited BVI v. Muhammad Ammad Siddique*, Case No. C2015-0001(see also, D2000-0243, *CBS Broadcasting, Inc. v. Gaddoor Saidi*); *E. Remy Martin & C v. Christopher MacNaughton*, Case No. D2018-2106.*

For the above reasons, the Complainant submits that the Respondent’s registration and use of the Disputed Domain Name is in bad faith.

The Respondent has made the following submission:

The complaint is unfounded based on the following factual and legal grounds:

a) Ownership and Intent: We registered the heydude.pk domain with the intention of establishing our own brand. Although we switched to a different name for our brand and sought a potential buyer for the domain, we were not aware of any trademark registration in our country against the heydude.pk domain.

b) Price Negotiation: While we did engage in discussions with a potential buyer who expressed interest in purchasing the domain at \$4000, the transaction did not materialize due to disagreement among our partners regarding the price. The cancellation of the transaction was not based on any knowledge of a trademark registration against the domain.

c) Lack of Bad Faith: We operated in good faith throughout the process and had no knowledge of any conflicting trademark rights. There was no intention to infringe upon or exploit the rights of any third party. Any communication with the potential buyer was solely for the purpose of negotiation and selling the domain in a legitimate manner.

d) Upon realizing that the trademark associated with the heydude.pk domain is registered by another company, we promptly took action to remove the webpage offering the domain for sale. We acknowledge the importance of respecting intellectual property rights and have taken steps to ensure compliance with trademark regulations. As a result, the webpage for selling the domain has been removed to avoid any further confusion or potential infringement.

The Complainant and its trademark “HeyDude” have been well-known and associated with the Complainant 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.

Based on the information shared by the Respondent, it appears that the Respondent is not using the DDN and has indicated a desire to sell the DDN to the Complainant.. Considering that the Respondent, in his response in Remedies Sought, has accepted that the Respondent is “willing to sell the heydude.pk domain to the trademark owner at a revised price of \$10,000 as a resolution to the matter”. It is well-established that it is an indication of bad faith to sell a domain name for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name. It appears clearly from his contention that Respondent does not use the DDN in connection with a legitimate purpose as a website and that its use is for the purpose of selling it. This is supported by the case of *Multi thematiques v Matthew C. Harper* WIPO Case No. D2000-0694.

The Panel finds that the HeyDude 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 proof or compelling argument that it was not aware about the Complainant or its business at the time of registration of the DDN. Moreover, the Panel finds that the Respondent's offer to sell the DDN to the Complainant for valuable consideration in excess of the out-of-pocket expenses incurred directly in relation to the DDN. The Panel, therefore, 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 Complainant reserves crucial interest in the Hey Dude 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 <heydude.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: Raja Abubakar

Sole Panelist

Date: 01 August 2023