

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. 2024-0015

Also in PDF C2024-0015

1. The Parties

The Complainant is TIMES OF PAKISTAN (PRIVATE) LIMITED. having its office at 226-B, Bilal Town Jhelum, Punjab, 49620, Pakistan. The Complainant has initiated the complaint vide their authorized representative, Moazzam Ishaq (Director and CEO), 226-B, Bilal Town Jhelum, Punjab, 49620, Pakistan.

The Respondent's name is Shoaeb Shams with their address 146/I, Shalimar Lane, Cavalry City, Lahore Cantt, Lahore, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <timesofpakistan.pk>, hereinafter referred to as the Disputed Domain Name ["the DDN"]. Vide email dated 05 September 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 08 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 07 September 2024 informing the Respondent that if a Response was not received 10 days from the notification, the dispute would be proceeded *ex parte*. The Respondent then submitted a response on 16 September 2024.

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 <timesofpakistan.pk>.

PKNIC has confirmed via their email dated 5th September 2024 that the DDN was registered by the Respondent above-named and that the email address provided at the time of registration is shoaeb.shams@e2esp.com. DNDRC awaited the submission by the Complainant of the Complaint as per the prescribed forms also available at www.dndrc.com/downloads. The Respondent then subsequently provided a response within the required time period.

1. Parties Contentions

A. Complainant

The Complainant's brief contentions are reproduced below:

1. *"Times of Pakistan" is a registered trademark of Times of Pakistan (Private) Limited, a company duly established and currently operating in accordance with the laws of Pakistan. We are the only registered Media and News agency under the name "Times of Pakistan", and we hold the trademark rights for this name. Therefore, our organization possesses the legal entitlement to safeguard our trademark.*
2. *This submission is made in accordance with the PKNIC Internet Domain Registration Policy August 19, 2019, version 4.4, and the Uniform Domain-Name Dispute-Resolution Policy (UDRP) criteria. Attached are copies of our company incorporation certificate, FBR registration, and trademark registration categorized under "Media and News agency."*

Therefore, the Complainant seeks the following remedy:

Given the circumstances elucidated above, we hereby formally request the transfer of ownership of the domain "timesofpakistan.pk" to our organization.

B. Respondent

The Respondent's brief contentions are reproduced below

We are writing this to you with reference to your complaint dated 08.07.2024 on the above-mentioned subject. The complaint dated 8 July, 2024 made by you against us is absolutely false, frivolous, vexatious, baseless, unfounded, misconceived and based on patent mala fide and hence we stoutly refute the allegations made against us in the complaint.

Furthermore, we contend that the Pakistan Office of the DNDRC lacks jurisdiction over this matter and is therefore not a competent forum for entertaining this complaint under reply.

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 DDN, 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:

The domain in dispute is being operated without our consent, which violates our trademark rights under the laws of Pakistan. Our trademark "Times of Pakistan" is legally registered and recognized in Pakistan, providing us with the exclusive right to use this name in connection with our media and news services. Our trademark is registered in respect of Media and news agency, news reporting, reporters' services, electronic news agencies services, transmission of messages over electronic media, provision of information relating to media communications.

The Respondent has stated:

We are writing this to you with reference to your complaint dated 08.07.2024 on the above-mentioned subject. The complaint dated 8 July, 2024 made by you against us is absolutely false, frivolous, vexatious, baseless, unfounded, misconceived and based on patent mala fide and hence we stoutly refute the allegations made against us in the complaint.

Furthermore, we contend that the Pakistan Office of the DNDRC lacks jurisdiction over this matter and is therefore not a competent forum for entertaining this complaint under reply.

For the purpose of proving illegality or unlawfulness, it will be sufficient if the Complainant proves that they possess rights to the trademark that is wholly incorporated within the DDN. The Complainant has provided a copy of a certificate of registration issued by the Government of Pakistan, which confirms that it has registered the trademark “Times of Pakistan” in Pakistan in Clas 38. The Complainant has also submitted proof that they have applied for trademark registration in multiple other classes in Pakistan. The Panel finds that the Complainant has submitted sufficient evidence that it has trademark rights in the word “Times of Pakistan”. The DDN does prima facie incorporate in its entirety the registered trademark of the Complainant.

The Respondent, within their contentions has made have referred to the complaint as “*false, frivolous, vexatious, baseless, unfounded misconceived and based on patent mala fide...*”. Due to the Respondent failing to provide any evidence or further contentions that would justify this claim, the Panel therefore, dismisses the claim as it lacks substance and does not support the claims made.

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 with respect to any trademark rights

in relation to the DDN, the Panel is unable to infer whether the Respondent also has rights to the term “Times of Pakistan” that would indicate that the registration of the DDN by the Respondent was bona fide.

The Panel has found 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 DDN 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:

We are the sole registered media and news agency operating under this name, and our trademark rights are well documented and legally protected. The disputed domain name "timesofpakistan.pk" is identical to our trademark causing confusion among consumers, misleading them to believe that it is associated with or endorsed by our organization. This situation is harming both our business and reputation. It also complicates the ability of our internet readers and social media followers to locate our genuine presence, creating additional challenges for our organization.

The Respondent has contended the following:

We are writing this to you with reference to your complaint dated 08.07.2024 on the above-mentioned subject. The complaint dated 8 July, 2024 made by you against us is absolutely false, frivolous, vexatious, baseless, unfounded, misconceived and based on patent mala fide and hence we stoutly refute the allegations made against us in the complaint.

Furthermore, we contend that the Pakistan Office of the DNDRC lacks jurisdiction over this matter and is therefore not a competent forum for entertaining this complaint under reply.

A finding of identicalness or confusing similarity will arise if a DDN is the same as the trademark. This principle can be seen upheld in the case of Government Employees Insurance Company (“GEICO”) v. Contact Privacy Inc. Customer 7151571251 / kendrick Whiteman, geico Case No. D2022-3173, alongside several other WIPO and DNDRC cases.

The Panel notes that there are no words or phrases attached to the DDN to try and alter it or distinguish it from the Complainant’s registered trademark.

The Panel also acknowledges the widely recognized principle, that the inclusion of a ccTLD such as “.pk” does not negate a finding of identicalness or 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. Bkangara Windarti, My Store Case No. D2024-2000, for example).

The Respondent has not indicated that it also has trademark rights with respect to the phrase “Times of Pakistan”. 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:

The respondent has no legitimate interest in the domain name "timesofpakistan.pk." Our main domain "www.timesofpakistan.com" has been in operation since 2002 and we currently have more than 3 million followers on our social media accounts, further validating our brand. We also own several similar domains that redirect to our main site, including: www.timesofpakistan.net, www.timesofpakistan.org, www.timesofpakistan.info, www.timesofpakistan.com.pk, www.timesofpakistan.news, www.thetimesofpakistan.com.pk

The disputed domain solely serves to infringe upon our registered trademark and mislead the public.

The Respondent has made the following contention

We are writing this to you with reference to your complaint dated 08.07.2024 on the above-mentioned subject. The complaint dated 8 July, 2024 made by you against us is absolutely false, frivolous, vexatious, baseless, unfounded, misconceived and based on patent mala fide and hence we stoutly refute the allegations made against us in the complaint.

Furthermore, we contend that the Pakistan Office of the DNDRC lacks jurisdiction over this matter and is therefore not a competent forum for entertaining this complaint under reply.

For the purposes of this criterion, it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks legitimate interest, after which the burden of proof shifts to the Respondent to prove otherwise (See *MicroBilt Corporation v. Greg J Michalko Case No. D2024-2212*).

The Panel notes that the Complainant has contended the lack of legitimate interest on part of the Respondent and has provided information to support its own legitimate interest to the DDN. The Complainant has thereby establishing a prima facie case against the Respondent. It would now be on the Respondent to provide sufficient evidences to demonstrate that, otherwise, failure of which would result in the Complainant satisfying the second element.

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 bona fide offering of goods and services, the 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 has found that the Complainant established the brand in 2002 while the Respondent had registered the DDN eight years later.

While the Respondent has denied the contentions of the Complainant in their entirety, the Respondent failed to meet the burden shifted upon them by providing any information to support their legitimate interest in the DDN. In the absence of any information provided by the Respondent, the Panel has no information which suggests that the Respondent is using the DDN for bona fide offering of goods or services, that the Respondent is commonly known by the DDN, or that the Respondent is making a legitimate non-commercial use of the DDN.

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:

The domain "timesofpakistan.pk" was registered and is being used in bad faith. The respondent has linked our official Facebook page (facebook.com/timesofpakistan) on their website to impersonate our well-known brand, which is a clear violation of our trademark rights. This can be verified by visiting the "timesofpakistan.pk" website and clicking on the Facebook icon.

Furthermore, the disputed domain previously used a Twitter account for impersonation, resulting in suspension upon our complaint to Twitter. The link to the suspended account is still present on the disputed domain, as evidenced by the attached screenshot of the email from Twitter.

The respondent's website sometimes posts content that promotes propaganda, causing difficulties for our organization and misleading the public into believing there is an affiliation with "Times of Pakistan." The respondent's actions are clearly intended to attract web traffic through deliberate misrepresentation and public confusion.

The Respondent has submitted the following response:

We are writing this to you with reference to your complaint dated 08.07.2024 on the above-mentioned subject. The complaint dated 8 July, 2024 made by you against us is absolutely false, frivolous, vexatious, baseless, unfounded, misconceived and based on patent mala fide and hence we stoutly refute the allegations made against us in the complaint.

Furthermore, we contend that the Pakistan Office of the DNDRC lacks jurisdiction over this matter and is therefore not a competent forum for entertaining this complaint under reply.

The Panel acknowledges paragraph 4(b) of the Policy that sets out, without limitation, circumstances which, if found by the Panel to be present, will count towards evidence of the registration and use of a domain name in bad faith. Paragraph 4(b)(iv) of the Policy states that if a respondent has intentionally attempted to attract for their commercial gain, users of the internet to its website by creating a likelihood of confusion with the Complainant's mark as to the source or affiliation of its website, such use would constitute a registration and use in bad faith.

As stated by the Complainant, the Respondent has linked the Facebook page of the Complainant on their website which shows that the Respondent is attempting to impersonate the Complainant or otherwise mislead individuals about its affiliation with the Complainant. The Complainant has also provided information that the Respondent previously used a Twitter (now X) account to impersonate Complainant, which was subsequently suspended by the Complainant. This shows the Respondent's intent to create confusion for users of the internet about a potential affiliation with the Complainant and also suggests that the Respondent was well-aware of the Complainant and its trademark.

The Panel also notes that the Complainant has been using both its domain name <timesofpakistan.com> and its trademark "Times of Pakistan" since 2002. This is supported by the WHOIS information for its domain name and multiple trademark applications filed with the Registrar of Trademarks with state the period of use as 2002. The Complainant has also provided information, including information about its following on social media, which supports its contention that it is a well-known mark within the news agency.

In the absence of any additional information provided by the Respondent, the Panel finds that it is improbable that the Respondent was not aware of the Complainant's mark at the time of registration of the DDN or during its use. 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 "Times of Pakistan" mark is registered by the Complainant and Respondent has no legitimate rights to 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 DDN 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 <timesofpakistan.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: 18 December 2024