

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. 2024-0012

Also in PDF 2024-0012

1. The Parties

The Complainant is COSRX Inc. having its office at West - SF, Centerfield, 231, Teheran-or, Gangnam-gu, Seoul, Republic of Korea. The Complainant has initiated the complaint vide their authorized representatives, Mr. Kazim Raza Abbasi and Mr. Muhammad Asad of A.A. & Associates, F 61/9, Block 4, Clifton, Karachi, Pakistan.

The Respondent's name is QU Digitals with their address 13J, Gulberg III, Lahore, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <cosrx.com.pk>, hereinafter referred to as the Disputed Domain Name [the "DDN"]. Vide email dated 24 August 2024, PKNIC has informed DNDRC that the DDN was registered by the Respondent.

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 30 July 2024 after which DNDRC completed its compliance review.

The Respondent was issued a notification of the dispute along with a copy of the Complaint and a Response Form on 26 August 2024 informing the Respondent that if a Response was not received 10 days from the notification, the dispute would proceed ex parte. Two reminders were also subsequently sent to the Respondent on 4 September 2024 and 19 September 2024 respectively.

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

4. Factual Background

The domain name upon which the Complainant is based is <cosrx.com.pk>.

PKNIC has confirmed via their email dated 24 August 2024 that the DDN was registered by the Respondent above-named and that the email address provided at the time of registration is qudigitals334@gmail.com.

1. Parties Contentions

A. Complainant

The Complainant's brief contentions are reproduced below:

- COSRX inc.** is a Korean beauty brand founded by **Mr. Jun Sang Hun** (now, the acting CEO of COSRX inc.) as a small skin-care brand in the year **2002** which was later formally incorporated as a company on December 16, 2013. With customized solutions being their top priority for premium quality skin-care needs of their customers, the name **COSRX** was originally coined as a result of the combination of the terms "**Cosmetics + Rx (symbol for prescription) = COSRX**."*
- With skin-friendly ingredients that alleviate irritated skin, the Complainant aims to provide a better tomorrow for their customers, which has been the inspiration behind conceptualizing their brand's slogan **Expecting Tomorrow**/* 
- COSRX** currently has developed and is selling more than 150 types of cosmetic products that are supplied to more than 146 countries globally. Being a leading Korean K-beauty brand, **COSRX** has become significantly popular in the cosmetic skincare sector globally and has been recognized as the "No. 1 brand in the skincare sector in the Philippines on Shopee (the leading online platform in Southeast Asia)" and "No. 2 brand in the skincare sector in Malaysia on Shopee". The Complainant has also achieved an average growth rate of 205% on Amazon in U.S. and has garnered 1.3 billion cumulative brand views on the social-media platform TikTok.*
- Through the years, Complainant's products have been awarded the Global Beauty Awards more than 119 times, during the period 2014 - 2021. The Complainant's COSRX products, with 8 product lines, including **FULL FIT, PURE FIT, SHIELD FIT, REAL. FIT, ONE STEP, HYDRIUM, BALANCIUM, AC COLLECTION**, has won many overseas and Korean awards including **Amazon Best Seller in Facial Cleansing Gels, Amazon's Choice,***

*Get It Beauty 2020 View Label, 29 BEAUTY AWARD 2020, and many other famous awards in the beauty industry. In recent times, COSRX has been named a **2023 TOP Brand Seller** by the e-commerce giant Amazon. This year, **COSRX's** exceptional growth and success in the highly competitive e-commerce marketplace has earned the brand a place on this highly coveted list. A representative snapshot of titles awarded to the Complainant's products has been pasted below:*



5. In 2022, **COSRX** experienced significant growth on Amazon's marketplace, with an average increase of 266% in overall sales. Most notably, in the United States, the **snail** line, including the **Advanced Snail 96 Mucin Essence**, **Advanced Snail 92 All in One Cream**, **Advanced Snail Radiance Dual Essence**, and **Advanced Snail Mucin Power Sheet Mask**, has experienced a significant increase in sales thanks to being part of the list of TikTok famous products. Moreover, during the 2022 Amazon Prime Day event, the Complainant's **Acne Pimple Master Patch**, led to record-breaking sales, achieving a 660% increase compared to the previous year.
6. Complainant had first registered the **COSRX**-formative ccTLD **www.cosrx.co.kr** in the year **2006**, followed by the top-level domain name **www.cosrx.com** on **December 04, 2007** wherein an active website has been operating for many years. Relevant screenshot of Complainant Company's website displaying the trade mark **COSRX** is copied below:



7. Further, with the expansion of Complainant's international business, they have also registered additional **COSRX**-formative top-level domain names. Some of the said domain names either have independent websites or are redirected to the Complainant's parent website www.cosrx.com. A non-exhaustive list of such domain names is below:

S. No.	Domain Name	Creation Date	Country
1.	cosrx.co.kr	September 15, 2006	South Korea
2.	cosrx.com	December 04, 2007	gTLD
3.	cosrx.kr	November 19, 2014	South Korea
4.	cosrx.de	March 28, 2017	Germany
5.	cosrx.jp	March 28, 2017	Japan
6.	cosrx.id	March 29, 2017	Indonesia
7.	cosrx.ph	March 29, 2017	Philippines
8.	cosrx.tw	March 29, 2017	Taiwan

Copies of a few of the aforesaid website pages and their corresponding WHO IS results are marked as **Exhibit5**.

8. The reputation of a trade mark in today's world is not limited either by geographical or political boundaries as with the ease of communications, people and reputations travel around the world crossing such boundaries, as if they did not even exist. With the advent of satellite television and lately the Internet, the world has become a global village. The reputation of a trade mark flashes quickly throughout the world through the aforesaid media of advance information technology. Complainant Company has a presence on the internet

and information about them is accessible to persons in Pakistan and abroad. Even a simple online search for the word **COSRX** reveals details of Complainant Company's various products under the said mark.

9. In addition to Complainant's official websites, Complainant also uses the medium of social media to promote its goods/services under various trade marks including **COSRX** and variations thereof. Therefore, Complainant has been promoting its business on various social networking websites like Facebook (16K Likes as on May 02, 2024), YouTube (11.9K Subscribers as on May 02, 2024), Instagram (613K Followers as on November May 02, 2024) and X (8.7K Followers as on May 02, 2024).
10. Further, Complainant's **COSRX** branded products are available for sale on various well known and popular **e-commerce websites in Pakistan** like <https://beautyglance.pk/> <https://www.theskinfit.com/>, etc. Screenshots of Complainant's products as available on some e-commerce websites in Pakistan, is copied below:





11. *By virtue of continuous and extensive use worldwide and in Pakistan, and the quality of Complainant's products, Complainant's business has acquired substantial reputation in the industry and its trade mark **COSRX** and variations thereof are always associated with its business and products alone. As a result of the above-described extensive use and promotion, the mark **COSRX** has become distinctive and famous globally and have enjoyed such distinctiveness and notoriety since long prior to the date on which Respondent registered the Domain Name i.e. June 02, 2023.*
12. *The Complainant makes every effort to protect its trade mark rights. Protection of the Complainant's trade marks extends beyond registration activities to enforcement actions, which range from opposing trade mark applications for same or similar marks to sending cease and desist letters to infringers of identical or deceptively similar mark.*

SUCCESSFUL DOMAIN ENFORCEMENT ACTIONS

13. *The Complainant has also taken successful domain recovery action against various domain names globally. Details of the decisions passed in favour of the Complainant by the Domain Dispute Panels have been mentioned below:*

Case No.	Date Of Decision	Domain Name	Panel Decision
UDRP Case COSRX	August 27, 2023	COSRXUS.COM	Domain name transferred to COSRX Inc. A copy of the decision may be accessed here
v. 陈龙 (chenlong) Case No. D2023-2785			(at the URL https://www.wipo.int/amc/en/domains/search/fulltext_decisions.jsp?q=cosrx)
INDRP Case— India COSRX INC v. Tejas Taori INDRP	March 11, 2024	COSRX.IN	Domain name transferred to COSRX Inc. A copy of the decision may be accessed here , (at the URL https://www.registry.in/s3-assets/indrp-1805_repaired.pdf).

Therefore, the Complainant seeks the following remedy:

In accordance with ICANN Policy, paragraph 4(i), and PKNIC - Internet Domain Registration Policy, paragraph 4, for the reasons described in paragraph 8 above, Complainant requests the Administrative Panel appointed in this administrative proceeding to issue a decision to transfer the disputed domain name "COSRX.COM.PK" to the Complainant.

B. Respondent

The Respondent did not submit a response.

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 DDNs 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 Names, the application and registration of the DDNs shall be assessed in consideration of the following criteria:

- i. Whether the DDNs infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the DDNs is bona fide?
- iii. Whether the application and/or registration of the DDNs contravenes the Pakistan Penal Code, 1860 (the “Penal Code”) or any applicable criminal law?

The Complainant has contended:

- 14. *The unauthorised adoption and registration by the Respondent of the Disputed Domain Name (which consists of the Complainant's registered trademark COSRX) constitute inter alia the actionable wrongs of infringement and passing-off. By such adoption and registration, the Respondent infringes the exclusive rights vested in the Complainant in respect of the trademark COSRX in Pakistan. Moreover, through such registration or use of the Disputed Domain Name, the Respondent intends to mislead the general public, including the Internet users in Pakistan and elsewhere, and to cause them into believing that the Disputed Domain Name is authorised or controlled by the Complainant or persons having a business connection with the Complainant, which is not the case.*

15. *The unauthorised adoption, registration and/or use by the Respondent of the Disputed Domain Name further falls within the prohibition of the provisions of the Trade Marks Ordinance 2001 and the Pakistan Penal Code, 1860, including, in particular, sub-section (6) of section 40 of the Trade Marks Ordinance 2001; clause (I) of paragraph 4 of Third Schedule to the Trade Marks Ordinance 2001; and sections 480,481,482,483,485 and/or 486 of the Pakistan Penal Code 1860. Text of these provisions is attached hereto as **Exhibit 9**. Furthermore, in this regard, the Complainant relies on the analysis and findings of the DNDRC Panel in Standard Chartered PLC v. Hosting Campus Domain (Case No. C2007-0001, dated 30 August 2007 - (copy attached as a part of Exhibit 7 mentioned earlier).*
16. *In view of the above, there is no doubt that the Domain Name and/or the Respondent contravene the provisions of the Policy Agreement and the PKNIC - Internet Domain Registration Policy (attached hereto respectively as **Exhibit 10**), which provide inter alia that:*
- a. The applicant for registration of a domain name at the time of making the application expressly represents, agrees and warrants as follows:*
 - applicant's statements in the application are true and the applicant has the right to use the domain name as requested in the application;*
 - applicant has a bona fide intention to use the domain name on a regular basis on the Internet;*
 - the use or registration of the domain name by the applicant does not interfere with or infringe the right of any third party in Pakistan, with respect to trade mark, service mark, trade name, company name or any other intellectual property right; and*
 - interviewee is not seeking to use the domain name for any unlawful purpose, including, without limitation, tortuous interference with contract or prospective business advantage, unfair competition, injuring the reputation of another, or for the purpose of confusing or misleading a person, whether natural or incorporated.*
 - b. The applicant of a domain name at the time of making the application certifies that, to his or her knowledge, the use of the domain name does not violate trade mark or other statutes.*
 - c. The Respondent has intentionally registered and used the Domain Name violating the Policy Agreement and the PKNIC - Internet Domain*

Registration Policy. In this regard before approaching the Honourable DNDRC Tribunal, the Complainant through its lawyers approached PKNIC on the basis of its registered prior rights in the COSRX Marks for details of the Registrant and resolution of the matter, whereupon the Complainant was directed to approach the DNDRC forum. Hence the subject complaint is being filed upon such direction by PKNIC in Pakistan

17. *It will be noted that the DNDRC Panel in Standard Chartered PLC v. Hosting Campus Domain (Case No.C2007-0001, dated 30 August 2007) (see Exhibit 7 supra) has found that if a complainant simply establishes that the respondent's domain name infringes upon the complainant's registered trade name or trade mark, this renders the respondent's domain name to be illegal, unlawful and invalid and further constitutes an adequate ground for the transfer of the domain name to the complainant.*

The Respondent has not submitted a response.

The Panel has reviewed the submissions of the Complainant.

The Complainant has provided a copy of a certificate of registration issued by the Government of Pakistan, as well as several other countries which indicating that it has registered the brand mark “COSRX” in Pakistan. The Panel finds that the Complainant has submitted sufficient evidence that it has trademark rights in the word “COSRX”. 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 “COSRX” 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.

It is essential to note that the Panel only considers the infringement of the trademark in the DDN itself and any infringement on the website itself shall not be admissible for the satisfaction of this criterion. The Complainant has claimed that Respondent’s unauthorized use of the Trademark infringes their intellectual property rights in Pakistan, which we see is the case within the DDN.

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:

18. *Complainant is the registered proprietor of the trademark **COSRX** in many countries around the world, including in Pakistan, and has been continuously and exclusively using the same in relation to its business for many years. As stated in the preceding paragraphs, Complainant has continuously been in use of the brand since its launch in **December 2013**, which is much prior to the date on which Respondent registered the domain <**COSRX.COM.PK**>, i.e. more than ten years apart. By virtue of long-standing use and registration, Complainant's trademark **COSRX** qualifies to be a well-known mark and is bound to be protected.*
19. *The disputed domain name incorporates the Complainant's registered trademark COSRX, which is also the principal element of the trade name of the Complainant COSRX Inc. and is identical to their top-level domain name <**COSRX.COM.PK**>.*

As stated by the WIPO Panel in Dr. Ing. H.c.F. Porsche AG v. Vasiliy Terkin (Case No. D2003-0888, dated 6 January 2004 a domain name that wholly incorporates a complainant's registered trade mark is sufficient to establish confusing similarity.

20. *The additional element '.PK' is insufficient to negate the confusing similarity between Respondent's domain name and Complainant's famous mark, especially where the same is merely a ccTLD. Reliance is placed on the following cases wherein the use of an additional feature (such as a ccTLD) does not make the domain name in dispute sufficiently distinct from the trademarks of the complainants: Hewlett-Packard Dev. Co. L.P. v. Surya Tech., FA0708001059665 (Nat. Arb. Forum Oct. 2, 2007) ("the addition of the gTLD are not sufficient to differentiate a domain name from a known mark"); Dell Inc. v. Protection of , Private Person / Privacy Protection, FA1606001681432 (Nat. Arb. Forum Aug. 1 , 2016) , (A TLD (whether a gTLD, sTLD or ccTLD) is disregarded under a Policy ,r 4(a)(i) analysis because domain name syntax requires TLDs"). Further, it is also important to note that WIPO has stated in its publication titled 'WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Ed under paragraphs 1.2.1 and 1.12 that "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie*

satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case"; Where the complainant's trademark is recognizable within the disputed domain name, the addition of other third-party marks (i.e.,), is insufficient in itself to avoid a finding of confusing similarity to the complainant's mark under the first element of the UDRP.

*Copies of these decisions/cases are attached hereto as **Exhibit 6**.*

21. *Furthermore, the also Complainant relies on the analysis and findings of the Pakistan DNDRC Panel in the following matters:*

(a) *In the matter of Standard Chartered PLC v. Hosting Campus Domain (Case No. C2007-0001, dated 30 August 2007) wherein it was held that irrespective of the contents of the website or the goods and services offered on the website, as long as the domain name in dispute is confusingly similar or identical to the trade mark in question, the use of the domain name would be an infringement of the registered trademark;*

(b) *In the matter of Pakistan Herald Publications (Private) Limited. v. Averroes Sapertise Management, (Case No. C2011-0001, dated 30 March 2011) wherein it was held that on account of the popularity and goodwill subsisting in the complainant's trademark 'DAWN', and the fact that trademark registrations had been obtained not just in Pakistan but in various countries around the world was sufficient to show that the domain name registration had been obtained in bad faith and on the basis of inter alia the same the complaint was allowed and the domain name registration was cancelled;*

(c) *In the matter of Google Inc. v. Starcom Systems, Case No. C2013-0004, dated 21 September 2013 wherein it was held that upon evidence of mala fide intention on the part of a registrant of a domain name is sufficient ground to cancel the registration of the domain name and that it is the duty of the respondent to rebut any of the contentions made by the proprietor of the registered trademark.*

*Copies of these abovementioned cases are attached hereto as **Exhibit 7**.*

22. *Based on the above submission, there can be no doubt that the Disputed Domain Name "COSRX.COM.PK" is identical and/or confusingly similar to the **COSRX Trade Marks** in which the Complainant has prior exclusive rights.*

The Respondent has not submitted a response.

The Panel has reviewed the submissions of the Complainant.

The first element of paragraph 4(a) of the Policy requires a complainant to establish first, that it has rights in a trade mark or service mark, and secondly, that the disputed domain name is identical or confusingly similar to that trade mark or service mark.

The Panel understands that the disputed domain name is exactly the same as the Complainant's trademark "COSRX", and there are no words or phrases attached to it to try and alter it or have it appear differently than the trademark. This further solidifies the fact that the Respondent intended to create the impression of an affiliation without any authorization from the Complainant.

The Panel acknowledges the widely recognized principle, that the inclusion of a ccTLD such as ".com.pk" does not negate a finding of confusing similarity due to it being a standard requirement of registration. This principle has also been affirmed in numerous DNDRC and WIPO cases (See H. Lundbeck A/S v. Bkanggara Windarti, My Store Case No. D2024-2000).

Based on the assessment above and in the absence of any submission from the Respondent, the Panel concludes that the DDN is confusingly similar to a trademark in which the Complainant holds rights.

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."

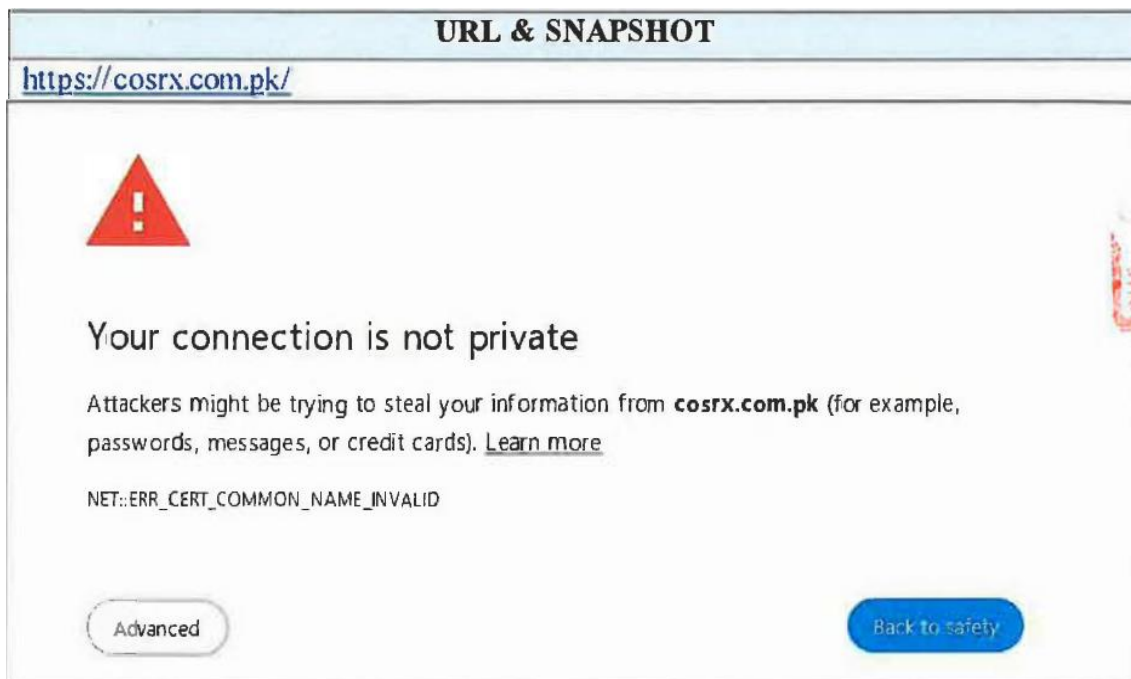
The Complainant has contended:

23. Pursuant to ICANN Policy, sub-paragraph 4(c), a respondent may show rights in the domain name by (1) its use or preparations to use the domain name in connection with a bona fide offering of goods or services prior to notice of the dispute; (2) being commonly known by the domain name; or (3) legitimate non-commercial or fair use.

The Respondent fails on all counts as discussed below:

*It is submitted that Respondent has no rights or legitimate interests in the domain name <COSRX.COM.PK>. Complainant has not authorized, licensed or otherwise allowed Respondent to make any use of its registered trade name/ mark and brand name **COSRX** and/or its phonetic equivalents/ variations, and Respondent does not have any affiliation or connection with Complainant or with Complainant's services under the name/mark **COSRX**. Moreover, it is submitted that **COSRX** is a unique combination of terms coined by the Complainant by merging the terms "Cosmetics" and "Rx" (symbol for prescription), to form the name/mark **COSRX**, that has no dictionary meaning. Thus, the Respondent does not even remotely have any reason, to use the Complainant's well known trade name/trading style and registered trademark "**COSRX**".*

*Further, the Respondent is currently not making any legitimate non-commercial or fair use of the domain name, and the same is also corroborated by the fact that no website is being hosted from the said domain and in fact the web-browser shows an alert that attackers might be trying to steal information from the domain name. In support of the aforesaid, a screenshot dated **June 25, 2024** indicating the inactivity of the impugned domain name <COSRX.COM.PK> has been tabulated below:*



A dated PDF copy of the above is attached herewith as Exhibit 2 supra.

*Further, any use of the domain name <COSRX.COM.PK> in the future by Respondent is likely to create a false association and affiliation with the Complainant and its well-known trade mark as well as brand name **COSRX**. Therefore, it is submitted that Respondent has no rights or legitimate interests in respect of the impugned domain name and is incapable of making a legitimate non-commercial or fair use of the domain name.*

24. *Respondent herein has registered the disputed domain <COSRX.COM.PK> approximately 10 years after the brand launch by the Complainant i.e. in **December, 2013**, and several years after the Complainant's trademark registrations. Under the circumstances of this case, Respondent's use of the disputed domain name is not " bona fide offering of goods or services" within the meaning of Paragraph 4 (c)(i) of the ICANN Policy since there is no apparent legitimate justification for Respondent's registration of the <COSRX.COM.PK> domain name, that is visually, phonetically, conceptually, deceptively and confusingly similar/identical to Complainant's trade name/mark COSRX.*

Further, the continued ownership of the disputed domain <COSRX.COM.PK> name by Respondent, despite not having any legitimate or fair reason to do so, prevents Complainant from reflecting its trademark in the subject domain name. In Motorola, Inc. vs NewGate Internet, Inc. (WIPO Case D2000-0079), it was held that use of the trademarks not only creates a likelihood of confusion with Complainants' marks as to the source, sponsorship, affiliation or endorsement of its web site, but also results in dilution of the marks.

*For the reasons stated in the foregoing paragraphs, it is not possible to conceive of any plausible use of the domain name <COSRX.COM.PK> by Respondent that would not be illegitimate, as it would inevitably create a false association and affiliation with Complainant and its well-known trade mark **COSRX**. Therefore, it is submitted that Respondent has no rights or legitimate interests in respect of the impugned domain name.*

The Respondent has not submitted a response.

The Panel has reviewed the submissions of the Complainant.

The Panel notes that the Complainant has established a prima facie case of the Respondent lacking legitimate interest in the DDN where the burden of proof shifts on the Respondent to demonstrate otherwise. If the Respondent fails to do so, the complainant is deemed to have satisfied the second element (See *MicroBilt Corporation v. Greg J Michalko Case No. D2024-2212*).

The Panel further acknowledges that legitimate rights in the DDN can be proved if either one of the three criteria are met by the Respondent which includes the use of the DDN for Bonafide offering of goods and services, Respondent being commonly known by the DDN or Respondent making a legitimate non-commercial use of the DDN according to the Paragraph 4(a)(ii) of UDRP.

The Panel agrees with the complainant that due to the trademark “COSRX” having no dictionary meaning and hence no reason for the Respondent to use the tradename, the Panel cannot presume that the Respondent has any legitimate use of the DDN.

Additionally, the Panel finds the evidence provided by the Complainant to be sufficient to prove that the Respondent’s use of the DDN is not legitimate or fair as the DDN is registered as the exact tradename, without any element of uniqueness whatsoever and a clear intent of implying an affiliation with the Complainant’s brand, that too without approval in any form. There is also no website currently being hosted from the domain and visiting the domain shows it to be inactive.

Furthermore, the Respondent’s registration of the domain name took place 10 years after the launch of the Complainant’s brand. This indicates that there is no justification for the Respondent to register and using a domain name that is the same as the Complainant’s widely known and registered trademark, hence disproving any potential for a bona fide or legitimate use.

The Panel also agrees with the case cited by the Complainant (*Motorola, Inc. vs NewGate Internet, Inc. (WIPO Case D2000-0079)*), where it was held that such a use of a trademark not only creates confusion in customers, but also dilutes the trademark. Since there is no actual affiliation with the Complainant’s brand, anything that shows on the DDN will cause confusion for customers as to whether there is an affiliation or sponsorship by the Complainant or their brand.

Consequently, the Complainant has made a prima facie case that the Respondent has no rights or legitimate interests in the domain name and the Respondent failed to meet the burden shifted upon them.

The Panel therefore finds that the Respondent does not have any legitimate interest in the DDN.

IV. Registration and use in bad faith

The Complainant has made the following submission:

25. *Sub-paragraph 4(b)(ii) of the I CANN Policy allows for a finding of bad faith when the registration was acquired to prevent a trademark owner from reflecting the mark in a corresponding domain name. When Respondent acquired the Disputed Domain Name, it had constructive knowledge of the COSRX Marks via the Complainant's trade mark registrations and use in Pakistan (as well as in numerous other countries around the world). As stated by the WIPO Panel in Kraft Foods (Norway) v. Fredrik Wide and Japp Fredrik Wide (Case No. D2000-0911, dated 23 September 2000- copy attached as Exhibit 8), the fact "that the Respondent chose to register a well-known mark to which he has no connections or rights indicates that he was in bad faith when registering the domain name at issue".*

*Furthermore, the fact that the mark **COSRX** is a unique combination of words coined by the Complainant, further aggravates the Respondent's bad faith, in as much as, the Respondent is using the identical name with respect to the impugned domain name <**COSRX.COM.PK**>. There can be no other plausible explanation as to how the Respondent arrived at the impugned domain name <**COSRX.COM.PK**> which incorporates the Complainant's mark **COSRX** as well as their various domain names in toto. The fact that the Respondent is currently not hosting any active website on the said domain gives the unwavering impression that it is a case of **passive holding** and the same is tantamount to the fact that the Respondent does not hold any legitimate interest in the domain name.*

*Further, it is also submitted that in light of the aforesaid immense reputation of the Complainant's mark **COSRX** worldwide, as well as its ubiquitous presence on the Internet, Respondent was, or should have been, aware of Complainant's trademarks long prior to registering the domain name. In view of the aforesaid, it is submitted that Respondent had constructive notice of Complainant's mark **COSRX**. See *Caesars World, Inc. v. Forum LLC* (WIPO Case No, D2005-0517), *HUGO BOSS Trade Mark Management GmbH & Co. KG, HUGO BOSS AG v. Dzianis Zakharenka*, (WIPO Case No, D2015-0640). Reliance is also placed on *Instagram, LLC v. Contact Privacy Inc. I Sercan Lider* (WIPO Case No. D20 19-041 9) wherein it was held that "**passive holding** can be sufficient to find bad faith use"*

*Furthermore, given the Complainant's prior established goodwill and proprietary rights in the COSRX Marks, the registration of the Disputed Domain Name by the Respondent is clearly in bad faith with an attempt to misappropriate and cash on and to trade unfairly upon the worldwide reputation and goodwill enjoyed by the Complainant. (*The Pakistan_ Herald Publications (Private) Limited. v. Averroes Sapertise Management*, (Case No.2011-0001, dated 30 March 2011 copy attached as Exhibit 7 supra).*

The Respondent has not submitted a response.

The Panel has reviewed the submissions of the Complainant.

The Panel first acknowledges the global recognition of the Complainant's "COSRX" trademark in relation to its provision of messaging services. At the outset, the recognition of the Complainant's mark makes it highly unlikely for the Respondent to be unaware of the existence of the mark at the time of the registration of the DDN. The Panel has reviewed *Kraft Foods (Norway) v. Fredrik Wide and Japp Fredrik Wide (Case No. D2000-0911, dated 23 September 2000-* cited by the Complainant and agrees with the principle of the Respondent registering a well known mark as the domain name, that they have no connection or affiliation with clearly indicates bad faith. Additionally, the uniqueness of the Complainant's tradename due to it being a combination of two words makes it so that there is no other plausible justification as to why the Respondent would register "COSRX" as the domain name.

Therefore, registration of a DDN that resembles a well-known trademark without the Complainant's authorization establishes the element of registration in bad faith on part of the Respondent

The Panel notes that while the Respondent's use of the DDN does not involve any commercial activity, mere absence of such an element does not automatically negate commercial use of the DDN (See WIPO Section WIPO Overview 3.0, section 2.5.3). The Panel agrees with the Complainant that the DDN can possibly mislead users into thinking the site is affiliated with or endorsed by the Complainant. The Panel relies on *Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003*, as well as *Instagram, LLC v. Contact Privacy Inc. I Sercan Lider (WIPO Case No. D20 19-041 9)* as cited by the Complainant and finds that the current inactive status of the website would amount to passive holding of a website and would not prevent a finding of bad faith.

The evidence provided by the Complainant and the lack of submission from the Respondent concludes that the conduct satisfies the requirements of paragraph 4(b)(iv) of the Policy and is evidence of registration and use of the DDN in bad faith.

The Panel, therefore, finds that the DDN was registered and is being used in bad faith by the Respondent.

7. Decision

The Panel, upon the review of the information provided by the Complainant, recognizes that the "COSRX" mark is registered to the Complainant and Respondent has no legitimate rights over it.

The continuous use of the DDN purporting to the Complainant's registered trademark could seriously hinder the exercise of the rights of the Complainant in the trademark and could also jeopardize the reputation of the Complainant by amounting to confusion regarding the ownership of the DDN.

Taking all the discussion above into consideration, the Panel concludes and decides that:

1. The Respondent's registration of the DDNs violates the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19);
2. The DDN is confusingly similar to the registered trademark of the Complainant;
3. The Respondent has no legitimate interest in the DDN;
4. The DDN was registered and is 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 <cosrx.com.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: Rayyan Altaf

Sole Panelist

Date: 5 November 2024