

**Domain Name Dispute Resolution Center (DNDRC)**

**Arbitration and Mediation Center**

**COMPLAINT PANEL DECISION**

**Telenor Pakistan (Pvt) Limited v. Easy Pay**

**Case No. C2016-0001**

**Also in PDF C2016-0001**

**1. The Parties**

The Complainant is Telenor Pakistan (Pvt) Limited, having its office at Silver Square, Plot 15, Mehr Ali Road, F-11 Markaz, Islamabad, Pakistan.

The Complainant has initiated the Complaint vide their authorized representatives, Mr. Hasan Irfan Khan, Mr. Mueen Qamar and Mr. S.M. Bilal Ahsan of Irfan & Irfan, located at 85, The Mall, Lahore 54000, Pakistan.

As per the PKNIC Whois database, the Respondent is Easy Pay and the contact details are [naveedsqb@gmail.com](mailto:naveedsqb@gmail.com) [provided by Registry].

**2. The Domain Names and Registrar**

The domain name in dispute is <easy pay.pk>, hereinafter referred to as the Disputed Domain Name and has been registered by Easy Pay since 25.02.2014.

**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 4.2, 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.

A complaint was received and accepted by the Domain Name Dispute Resolution Center (the “DNDRC”) with all completed formalities as on 18<sup>th</sup> January, 2016.

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 26<sup>th</sup> January, 2016 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 Response. 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.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Ms. Zahra D’Souza 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 domain name upon which the Complaint is based is <easypay.pk>.

PKNIC has confirmed via their email dated Monday, 1<sup>st</sup> February, 2016 that the Disputed Domain Name has been registered by the Respondent named in the Complaint and that their email address is [naveedsqb@gmail.com](mailto:naveedsqb@gmail.com).

#### **5. Parties Contentions**

##### **A. Complainant**

The Complainant’s contentions are reproduced below:

The domain name [www.easypay.pk](http://www.easypay.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 registered trademark EASYPAlSA which has been unauthorizedly copied by the Respondent and registered as a domain name with PKNIC Registry.

The Complainant is a Pakistani Company incorporated under the Companies Ordinance, 1984 and is the wholly owned subsidiary Telenor Group which is a renowned Norwegian multinational telecommunications company headquartered at Fornebu in Bærum, Norway. The Telenor Group’s business under the name of “TELENOR” was founded in the year 1885. With its humble beginning, the group has grown to become a multi-billion dollar business under the name / mark “Telenor”. Telenor Group is widely recognized as one of the world’s largest mobile telecommunications companies in the world with over 166 million mobile subscriptions and a workforce of 33,000. Telenor group is an international provider of voice, data content and mobile communication services in 13 markets across Europe and Asia and an additional 17 markets through its ownership in Vimpel Com Ltd. In addition, it has extensive broadband and TV distribution operations in four Nordic Countries, and a 10-year old research and business line for Machine-to-Machine technology. The Complainant’s mark “Telenor” is one of the world’s best known brands.

Telenor Pakistan is a subsidiary of the Telenor Group. Currently, Telenor Pakistan has a total subscriber base of 35.2 million with over 26% SIM market share. On acquiring the license for providing GSM services in Pakistan in 2004, Telenor Pakistan launched its services commercially in Karachi, Islamabad and Rawalpindi on 15 March 2005 which expanded to Lahore, Faisalabad and Hyderabad on 23 March 2005. As of today, Telenor covers more than 3,500 cities and towns across Pakistan. The company creates 2,500 direct and 25,000-plus indirect employment opportunities. It has a network of 23 company-owned sales and service centers, more than 200 franchisees and some 100,000 retail outlets. The company has over 8,000 3G-ready cell sites throughout the country and offers GPRS and EDGE nationwide and 3G services in over 90 cities. It is also well-recognized as being the single largest direct European investment in Pakistan.

In 2008, a successful joint venture between Tameer Microfinance Bank Limited and Telenor Pakistan, brought about Pakistan’s first and largest branchless

*banking service, “Easypaisa”, which was officially launched in October, 2009. In a country of over 190 million people, with only 10,000 bank branches and approximately 15 million bank accounts, Easypaisa was Pakistan’s first branchless banking deployment aimed to increase access to financial services for the people of Pakistan, with over 25,000 Easypaisa shops across the country. Easypaisa was also quoted by CNN as the “model to follow” in launching mobile banking services.*

*Easypaisa is Pakistan’s first and largest mobile money service and third largest in the world, catering to 6 million customers every month. It currently has over 40,000 agents in 750 cities and towns across Pakistan.*

*The present complaint has been instituted in order to protect the Complainant’s rights in the trade mark EASYPAY which has been unauthorizedly copied by the Respondent as a domain name with PKNIC Registry.*

*Telenor Easypaisa is offering one of its kind and the first end-to-end “Online Payment Solution” for its customer under the brand name of “EASYPAY”. “EASYPAY” offers online businesses/merchants and their customers a way of accepting online payments in Pakistan through multiple payment channels.*

*Customers can pay directly to the online retail store through their Easypaisa Mobile Account or they can make payments at any one of the 65,000 Easypaisa shops scattered across Pakistan. They can also use their Visa and MasterCard credit/debit cards safely and with no added cost through the “EASYPAY” option. The “EASYPAY” online payment service which is located at <https://easypay.easypaisa.com.pk/> and is accessible throughout Pakistan and is available for use by millions of customers in Pakistan.*

*The Complainant submits that the online payment service was officially launched to the general public in Pakistan on 28 May, 2015.*

*The Complainant had applied and secured registration of trademark “EASYPAY” in Class 38 (Telecommunication services; electronic mail services) under Registration No. 204480 as early as the year 2004.*

*The Complainant submits that on account of its extensive popularity of the Easypaisa as well as its by-product “EASYPAY”, the trade mark “EASYPAY” is*

*well known to the Pakistani population as a trademark of the Complainant. Therefore, the Respondent can have no plausible reason for adoption of an identical mark as part of the domain name. The Respondent's intention is clearly to take advantage of the goodwill and reputation enjoyed by the Complainant's registered trade mark "EASYPAY"*

The Complainant further relies on four legal grounds in support of their contentions:

- A. The Domain Name is identical or confusingly similar to the Complainants' trade marks in which they have rights*
- B. The Respondent has no rights or legitimate interests in respect of the Domain Name*
- C. The Domain Name was registered and is being used in bad faith*

Hence, the Complainant seeks the following remedies:

*In accordance with Paragraph 4(1) of the Policy read in conjunction with paragraph 25, 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 registration of the domain name [www.easypay.pk](http://www.easypay.pk) be cancelled.*

## **B. Respondent**

The Respondent has not submitted any response to DNDRC.

Under section 5(e) of the UDRP, in the absence of a response, the Panel has the authority to commence the proceedings in default and to determine the matter based upon the Complaint.

## **6. 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.

## **7. Discussion and Findings**

In *Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001)*, the Panel laid down the following 4 heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy, dated 07-Aug-2007, version 4.2 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 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 of the Application & Registration**

The PKNIC - Internet Domain Registration Policy Aug-07-2007 version 4.2 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. *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.*

As per the PKNIC - Internet Domain Registration Policy Aug-07-2007, version 4.2,

*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, 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 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 in consideration of the following criteria:

- 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, 1860 (the "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 stated:

*The Complainant owns trademark registrations for the mark "EASYPAY" effective from December 31, 2004 as contained in Exhibit 2 (above) issued over a decade ago and much prior to, or resulting from applications filed much prior to February 25, 2014, the registration date for the disputed Domain Name. Each remains valid and in full force. Thus, the Complainant has rights in the "EASYPAY" mark that predate the registration date of the Domain Name.*



*A domain name is “nearly identical or confusingly similar” to a complainant’s mark when it “fully incorporate[s] said mark,” PepsiCo. Inc. v. PEPSI SRL, D2003-0696 (WIPO Oct. 2, 2003) (holding [pepsiadventure.net](http://pepsiadventure.net), [pepsitennis.com](http://pepsitennis.com) and others confusingly similar to complainant’s PEPSI mark since they “incorporate[ed the] trademark in its entirety”). Here, the Domain Name [www.easypay.pk](http://www.easypay.pk) incorporates the registered trademark “EASYPAY” in its entirety, and is identical to it.*

*The Respondent’s domain name ‘[www.easypay.pk](http://www.easypay.pk)’ is derived by incorporating the Complainant’s trademark “EASYPAY” 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.*

*The Complainant further submits that it has not licensed or otherwise permitted the Respondent to use the “EASYPAY” trademark, or any other trademark incorporating the “EASYPAY” mark. The Complainant has also not licensed or otherwise permitted the Respondent to apply for or use any domain name consisting of or incorporating the “EASYPAY” mark.*

*Therefore, the Domain Name is identical to the Complainant’s mark, “EASYPAY”.*

The Complainant has provided evidence that the Complainant has had trademark registration in favour of the “EASYPAY” mark in Pakistan in class 38 and class 42 since 31 December, 2004. Both trademark registrations are valid till 31 December, 2024 and are currently in force.

The Respondent has not provided any information whatsoever with respect to the Disputed Domain Name and as such, no data is available to the Panel to consider on the part of the Respondent.

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.

Hence, the Panel may well determine, on this criteria alone, 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 sub-issues as identified above.

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

The Complainant has asserted that the Complainant is the owner of the trade mark “EASYPAY” and that such mark has been registered in Pakistan in class 38 and class 42 since 31-12-2004. This has not been refuted by the Respondent.

The Disputed Domain Name Easypay is highly recognizable and the same is commonly associated with the Complainant, who holds the intellectual property rights to the tradename/trademark and is thereby 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 registered the trademark EASYPAY since 2004 and been using it to provide e-commerce payment solutions services to the masses since 2015, 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 EASYPAY. As for the Respondent, it has not availed the opportunity to submit a Response 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 Penal Code or any applicable criminal law?**

As established in **Standard Chartered PLC v. Hosting Campus Domain (Case No. C2007-0001)**:

*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.*

For this purpose, relevant provisions of Pakistani law pertaining to registration of the Disputed Domain Name are being analyzed.

Trade Marks Ordinance, 2001

***40. Infringement of registered trade mark.-***

*(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without consent of the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.*

***4. Domain name not to be misleading as to character or significance.-*** (1) *A domain name shall not be registered if the public is liable to mislead as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a domain name.*

Electronic Transactions Ordinance, 2002 (“ETO”)

***3. Legal recognition of electronic forms.—***

*No document, record, information, communication or transaction shall be denied legal recognition, admissibility, effect, validity, proof or enforceability on the ground that it is in electronic form and has not been attested by any witness.*

Penal Code

*Of Trade, Property and Other Marks*

***478. Trade mark.***

*A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this Code the expression “trade mark” includes*

*any trade mark which is registered in the register of trade marks kept under the Trade Marks Act, 1940 (V of 1940)*

It is apparent on perusal of the above-quoted sections of the Trade Marks Ordinance, 2001 and the Penal Code that the infringement of Trade Marks and Trade Names and domain names have been equated. Therefore, the provisions of the Penal Code dealing with Trade Mark infringement appear to also cover domain names.

Furthermore, according to Section 3 of ETO, all material, instruments that would otherwise be in writing or in physical form, if generated or made available in electronic form that would attract the provisions of the same sections of the Penal Code or any other applicable law had the material been in physical, written or printed form. The Penal Code, therefore, by the operation of Section 3 of ETO, equally applies to transactions, publications or materials including the use of any trade mark or trade name made available in any electronic form on the internet through the use of a domain name.

By continuing the registration of the Disputed Domain Name by a person who is other than the owner, holder or authorized user of the trade mark or trade name, the Respondent would be an aider, abettor, encourager and co-conspirator and also liable to criminal offences.

***479. Property mark.***

*A mark used for denoting that movable property belongs to a particular person is called a property mark.*

***480. Using a false trade mark.***

*Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.*

Accordingly, if a person other than the owner, rightful holder or authorized user of the trade mark or trade name uses the Disputed Domain Name, if possibly linked to any service or goods, it may constitute an offence under the Penal Code.

***481. Using a false property mark.***

*Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or*

*goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.*

***482. Punishment for using a false trade-mark or property mark.***

*Whoever uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.*

As interpreted in *Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001)*, the use of a false property mark (which includes domain names on electronic encasements, packaging or containers such as websites or TCP/IP packets or messages) with the reasonable expectation that people would be misled to believe that the trade mark or trade name or domain name belongs to a person to whom it does not belong may constitute an offence under the Penal Code. Similarly, the following sections of the Penal Code may also be attracted:

***483. Counterfeiting a trade mark or property mark used by another.***

*Whoever counterfeits any trade mark or property mark used by any other person shall be punished with imprisonment of either description for a term which may extend to two years, or with fine, or with both.*

***485. Making or possession of any instrument for counterfeiting a trade mark or property mark.***

*Whoever makes or has in his possession any die, plate or others instrument for the purpose of counterfeiting a trade mark or property mark or has in his possession a trade mark or property mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong, shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both.*

***473. Making or possessing counterfeit seal, etc., with intent to commit forgery punishable otherwise.***

*Whoever makes or counterfeits any seal, plate or other instrument for making an impression, intending that the same shall be used for the purpose of committing any forgery which would be punishable under any section of this chapter other than section 467, or, with such intent, has in his possession any such seal, plate or other instrument, knowing the same to be counterfeit, shall be punished with imprisonment of either description for a term which may extend to seven years, and shall also be liable to fine.*

**464. Making a false document. A person is said to make a false document:**

*First: Who dishonestly or fraudulently makes, signs, seals or executes a document or part of a document, or makes any mark denoting the execution of a document, with the intention of causing it to be believed that such document or part of a document was made, signed, sealed or executed by the authority of a person by whom or by whose authority he knows that it was not made, signed, sealed or executed, or at a time at which he knows that it was not make, signed, sealed or executed;*

**470. Forged document.**

*A false document made wholly or in part by forgery is designated “a forged document”.*

**471. Using as genuine a forged document.**

*Whoever fraudulently or dishonestly uses as genuine any document which he knows or has reason to believe to be a forged document, shall be punished in the same manner as if he had forged such document.*

**476. Counterfeiting device or mark used for authenticating documents other than those described in section 467, or possessing counterfeit marked material.**

*Whoever counterfeit upon, or in the substance of, any material, any device or mark used for the purpose of authenticating any document other than the documents described in section 467 of this Code, intending that such device or mark shall be used for the purpose of giving the appearance of authenticity to any document then forged or thereafter to be forged on such material, or who, with such intent, has in his possession any material upon or in the substance of which any such device or mark has been counterfeited, shall be punished with imprisonment of either description for a term which may extend to seven years, and shall also be liable to fine.*

The Panel opines that the Respondent’s registration of the Disputed Domain Name could incur liability under the above-mentioned provisions in the Trade Marks Ordinance, 2001, Penal Code and ETO. This Complaint can be decided 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 Aug 7, 2007.ver 4.2.

**II. Identical or confusing similarity to a trademark or service mark in which the Complainant has rights**

The Complainant has contended the following:

*The Complainant owns trademark registrations for the mark “EASYPAY” effective from December 31, 2004 as contained in Exhibit 2 (above), issued over a decade ago and much prior to, or resulting from the applications filed much prior to February 25, 2014, the registration date for the disputed Domain Name. Each remains valid and in full force. Thus, the Complainant has rights in the “EASYPAY” mark that predate the registration date of the Domain Name.*

*A domain name is “nearly identical or confusingly similar” to a Complainant’s mark when it “fully incorporate[s] said mark.” PepsiCo. Inc. v. PEPSI SRL, D2003-0696 (WIPO Oct. 28, 2003) (holding pepsiadventure.net, pepsitennis.com, and others confusingly similar to complainant’s PEPSI mark since they “incorporate[ed the] trademark in its entirety”). Here, the Domain Name [www.easypay.pk](http://www.easypay.pk) incorporates the registered trademark “EASYPAY” in its entirety, and is identical to it.*

*The Respondent’s domain name ‘[www.easypay.pk](http://www.easypay.pk)’ is derived by incorporating the Complainant’s trademark “EASYPAY” 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 Complaint which is not the case.*

*The Complainant further submits that it has not licensed or otherwise permitted the Respondent to use the “EASYPAY” trademark, or any other trademark incorporating the “EASYPAY” mark. The Complainant has also not licensed or otherwise permitted the Respondent to apply for or use any domain name consisting of or incorporating the “EASYPAY” mark.*

*Therefore, the Domain Name is identical to the Complainant’s mark “EASYPAY”.*

The Respondent has not provided any information, and has not refuted the contention put forth by the Complainant with respect to its trademark “EASYPAY”.

It is evident that the Disputed Domain Name reproduces in its entirety the trade mark owned by the Complainant, thereby rendering the Disputed Domain Name confusingly similar to the trademark of the Complainant.

It is an established principle that the incorporation of a Complainant's trade 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 EASYPAY. The mere addition of a gTLD suffix “.com” or its equivalent is not relevant to the consideration of confusing similarity as it is an integral part of a domain name. The registration of a domain name, the second level domain of which is the trademark of another may be sufficient proof of confusion (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 therefore finds confusing similarity between the Disputed Domain Name and the Complainant's trademark under paragraph 4(a)(i) of the Policy.

### **III. Legitimate interests in a domain name**

The Complainant has contended:

*The Complainant submits that there is no credible legitimate reason for the Respondent to have chosen to acquire the Domain Name. “EASYPAY” is not a natural word nor a common name, nor one which is common or a 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 “EASYPAY” mark to generate web-traffic and to confuse internet users visiting the Respondent's site when looking for the Complaint and their famous suite of services.*

*The Respondent is not and has never been known by the “EASYPAY” name or by any similar name.*



*Registration and use of the domain [www.easypay.pk](http://www.easypay.pk) by the Respondent is neither bonafide nor a legitimate noncommercial or fair use of the Domain Name. The goodwill in the “EASYPAY” mark rightfully belongs to the Complainant and has been improperly appropriated by the Respondent. Such conduct can never constitute a legitimate interest.*

*The Complainant submits that when the Respondent registered the disputed domain name, it was aware of the Complainant’s activities, its Trademarks including the registered mark “EASYPAY” 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 not have a right or legitimate interests. Please refer to Croatia Airline d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 and Clerical Medical Group Limited v. Clericalmedical.com (Clerical & Medical Services Agency), WIPO Case No. D2000-1228.*

*As such, its use of the Domain Name cannot constitute a bona fide offering of goods or services or a bona fide company name or trading name and such conduct can never constitute a legitimate interest.*

The Respondent has not submitted a Response, 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 that the Complainant prove the Respondent has no rights or legitimate interests in the Disputed Domain Name, once the Complainant has established a *prima facie* case that none of the three circumstances establishing the rights or legitimate interests apply, 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, there is nothing to suggest based on the evidence before the Panel that the Respondent seeks to bring itself within any one of the three categories abovementioned, or demonstrate any other basis of a right or legitimate interest. Also, there is no evidence suggesting that the Respondents ever sought approval from the Complainant to use the mark “EASYPAY” in which the Complainant has trademark rights. Furthermore, the Respondent has not been able to demonstrate any rights or legitimate interests with respect to the Disputed Domain Name.

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

#### **IV. Registration and use in bad faith**

The Complainant has made the following submission:

- i. The nature of services being provided by the Respondent overwhelmingly supports the conclusion that Respondent registered and is using the 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.easypay.pk](http://www.easypay.pk) on February 25, 2014, which is subsequent to the adoption and registration of the mark **EASYPAY** by the Complainant. First, the fame and unique qualities of the “**EASYPAY**” mark made 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, FA 0205000112627 (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 the Complainant’s marks 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 well-recognized mark like **EASYPAY** is sufficient. *Google v. Abercrombie 1, FA0111000101579 (Nat. Arb. Forum Dec. 10, 2001)* (because of the famous and distractive 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 identical to the Complainant’s well-recognized and registered mark. In doing so, the Respondent has intentionally attempted to attract for commercial gain Internet users to the web site, by intentionally misleading them and creating a likelihood of confusion with the Complainants’ trademark as to the source, sponsorship, affiliation or endorsement of the website (Policy, paragraph 4(b)(iv)).*
- iii. *The Respondent’s choice of domain name is not accidental and has clearly been made to derive unfair money advantage. In support of this submission, the Complainant contends:*
  - (1) *The word “EASYPAY” is exclusively referable to the Complainant and the suite of services provided by the Complainant. Thus, use of words and domain [www.easypay.pk](http://www.easypay.pk) by the Respondent is clearly to align its business/services with that of the Complainant.*
  - (2) *The Respondent first registered the Domain Name on February 25, 2014 (almost 10 years after the Complainant had registered its trademark “EASYPAY” in Pakistan.*
  - (3) *As previously set out, the Respondent has adopted an identical mark “EASYPAY” as part of the 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 their activities have been authorized, approved or sponsored by the Complainant. The Respondent has wrongfully registered the Domain Name to deceive consumers. Thus, from the circumstances, it's plain that the adoption of the "EASYPAY" domain was not independent but parasitic and made in bad faith.*

*(4) The Respondent's bad faith is further evident by observing its website [www.easypay.pk](http://www.easypay.pk) on which hit claims to be providing services in collaboration with **EASYPAY**, another well-known mark of the Complainant's. Under the heading "services", the transaction receipts appears on clicking the respective **EASYPAY** AND **EASYPAY MOBILE** account links.*

*The above clearly shows Respondent's knowledge of EASYPAY mark, since it is fully aware of the EASYPAY services of the Complainant.*

In regards to the issue of bad faith, 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 Panel finds that the Complainant has demonstrated, vide the Complaint and the Annexures provided, that it has trademark rights to the mark “**EASY PAY**” and that the Disputed Domain Name is confusingly similar to their trademark. As the Respondent has registered the Disputed Domain Name, the Complainant is unable to utilize its intellectual property rights to full potential, which it sought to protect by obtaining trademark registration in Pakistan.

Moreover, 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 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.

**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 Mudjacks 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**

The Panel recognizes and appreciates the contributions the Complainant made in assisting this Panel through proper drafting of the Complaint with adequate supporting evidence allowing this Panel to come to its decision regarding this issue.

Analyzing the details provided by the Complainant, the Panel perceives that the EASY PAY marks and the Registered Trade Marks are recognized domestically, hence the Complainant reserves crucial interest in them. Usage of these marks by the Respondent for unfair commercial gain could endanger the reputation that the Complainant has worked hard at building and maintaining.

Taking all of the case law and discussion above into consideration, the Panel is of the opinion that the Respondent registered the domain name in dispute <easypay.pk> with mala fide intent.

For the above-mentioned reasons, the Panel concludes and decides that:

1. The Respondent's registration of the Disputed Domain Name is contrary to the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2
2. The Respondent has no legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Name is identical to the Complainant's trademark/names and registered domain names.
4. The Respondent is engaging in the unfair use of the Complainant's trade marks/names for personal commercial gain.

Pursuant to Section 4 of the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2, and Section (i) of the Policy, the Panel therefore recommends that PKNIC transfer the registration of the domain name in dispute <www.easypay.pk> to the Complainant, as prayed within 48 hours of receipt of this decision by email or its being uploaded on to DNDRC's website [www.dndrc.com/cases\\_resolved/](http://www.dndrc.com/cases_resolved/), whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

**Arbitrator: Ms. Zahra D'Souza**

**Sole Panelist**

**Date: 19<sup>h</sup> February, 2016**