

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Google Inc. v. Starcom Systems

Case No. C2013-0004

Also in PDF C2013-0004

1. The Parties

The Complainant is Google Inc., having its office at 1600 Amphitheatre Parkway, Mountain View, CA 94043, United States of America.

The Complainant has initiated the Complaint vide their authorized representatives, Mr. Hasan Irfan Khan (Advocate Supreme Court), Mr. Mueen Qamar (Advocate Supreme Court), Ms. Maria Farrukh Irfan Khan and Ms. Yasmin Kasuri (Advocate) of M/s Irfan & Irfan Attorneys-at-law, located at 85, The Mall, Lahore, Pakistan.

As per the PKNIC Whois database, the Respondent is Starcom Systems and the contact details are 64 Burhani Bagh Bldg. Haidry Block E, North Nazimabad 74700, Karachi.

2. The Domain Name and Registrar

The domain name in dispute is <utube.com.pk>, hereinafter referred to as the Disputed Domain Name and has been registered by Starcom Systems since 23rd April, 2008 until 23rd April, 2014.

3. Procedural History

Under the Supplemental Rules of DNDRC which override the ICANN Rules for Uniform Domain Name Dispute Resolution Policy in terms of paragraph 2 of the PKNIC - Internet Domain Registration Policy v 4.1, which states that “*DNDRC may consider and issue a recommendation in the matter in accordance with its own rules for such disputes or in default of such rules apply the Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999) and/or the Rules for Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999).*” As such DNDRC applies its Supplemental Rules to these proceedings as well as the UDRP and in case of any conflict the DNDRC Supplemental Rules to the ICANN Rules for the UDRP and UDRP apply.

The Complaint was filed with the Domain Name Dispute Resolution Center (the “DNDRC”) on 23rd August, 2013.

In accordance with the PKNIC - Internet Domain Registration Policy and the Rules of ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP], paragraphs 2(a) and 4(a), DNDRC formally notified the Respondent of the Complaint via email dated 02nd September, 2013 and the Respondent was asked to provide DNDRC with the Response in the format provided. The Respondent was informed that if a Response in accordance with the Rules, on the Response Form provided was not received within 10 days from the notification, the dispute would proceed *ex parte*.

The Respondent failed to submit a proper Response in the proper and specified manner and on the Response Form provided to the Respondent for ease of use. Under section 5(e) of the UDRP, the Panel has the authority, in the absence of a proper response, to commence with the proceedings in default and to determine the matter *ex parte* based upon the Complaint. However, the Respondent, did, vide email dated 02nd September, 2013, send an email to the DNDRC, contents of which are reproduced and discussed below herein.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), the Center appointed Mr. Mustafa Syed as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules. The Panel finds that it was properly constituted.

The language of the proceedings is English.

4. Factual Background

The Disputed Domain Name has been registered by the Respondent as of 23rd April, 2008 until 23rd April, 2014.

Parties' Contentions

The Complaint contends the following:

- 1. The domain name www.utube.com.pk (the “Domain Name”) is the subject of this Complaint. The present complaint has been instituted in order to protect the Complainant's rights in the trademark and domain name YOUTUBE which has been unauthorizedly copied by the Respondent and registered as a domain name with PKNIC Registry. A copy of the domain records of www.utube.com.pk is enclosed as **EXHIBIT 1**.*

2. *The Complainant's business under the name "GOOGLE" was founded by Larry Page and Sergey Brin in the year 1997. With its humble beginning, the Complainant has grown to become a multi-billion dollar business under the name / mark "GOOGLE". The Complainant's primary website www.google.com, which was registered on September 15, 1997, is widely recognized as the world's largest search engine, easy-to-use free service that returns relevant results within seconds. The Complainant's mark "GOOGLE" is one of the world's best known brands almost entirely through word of mouth from satisfied users.*
3. *In addition to Complainant's primary business of providing internet search facilities, the Complainant is also engaged in providing a wide range of other products and services. Mostly important to this dispute is the popular website www.youtube.com that Google operates. The relevant press articles and publications from news papers showing the Complainant's wide array of applications and operations is attached as **EXHIBIT 2**.*
4. *In its existence of about 8 years, YouTube has gone on to become a world-leader in online video sharing/streaming including movies, TV clips, music videos as well as amateur content such as video blogging and short original videos, thus capturing the imagination of millions of viewers every month across the globe spanning all age groups, nationalities, backgrounds and interests. With the internet revolution and the increasing access to the worldwide web, it is safe to say that YouTube has entered into the consciousness of an entire generation and its logo has become one of the most popular and recallable logos. Additionally, a wide variety of content including movies, TV clips and music videos as well as user generated content such as video blogging and short original videos are uploaded and made available for instant viewing on the Complainant's YouTube website. Moreover, over one billion unique users visit YouTube each month, more than 100 hours of video are uploaded to YouTube every minute and over six billion hours of video are watched each month.*
5. *According to the web ranking website www.alexa.com, Complainant's YouTube website is ranked as no. 3 on the list top 500 websites in the world today. Attached as **EXHIBIT 3** is a printout from the independent website www.alexa.com in support of the mass popularity of the YouTube website and its services.*
6. *The mark YOUTUBE is a coined word and it was chosen by the*

*Complainant's predecessor-in interest, YouTube, Inc., for their video sharing service in February 2005. Thereafter, www.youtube.com was launched on April 24, 2005. The Complainant, Google Inc subsequently acquired YouTube, Inc in November 13, 2006 and consequently gained the right to use the mark YOUTUBE. Attached marked as **EXHIBIT 4** are copies of international press articles surrounding the first use of the trademark and domain name YouTube and the launch of its service.*

- 7. The Complainant has applied for and has obtained registration of the mark YOUTUBE in a number of countries including Pakistan, UAE, Kuwait, Jordan, Qatar United States of America, Argentina, Austria, Brazil, Canada, China, the European Union, Hong Kong, Japan, India, Israel, Mexico, Norway, Philippines, Singapore, South Korea, Switzerland, Taiwan and Venezuela. Furthermore, an international registration for YOUTUBE filed on March 1, 2006 under the Madrid Protocol was granted by WIPO. Annexed as **EXHIBIT 5** are collectively filed specimen copies of trademark registrations and applications filed by the Complainant for registration of the YOUTUBE mark in a number of countries as well as an illustrative list of YOUTUBE trademark registrations in favour of the Complainant across the world. In Pakistan the YOUTUBE mark is registered in Class 38 under registration no. 228932 and in class 41 under registration no. 228934 with use as early as 2005.*
- 8. The Complainant submits that the technology industry has also recognised its YOUTUBE service and a number of awards have been conferred upon it. Attached marked as **EXHIBIT 6** are extracts from the Time Magazine (on-line edition) awarding YOUTUBE the Best Invention of the year 2006. The Wall Street Journal and New York Times have also reviewed the effects on recruiting and corporate communications in 2006 with regards to YOUTUBE. The PC World Magazine has also named YouTube as the 9th of the Top 10 Best Products of 2006. The Complainant's YouTube website and the YOUTUBE mark as such has attained immense popularity across the world and Internet users recognize and associate YouTube as a part of Google Inc. across the world.*
- 9. YouTube is localized in 56 countries and one Union Territory across 61 languages, even in Urdu speaking countries like Pakistan. The popularity of YouTube can be gauged from the fact that there is an option in which you can view the YouTube page in a different languages and 'Urdu' is amongst the listed 61 languages. Moreover,*

*Bollywood movies (Movies made in India) and songs of the movies are extremely popular in Urdu speaking countries like Pakistan, since Urdu language is closest to Hindi language. Therefore, several thousand Urdu speaking populations in Pakistan regularly access videos uploaded on the Complainant's website. Thus, the trademark and domain name YouTube is extremely popular in Pakistan. A list of countries where the Complainant owns and operates the YOUTUBE domains is attached as **EXHIBIT 7**.*

- 10. The Complainant submits that the overwhelming success of its YOUTUBE services has resulted in the Complainant gaining extensive goodwill and reputation in the mark world-wide, and that on account of its extensive use and popularity, the domain name/trade mark YOUTUBE has achieved the status of a 'well-known' mark.*
- 11. This well-known status has been recognized by other Domain Name Dispute Resolution Bodies in their various decisions in favor of Complainant. Mostly recently, the Panelists in the www.youtube.ae dispute noted the well-known status of the YOUTUBE trademark. [Google Inc. V Mobitronix LLC Case No:DAE2011-0002]. Additionally, the Panelist in the www.youtube.ph dispute noted the same. [Google Inc. V PD Hosting Inc., Ken Thomas Case No:DPH2011-0004]. Attached as **EXHIBIT 8** is a compilation of decisions passed by various Domain Name Dispute Resolution Bodies in Complainant's favor with respect to the YOUTUBE Mark.*
- 12. As per the PKNIC domain records, the Registrant registered the Domain Name www.utube.com.pk on 23rd April 2008, the domain seems to imitate the Complainant's website www.youtube.com as it is phonetically identical to the Complainant's well known domain name 'YouTube' and provides services similar to those of the Complainant that are, namely, free download of movie clips and songs. The Respondent's website further mentions the trademark 'Pakistani Youtube' which shows clear intention of the Respondent to take advantage of YOUTUBE mark and services run by the Complainant. Attached as **EXHIBIT 9** are a few snapshots and print outs of the Respondent's website under the disputed domain name www.utube.com.pk.*

Remedies Sought by the Complainant:

In accordance with paragraph 4(1) of the Policy, for the reasons described in section V above, the Complainant requests the Registrar /

Administrative Panel appointed in the administrative proceeding to issue a decision that the Domain name <www.utube.com.pk> be transferred to the Complainant.

Respondent's Contention:

Improper response of the Respondent:

DNDRC, vide email dated 02nd September, 2013 notified the Respondent of the Complaint against them and provided them with a copy of the Complaint, inviting them to submit their response in accordance with the Rules and on the Response Form. However, the Respondent failed to do so and on 02nd September, 2013, sent the email, contents of which are reproduced below herein:

Dear Concern Person,

I received the complaint about the domain www.utube.com.pk

I understand that the domain name is infringing your client's brand name and we will be okay to remove the website from the domain and release the ownership of both domains ie; utube.com.pk and utube.net.pk to your client IF your client agrees to pay us the investment we have made in the last 5 years in this domain, website, server and hosting fee etc.

Please let us know the procedure. We would like to resolve this dispute in a positive manner without causing any issues for any of the parties involved.

Thank you

Huzaiifa Ali

5. Jurisdiction

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the Rules.

The Respondent applied for and was granted registration of the Disputed Domain Name on the basis of, and has submitted to, the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

6. Discussion and Findings

In the seminal case of *Standard Chartered PLC v. Hosting Campus Domain Case No. C2007-0001* the DNDRC used for the first time the conditions for deciding the issue of Illegality, unlawfulness or otherwise invalidity of the Application & Registration as laid out in the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 and made use of the same in rendering the landmark decision related to the disputed domain name <standardchartered.pk>, whereby it was held that:

In this context the following aspects of the dispute will be addressed in this decision:

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 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 Panel therefore, concludes that the registration of the domain name “<[standardchartered.pk](#)>” would be illegal, unlawful and otherwise invalid in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 not to mention that the Respondent’s registration and/or use of the domain name “<[standardchartered.pk](#)>” could possibly give the impression that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) by allowing the maintenance of such registration would be committing a contravention of the Pakistani criminal law and a breach of its own Internet Domain Registration Policy June 20, 2006 version 4.1.

It is once again reiterated and clarified for future disputes, Appeals and Complaints that the illegality and examination of Pakistani law in this context does not imply that Pakistani law has applicability or jurisdiction over PKNIC or the dispute. Instead the fact that Pakistani law is included as part of the terms of the PKNIC- Internet Domain Registration Policy June 20, 2006 version 4.1, the terms and conditions apply to PKNIC and all parties by virtue of contractual and representative clauses and the examination of Pakistani law is thus undertaken to examine whether any of these terms and conditions have been breached, violated and/or there is non-conformity by the applicant or PKNIC.

The Panel, taking into account the discussions and findings in the case of <standardchartered.pk> will now apply those onto the facts of this Complaint and will deal with each of the sub-issues sequentially below.

The application for the registration of the Disputed Domain Name on behalf of the Complainant is regulated by the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 and the UDRP Rules. The PKNIC Policy states:

“You, the applicant who wants to register a domain name under .PK is presumed to have read and agreed to this PKNIC Internet Domain Registration Policy”.

The Respondent applied for registration of the Disputed Domain Name on the basis of these regulations and was allowed registration subject to the same. Hence the relationship between the Respondent and PKNIC with respect to PKNIC’s domain name registration service is governed by the PKNIC - Internet Domain Registration Policy Aug 7, 2007.ver 4.2 and the UDRP Rules, as such the Respondent’s registration must be legitimate and in accordance with the requirements of these regulations and Rules.

The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 paragraph 6 states that:

*“PKNIC has neither the resources nor the legal obligation to screen requested Domain Names to determine if the use of a Domain Name by an Applicant may infringe upon the right(s) of a third party. Consequently, as an express condition and material inducement of the grant of an applicant's ("Applicant") request to register a Domain Name, Applicant represents, agrees and warrants the following four statements and a **failure to comply with them, or any other parts of the PKNIC policy, will cause PKNIC to cancel the domain registration of the non-compliant domains of Applicant:***

1. *Applicant's statements in the application are true and **Applicant has the right to use the Domain Name as requested in the Application;***
2. *Applicant has a **bona fide intention to use the Domain Name on a regular basis on the Internet;***
3. *The use or registration of the Domain Name by Applicant **does not interfere with or infringe the right of any third party in any jurisdiction in Pakistan, with respect to trademark, service mark, tradename, company name or any other intellectual property right;***
4. *Applicant 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.**”*

Correspondingly the UDRP lays down three basic requirements under paragraph 4(a) on the basis of which a domain name Complaint shall be decided:

(i) Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) Respondent's domain name has been registered and is being used in bad faith.

Therefore in the present context the decision of the dispute shall be addressed with respect to the following aspect:

- i. Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 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 with respect to the Application & Registration of the domain name

In terms of the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2, a domain name is registered , and hence is deemed valid, subject to inter alia paragraph 1 & 4and is held invalid if it:

- a. infringes upon a registered tradename,*
- b. is not bona fide as recognized by international best practice,*
- c. 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,*
- 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.

The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 paragraph 4 also states that:

If a party claims that a domain name already registered with PKNIC violates their registered trade name, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is 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, agitates 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 assessment of illegality, unlawfulness or otherwise invalidity of the Application & Registration of the domain name in dispute, the application and registration of the Disputed Domain Name shall be assessed under the following aspects:

- i. Whether the Disputed Domain Name infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Disputed Domain Name is bona fide?
- iii. Whether the application and/or registration of the Disputed Domain Name contravenes the Pakistan Penal Code or any applicable criminal law?

The Panel will deal with each of these sub-issues sequentially below.

- i. Whether the Disputed Domain Name infringes upon, or is an obvious derivation of, a registered trade name / trade mark?**

The complainant has submitted that:

*The Complainant is the registered proprietor of the trademark <YouTube> in various countries including Pakistan. Details of collectively filed specimen copies of trademark registrations and applications filed by the Complainant for registration of the YOUTUBE mark in a number of countries across the world and also an illustrative list of YOUTUBE trade mark registration in favour of the Complainant across the world are enclosed as **Exhibit 5***

The Complainant has provided, along with annexing evidence of the same, that the Complainant has trademark registrations in favor of the trademark YouTube in several countries, for example, Pakistan, UAE, Kuwait, Jordan, Qatar United States of America, Argentina, Austria, Brazil, Canada, China, the European Union, Hong Kong, Japan, India, Israel, Mexico, Norway, Philippines, Singapore, South Korea, Switzerland, Taiwan and Venezuela. Furthermore, Complainant has also obtained international registration of the YOUTUBE trademark under the Madrid Protocol as granted by WIPO.

As submitted by the Complainant and evidence of the same annexed with the Complaint, the Complainant holds trademark registration rights to YouTube in several countries, including Pakistan whereby it is registered in Class 38 as of the date 06.11.2006, bearing trademark number 228932 and in Class 41 as of the date 06.11.2006, bearing trademark number 228934.

As per paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2, if a Complainant simply establishes this one criterion of infringement upon a registered trade mark/name, the registration would be deemed illegal and unlawful and for all purposes invalid.

The Respondent has not provided any information whatsoever at all with respect to the Disputed Domain Name and as such, the Panel has no data with it in order to consider on part of the Respondent.

Therefore subject to the above stated observations, the Panel may well determine the Disputed Domain Name to be transferred to the Complainant, However for the purpose of completeness (but not to create any binding precedent requiring the same to be followed in the future), the Panel will also assess and determine the remaining issues as listed above.

ii. Whether the application and/or registration of Disputed Domain Name is bona fide?

It has been asserted by the Complainant, and has not been refuted by the Respondent, that the Complainant is the registered owner of the trade mark/name YouTube. The Complainant has registered its trademark and domain names world wide in order to reflect and protect the same. The facts illustrate that the entity YouTube is internationally renowned and highly recognizable. And that the same is associated with the Complainant who holds the intellectual property rights to the tradename/trademark and thereby is entitled to use it in all forms afforded by intellectual property rights legislations, inter alia, Trade Marks Ordinance, 2001 of Pakistan, which allows a trademark holder to use its trademark in corresponding domain name(s).

The Complainant has been using the trademark YouTube in providing services to the masses since 2005, well in time before the Respondent registered the Disputed Domain Name. The

documentation/evidence provided by the Complainant depicts the recognition and goodwill associated with the trademark YouTube, both being on a colossal level. As for the Respondent, it has not availed the opportunity to submit a Response in the appropriate form in order for the Panel to take into deliberation. In such a case, the Panel is unable to decipher anything on part of the Respondent.

iii. Whether the application and/or registration of the Disputed Domain Name contravene the Pakistan Penal Code or any applicable criminal law?

Before discussing this sub issue, it is imperative to clarify the grounds and consequences of the same. It is clarified that although Pakistani law does not apply by force of law over PKNIC's Jurisdiction it does however apply as a contractual term to the contract executed between the Respondent and PKNIC thus defines the scope and terms of use of the domain name under the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2. As such it is clarified for future disputes, Appeals and Complaints that illegality with respect to the Application and Registration and examination of Pakistani law in this context does not imply that Pakistani law has applicability or jurisdiction over PKNIC or the dispute in question. Conversely the fact that Pakistani law is included as part of the terms of the PKNIC- Internet Domain Registration Policy Aug 07, 2007, version 4.2, these terms therefore apply to PKNIC and all relevant parties by virtue of the contractual and representative clauses thus the examination of Pakistani law is undertaken to determine whether any and/or all of these terms and conditions have been breached, violated and/or if there exists any non-conformity by the applicant or PKNIC.

The relevant Pakistani legislations pertaining to registration of the Disputed Domain Name includes, inter alia, The Trade Marks Ordinance, 2001, The Electronic Transactions Ordinance, 2002, subject to which infringements of Trade Marks and Trade Names is equated with the infringement of domain names hence the provisions of the Pakistan Penal Code Act, 1860 that deal with infringement of Trade Marks, would possibly also cover domain names.

Additionally under the Pakistan Penal Code Act, 1860 sections 464, 470, 471, 473, 476, 479, 480, 481, 482, 483 and 485 the continuing registration of the Disputed Domain Name by a person other than the owner/rightful holder/authorized user of the registered trademarks/names could be construed to be an offence on multiple accounts, and by operation, would not only give the impression to the Respondent that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) was allowing aiding, abetting, encouraging and conspiring with the Respondent and would also be liable to criminal offences under the above mentioned legislations.

Lastly by operation of the Electronic Transactions Ordinance 2002 section 3 and the Prevention of Electronic Crimes Ordinance 2009 section 15, (although, the same is not in effect at the moment, but it was at the time of registering the Disputed Domain Name by the Respondent) it can be construed that in any event where a Respondent has established or is using a website or a domain for any purpose, in which he does not hold legitimate interests, is entitled to be charged with the offence of spoofing under s.15 of the PECO 2009. The punishment under this legislation is not simply limited to fines and could also amount to imprisonment.

The above mentioned factors would increase the likelihood of giving rise to liability under the above mentioned statutes, which in turn would raise significant doubt regarding the legitimacy and bona fide of the Respondent's registration of the Disputed Domain Name.

The Panel reasonably opines and infers that the Respondent's registering the Disputed Domain Name could incur liability under the above mentioned Pakistani Legislations. This, in itself, is a basis on which this Complaint could be decided. However, for the sake of completeness and procedural fairness, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

The Panel in addition to the above, has made note of the issue pertaining to email(s) sent by users, being bona fide customers/consumers of the Complainant. The Panel has taken into account another way in which the use of the Disputed Domain Name would cause confusion and would be contrary to both, the letter and spirit and public policy of the ICANN UDRP as well as the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2.

The Panel notes the manner in which any "*a reasonable bystander*" or "reasonable user" may be misled and confused when sending emails to the Disputed Domain Name, being under the impression that the same, either are or maybe that of the Complainant. A customer, seeking any of the online services being provided by the Complainant, seeking any information, providing his own confidential information etc. may be misled into sending an email address corresponding to the Disputed Domain Name, considering either/all of them to be that of the Complainant. In such a manner, not receiving a response, or his confidential information being misused, or any other confusion being created in a customer's mind would not only affect the customer loyalty that forms an asset for the Complainant but might also endanger the Complainant's sales/profits/revenue that the Complainant earns from its customer base. The confusing similarity and in fact identical nature of the way in which the Complainant's registered trademark is used would lead to confidential messages being received by the Respondent. This situation would be similar to the one that arose in the famous case commonly known as the One In A Million Judgment before the Supreme court of the Judicature In the Court of Appeal (Civil Division) On

Appeal from the High Court of Justice Chancery Division, UK. The Judgment identified the likelihood that the sending of such emails would lead to substantial confusion which would be detrimental to business of an established business with legitimate interest in the use of the domain name. The Court also came to the conclusion that the act of registration of confusingly similar domain name would constitute passing-off:

It is accepted that the name Marks & Spencer denotes Marks & Spencer Plc and nobody else. Thus anybody seeing or hearing the name realises that what is being referred to is the business of Marks & Spencer Plc. It follows that registration by the appellants of a domain name including the name Marks & Spencer makes a false representation that they are associated or connected with Marks & Spencer Plc. This can be demonstrated by considering the reaction of a person who taps into his computer the domain name marksandspencer.co.uk and presses a button to execute a "whois" search. He will be told that the registrant is One In A Million Limited. A substantial number of persons will conclude that One In A Million Limited must be connected or associated with Marks & Spencer Plc. That amounts to a false representation which constitutes passing-off.

Mr Wilson submitted that mere registration did not amount to passing-off. Further, Marks & Spencer Plc had not established any damage or likelihood of damage. I cannot accept those submissions. The placing on a register of a distinctive name such as marksandspencer makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill in the name. Such persons would not know of One In A Million Limited and would believe that they were connected or associated with the owner of the goodwill in the domain name they had registered. Further, registration of the domain name including the words Marks & Spencer is an erosion of the exclusive goodwill in the name which damages or is likely to damage Marks & Spencer Plc.

I also believe that domain names comprising the name Marks & Spencer are instruments of fraud. Any realistic use of them as domain names would result in passing-off and there was ample evidence to justify the injunctive relief granted by the judge to prevent them being used for a fraudulent purpose and to prevent them being transferred to others.

This case represents good law even today and was upheld finally in Appeal by the Court of Appeal. As such similarly, in this case the registration of the Disputed Domain Name by the

Respondent would also constitute passing-off and a contravention of the criteria (i), (ii) and (iii) of paragraph 1 of the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2.

The above mentioned factors would increase the likelihood of giving rise to liability under the above mentioned legislations, which in turn would raise significant doubt regarding the legitimacy and bona fide of the Respondent's registration of the domain name in dispute.

In the opinion of the Panel this criteria has been sufficiently proven by the Complainant and no evidence to the contrary has been tendered by the Respondent. However this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

II. Identical or confusing similarity with a trademark or service in which the Complainant has rights

The Complainant has contended the following:

- i. *The Complainant has used the YOUTUBE trademark and domain name continuously since well prior to 23rd April, 2008 (the registration date for the disputed Domain Name). The Complainant owns many registrations for the mark YOUTUBE as contained in **EXHIBIT. 5** issued prior to, or resulting from applications filed prior to 23rd April, 2008 including its registration in Pakistan. Each remains valid and in full force. Thus, the Complainant has rights in the YOUTUBE mark that predate the registration date of the Domain Name. Further there have been awards in the Complainant's favor with regards to disputes over the domain names containing the word YOUTUBE. See, e.g., Google Inc. v Miller FA0708001067791 (Nat'l Arb Forum Oct 24, 2007) (Where youtubex.com was found to be in bad faith and confusingly similar to the Complainant's domain name youtube.com). See also Google Inc. V Nimbalkar, FA0708001068746 (Nat'l Arb Forum Nov 28, 2007) (finding further that the YOUTUBE mark is a "Well-known and distinctive" domain name and www.youtube.com is confusingly similar to the Complainant's domain name).*
- ii. *The Complainant owns the Domain name www.youtube.com and the Respondent's disputed domain name 'www.utube.com.pk' is derived by*

incorporating the mark 'UTUBE', which is phonetically identical to the Complainant's trademark "YOUTUBE" in its entirety to attract internet users and consumers for commercial gain. Therefore, there is a likelihood of confusion, and in fact suggests that the disputed domain name refers to the Complainant or that the Respondent is associated with the Complainant which is not the case. Furthermore, 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 in the mind of the Complainant's customers, as held in Google Inc. v Mubarkan Pvt. Ltd (Case No:C2012-0002) for the domain www.gmails.pk, which was found to be similar to Complainant's trademark GMAIL.

- iii. *The Complainant further submits that it has not licensed or otherwise permitted the Respondent to use the "YOUTUBE" trademark, or any other trademark incorporating a mark phonetically identical to the "YOUTUBE" mark. The Complainant has also not licensed or otherwise permitted the Respondent to apply for or use any domain name consisting of or incorporating a mark phonetically identical to the "YOUTUBE" mark. See Rediff.com India Ltd. v. Daniyal Waseem DNDRC (Case No. C2009-0005) it was held that "Both under past UDRP decisions (see for instance Nike, Inc. v. B.B. de Boer, WIPO Case No. D2000-1397; and Carolina Herrera, Ltd. v. Alberto Rincon Garcia, WIPO Case No. D2002-0806) and under the Policy, a well-established principle is that when someone registers a domain name, it represents and warrants to the registrar that, to its knowledge, the registration of the domain name will not infringe the rights of any third party. In the case at issue, the Panel reasonably finds that since the Complainant's marks are widely known, it is unlikely that the Respondent, at the time of registration of the disputed domain name or thereafter, was not aware that it was infringing the Complainant's marks."*

The Respondent has not provided any information whatsoever at all and in particular not refuted the contention put forth by the Complainant with respect to its trademark Youtube.

As is evident, the Disputed Domain Name reproduces the Complainant's registered trademark with a minor alteration in the spelling, thereby rendering the Disputed Domain Name confusingly similar to the registered trademark of the Complainant. Furthermore, the addition of the generic ccTLD indicator ".pk" cannot be taken into consideration when judging confusing similarity. It is well-established that the incorporation of a Complainant's mark in full within a

disputed domain name may be sufficient to establish confusing similarity between the mark and the disputed domain name (see *Nokia Group v. Mr. Giannattasio Mario*, WIPO Case No. D2002-0782, *The Ritz Hotel Ltd v. Damir Kruzicevic*, WIPO Case No. D2005-1137, and *Quintessentially UK v. Mark Schnoreberg / Quintessentially Concierge*, WIPO Case No. D2006-1643.)

The Complainant has produced adequate evidence of its rights in the trademark YouTube. gTLD suffix “.com” or its equivalent is an integral part of a domain name and is not considered relevant to the consideration of confusing similarity. The remainder of the Disputed Domain Name, being YouTube is the strong, distinctive and globally renowned trademark of the Complainant. (see *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1059 9th Cir. 1999; "*The intentional registration of a domain name knowing that the second level domain is another company's valuable trademark weighs in favor of likelihood of confusion.*").

The Panel finds confusing similarity between the Disputed Domain Name and the Complainant's trademark under paragraph 4(a)(i) of the Policy.

III. Legitimate interest or rights in the Domain Name

The Complainant has contended:

- i. The Complainant submits that there is no credible legitimate reason for the Respondent to have chosen to acquire the disputed Domain Name. 'UTUBE' is not a natural word nor a common name, nor one which is a common or natural descriptor for the use which is being made of the Domain Name. The Respondent's purpose in selecting the Domain Name was plainly to use the fame of the YOUTUBE mark to generate web-traffic and to confuse internet users visiting the Respondent's site when looking for the Complainant and their famous suite of services.*
- ii. The Respondent is not and has never been known by the UTUBE name or by any similar name.*

- iii. *Registration and use of the domain www.utube.com.pk by the Respondent is neither bonafide nor a legitimate noncommercial or fair use of the Domain Name especially because it mentions 'Pakistani Youtube' on its website and advertises itself as the Pakistani version of the official YouTube which is clearly aimed to derive unfair commercial gain by the Respondent and infringes Complainant's rights in the YOUTUBE mark. The goodwill in the YOUTUBE name rightfully belongs to the Complainant and has been improperly appropriated by the Respondent. Such conduct can never constitute a legitimate interest.*
- iv. *The Complainant submits that when the Respondent registered the disputed domain name, it was aware of the Complainant's activities, its trademarks and its domain name "YOUTUBE" and these facts establish a prima facie case that the Respondent has no right or legitimate interest in the disputed domain name and that pursuant to the Policy, the burden shifts to the Respondent to show it does have a right or legitimate interests. Please refer to Croatia Airlines d.d. v. Modern Empire Internet Ltd., [WIPO Case No. D2003-0455](#) and Clerical Medical Investment Group Limited v. Clericalmedical.com (Clerical & Medical Services Agency), [WIPO Case No. D2000-1228](#).*
- v. *On information and belief, Registrant is not commonly known by the name or nickname of the Domain Name, or any name containing/identical to Complainant's YOUTUBE Mark.*

Registrant's information on the domain records in connection with the Domain Name makes no mention of the Domain Name or the Mark as Registrant's name or nickname. See, Popular Enterprises, LLC v. Sung-a Jang, FA0610000811921 (Nat. Arb. Forum Nov. 16, 2006) (“[r]espondent’s WHOIS information does not suggest that [r]espondent is commonly known by the <ntester.com> domain name”). Registrant’s address is not mentioned on records and is mentioned as Ali, Karachi which establishes the fact that the Respondent has tried to hide his identity. As the Domain name is plainly registered for commercial purposes, it cannot constitute a legitimate non-commercial or fair use of the Domain Name. The adoption by the Respondent of the phonetically and visually identical ‘UTUBE’ domain name is plainly designed to assist it in impersonating the Complainant.

- vi. *As such, the Respondent’s use of the disputed Domain Name cannot constitute a bona fide offering of goods or services or a bonafide company name or trading name and such conduct can never constitute a legitimate interest.*

The Respondent has not submitted a Response in the appropriate form, nor has it provided any information, annexures, evidence, documentation or the like to support its registration of the Disputed Domain Name and in particular assert a legitimate interest in the Disputed 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.”

Although paragraph 4(a)(ii) requires the Complainant to prove that the Respondent has no rights to or legitimate interests in the Domain Name, once the Complainant establishes a *prima facie* case that none of the three circumstances establishing the legitimate interests or rights applies, the burden of production of evidence on this factor shifts to the Respondent to rebut the showing, despite the overall burden of proof remaining upon the Complainant to prove each of the three elements of paragraph 4(a). (*Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270; *Universal City Studios, Inc.*, *supra*).

In the present case, on the evidence before the Panel there is nothing to suggest that the Respondent seeks to bring itself within any one of the three abovementioned categories or demonstrate any other basis of a right or legitimate interest. Also, there is no evidence suggesting that an approval was ever sought by the Respondent from the Complainant who has trademark rights in the mark YouTube. It further avers that even upon becoming aware of the existence of the Complaint, the Respondent did not avail the opportunity to submit a Response in the required form and put before the Panel its case.

If the Respondent indeed had any rights in and to the Domain Name or contended for such rights, the Panel finds it highly improbable in light of the circumstances that it has offered to sell the Disputed Domain Name to the Complainant.

The Panel accordingly finds that the Complainant has established the second element in terms of paragraph 4(a)(ii) of the Policy.

Furthermore, the Respondent has failed to demonstrate any rights or legitimate interests with respect to the Disputed Domain Name and has, in effect conveyed lack of legitimate interest and rights pertaining to the Disputed Domain Name. The Panel is unable to find that the Respondent has any legitimate interest and rights to the Disputed Domain Name.



IV. Registration and use of the domain name in bad faith

The Complainant has made the following submission:

- i. *The nature of services being provided by the Respondent's disputed domain name www.utube.com.pk overwhelmingly support the conclusion that Respondent registered and is using the disputed Domain Name in bad faith. It is submitted that the Respondent's bad faith is further exemplified by the fact that they have registered the domain www.utube.com.pk on 23rd April, 2008, which is subsequent to the adoption and use of the mark YOUTUBE by the Complainant. The fame and unique qualities of the YOUTUBE mark makes it extremely unlikely that the Respondent created the Domain Name independently. See, e.g., *The J. Jill Group, Inc. v. John Zuccarini d/b/a RaveClub Berlin*, FA0205000112627 (Nat. Arb. Forum July 1, 2002) ("Because of the famous and distinct nature of Complainant's mark and Complainant's J. JILL listing on the Principal Register of the USPTO, [r]espondent is thought to have been on notice as to the existence of Complainant's mark at the time [r]espondent registered the infringing <jjill.com> domain name. Thus, [r]espondent's registration despite this notice is evidence of bad faith registration"). Even constructive knowledge of a famous mark like YOUTUBE is sufficient. *Google v. Abercrombie 1*, FA0111000101579 (Nat. Arb. Forum Dec. 10, 2001) ("because of the famous and distinctive nature of Complainant's GOOGLE Mark, [r]espondent is thought to have been on notice of the existence of Complainant's mark at the time [r]espondent registered the infringing [domain name]") (re googld.com domain name).*
- ii. *The Respondent has registered the Domain Name which is phonetically and visually identical to the Complainant's well known mark and domain. In so doing, the Respondent has*

intentionally attempted to attract Internet users to the web site, for commercial gain, by intentionally misleading them and creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website (Policy, paragraph 4(b)(iv)). The commercial gain is evidenced from the fact that besides providing similar services to those of the Complainant, the Respondent's domain name contains third party advertisements/links which is likely aimed at commercial gain for the Respondent.

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

(1) At the time of registration of the disputed domain name by the Respondent i.e., on 23rd April, 2008, the mark and domain name "YOUTUBE" was well-known and registered in several countries of the world including Pakistan. Therefore, the popularity and registration of the "YOUTUBE" trademark and domain name was a constructive notice to the Respondent on Complainant's rights in the "YOUTUBE" mark and name. Thus, the adoption of a phonetically and visually identical mark/domain name by the Respondent is in bad faith. Please refer to Google Inc. v. ShaheenYounas, Case No. D2012-1365.

(2) The word YOUTUBE is a unique coined word, which is exclusively referable to the Complainant and the suite of services provided by the Complainant. Thus, use of words, mark and domain www.utube.com.pk by the Respondent is clearly to align its business/services with that of the Complainant. The Complainant has made extensive use of the YOUTUBE mark for a considerable time, such that the YOUTUBE mark has acquired goodwill and

reputation globally as it has contents that cater to many different age groups, languages and cultures.

As previously set out, the Respondent has adopted an identical mark UTUBE as part of the disputed Domain Name. The entire business activity of the Respondent is to deceive the innocent trade and public by misrepresenting themselves as part of the Complainant's company or to misrepresent that the Respondent's activities have been authorized, approved or sponsored by the Complainant. The Respondent has wrongfully registered the disputed Domain Name to deceive consumers. Thus, from the circumstances, it's plain that the adoption of UTUBE in the disputed domain name was not independent but parasitic and made in bad faith

In regards to the issue of bad faith the Paragraph 4(b) of the UDRP states that:

*“the following circumstances, in particular but **without limitation**, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:*

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

Paragraph 15(a) of the Rules instructs the Panel to “*decide a complaint on the basis of the statements and documents submitted in accordance with the policy, these rules and any rules and principles of law that it deems applicable*”.

The Complainant has demonstrated, vide the Complaint and the Annexures provided, that it has trademark rights to YouTube and that the Disputed Domain Name is confusingly similar to their registered trademark. By virtue of the Respondent having registered the Disputed Domain Name, the Complainant is unable to utilize to full potential its intellectual property rights, which it has sought to protect by way of several trademark registrations in various jurisdictions across the world.

Furthermore, the Respondent has not responded to the contentions and assertions put forth by the Complainant, nor has it refuted any of the allegations brought by the Complainant. The Respondent has not provided any information whatsoever at all to the DNDRC that could have been taken into account for the purposes of this Decision.

As such, the Panel is unable to infer any bona fide on part of the Respondent.

Respondent’s Email:

The Respondent sent an email to the DNRC on 02nd September, contents of which have been reproduced above herein and shall be discussed here. Even though the email sent by the Respondent does not constitute a valid and proper response required to be submitted in the appropriate form, the Panel has taken it into account without forming any binding precedent for future references.

The Respondent has alleged to sell the Disputed Domain Name to the Complainant in consideration for the investment it has made in the last 05 years in this domain, website, server and hosting fee etc.

The Panel has sought the guidance of WIPO in the matter of Respondent offering to sell the Disputed Domain Name to the Complaint. The Consensus View in this regard shows that evidence of offers to sell the domain name are generally admissible under the UDRP, and is often used to show bad faith. This is so both in relation to offers by a respondent to sell made prior to a complainant's filing of a UDRP complaint, or after such filing. The latter takes account of the fact that cybersquatters often wait until a trademark holder launches a complaint before asking for payment. The legal criteria for showing bad faith directly specify that an offer for sale can be evidence of bad faith, and panels are competent to decide whether settlement discussions bad faith effort to extort.

In this regard, the Panel reasonably opines that the Respondent has demonstrated lack of bona fide on its part by making an offer to sell the Disputed Domain Name, to which it has no rights nor any legitimate interest.

WIPO Authorities:

The Panel, for the purpose of assessing the matter and this Decision, has taken into account, reviewed and made use of the Discussions & Findings in the WIPO Authorities mentioned and relied upon by the Complainant.

Furthermore, the Panel has also relied upon the Discussions & Findings in several WIPO Administrative Panel Decisions, inter alia:

- CBS Broadcasting, Inc. v. Gaddoor Saidi, WIPO Case No. D2000-0243,
- Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525
- Advance Magazine Publishers Inc. v Marcellod Russo, WIPO Case No. D2001-1049
- McMullan Bros., Limited, Maxol Limited, Maxol Direct Limited Maxol Lubricants Limited, Maxol Oil Limited Maxol Direct (NI) Limited v. Web Names Ltd, WIPO Case No. D2004-0078
- NB Trademarks, Inc. v. Domain Privacy LTD and Abadaba S.A., WIPO Case No. D2008-1984

- The South African Football Association (SAFA) v. Fairfield Tours (Pty) Ltd, WIPO Case No. D2009-0998

8. Decision

For the foregoing reasons, the Panel therefore concludes and decides that:

- i. The Respondent's registration of the Disputed Domain Name is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
- ii. The Respondent has no legitimate interest in the Disputed Domain Name.
- iii. The Disputed Domain Name is identical to the Complainant's trademark/names and registered domain names.
- iv. The Respondent is making mala fide use of the Complainant's trade marks/names.
- v. Pursuant to Paragraphs 4 of the PKNIC - Internet Domain Registration Policy Aug

07, 2007 version 4.2, and Paragraph (i) of the UDRP the Panel therefore recommends to PKNIC to transfer the registration of the Disputed Domain Name to the Complainant, as prayed for within 48 hours of receipt of this decision by email or it being uploaded onto the DNDRC website www.dndrc.com/cases_resolved/, whichever takes place earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Mr. Mustafa Syed

Sole Panelist

Date: 21st September, 2013