

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Telenor v. Mohammad Tahir

Case No. C2008-0001

Also in PDF C2008-0001

1. The Parties

The Complainant is Telenor. (“Complainant”), located at 13-K Moaiz Center, F-7 Markaz, Islamabad, having contact number; +92(051) 111-345-700, fax number; +92 (051) 265-2960, email: ansieyali@telenor.com.pk. The current legal status of the Complainant is that of ‘private limited company’, and the place of business is Islamabad, Pakistan, with the principal place of business being 13-K Moaiz Center, F-7 Markaz, Islamabad.

The Respondent is Mohammad Tahir, (“Respondent”) located at Karachi, Pakistan. The current legal status of the Respondent is that of ‘individual’. All the other details of the Respondents are unknown, only an email address is known, being tshakoor@gmail.com

2. The Domain Name and Registrar

The disputed domain name is <telenor.pk> (the “Domain Name”). The Complainant has informed DNDRC from the verified records with PKNIC that the Respondent applied for registration of the domain name through ns1.fastpark.net and ns2.fastpark.net, on and its Create Date was 20th June 2006 with an Expire/Paid until Date of 20th June 2008 registered with PKNIC.

3. Procedural History

The Complaint was filed with the Domain Name Dispute Resolution Center (“DNDRC”) on November 21 2007. The DNDRC verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the DNDRC Supplemental Rules.

In accordance with the Rules, paragraphs 2(a) and 4(a), the DNDRC, on December 07, 2007, formally notified the Respondent of the Complaint, and the proceedings

commenced on December 15, 2007. In accordance with the Rules, paragraph 5(a), the due date for Response was December 14, 2007. The Respondent did not submit any response. Accordingly, the Center commenced the proceedings ex parte.

The DNDRC appointed Mr. Mustafa Syed as the sole panelist in this matter on the 15th December 2007. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant and its affiliated companies carry on one of the world's largest cellular service provider, which is commonly known as the "Telenor". Under the trade name 'telenor', Telenor and its affiliates provide telecommunication and cellular based services through an international network of mutually interdependent licensees/franchisees and corporately-owned operations, all operating under and using the Telenor Mark.

The Complainant also provides access to its services through internet using domain names 'telenor', both domestically, and internationally to its existing and potential users for customer support and for promotion of its services.

The Respondent is a private individual. Other details of the Respondents are not available.

The Complainant asserted that it has intensively used the Telenor trademark throughout the world for decades and as result thereof it has become well known, and has a an extensive customer loyalty, that is well established and a source of profit for the Complainant. The authorized Telenor dealers/franchisees use the Telenor marks, both internationally and domestically.

The Complainants are generally aggrieved by the domain name registration and potential use of <telenor.pk> by the Respondent.

The Complainants are the applicants of the following registered trade and pending marks in Pakistan:

"Telenor ASA", Class 09, Application dated 07/03/2006, Application No. 219683

"Telenor ASA", Class 09, Application dated 14/03/2006, Application No. 219677

"Telenor ASA", Class 09, Application dated 07/03/2006 Application No. 219669

"Telenor ASA", Class 16, Application dated 14/03/2006 Application No. 219681

"Telenor ASA", Class 16, Application dated 07/03/2006, Application No. 219674

“Telenor ASA”, Class 16, Application dated 07/03/2006, Application No. 219680

“Telenor ASA”, Class 16, Application dated 07/03/2006, Application No. 219685

“Telenor ASA”, Class 35, Application dated 14/03/2006, Application No. 219666

“Telenor ASA”, Class 35, Application dated 07/03/2006, Application No. 219682

“Telenor ASA”, Class 35, Application dated 07/03/2006, Application No. 219670

“Telenor ASA”, Class 35, Application dated 07/03/2006, Application No. 219657

“Telenor ASA”, Class 36, Application dated 14/03/2006, Application No. 219687

“Telenor ASA”, Class 36, Application dated 07/03/2006, Application No. 219684

“Telenor ASA”, Class 36, Application dated 07/03/2006, Application No. 219664

“Telenor ASA”, Class 37, Application dated 14/03/2006, Application No. 219672

“Telenor ASA”, Class 37, Application dated 07/03/2006, Application No. 219656

“Telenor ASA”, Class 37, Application dated 07/03/2006, Application No. 219663

“Telenor ASA”, Class 38, Application dated 07/03/2006, Application No. 219679

“Telenor ASA”, Class 38, Application dated 07/03/2006, Application No. 219678

“Telenor ASA”, Class 38, Application dated 07/03/2006, Application No. 219667

“Telenor ASA”, Class 41, Application dated 14/03/2006, Application No. 219673

“Telenor ASA”, Class 41, Application dated 14/03/2006, Application No. 219676

“Telenor ASA”, Class 41, Application dated 14/03/2006, Application No. 219658

“Telenor ASA”, Class 41, Application dated 14/03/2006, Application No. 219665

“Telenor ASA”, Class 42, Application dated 07/03/2006, Application No. 219675

“Telenor ASA”, Class 42, Application dated 07/03/2006, Application No. 219660

(Collectively referred to as the “Registered Trade Marks”).

The duly certified copies of the entries in the Register of Trade Marks in respect of each of the above-mentioned trade marks issued by the Pakistan Trade Mark Registry have been received by the DNDRC.

The Domain Name was registered on June 26, 2006, for a validity period of 2 years, and having the expiry date of June 26, 2008. The Domain Name leads to a so-called “click through” website with pop-ups (e.g. an advertisement for an on-line cellular based services) and different links to other websites and companies, none of them associated with the Complainant or its authorized dealers, but all of the seemingly similar expertise as the Complainant, being that of cellular-based services.

A print-out of telenor.pk PKNIC database dated December 15, 2007, mentioned “Muhammad Tahir” as the registrant.

5. Parties’ Contentions

A. Complainant

Based on the following arguments the Complainant requested the Panel to issue a decision that the Domain Name be transferred to them.

Identical or Confusingly Similar

The Complainant contended that the dominant and distinctive component of the Domain Name is “Telenor”, which is identical to the Complainant’s registered trademarks. The Complainant submits that the word “telenor”, which is the essential element of the Registered Trade Marks, has been reproduced and incorporated into the Domain Name. The thrust of the Registered Trade Marks is to convey to the reader the name “telenor” and it is this concept that makes up the Domain Name.

The Domain Name is completely identical to the readable portion of the Registered Trade Marks. Where the Registered Trade Marks are looked at as a whole, it is clear that they are trade marks consisting of the words “telenor”. As the logo cannot be reproduced in a domain name for the purpose of assessing the Domain Name, the logo must be disregarded (see *Asset Loan Co. Ply Ltd v Gregory Rogers* Case No. D2006-0300 and see also *Yell Ltd v Ultimate Search* Case No. D2005-0091). Consequently, the Domain Name is identical to the Registered Trade Marks according to this test.

Further, the Domain Name also reproduces fully and is identical to the Trade Mark Applications over which the Complainant holds rights. In addition, the Domain Name reproduces fully and is identical to the Domain Names registered by the Complainant.

Rights or Legitimate Interests

The Complainant claimed that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent is not a licensee and has not been

authorized in any way to use the Complainant's "Telenor" trademarks. Furthermore, the Respondent does not make legitimate non-commercial or fair use of the Domain Name.

The Respondent has no rights to or legitimate interests in the Domain Name as per (Policy, para 4(a)(ii), Rules, para 3(b)(ix)(2))

Paragraph 4(c) of the Policy provides that evidence of one or more of the following shall demonstrate a respondent's rights or legitimate interests to a domain name:

(i) Before any notice to the respondent of the dispute, the respondent's 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) The respondent (as an individual, business, or other organization) had been commonly known by the domain name; or

(iii) The respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

In *De Agostini S.p.A v Marco Cialone* Case No. DTV2002-0005, the Administrative Panel held that:

"...satisfying the burden of proving a lack of the Respondent rights or legitimate interests in respect of a domain name ... is quite onerous, since proving a negative circumstance is always more difficult than establishing a positive one. Accordingly, and in line with other prior decisions, the Panel holds that it is sufficient that the Complainant shows a prima facie evidence in order to shift the burden of proof on the Respondent".

Accordingly, once a complainant has made out a prima facie case that a respondent has no rights or interests in the domain name, the burden of proof shifts to the respondent to offer

evidence of his rights or legitimate interests in the disputed domain name. (See also *Intocast AG v Lee Daeyoon* Case No. D2000-1467.

In the present case, the *prima facie* evidence set out below supports the contention that the Respondent has no *bonafide* rights or legitimate interests in the Domain Name. The Respondent is an individual and is not associated or affiliated with the Complainant in any way. Furthermore, nothing in the domain name record at Annex A suggests that the Respondent is commonly known by the Domain Name. The Respondent is not known through the website corresponding to the Domain Name. There is no linkage between the Respondent and the Domain Name. The Domain Name is not used in connection with a *bonafide* offering of goods or

services by the Respondent. The Respondent is not making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Registered Trade Marks and the Trade Mark Applications:

(a) The Complainant has not at any time ever authorized or consented to the Respondent's use of the Domain Name whether for commercial or non commercial activities; and

(b) In light of the famous nature of the Registered Trade Marks and the Trade Mark Applications in respect of the marks and the extensive use of such marks, use of the Domain Name leads to the clear inference that the Respondent's use is an opportunistic attempt to attract visitors via the Complainant's famous marks and is not a legitimate noncommercial or fair use.

The Complainant submits that the Respondent is diluting the Registered Trade Marks and Trade Mark Applications. The Respondent is, in effect, preventing the Complainant from reflecting the Registered Trade Marks and Trade Mark Applications in a domain name that is meaningful to the conduct of their business. In *CSA International (a.k.a Canadian Standards Association) v John O.Shannon and Care Tech Industries, Inc.* Case No. D2000-007 I, the Administrative Panel held that "*the adoption by the Respondents of an Internet address substantially identical or confusingly similar to that of the name, Internet address and trade marks of the Complainant must inevitably and misleadingly divert consumers to that address and have the effect of tarnishing the trade marks*".

The Respondent is using the site as a search engine for mobile accessories and telecommunication related activity. The Complainant is well-known in the telecommunications industry in Pakistan and is operating all over the country. The diversion of the Domain Name to a site such as this is misleading to the consumer and is likely to create the impression that the Complainant is linked to the site in some way. This could tarnish the Complainant's goodwill and reputation and cause confusion to the users of the Complainant's customers and the users who use the Complainant's website for the web based services.

The Respondent's act of incorporating the "telenor" mark in the Domain Name undermines the branding and reputation of the Complainant on the Internet. To achieve consistent branding, the Complainant currently registers all domain names bearing the "telenor" mark subject to availability and local registration rules. It is clear that the "telenor" branding will be diluted if a domain name bearing the "telenor" mark is registered and used by a third party.

Given that the Respondent is not commonly known by the Domain Name, and is not in any way connected or affiliated to the Complainant; and is not authorized to use the "telenor" marks, the Respondent *prima facie* has no rights or legitimate interests in the Domain Name. Consequently, the burden of proof shifts to the Respondent to prove that it has rights or legitimate interests in the Domain Name. But since the Respondent has

not submitted any response or countered the allegations brought forth by the Complainant, the Panel is led to proceed *ex parte*.

Registered and Used in Bad Faith

The Complainant asserted that the Respondent has “registered the domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that [he has] engaged in a pattern of such conduct” as meant in the Policy, Paragraph 4(b) (ii). Furthermore, the Complainant contended that the Respondent is intentionally attempting “to attract, for commercial gain, Internet users to [the] website....by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the] website or location or of a product or service on the website or location” as meant in the Policy Paragraph 4(b) (iv). The website which is linked to the Domain Name is a search portal with links to other third party websites. The Respondent earns revenues from the advertised listings. Visitors who accidentally come across the Respondent’s website or who are looking for information regarding the Complainant’s authorized “Telenor” dealers may be confused as to whether the Respondent’s website is sponsored by or affiliated with the Complainant.

(Policy, paras 4(a)(iii) and 4(b); **Rules**, para 3(b)(ix)(3))

In *Telstra Corporation Limited v Nuclear Marshmallows* Case No. D2000-003 (“Telstra Case”), the Administrative Panel held that inactivity by a respondent may amount to the domain name being used in bad faith in the certain circumstances. Amongst others, the following two (2) circumstances were mentioned by the Administrative Panel in finding that passive bad faith use existed. These circumstances are where:

- (1) The complainant’s trade mark has a strong reputation and is widely known, as evidenced by its substantial use in the country of registration of the domain name as well as in other countries; and
- (2) There is no evidence whatsoever of any actual or contemplated good faith use by a respondent of the domain name.

Applying the first test in determining passive bad faith, namely that a complainant’s trade mark has a strong reputation and is widely known, as evidenced by its substantial use in the country of registration of the domain name as well as in other countries, it is understood that the Complainant has been operating as a cellular service provider in Pakistan for more than three years, is a large international firm in Pakistan, and maintains several branches in major cities across Pakistan through “Telenor” Pakistan. The Respondent must have been aware of the existence of the Complainant and its rights at the time of registration of the Domain Name. Given that the “telenor” mark is well-known in Pakistan, the Respondent must have had prior knowledge of these Registered Trade Marks and Trade Mark Applications. The Domain Name is therefore so obviously

connected with such a well-known name that its very use by someone with no connection with the industry suggests opportunistic bad faith (see *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v The Polygenix Group Co.* Case No. D2000-0 163).

From the domain name records at Annex A, it appears that the Domain Name was registered on 20/06/06. It is submitted that the only reasonable inference is that the registration of the Domain Name at this crucial time when “telenor” was seeking to expand its operations in Pakistan was due to an opportunistic motive to hijack the Domain Name for monetary gain.

It is further alleged that the Respondent has used and is using the Domain Name in bad faith. Another crucial matter to be taken into consideration in this case is the fact the Respondent is offering the domain name under dispute <telenor.pk> for sale to the public at large. There are countless authorities that show that the offering of the domain name in dispute for sale, either to the Complainant(s) only, or the mass public, or both, is sufficient evidence of mala fide intent on the Respondent’s part to attain undue, unfair commercial advantage and hence has been found to be a basis for the domain name in dispute to be transferred to the Complainant. There are various WIPO authorities on this issue, for example, *Bayerische Motoren Werke AG v. Whois Protection*(Case No. D2007-1142), *Debevoise & Plimpton LLP v. Marketing Total S.A.*(Case No. D2007-0451), *Gulf Air v. Surash Kumer*(Case No. D2007-0443), *Société Peclers Paris v. PECLERS.COM c/o Whois Identity Shield / Société Peclers Paris Domain Administrator* (Case No. D2007-0630), that are worthy to be taken into consideration, as the findings in the above mentioned authorities lead the Panel to purport that the Respondent is using the domain name in dispute <telenor.pk> with mala fide intent.

Accordingly, the Complainant contends that the registration and use of the Domain Name which is identical to the well-known “telenor” mark as well as the Complainant’s Registered Trade Marks and Trade Mark Applications was in opportunistic bad faith. For these reasons the Complainant asserted that the actions of the Respondent should be considered to be evidence constituting bad faith registration and use.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the requested remedy can be granted if the Complainant asserts and proves each of the following:

A. Illegality, unlawfulness or otherwise invalidity of the Application & Registration

B. that the Domain Name is identical or confusingly similar to a trademark or a service mark in which Complainant has rights;

C. that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

D. that the disputed domain name has been registered and is being used in bad faith.

Illegality, unlawfulness or otherwise invalidity of the Application & Registration

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 PKNIC - Internet Domain Registration Policy Aug-07-2007 version 4.2 clearly states that it creates an exception for and thus, excludes the registration of 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, Trade Mark Ordinance 2000.*
- 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, Para 4,

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 (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.

The PKNIC – Internet Domain Registration Policy Aug 07, 2007 version 4.2 para 15 states that:

The party requesting registration of this name certifies that, to his/her knowledge, the use of this name does not violate trademark or other statutes.

Furthermore, Para 25, sub-section (iii) and (iv) state that:

- i. 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;*
- ii. 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.*

Hence, any registration in contravention of paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug-07-2007, version 4.2 would be ab initio void and in any case voidable in terms of paragraph 4 of The PKNIC - Internet Domain Registration Policy Aug-07-2007, version 4.2.

Para 4 of the Policy states:

‘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 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 (with PKNIC amendments) or as per the orders of a court judgment in Pakistan’.

The above mentioned clause, calls for the Complainant to show that the Domain Name is infringing upon their registered trade name, this is satisfied in the case of the Complainant, as they have registered the trade name ‘Telenor’ and the respective trademark, both globally and domestically, and this is evidenced by the certificates of registration of the trademark and the trade name in more than 10 countries. In case of registration in Pakistan, the Complainant has applied for the registration, and this is shown by the certificates of application of the trademark and the trade name, provided to DNDRC as annexure “B” and “C”. In addition to this, the above stated clause requires the Complainant to show that a domain name already registered with PKNIC is an obvious derivation of their registered company name. This is evidenced by the fact that the domain name in dispute ‘telenor.pk’ is, in its entirety, the trade name of the Complainant, which is registered. There are no subsequent additions to the word, and

neither is there any typo squatting, that could be witnessed by a change in the spelling or variation in the context of the word 'telenor'. Furthermore, the word 'telenor' does not hold a generic, or a literate meaning. It is very closely associated with the provision of the services by the Complainant and hence does not refer to any thing generally. As for the third requirement in the above mentioned clause, the Complainant is required to show that the Respondent is involved in some activity that is not considered to be bona fide, as per the international best practice. This burden of proof on the Complainant is satisfied by the fact that the Complainant is very well connected with the trade name 'Telenor', and the provision of services under this name, and this is shown by the popularity level of the Complainant, and its fame and well-established reputation, in regards to the provision of cellular services, both internationally and domestically. Once the Complainant has shown compliance, the burden of proof shifts to the Respondent to counter the allegations. As the Respondent has not submitted any response, hence, it can be very well apprehended that the Respondent has not registered the trade name 'telenor', and this is further strengthened by the fact that the respective trade name belongs to the Complainant, and hence it cannot be registered by the Respondent at the same time, and neither has the Complainant authorized or permitted the Respondent to use this trade name, nor is the Respondent, in any way affiliated with the Complainant, thus, it cannot be contended that the Respondent has any legitimate rights in the trade name, 'telenor'. Furthermore, the Respondent is making use of the trade name in its entirety, and complete derivation. There are no changes or alterations in the trade name. The Respondent fails to satisfy this requirement. In addition to this, the Respondent is utilizing the domain name in dispute 'telenor.pk' in a mala fide fashion. This is evident by the fact that the Respondent has offered the domain name in dispute 'telenor.pk' for sale. The Domain Name is available to be purchased by any one interested in buying it. This is clear evidence of mala fide use of the domain name. Furthermore, the Domain Name is being utilized to divert internet users to other websites through links and pop-ups. This negates the bona fide use of the domain name requirement and hence the Respondent fails to establish the bona fide intent or provision of services. The Complainant sustains legitimate rights and interests in the Domain Name, as evidenced by the fact that the Complainant is a well-established business with a reputable goodwill and fame. However, neither is the Respondent a known establishment or an individual entity, nor has it been authorized by the Complainant, or is an associated dealer or franchisee of the Complainant. Hence it can be concluded that the Complainant succeeds in complying with the requirement set out in the Para 4 of the Policy, whereas the Respondent fails to do so.

Para 7 reads as:

'Any claim to trade name or copyright under .PK domain name is considered valid only if it is registered with an official trade-name/copyright/patent office in Pakistan, or is recognized by the courts of law in Pakistan (e.g. international trademarks).'

Hence, the burden of proof on the Complainant to satisfy this requirement is established, as the Complainant has provided the registration certificates of the trade name 'Telenor' in more than 10 countries, and the certificates of application for registration in Pakistan.

The Respondent however has failed to do so, as the Respondent has not submitted any response or any evidence countering the Complainant's allegations, and hence satisfying this requirement.

Para 16 of the Policy states:

'Registering a domain name does not confer any legal rights to that name and any disputes between parties over the rights to use a particular name are to be settled between the contending parties using normal legal methods and the "Dispute Resolution" method described above'.

The Sole Panelist finds that the proceedings have been commenced and concluded in accordance with the Rules. The Complainant submitted the Complaint, duly and appropriately filled, in compliance with the Rules, the Respondent however failed to do so, even though an opportunity was provided to them, as per the Rules.

Para 25 of the Policy reads:

'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:

- i. Applicant's statements in the application are true and Applicant has the right to use the domain name as requested in the Application;*
- ii. Applicant has a bona fide intention to use the domain name on a regular basis on the Internet;*
- iii. 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;*
- iv. Applicant is not seeking to use the domain name for any unlawful purpose, including, without limitation, tortious 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.'*

The Panelist finds it helpful to provide a detailed analysis of each of the above mentioned sub-clauses in the Para 25 of the Policy, and their applicability in this case.

The sub-clause (i) reads as:

Applicant's statements in the application are true and Applicant has the right to use the domain name as requested in the Application;

The Applicant, in this case being the Respondent, is required to verify that he has a right to use the domain name. However, in this case, the Respondent fails to show any such rights, first, by the failure to respond to the Complainant's contentions, and secondly, the DNDRC, has not received any documentation, for example, registration certificates, etc, in order to prove its legitimate interest and rights in the domain name in dispute. Another matter to be taken into consideration is the fact that the Respondent is not a known individual or a well-established company, thus it cannot be perceived that the Respondent has legitimate rights or interest in the Domain Name. The Complainant has been using other variants of the Domain Name for quite an extensive period of time now and hence it is evident that it holds legitimate interests in the Domain Name. This is further strengthened by the fact that the trade name 'telenor', is very well established and is associated with the provision of the cellular services by the Complainant, both internationally and nationally. The trade name is very well connected with the Complainant and thus it can be said that it is the Complainant, rather than the Respondent, who holds rights in using the domain name in dispute.

The sub-clause (ii) of the above mentioned Para 25 of the Policy mentioned above states that:

Applicant has a bona fide intention to use the domain name on a regular basis on the Internet;

This section calls for the Respondent (being the Applicant here), to prove that it shall utilize the domain name in a bona fide way. This however, is not the case here, as the Respondent does not sustain any legitimate right to use the Domain Name, as the trade name, which forms the entirety of the Domain Name, is a registered trade name belonging to the Complainant. Furthermore, the Respondent has offered the Domain Name for sale. This is substantial evidence of its mala fide intent. This implies that the Respondent does not wish to keep the Domain Name for his own purposes relating to business of some sort, or any provision of services, on a long-term and regular basis. This conclusion is arrived at by the fact that the Domain Name has been put up to be purchased by any body interested. If the Respondent had any intention(s) to utilize the Domain Name for a bona fide purpose, it would not have offered to sell the domain name, instead would have retained it for his own use. Hence, summing up the crux, it can be concluded that the Respondent is not involved in a bona fide mode of using the Domain Name.

The sub-clause (iii) of the Para 25 of the Policy, states:

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, trade name, company name or any other intellectual property right;

It is very crucial to satisfy this requirement, as copyright infringement or breach of a trade mark ordinance clause is a severely punishable offence. The Respondent is in clear violation of the section.74 of the Trade Marks Ordinance 2000, which states that:

Use of trade mark by a person other than the proprietor thereof:-

- (1) The permitted use of a trade mark shall be deemed to be use of the trade mark by the owner of the trade mark and shall be deemed not to be use of the trade mark by a person other than the owner for any purpose for which such use is material under this Ordinance or any other law for the time being in force.*
- (2) The tribunal while determining as to whom the benefit of use of a trade mark be passed, shall pass the benefit to none else, except to-*
 - (a) the proprietor of the trade mark, if the trade mark is registered; or*
 - (b) the owner of the trade mark, if the trade mark is entitled to protection under the Paris Convention as a well known trade mark.*

Neither has the Respondent registered the trade name 'telenor', nor has it applied to do so. However, the Complainant has not only registered the trade name 'telenor' globally, but it has also applied for the registration of the respective trade name in Pakistan, and this is evidenced by the certificates of application of the trade name in Pakistan, that the Complainant has provided to the DNDRC.

The last section, being the sub-clause (iv) of the Para 25 of the Policy, states that:

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.'

The Respondent is actively involved in the provision and promotion of web based services and what seem to be telecom services, that are very closely identical to the services provided by the Complainant, hence the Respondent is interfering in the with the prospective business advantage that the Complainant might have. In addition to this, the Respondent's activity on the Domain Name also creates unfair competition for the Complainant, hence injuring the business and reputation of the Complainant. This is also supported by the fact that the Respondent is misleading the users to other links and pop-ups. All of the hereby mentioned allegations are supported by the fact that the Respondent is using the Domain Name for provision of a wide array of web based services conflicting with the services provided by the Complainant. It is also a threat to the gain that the Complainant might have in order to expand the profitability of its business. This is strengthened by the Respondent's failure to show any legitimate rights or interest that it might have in the Domain Name. The Complainant is a well-known cellular service operator and hence has a widely spread network, that is closely connected with fame, good reputation, goodwill and its tradename. This is being put at risk by the Respondent's use of the Domain Name in dispute, as the users, looking for the Complainant's web based services, might end up on the Domain Name, thinking it

belongs to the Complainant, or is affiliated to the Complainant. Hence, disrupting the creditability and the customer loyalty that the Complainant has from its users.

The various ways in which the domain name in dispute <telenor.pk> would cause confusion, is not limited to the ones mentioned above. In addition to the above discussed problems of the cyber squatting of the domain name that the Respondent is involved in is the critical issue of the sending of the email(s) by a user to the intended recipient, being the Complainant, but however, being received by the Respondent.

In case any “reasonable bystander” or “reasonable user” may be misled and confused when sending emails to this domain name that the domain name may be that of the Complainant. The confusing similarity and in fact identical natures of the domain name 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 Judgement before the 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 Judgement 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 domain name “<[telenor.pk](#)>” by the Respondents would also constitute passing-off and a contravention of the criteria of The PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.

In terms of The PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2 if a Complainant simply establishes this one criterion the registration would be deemed illegal, unlawful or otherwise invalid. As such since, in the opinion of the Panel this criteria has been established by the Complainant and no evidence to the contrary has been tendered by the Respondent in their Response, the same stands proved and constitutes adequate grounds for the transfer of the Domain Name “<[telenor.pk](#)>” to the Complainant.

Any emails that the user would send on this address, considering it to be of the Complainant, being the intended recipient, would not get any reply. The email might be of any query that the user needs information upon, or any confidential data that the user might be disclosing in the email. As the email would be going to the Respondent, and the user would not be getting any response back, he might be misled into believing that the Complainant is inefficient, or the provision of the web based services by the Complainant have become ineffective. This would yield a sufficient amount of confusion and ambiguity for the user, who, being ignorant, and unaware of the true nature of the case, and the sensitivity of the issue, would be misled into believing that he sent the email(s) to the Complainant, but instead it would be the Respondent who would be getting them. In addition to the confusion that this would cause to the user, the Complainant would also be adversely affected by this, as the Complainant, might lose its clientele that it has acquired through the internet. In addition private and personal information of the Customers and users would be received illegally and unauthorizedly by the Respondent.

Another matter to be taken into consideration is whether the application and/or registration of the Domain Name “<[telenor.pk](#)>” contravene the Pakistan Penal Code or any applicable criminal law?

Before proceeding with this analysis the Panel feels compelled to clarify the basis and effect of this sub-issue. It is clarified that although Pakistani law does not apply by force of law over the PKNIC Jurisdiction it does apply as a contractual term to the Contract between the Respondent and PKNIC and 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 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 Aug 07, 2007 version 4.2, 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.

In this spirit and for this purpose alone the following provisions of Pakistani law are being analyzed. The ordinances, and the sections mentioned herein below, have been discussed at length in the landmark decision of the DNDRC in the case of standardchartered.pk, available on the DNDRC website. (http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf)

Electronic Transaction Ordinance 2002.section 3.

Pakistan Penal Code 1860, sections 467, 470, 471, 473, 476, 479, 480, 481, 482, 483, 485,

Trade Marks Ordinance 2001, section 40, 4(1), and 74.

The above mentioned ordinances provide that the use of a registered trade name or a registered trade mark, by a third party, is illegal, and severely punishable, as stated in the respective statute. Hence any body, or any firm/corporation, involved in utilizing a trade name or a trade mark that is already registered by another party, is deemed to be liable to criminal prosecution, and maybe incurred with fine, as described in the particular Ordinance.

Identical or Confusingly Similar

The Complainant holds Telenor trademark registrations in more than 10 countries, including Germany, USA, Thailand, amongst other, and has applied for registration of the Trademark in Pakistan, where the Respondent is based. Consequently, the Panel finds that the Complainant has rights in the Telenor trademark.

For the purpose of assessing whether the Domain Name is identical or confusingly similar to the Telenor trademark in which the Complainant has rights, the “.pk” suffix is disregarded, as it being a necessary component of the Domain Name. There lies no difference between the Telenor trademark and the Domain Name. As such the use of a common word strengthens the likelihood of confusion. As a result the Panel considers the Domain Name <telenor.pk>, confusingly similar to the Complainant’s Telenor trademark (see *Toyota Motor Sales USA v. Rafi Hamid dba ABD Automobile Buyer*, [WIPO Case No. D2001-0032](#)).

The Complainant alleges that it has numerous registrations of the trademark ‘Telenor’. This has been verified by the copies of Registration Certificates attached as Annex C. The Complainant further contends that the domain name in dispute is identical with and confusingly similar to the Telenor mark pursuant to the Policy paragraph 4(a)(i).

The Complainant has provided that it has numerous registrations of the trademark 'telenor' and that its trademark registrations are valid and subsisting and serve as *prima facie* evidence of its ownership and the validity of the Telenor mark. The Complainant further contends that its registrations are incontestable and conclusive evidence of its ownership of the mark and exclusive right to use the mark in connection with the stated web based and telecom services. Panel decisions have held that registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive. Respondent has the burden of refuting this assumption. *See, e.g., EAUTO, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, ICANN Case No. D2000-0047.

The Respondent has not countered the contested allegations incurred on him by the Complainant. Therefore, the Sole Panelist finds that Complainant, for purposes of this proceeding, has enforceable rights in the Domain Name.

Complainant further alleges that Respondent's use of the Telenor name and mark in the Domain Name at issue erroneously leads the Complainant's customers and customers of Complainant's authorized TELENOR dealers to believe that the Domain Name is somehow associated with, endorsed by or sponsored by Complainant and/or its authorized TELENOR dealers. Administrative panels and arbitrators have found domain names, which incorporate well-known or famous marks to be confusingly similar in that the offending domain name is misleading. *See, Nike, Inc.*, WIPO Case No. D2000-0167.

Complainant's mark and its services are famous. Complainant has been using its trademark as a web address and domain name for quite a long while now. Acts and services are likely to conclude that the Domain Name is simply an extension of Complainant's business. Persons encountering Respondent's site will be misled into believing that the Complainant is beginning another business, which could be detrimental to the Complainant. In view of the fame of Complainant's marks and the lack of distinctiveness afforded by the simple addition of non-distinctive or descriptive material, the Domain Name is misleading.

Therefore, the Sole Panelist finds that the Domain Name is confusingly similar to the TELENOR mark pursuant to the Policy paragraph 4(a)(i).

Rights or Legitimate Interests

According to paragraph 4(c) of the Policy the Complainant should prove that the Respondent has no right or legitimate interest in the Domain Name. According to the consensus view among panels, this condition is met if the Complainant makes a *prima facie* case that the Respondent has no rights or legitimate interests, and the Respondent fails to show one of the three circumstances mentioned in paragraph 4(c) of the Policy.

The Complainant contended that it did not authorize the Respondent to use the Telenor trademark in any way. Nor could the Panel establish any indications that the Respondent was previously known under the Domain Name or is using the Domain Name for *bona*

fide offering of goods or services, or for non-commercial or fair use. For these reasons, the Panel finds that the Respondent has no rights or legitimate interest in the Domain Name.

The Respondent has no relationship with, license from or specific permission from the Complainant to utilize the ‘telenor’ trade mark or trade name, nor is the Respondent an authorized dealer, franchisee of the Complainant.

The Policy paragraph 4(c) allows three nonexclusive methods for the Sole Panelist to conclude that it has rights or a legitimate interest in the Domain Name:

(i) evidence of use of, or demonstrable preparations to utilize , the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services

In the present case, the Sole Panelist cannot confer any such activity by the Respondent. Even though the Domain Name is being used by the Respondent, it is not being done so for a bona fide provision of services. This is evidenced by the fact that the Respondent has offered the Domain Name for sale to the masses. Furthermore, it can be seen that the Domain Name is being used to transfer the user to other pop-ups and links, to various other domains that offer various web based services.

(ii) the Respondent has been commonly known by the domain name, even if there has been no acquisition of the trademark or service mark rights.

The Respondent fails in entirety in satisfying this criterion. This is so as the Respondent has failed to provide the DNDRC with any supporting evidence, in order to show his credibility. So much so, the Respondent has not even provided any response to the DNDRC. Hence, the Sole Panelist cannot confer that the Respondent has been known by the Domain Name in the past, or hold any legitimate rights or bona fide interests in the Domain Name.

(iii) the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain by misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The burden of proof, under this head, is on the Respondent, to satisfy the Sole Panelist with his bona fide intent and bona fide provision of services. This is not the case here. The provision of services by the Respondent, or use of the Domain Name by the Respondent, cannot be considered to be a legitimate noncommercial or fair use of the domain name. This is so because the Domain Name is being used to divert the users onto other links and pop-ups. This is in addition to the Domain Name being offered for sale. Furthermore, the services provided on the Domain Name are very similar to the ones provided by the Complainant, and hence the users are very likely to be misled into believing that the Domain Name is a subsidiary of the Complainant, or is affiliated with the Complainant. This would have an adverse effect on the Complainant’s credibility

and mass appeal. This is so because if the user is not satisfied with the services provided on the Domain Name, he would consequently blame the Complainant of the inefficiency and lack of proficiency suffered by him while browsing on the Domain Name. One other point to be noted and of considerable significance is the fact that the Domain Name facilitates users to send emails to the email address of the Respondent, which may be overlooked by unaware user, hence any emails that the user wishes to send to the Complainant, regarding the web based or cellular services of the Complainant, or regarding any other enquiry of seeking information, will be sent to the Respondent, and hence the Complainant will lose its customer loyalty. If the Respondent replies to the email(s) in any way that is not in consonance or in accordance with the Complainant's way of conducting business or provision of services or retains, possesses or misuses any personal information provided in the email and actually intended for the Complainant, the Complainant will lose the trust and the creditability that the user(s) have in the Complainant.

Complainant alleges that Respondent has offered no bona fide goods or services using the Domain Name, is not commonly known by the Domain Name at issue in this proceeding and cannot claim that it is making a noncommercial or fair use of the Domain Name. This has been discussed at length above and the Sole Panelist is satisfied that the Complainant is correct in its allegations against the Respondent.

The Respondent has provided no response to the allegations of the Complainant, even though an invitation to submit a response was sent to them, as per the Rules.

The file contains no evidence that the use of the Domain Name meets the elements for any of the nonexclusive methods provided for in the Policy paragraph 4(c). Therefore, the Sole Panelist finds that Respondent has no rights or legitimate interest in the Domain Name pursuant to the Policy paragraph 4(a)(ii).

Registered and Used in Bad Faith

The Domain Name is composed of the term "telenor", which is identical to the Complainant's Telenor trademarks. The Panel considers that the Telenor trademarks have a reputation and are well known throughout the world. In accordance with *ACCOR v. Tigertail Partners*, [WIPO Case No. D2002-0625](#), the Panelist finds it is reasonable to conclude that only someone who was familiar with the Telenor trademark could have registered the Domain Name. Therefore the Panelist finds that the Domain Name was registered in bad faith.

For this finding it is irrelevant from where the Respondent has acquired the Domain Name or if it is the same entity, since for the purposes of the Policy, the acquisition of the domain name at issue constitutes registration. (See *MC Enterprises v. Mark Segal (Namegiant.com)*, [WIPO Case No. D2005-1270](#)).

The Complainant must also prove that the Respondent is using the Domain Name in bad faith.

According to paragraph 4(b) of the Policy an indication for use in bad faith is if the Respondent is intentionally attempting to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of his website or of a product or service on his website.

The Respondent generates traffic to the websites linked to the Domain Name by creating a likelihood of confusion with the Telenor trademark. The website is a so called "click through" website with pop-ups (e.g. an ad for on-line web based cellular services) and various links to other websites and companies, none of them associated with the Complainant or its authorized dealers. Such use is considered to be commercial. Therefore, in view of paragraph 4(b) of the Policy, the Panel finds that the Domain Name is also being used in bad faith.

The Panel finds it very well possible that the Complainant is correct in alleging that the Respondent is engaged in a pattern of 'cyber squatting' as contented in the case of *Fry's Electronics, Inc v. Whois ID Theft Protection*, [WIPO Case No. D2006-1435](#); *The Hartz Mountain Corporation v. Whois ID Theft Protection*, [WIPO Case No. D2006-1319](#); *Charlotte Russe Holding, Inc. v. Whois ID Theft Protection*, [WIPO Case No. D2007-0371](#), and *Swarovski AG v. Whois ID Theft Protection*, [WIPO Case No. D2007-0225](#). However, it is not necessary to make a finding in this respect, since the Panelist has already concluded that the Respondent registered and is using the Domain Name in bad faith.

The Panel finds that the recent seminal decision in the case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001), dated 30 Aug 2007, rendered through the DNDRC is of much use in analyzing the facts in this case and applying the various aspects of the PKNIC - Internet Domain Registration Policy Aug 07 2007, version 4.2 and the UDRP. As such much of the intricate legal analysis with regard to applicability of the PKNIC - Internet Domain Registration Policy Aug 07 2007, version 4.2 and the Rules and the UDRP can be avoided in this discussion and hence, much reference may be made to that decision here. The decision is available on the DNDRC website www.dndrc.com . (http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf)

The Complainant contends that the Respondent registered and is using the Domain Name in bad faith in violation of the Policy paragraph 4(a)(iii).

The Policy paragraph 4(b) sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of domain names:

(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;

The burden of proof, here, is on the Complainant to show that the Respondent is engaged in a mala fide provision of services, or mode of business. The Complainant, has, hereby, duly satisfied the Sole Panelist on this point, as the Domain Name is being used as link through web site to various other links and pop-ups, which may have paid the Respondent for this. Also, it may be a pay per click web site, whereby, every time a user visits the Domain Name and clicks on any of the links, the Respondent gets a monetary value for it. The Sole Panelist is led to conceive these notions based on common sense and the logic that is derived out of the way the Domain Name is being utilized. The Respondent has failed to provide any response to the contentions made out against him by the Complainant, and hence the Sole Panelist could not be satisfied by the Respondent in order to change his views. Also, the Domain Name in dispute is being offered for sale. And whoever purchases the Domain Name, will pay a price for it, from which the Respondent will benefit, and hence, proof of monetary gain that the Respondent will gain. Here, the Respondent has not offered to sell the Domain Name to the Complainant, but to the mass public.

(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;

The Domain Name uses the Complainant's trade name in its entirety. The Complainant is a very widely and well established cellular service provider, and is commonly known by its trade name 'Telenor' all over the world. The Respondent has registered the domain name in dispute 'telenor.pk', and hence prevented the Complainant from getting it registered and using it for their own purposes, or provision of services. The Complainant has other domain names, registered, which also use the trade name 'Telenor', which the Complainant uses for their business purposes. But as the domain name in dispute 'telenor.pk' has been registered by the Respondent, the Complainant, is prevented from using it for its own trade purposes.

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

This can be seen by the fact that the Domain Name has been registered, and is being used by the Respondent, for provision of various conflicting web and/or telecom based services. The Domain Name diverts the user to various other links that provide similar services. Hence, affecting the business of the Complainant in an adverse fashion. The Domain Name is offered to sale, this shows that the Respondent does not wish to keep the Domain Name for his own purposes. He is not keen to use the Domain Name over a long term basis, hence shows that he is not using the Domain Name for a bona fide offering of goods/services. He has, by registering the Domain Name, prevented the Complainant from doing so, and hence affected their business. The creditability that is an asset for the Complainant has been greatly threatened by the Respondent's acts associated with the Domain Name.

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website 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 website or location or of a product

This is a very significant factor, and the Sole Panelist is content on the point that the Respondent is using the Domain Name for mala fide purposes. This is evidenced by the fact that the Respondent is utilizing the Domain Name for mala fide provision of services. This is so, because the domain name in dispute 'telenor.pk' uses the trade name of the Complainant 'Telenor', in entirety. Hence any user looking for the Complainant's online services will be misled into believing that the Domain Name belongs to the Complainant. And may think that the Respondent is an affiliate or authorized dealer of the Complainant, when this is not the case at all. Any mal services or inefficiency experienced by the user on the Domain Name would therefore be associated with the Complainant being considered inefficient, and hence the Complainant's goodwill and repute would be tainted.

The Complainant alleges that the Respondent has registered the Domain Name in order to prevent the Complainant from reflecting the trademark in the corresponding Domain Name and has engaged in a pattern of such conduct, thus meeting the criteria for subparagraph 4(b) (ii).

The Complainant alleges that the Respondent is using the Domain Name for the provision of web based services, that is of the same nature as the services provided by the Complainant and this is being done without the permission of the Complainant. Complainant further alleges that Respondent registered and is using the Domain Name in bad faith. The Respondent's intent to prevent Complainant from using the Domain Name is further evidenced by his failure and refusal to provide a response to DNDRC despite an attempt to contact DNDRC and to counter the allegations incurred by the Complainant. The Sole Panelist additionally finds that this evidence is sufficient to establish the necessary elements of bad faith under the Policy paragraph 4(b)(ii).

The four criteria set forth in the Policy paragraph 4(b) are nonexclusive. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. In addition to these criteria, other factors alone or in combination can support a finding of bad faith.

Additional to the above mentioned and discussed elements; another factor found to support a finding of bad faith is the Respondent's knowledge of the Complainant's mark. The Complainant's trade name 'Telenor' is well established and is associated with reputable success and familiarity. Hence it is unlikely that the Respondent was not aware of the use of the 'telenor' mark by the Complainant. The 'telenor' trade name is not a generalized or literate word, however it is exclusively associated and connected with the business of the Complainant and hence forms the unique selling point for the Complainant.

The Complainant has had the right to use and has used the mark Telenor in various countries all over the world, including Pakistan, both substantially and continuously for more 10 years. The significant goodwill and value of the Telenor mark must have been clearly understood by the Respondent. Given the fame of the mark Telenor, it is clear that Respondent registered the Domain Name with full knowledge of Complainant's rights in the trademark and service mark Telenor. The Respondent's conduct prevents Complainant and its authorized dealers from promoting its own products and services and prevents Complainant from using this domain name. The result is that Internet traffic intended for Complainant or its authorized dealers can be diverted to the Respondent. The Respondent's use of the Domain Name creates a likelihood of confusion with Complainant's marks. Since the Respondent is not licensed to use the mark Telenor in this manner, the Complainant is harmed because Telenor's valuable trademarks and reputation are being placed into the hands of the Respondent over which the Complainant has no control. The fame and the goodwill attached to the Telenor mark is a source of profit to the Complainant, as the trade name 'telenor' is an asset for the Complainant. The public is harmed because it is likely to be confused as to the source of the goods and services that may be offered at sites operated under the Domain Name or by mistakenly trusting the Domain Name as associated with "Telenor" and giving out their personal information to a party not associated their trusted tradename. Hence the Complainant's reputation is being adversely affected in the market and might lead to its popularity being tarnished, and its market share to deteriorate and hence cause a loss to the Complainant.

Actual or constructive knowledge of the Complainant's rights in the Trademarks is a factor supporting bad faith. See *Expedia, Inc. v. European Travel Network*, D2000-0137 (WIPO April 18, 2000).

Conclusion

The Panel finds it of utmost help and a source of guidance, in deciding the outcome of this case, to take into consideration, the cases, points and illustrations set forth in the recent decision of the case *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001), dated 30 Aug 2007 and hence the following decision is based on the findings in this case.

Moreover, the Panel also recognizes and appreciates the efforts of the Complainant in assisting this Panel through a thoroughly professional and comprehensive drafting of the Complaint with adequate supporting evidence allowing this Panel to determine the various issues in this case.

Analyzing the details provided by the Complainant, the Panel perceives that the Telenor marks and the Registered Trade Marks are well-recognized and highly acclaimed, both, domestically, and globally, hence the Complainant reserves crucial interest in them. The Respondent's utilizing the Telenor marks is most likely to endanger the creditability of the Complainant, hence causing its reputation to be adversely affected.

In accordance with all the evidence provided, and taking the aid of all the case law mentioned, the Panel is of the opinion that the Respondents registered the domain name in dispute <telenor.pk> with mala fide intent, as at the time of the registration of the domain name, the Complainant's reputation and renowned proprietary rights and interest in the domain name were well-known and apparent since the Complainants have been one of the pioneers in establishing global and cross-border cellular based services and have well established goodwill in their Trademark/name and domain names, both, domestically and globally. Hence, on a balance of probabilities and based upon the substantial evidence placed before this Panel, it is unlikely that the Respondent was unaware of this fact. Furthermore, the fact that the Respondent has purported to offer the same services as the Complainant by using the domain name in dispute <telenor.pk>, which is identical to that of the Complainants Registered Trade Marks, has and is likely to cause substantial confusion and diversion of the loyal customers of the Complainant. In view of all contentions stated and discussion above, the Panel finds that the Respondent is in contravention of the provisions of the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2, and UDRP, and hence, the Complainant is entitled to transfer of the domain name in dispute <telenor.pk>

Decision

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

1. The Respondent's registration of the domain name in dispute is in violation of the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2
2. The Respondent has no legitimate interest in the Domain name.
3. The Domain Name is confusingly similar/identical to Complainant's Trade Marks.
4. The Respondent is making mala fide use of the Domain name.

Pursuant to Paragraphs 4 of the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2, and Paragraph (i) of the UDRP the Panel therefore recommends to the PKNIC to transfer the registration of the domain name at issue <telenor.pk> to the Complainant, as prayed within 48 hours of receipt of this decision by email or it being uploaded on to DNDRC's website www.dndrc.com/cases_resolved/, whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Mustafa Syed

5th February 2008