

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. 2024-0017

Also in PDF C2024-0017

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 Muhammad Nabeel with their address St#3; H#3, Jia Musa Shahdra, Lahore.

2. The Domain Name and Registrar

The domain name in dispute is <thetimesofpakistan.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 11 September 2024.

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

4. Factual Background

The DDN upon which the Complaint is based is <thetimesofpakistan.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 nabeeljaan666@gmail.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:

"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.

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 "thetimesofpakistan.pk" to our organization.

B. Respondent

The Respondent's brief contentions are reproduced below

I have developed it solely for blogging purposes. Please note that my website is intended for personal use and does not operate as a news agency or compete with your business in any capacity.

Furthermore, I would like to highlight the following key points:

1. Purpose of the Website: My site is a personal blog, not a commercial news outlet. The content is focused on personal commentary and does not engage in news reporting or any other activities that might overlap with your services.

2. Domain Registration: The domain thetimesofpakistan.pk was purchased before your trademark registration. I intended to establish a platform for sharing personal insights and articles, and at no point was there any intention to infringe upon or compete with your trademark.

3. Distinctive Identity: The names and identities of our domains are distinct. There is a significant difference between "timesofpakistan.com" and "thetimesofpakistan.pk". This difference is clear and should not confuse users. Our audiences and the nature of our content are also distinct, reducing any potential for misunderstanding.

Given these points, I request that you reconsider the dispute, as my website does not conflict with your trademark or business activities.

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.

Lack of Trademark Violation: Given the different purposes and identities of the domains, there is no infringement on the complainant's trademark rights.

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 Class 38. The Complainant has also submitted proof that they have applied for trademark registration in multiple other classes in Pakistan.

The Respondent, within their contentions has stated that they are using the DDN as a personal blog rather than a commercial news outlet, and that the identity of the DDN <thetimesofpakistan.pk> is significantly different from the Complainant’s domain <timesofpakistan.com>.

The Complainant has not provided any supporting arguments to demonstrate whether the addition of the word “the” in the DDN will still constitute trademark infringement.

In the absence of any further submissions, the Panel finds that there is insufficient information to determinatively conclude that this PKNIC criteria has been met. Therefore, it is necessary to assess whether each of the UDRP criteria has been met, to establish whether the Complaint can be accepted.

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 "thetimesofpakistan.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.

Attached are copies of our company incorporation certificate, FBR registration, and trademark registration categorized under "Media and News agency." Additionally, we have included screenshots of our official social media accounts and the WHOIS record of our main domain "www.timesofpakistan.com," which has been in operation since 2002.

The Respondent has contended the following:

No Likelihood of Confusion: The domain names and their associated identities are sufficiently distinct, minimizing the risk of confusion among users.

UDRP panels have consistently held that domain names are identical or confusingly similar to trademarks under the Policy when the relevant trademark is recognizable within a disputed domain name regardless of the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise). 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 applies the test set out under paragraph 1.7 of the UDRP policy and through comparison of the DDN and the Complainant’s trademark, finds that the DDN incorporates the trademark entirely, with the only addition in the DDN being the word “the”, which will not negate confusing similarity.

Furthermore, the Panel acknowledges the widely recognized principle, that the inclusion of a ccTLD such as “.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, the Panel rejects the Respondent’s claim that the domain names are sufficiently distinct. 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 "thetimesofpakistan.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

Distinct Purpose: The domain in question is used solely for blogging and not as a news agency, which differentiates it from the complainant's business activities.

For the purposes of this criterion, if the Complainant contends that that the Respondent lacks legitimate interest, it will be sufficient to shift the burden of proof on to the Respondent to prove otherwise (See *MicroBilt Corporation v. Greg J Michalko Case No. D2024-2212*). The Panel notes that a prima facie case has been established against the Respondent by the Complainant's contention that the Respondent lacks a legitimate interest.

The Respondent must now provide satisfactory evidence that demonstrates otherwise and failure to do so would result in the second element being satisfied by the Complainant.

The Panel recognizes that legitimate rights in the DDN may be proven if the Respondent can meet either one of the three criteria, which includes the use of the DDN for a bona fide 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 Respondent has contended that the DDN is being used for “*blogging and not as a news agency*”. Furthermore, the Respondent, within his contention in has explicitly stated that the website is intended for personal use and is not a commercial news outlet. Therefore, from this contention, the Panel finds that the Respondent does not meet the first criteria of a bona fide offering of goods and services through use of the DDN as he has himself stated that he is not offering any such goods or services.

As for the second criteria, the Complainant has contended that their domain has been in operation since 2002, and they have amassed 3 million followers across their social media accounts. Whereas the DDN was registered by the Respondent on 15 November 2021, and there has been no contention that shows that the Respondent is well known or commonly known by the DDN. Hence, the Panel finds that the Respondent has not met the second criteria.

The Respondent has failed to provide any evidence to suggest that their use of the DDN constitutes a bona fide use, or a legitimate, non-commercial use. Consequently, the Complainant has made a prima facie case that the Respondent has no rights or legitimate interests in the domain name.

As for the third criteria, although the Respondent has contended that the DDN is being used for a non-commercial and personal purpose, the Complainant has stated that the DDN only serves to infringe upon the Complainant’s trademark and to mislead the public. To address this issue, the Panel relies on the principle in the case (*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 is shown on the DDN will cause confusion for customers as to whether there is an affiliation or sponsorship by the Complainant or their brand.

The Panel finds that the Complainant has established a prima facie case that the Respondent lacks legitimate interest in the DDN. The Panel further finds that the Respondent has failed to establish that it has legitimate interest in 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 "thetimesofpakistan.pk" was registered and is being used in bad faith. The respondent is using this domain impersonate our well-known brand, which is a clear violation of our trademark rights.

Furthermore, the disputed domain previously used a Facebook account for impersonation, resulting in suspension upon our complaint to Meta, as evidenced by the attached screenshot of the email from Meta.

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:

Prior Registration: The domain was purchased before the complainant's trademark registration, indicating no intent to infringe on their rights.

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 was also using a Facebook page linked on the DDN to impersonate the Complainant and their brand, which was subsequently suspended on the Complainant's complaint to Meta. This shows that the Respondent was intentionally attempting to attract, for commercial gain, users to the DDN. Thus, the Respondents intent to create confusion for users of the internet with the Complainant's mark is shown.

The Respondent has contended that the DDN was purchased before the Complainant's registration of their trademark which indicates a lack of any intention to infringe upon the Complainant's rights. The Panel, however, acknowledges that the Complainant's brand has existed and been in use since 2002, and the Respondent has registered the DDN in 2021, as established above. Thus,

it is highly unlikely that the Respondent was unaware of the Complainant's brand at the time of registration.

The Panel concludes through the evidence submitted by the Complainant, and the insufficient response by the Respondent, that the conduct satisfies the requirements of paragraph 4(b)(iv) of the Policy, as the DDN lacks any substantial elements that differentiate it from the Complainant's trademark and is evidence of registration and use of the DDN in bad faith.

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

7. Decision

The Panel, upon review of the information provided by the Complainant, recognizes that the "Times of Pakistan" mark is registered to the Complainant and Respondent does not possess legitimate rights over it. The ongoing use of the DDN 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.

Keeping in consideration the aforementioned discussion, the Panel finds that:

1. The Respondent's registration of the DDN does not violate 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 <thetimesofpakistan.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: Willayat Ali Shah

Sole Panelist

Date: 30 December 2024