

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Pakistan Herald Publications (Pvt.) Ltd. v. Ask4Solutions

Case No. C2011-0005

Also in PDF C2011-0005

1. The Parties

The Complainant is Pakistan Herald Publications (Pvt.) Lrd. having its principle premise of business at Haroon House, Dr. Ziauddin Ahmed Road, Karachi, Pakistan. The Respondent is Ask4Solutions. The Whois Data shows the Address of the Respondent to be Suit # 1, Minhas Plaza, Karachi, Pakistan.

The Complaint has been instituted by the authorized representative of the Complainant, Mr. Adnan I. Chaudhry, Advocate, located at F-66/3, Park Lane, Block 5, Clifton, Karachi, Pakistan.

2. The Domain Name and Registrar

The disputed domain name is <dawn.pk>

(Hereinafter referred to as the "Disputed Domain Name")

3. Procedural History

The Complaint was filed with the Domain Name Dispute Resolution Center (the "DNDRC") on 19th August, 2011.

In accordance with the PKNIC - Internet Domain Registration Policy and the Rules of ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP], DNDRC formally notified the Respondent of the Complaint via email dated 06th September, 2011 and the Respondent was asked to provide DNDRC with the Response in the format provided. The Respondent was informed that if a Response was not received 07 days from the notification, the dispute would proceed *ex parte*.

The Respondent however disregarded this opportunity failed to submit the Response in the form required by section 6(1) of the Supplemental Rules of DNDRC and failed to provide a response in the required manner. 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 based upon the Complaint.

The Supplemental Rules of DNDRC which override the ICANN Rules for Uniform Domain Name Dispute Resolution Policy in terms of paragraph 2 of the PKNIC - Internet

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

The DNDRC appointed Ms. Fozia Umar as the Sole Arbitrator in this matter who as sworn impartiality.

The language of the proceedings is English, being the language of the registration agreement.

4. Factual Background

The Complainant is the registered proprietor of the trade mark “Dawn” in Class 16. The Complainant was granted registration of this trademark vide registration number 58563 since 09th March, 1973. This trade mark is closely associated and synonymous with the Complainant’s business of printing and publishing of newspapers as well as other related media concerns being carried out over several years.

The Respondent registered the Disputed Domain Name on 20th January, 2006.

Additionally the Respondent has failed to provide DNDRC with a Response to the Complaint initiated against them in the required form by under section 6(1) of the Supplemental Rules of DNDRC despite a Notification of the same being sent by DNDRC to the Respondent providing the same with an opportunity to submit a Response.

5. Parties’ Contentions

A. Complainant

The Complainant contends that:

The Complainant is the printer and publisher of the newspaper Daily ‘DAWN’ and its internet edition, ‘dawn.com’ and ‘dawn.com.pk’. It will be seen from para 7 supra that ‘DAWN’ is the registered trademark of the Complainant not only in Pakistan but also in the USA and the European Union. The DAWN logo is also protected by copyright. The domain ‘dawn.com’ is also a registered trademark of the Complainant in Canada, and its registration as a trademark in Pakistan is pending. Apart from being the printer and publisher of the leading English newspaper of Pakistan, the Complainant is also associated with the TV news

channel 'DawnNews', which is a registered trademark of the Complainant. From para 7 supra it may also be noticed that most of the said trademarks and domain names have been registered long before the use of the disputed domain name.

In relation to newspapers, on-line news services and news-media broadcasts, 'DAWN', 'DawnNews' and its corresponding domain names are household names that have a reputation for disseminating quality and unbiased news reports and views. The Complainant has established such reputation over a considerable period of time and at a substantial expense.

The disputed domain redirects a browser to the website of "fizanews.com", which too contains news content apparently taken from on-line news providers. This gives the impression that "fizanews.com" is somehow related to or linked to the Complainant /DAWN or endorsed by DAWN. The intention of the Respondent is obviously to attract traffic by misleading and confusing the public.

'DAWN', 'DawnNews' and its corresponding domain names are protected marks of the Complainant. The disputed domain name is deceptively similar to the registered trademarks and domain names of the Complainant. The precise use of the word 'dawn' to create and register the disputed domain names is ex facie deceptive and malafide.

The disputed website is a risk to the Complainant's goodwill and reputation inasmuch as, news, views and opinions that may not be approved by the Complainant may be mistaken by readers to be that of the Complainant.

The disputed domain name is in violation of Clauses 1 and 25 of the PKNIC Internet Domain Registration Policy, ver 4.2, dated August 7, 2007 inasmuch as:

- (a) the disputed domain name infringe on the registered trademarks and domain names of the Complainant mentioned in para 7 supra;*
- (b) in registering the disputed domain name with PKNIC, the Respondent has deliberately not given any address so as to escape contact and avoid legal process;*
- (c) the trademarks and domain names of the Complainant being established and popular marks/domain names in the news and media industry, the registration and use of the disputed domain name by the Respondent is aimed at deceiving, confusing and misleading the public, if not to extort money from the Complainant;*
- (d) the registration and use of the disputed domain name is ex facie malafide.*

In Pakistan, the acts complained of attract both civil and criminal liability under the Trade Marks Ordinance, 2001 and the Copyright Ordinance, 1962. The acts complained of also attract liability abroad under laws under which the Complainant's trademarks are registered.

For all the above mentioned contentions, the Complaint seeks the following Remedies:

- (i) *Cancellation of the registration of the domain 'dawn.pk'*
- (ii) *Removal of the website 'www.dawn.pk'*

B. Respondent

The Respondent failed to submit the Response in the form required by section 6(1) of the Supplemental Rules of DNDRC

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

7. Jurisdiction

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

The Respondent applied for, 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.

8. Discussion and Findings

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

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

1. *Illegality, unlawfulness or otherwise invalidity of the Application & Registration (a criteria in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 in addition to the criteria of the UDRP)*
2. *Identical or confusing similarity to a trademark or service in which the Complainant has rights (a UDRP criteria)*
3. *Legitimate interest in Domain Name (a UDRP criteria)*
4. *Registration and use in bad faith (a UDRP criteria)*

The Panel therefore, concludes that the registration of the domain name "<standardchartered.pk>" would be illegal, unlawful and otherwise invalid in terms of

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

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

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

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

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

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

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

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

- 1. Applicant's statements in the application are true and Applicant has the right to use the Domain Name as requested in the Application;*

2. *Applicant has a bona fide intention to use the Domain Name on a regular basis on the Internet;*
3. *The use or registration of the Domain Name by Applicant does not interfere with or infringe the right of any third party in any jurisdiction in Pakistan, with respect to trademark, service mark, tradename, company name or any other intellectual property right;*
4. *Applicant is not seeking to use the Domain Name for any unlawful purpose, including, without limitation, tortuous interference with contract or prospective business advantage, unfair competition, injuring the reputation of another, or for the purpose of confusing or misleading a person, whether natural or incorporated.”*

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

- (i) Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and*
- (ii) Respondent has no rights or legitimate interests in respect of the domain name; and*
- (iii) Respondent’s domain name has been registered and is being used in bad faith.*

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

- i. Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver 4.2 criteria).
- ii. Identical or confusing similarity with a trademark or service in which the Complainant has rights (a UDRP criteria).
- iii. Legitimate interest in the domain name (a UDRP criteria).
- iv. Registration and use of the domain name in bad faith (a UDRP criteria).

It is imperative to note that the Respondent has not submitted any Response to this Complaint even though an opportunity to do the same was afforded to the Respondent by the DNDRC. Under the Policy, the Panel is empowered to proceed with the Complaint on an ex parte basis. However, relying on the WIPO Overview of WIPO Panel Views, it has been determined as to what the WIPO opines in situations where the Respondent does not submit a Response. Does it automatically grant the Complainant the Remedies it has sought in the Complaint or whether it is still obligatory for the Panel to take into account every contention put forth by the Complaint and

determine whether it satisfies the Procedural matters. In this regard, the Panel has considered the WIPO view on this matter and has found that:

4.6 Does the failure of the respondent to respond to the complaint (respondent default) automatically result in the complainant being granted the requested remedy?

Consensus view: The respondent's default does not automatically result in a decision in favor of the complainant. Subject to the principles described in 2.1 above with regard to the second UDRP element, the complainant must establish each of the three elements required by paragraph 4(a) of the UDRP. While a panel may draw negative inferences from the respondent's default, paragraph 4 of the UDRP requires the complainant to support its assertions with actual evidence in order to succeed in a UDRP proceeding.

Relevant decisions:

The Vanguard Group, Inc. v. Lorna Kang [D2002-1064](#),

Berlitz Investment Corp. v. Stefan Tinculescu [D2003-0465](#)

The above mentioned WIPO view makes it clear that even though the Respondent has omitted submission of a Response to rebut and/or counter the contentions of the Complainant that the latter has made against the Respondent, the same has not sought to put forth any defence and/or counterclaim, this does not imply that this omission results in an automatic transfer of the Disputed Domain Name to the Complainant. The matter has to be decided on the basis of merits and evidence submitted by the Complainant (if any) needs to be taken into account and consideration while rendering the Decision. As such, this Panel has reviewed, assessed and evaluated the Complaint and the Complainant's contentions based on the Facts provided along with the supporting documentation/evidence annexed thereto.

I. Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration of the domain name

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

- a. infringes upon a registered tradename,*
- b. is not bona fide as recognized by international best practice,*
- c. is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,*
- d. has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including*

offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law), or

e. in the opinion of PKNIC is not appropriate for registration.

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

If a party claims that a domain name already registered with PKNIC violates their registered trade name, an obvious derivation of their registered company name, is not bona fide as recognized by international best practice, is a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, agitates the right to cancel or transfer the domain to the claiming party as per the ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.

Hence, any registration of a domain name, in contravention of paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007. ver 4.2, would be ab initio void and as well as voidable under the requirements of paragraph 4 of The PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.

For the assessment of illegality, unlawfulness or otherwise invalidity of the Application & Registration in order to determine whether the application and registration of the Disputed Domain Name is ab initio illegal with respect to the following aspects in the context of which this dispute shall be assessed:

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

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

- i. Whether the Disputed Domain Name infringes a registered trade name / trade mark?**

The Complainant has alleged that:

The disputed domain names infringe the following trademarks and domain names of which the Complainant is the owner:

(i). 'DAWN' is the registered trademark of the Complainant in Pakistan since March 9, 1973 in relation to newspapers under Class 16 of the Trade Marks Ordinance, 2001. Copy of the trademark registration certificate for Trade Mark No.58563 is filed herewith **Annexure B-1**.

(ii). 'DAWN' is the registered trademark of the Complainant in the USA since August 20, 2002 in relation to newspapers and computer services of on-line newspapers under Class 16 and 42 respectively of the United States Trademark Act, 1946. Copy of the trademark registration certificate # 2,608,759 is filed herewith **Annexure B-2**.

(iii). 'DAWN' is the registered trademark of the Complainant in the European Union since November 12, 2001 in relation to newspapers and periodical publications in electronic and on-line form. Copy of the trademark registration certificate for European Union Trademark No.002458297 is filed herewith **Annexure B-3**.

(iv) The Complainant is also the registered copyright owner of the logo 'DAWN'. Copy of the certificate of registration of copyright (# 20394) is filed herewith as **Annexure B-4**.

(v). 'dawn.com' is the registered domain of the Complainant with Network Solutions Inc. since April 14, 1997. Copy of the search record for "dawn.com" is filed herewith as **Annexure C-1**.

(vi). 'DAWN.COM' is the registered trademark of the Complainant in Canada since May 6, 2002. Copy of the trademark registration certificate # TMA561,404 is filed herewith **Annexure C-2**.

(vii). The Complainant's application for also registering 'DAWN.COM' as a trademark in Pakistan is pending before the Trade Marks Registry, Pakistan, a copy whereof is filed herewith as **Annexure C-3**.

(viii). 'dawn.com.pk' is the registered domain of the Complainant with the PKNIC since September 22, 2003. Copy of the domain record maintained by the PKNIC for "dawn.com.pk" is filed herewith as **Annexure D**

(ix). 'DawnNews' is the registered trademark of the Complainant in Pakistan since August 20, 2007 under Class 41 of the Trade Marks Ordinance, 2001. A copy of the trademark registration certificate for Trade Mark No.240387 is filed herewith as **Annexure E**

(x) 'dawnnews.com.pk' is the registered domain of the Complainant with PKNIC since August 10, 2006. Copy of the domain record maintained by PKNIC for "dawnnews.com.pk" is filed herewith as **Annexure F**

The Panel has taken into account and determined the Annexures submitted by the Complainant along with the Complaint. The Complaint is indeed has the trade mark "Dawn" registered in its name. This registration has been granted to the Complainant by the Trade Marks Registry,

Government of Pakistan, as of 09th March, 1973 vide Registration Number 58563 and was issued under section 75 of the Trade Marks Act of 1940 and Rules 82-83. As such, it can be reasonably determined that the Complainant is the Owner of the Trade Mark “Dawn”. This finding verifies the information provided by the Complainant in form of Annexure B-1.

Furthermore, the Complainant is also the Owner of the Trade Mark “Dawn” vide Registration Certificate issued by the Principle Register, the United States Patent and Trademark Office, United State of America in Class 16 and 42 vide Registration Number 2,608,759 on 20th August, 2002. This shows that the Complainant has not only registered the trade mark “Dawn” in Pakistan, but as also secured its trade mark registration for the trade mark “Dawn” internationally. This information correlates with the evidence provided by the Complainant in form of Annexure B-2.

In furtherance to the above, the Complainant has also registered the trade mark “Dawn” in the European Union; such registration has been affirmed by grant of the registration of trade mark “Dawn” in favor of the Complainant since 08th September, 2003 vide registration number 2458297 in Classes 9,16,35,38,41 and 42. This information is confirmed by the Complainant vide affixing Annexure B-3 to the Complaint.

The above mentioned Trade Mark registrations clearly demonstrate that the trade mark has been registered by the Complainant. Also that this has not only been done in the domestic jurisdiction of Pakistan, but also internationally, in the United States of America and the European Union. This clearly illustrates that the trade mark “Dawn” is secured by the Complainant for its exclusive use and to avail all the rights conferred upon a trade mark owner.

The Disputed Domain Name incorporates and reproduces the name “dawn” in entirety. The above mentioned trade mark registrations in favor of the Complainant illustrate that by virtue of reproducing the trade mark “dawn” into the Disputed Domain Name, the same is infringing the trade mark registrations. Furthermore, the Complainant has not only sought to register “dawn” as a trade mark, but has also endeavored to register “dawn.com” and “dawn news” as its trade marks. The Panel has evaluated each of these individually and assessed the evidence submitted by the Complainant in support of these.

The Complainant has strived to register trade mark “dawn.com” not only in Pakistan, but also internationally, in particular, Canada. In Pakistan, the trade mark “dawn.com” has been applied for registration by the Complainant at the Trade Marks Registry, Intellectual Property Office, Government of Pakistan, in Class 42, vide Application Number 247602.

As for the registration of “dawn.com” in Canada, the Complainant has successfully obtained trade mark registration of “dawn.com”, vide Registration Number TMA785, 422.

Evidence of both of these registrations has been submitted by the Complainant in form of Annexure C-2 that was affixed with the Complaint.

In addition to the above mentioned trade marks, another derivation of the trade mark “dawn” that forms the crux of the Disputed Domain Name, another trade mark, “Dawn News” has also been registered by the Complainant. This trade mark has been registered in the name of the Complainant by the Trade Marks Registry, Government of Pakistan, in Class 41, vide Registration Number 240387 since 20th August, 2007.

As such, taking all of the trade marks as mentioned above, it can be reasonably inferred that the trade mark “dawn” and its derivatives have been registered by the Complainant. Hence, the Respondent’s act of incorporating the trade mark “dawn” in the Disputed Domain Name paves way for infringement of trade mark that has already been registered by a party other than the Respondent.

It is imperative to determine if being the owner of registered trade mark(s) affords the same automatic rights to a disputed domain name. In this regard, the Panel has also taken into account the Consensus View taken by WIPO in cases where there a registered trade mark is infringed:

1.1 Does ownership of a registered trademark to which the domain name is confusingly similar automatically satisfy the requirements under paragraph 4(a)(i) of the UDRP?

Consensus view: If the complainant owns a registered trademark then it satisfies the threshold requirement of having trademark rights. The location of the registered trademark and the goods and/or services it is registered for are irrelevant when finding rights in a mark.

Relevant decisions:

Uniroyal Engineered Products, Inc. v. Nauga Network Services [D2000-0503](#),

Thaigem Global Marketing Limited v. Sanchai Aree [D2002-0358](#),

Consorzio del Formaggio Parmigiano Reggiano v. La casa del Latte di Bibulic Adriano [D2003-0661](#)

It is one of the foremost and vital elements of the Policy that a domain name should not infringe a registered trade mark. The Respondent’s express and implied breach of the Policy is sufficient to result in cancellation of its registration of the Disputed Domain Name. Nonetheless for the purpose of completeness (but not to create any binding precedent requiring the same to be followed in the future), the Panel will also assess and determine the remaining issues as listed above.

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

In order to determine this aspect, it is important to first determine what is meant by “bona fide”. A simple, literal translation/interpretation of the terms means “good faith”. However, this is not enough for the purposes of deciding whether the application and/or registration of the Disputed Domain Name. The Panel opines that several factors lend weight and meaning to what constitutes “bona fide” or absence of it. Since the Disputed Domain Name have been registered by the Respondent, it would have to be determined whether the Respondent has acted in good faith in registering the same. For the purpose of assessing the Respondent’s registering the Disputed Domain Name, any/all contention(s) put forth by the Respondent in this matter would have been of much assistance to the Panel. However, since the Respondent has not submitted any

Response, the Panel is left with no option but to base its reasoning on reasonable inferences and discussions cited in previous precedents.

The Panel, in determining this sub issue (ii), dwelled upon the reason(s) the Respondent could have had in registering the Disputed Domain Name. These (possibly) could have been to advertise its products/services, provide an online portal for sale/publication/solicitation/facilitation/rendition of the Respondent's goods and/or services. The Panel based its opinion on the grounds that a common man employs while registering a domain name. Furthermore, the Respondent could have registered the Disputed Domain Name in order to have an online presence, make itself and its goods and/or services available to the consumer(s)/customer(s), have an online trading mechanism, etc. However, the Panel assesses why the Respondent chose this particular name "dawn" for registering the Disputed Domain Name. The Whois data of the Respondent shows it to be a company as opposed to an individual. As such, the Panel can disregard the Respondent to be a human. Moreover, the Respondent is not named "dawn" or anything of the like, that could give the likelihood of registering the Disputed Domain Name in reflection to the Respondent's own name. The Whois data shows the Respondent's name to be "Ask4Solutions". This leads the Panel to reasonably opine that it cannot form a correlation and/or a link that could give any indication of registering the Disputed Domain Name and using the word "dawn" that could match with a corresponding trade name, etc. Furthermore, since the Respondent has failed to submit any Response in this matter, the Panel has no information, data, evidence or anything of the like at its disposal to take into consideration while determining this Complaint. As such, the Panel is unable to determine any reason(s), the Respondent could have had in using the word "dawn" while registering the Disputed Domain Name.

Furthermore, the word "dawn" has already been registered by the Complainant. The Complainant is not a newly formed entity. It is one of the oldest and most prominent news paper publishers in Pakistan. It is highly unlikely that the Respondent was not aware of the Complainant or the business of the Complainant. The Panel reasonably infers that the Respondent would have known that the trade name "dawn" is already being used by the Complainant in its course of business.

In this respect, it is a pertinent fact that the Respondent could not fail to be reasonably aware of the reputable nature and large customer base of the Complainant at the time when the Respondent registered the Disputed Domain Name. The Panel takes into account the WIPO decision of **Hollywood Foreign Press Association v. F.M.I. Case No. D2008-1610**, whereby it was noted that:

"The Complainant contends that the Respondent registered the Domain Names knowing of the existence of the Complainant's trade mark, GOLDEN GLOBE, and with a view to exploiting the Complainant's trade mark rights, a primary claim being that the Respondent registered the Domain Names with a view to selling them at a profit. If the Complainant's allegations are made out, such a registration could not conceivably give rise to rights or legitimate interests in respect of the Domain Names. The Panel accepts the Complainant's unchallenged contention that it is inconceivable that the Respondent was unaware of the Complainant's mark, GOLDEN GLOBE, when the Domain Names were registered. The Complainant has undertaken various enquiries and has found no basis upon which the Respondent could be said to have rights or legitimate

interests in respect of the Domain Names. Moreover, the Respondent's name has no obvious connection with the Domain Names and the Complainant has granted the Respondent no license in respect of the GOLDEN GLOBE trade mark. The Complainant has made out a prima facie case under this head, a case calling for an answer from the Respondent. The Respondent has not responded to the Complaint; nor did the Respondent respond to letters from the Complainant's representative. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name."

The above mentioned precedent reaffirms and reiterates the view taken by the Panel that there isn't anything on record for the Panel to determine as bona fide on part of the Respondent while registering the Disputed Domain Name. The Respondent has no linkage to the trade name "dawn", it is neither a licensee, nor an affiliate of the Complainant, it is not in any way known by the name "dawn", and including but not limited to the above, the Respondent has not provided any information whatsoever at all to demonstrate any bona fide in its favor. As such, the Panel is left with no other inference but that there is no bona fide on part of the Respondent in registering the Disputed Domain Name.

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

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

The relevant Pakistani legislations pertaining to registration of the Disputed Domain Name includes, inter alia, The Trade Marks Ordinance, 2001, section 4 and 40, The Electronic Transactions Ordinance, 2002 section 3, subject to which infringements of Trade Marks and Trade Names is equated with the infringement of domain names hence the Pakistan Penal Code section 478(1), that deal with infringement of Trade Marks, would possibly also cover domain names.

Additionally under the Pakistan Penal Code, 1860 sections 464, 470, 471, 473, 476, 479, 480, 481, 482, 483 and 485 the continuing registration of the Disputed Domain Name by a person other than the owner/rightful holder/authorized user of the registered trade marks/names could be construed to be an offence on multiple accounts, and by operation, would not only give the impression to the Respondent that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a

duty to act) was allowing aiding, abetting, encouraging and conspiring with the Respondent and would also be liable to criminal offences under the above mentioned legislations.

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

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

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

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

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

It is accepted that the name Marks & Spencer denotes Marks & Spencer Plc and nobody else. Thus anybody seeing or hearing the name realises that what is being

referred to is the business of Marks & Spencer Plc. It follows that registration by the appellants of a domain name including the name Marks & Spencer makes a false representation that they are associated or connected with Marks & Spencer Plc. This can be demonstrated by considering the reaction of a person who taps into his computer the domain name marksandspencer.co.uk and presses a button to execute a "whois" search. He will be told that the registrant is One In A Million Limited. A substantial number of persons will conclude that One In A Million Limited must be connected or associated with Marks & Spencer Plc. That amounts to a false representation which constitutes passing-off.

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

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

This case represents good law even today and was upheld finally in Appeal by the Court of Appeal. As such similarly, in this case the registration of the Disputed Domain Name by the Respondent would also constitute passing-off and a contravention of the criteria (i), (ii) and (iii) of paragraph 1 of the PKNIC - Internet Domain Registration Policy Aug 07 2007 version 4.2.

The Panel shall continue to deal sequentially with the next three issues:

- (i) the domain name in dispute is identical or confusingly similar to a trademark or service mark in which the Complainant have rights; and
- (ii) the Respondents have no rights or legitimate interests with respect to the domain name; and
- (iii) the domain name has been registered and used in bad faith.

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

The Disputed Domain Name use the term "dawn" as its crux. A bare reading of the same gives the impression that the Respondent has incorporated the Complainant's registered trade mark "dawn" in the Disputed Domain Name. The Panel opines that any consumer/customer of the

Complainant would be confused into believing that the Disputed Domain Name have been registered by the Complainant. Since this is not true, it could adversely affect the reputability, prestige and goodwill of the Complainant, all of which are considerably important to any corporate entity in maximizing its business prospects and keeping its customers/consumers happy and satisfied. The addition of the suffix “.pk” does not create any distinctive distinction that may eliminate the possibility of confusion by the Complainant’s users. The addition of the suffix “.pk” has not been considered to add any element of distinctiveness (see *Nokia Corporation v. Firdaus Adinegoro/Beli Hosting*, WIPO Case No. D 2004-0814).

In order to determine this aspect, the Panel has based its discussions and findings under this head on several WIPO Authorities as cited below herein:

- VIRBAC v. PrivacyProtect.org, Mantow Tian, Preventic China Systems, Isaac Goldstein, Case No. D2011-0026:

B. Identical or Confusingly Similar

The Panel finds that the Complainant has rights in the Trade Mark acquired through use and registration which predate by many years the date of registration of the disputed domain name by the Respondent.

The disputed domain name contains the Trade Mark in its entirety. The Panel therefore holds that the Complaint fulfills the first condition of paragraph 4(a) of the Policy.

- Clearwire Communications LLC v. Ira Kugelman, Case No. D2011-0019:

A. Identical or Confusingly Similar

The disputed domain name is confusingly similar to the Complainant’s Mark

The Panel finds that the Complainant has established the first element under paragraph 4(a) of the Policy.

- Saxo Bank A/S v. Domains by Proxy, Inc. / Forexmedia LTD, Case No. D2011-0018:

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name <saxo-banque.com> is confusingly similar to the Complainant’s trademarks SAXOBANK.COM and SAXOBANK.

The Panel has also taken into account the Discussions and Findings in previous DNDRC cases.

- Standard Chartered PLC v. Hosting Campus Domain , Case No. C2007-0001:

As discussed above the registration of the domain name would in addition to confusing reasonable users of web browsers would also confuse users of email who could easily be confused by sending and receiving emails to and from the Domain Name under dispute “<[standardchartered.pk](#)>”.

As such the Panel finds that paragraph 4(a)(i) of the Policy is established.

- Pakistan Herald Publications (Pvt.) Ltd. v. Averroes Sapertise Management, Case No. C2011-0001:

The Disputed Domain Names contain the Complainant’s trade mark in entirety and as such is identical to the Complainant’s registered trade mark that the Complainant uses for the purposes of conducting its business.

As such, basing its reasoning on the above cited precedents and the findings therein, the Panel determines that the Disputed Domain Names are identical and confusingly similar to the Complainant’s trade mark.

The Complainant’s registered trade mark is very well associated and connected with the services and products provided by the Complainant in their course of business. The same being newspapers, magazines, television channel(s) and news in other forms including, but not limited to, online news provided via the websites/domains registered by the Complainant.

The Disputed Domain Nams contain the Complainant’s trade mark in entirety and as such is identical to the Complainant’s registered trade mark that the Complainant uses for the purposes of conducting its business.

The use of such a confusingly identical domain name would not only cause confusion to the user(s) and customer(s) of the Complainant but would also hinder the Complainant from registering the disputed domain name for the purposes of provision of online news and other related services in furtherance to their business thus may cause substantial, irreparable and irredeemable harm to the Complainant.

As such, basing its reasoning on the above cited precedents and the findings therein, the Panel determines that the Disputed Domain Name <dawn.pk> is identical and confusingly similar to the Complainant’s trade mark.

III. Legitimate interest in 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).”*

Evidently the onus of proving any of the above conditions, including legitimate interest, rests solely upon the Respondent as laid out in the UDRP and even otherwise under Rules of

Evidence, since the party that asserts legitimate interest must be able to conclusively prove the same. It would not be feasible to put the burden of proof upon the Complainant in any event as it is not possible to prove a negative factor.

The Respondent had the opportunity to demonstrate its rights or legitimate interest in the disputed domain name in accordance with paragraph 4(c) of the Policy however has not been able to do so conclusively in the opinion of this Panel due to failure to provide a Response in the required form, the Respondent have no documents or annexure as evidence to demonstrate their legitimate interest in the domain name in dispute or to substantiate their contentions that have been submitted via email and are being considered by the Panel in a limited manner for the sake of completeness alone. Thus the Panel may only decide the matter based upon the Complaint as per section 5(e) of UDRP.

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.”

In this paragraph, the following are listed as circumstances that in particular, but without limitation, would demonstrate a respondent’s legitimate interest or right in a disputed domain name:

- i. that the Respondent can show demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services;
- ii. that the Respondent has been commonly known by the domain name;
- iii. that the Respondent can demonstrate making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of the Complainant.

The Panel, while deciding on this element, shall take into account each factor of the Paragraph 4(a)(ii):

- i. *that the Respondent can show demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services;*

The above mentioned sub section calls for the Panel to take into account the steps, measures, attempts, etc taken by the Respondent to use the Disputed Domain Name for the purpose of

selling or offering good and/or services. Even if the Respondent was not actually using the Disputed Domain Name to do so, it could still allege “use” of the Disputed Domain Name if it showed any demonstrable preparations to use the Disputed Domain Name. This could be in form of disclaimer, banner, advance notification or anything along these, that could illustrate the intention(s) of the Respondent to use the Disputed Domain Name in near future.

However, in this case, none of these could be inferred since the Respondent has not submitted a Response and the Panel has no information, material, data or the like available to infer what the Respondent’s purpose is/was while registering the Disputed Domain Name.

Furthermore, the Panel, at its own initiative, visited the Disputed Domain Name and found that the Disputed Domain Name is being used to serve as a news portal whereby news, advertisement and the like are placed on the webpage on the Disputed Domain Name. This leaves the Panel with no other reasonable conclusion that the Respondent is using the Disputed Domain Name to serve as a competitor to the Complainant, by using the latter’s registered trademark as its domain name. Furthermore, since the Respondent has not submitted any kind of counter to the Complainant’s assertions, nor has it put forth any information to contest the matter on its part, the Panel is left with no other indication but that the Respondent is using the Disputed Domain Name in connection with a bona fide offering of goods or services since the same is being used to solicit not only a fair share of the business in the same market as that of the Complainant, but in fact is being done at the cost and expense of the Complainant’s registered trademark.

ii) that the Respondent has been commonly known by the domain name;

The Respondent has not submitted any information, data, record or anything at all for the Panel to take into consideration while rendering this Decision. However, for the sake of completeness and for a fair and just deliberation of the matter, the Panel has drawn reasonable inferences from the material provided by the Complainant, which was forwarded to the Respondent, and which has not been countered, rebutted and/or denied by the Respondent.

The Respondent, as the Whois data shows, is not an individual, but a corporate entity, which is located in Pakistan. As already discussed above herein, the Panel, cannot, reasonably, deduce a relationship between the Complainant and the Respondent, and as such cannot purport any affiliation, authorization, agency, association, dealership, distributorship, business prospect, or anything of this accord between the Parties. In such a case, it is highly unlikely for the Panel to be satisfied that the Respondent could have been known by the Disputed Domain Name.

Furthermore, not only that there isn’t any relationship between the Parties, there is the Panel’s view that the Respondent has been holding the Disputed Domain Name without any rights to do so. As such, it is most probable that the Respondent is banking and encashing on the Complainant’s massive fan following, customer/consumer/use portfolio since the Disputed Domain Name is being used to offer services drastically similar to those of the Complainant. In such a case, the Panel is not satisfied that the Respondent has been commonly known by the Disputed Domain Name and cannot reasonably infer otherwise.

iii) that the Respondent can demonstrate making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of the Complainant.

The Panel reiterates, for the sake of brevity that even though the Respondent has not submitted any Response; the Panel is making use of reasonable inference to arrive at this Decision. As such, in the case where the Panel does not have any information, record, data, evidence or the like to take into account on part of the Respondent, the Panel visited the Disputed Domain Name to gather whatever information it could in order to arrive at some conclusion.

The Panel found it interesting to note that the Disputed Domain Name is directed onto another domain name < <http://www.fizanews.com/>>. As such, when a user enters the URL www.dawn.pk, he is directed to the above mentioned domain name. The Panel finds this endangering to the Complainant's commercial share in the market of news and deduces that any user looking for the Complainant's website on the .pk ccTLD would end up, not only on a domain name that has not been registered nor being operated by the Complainant, but in fact would end up being directed onto a completely difference domain name. The Panel finds it highly likely that in such a situation, a user would be confused and misled into (incorrectly) believing that the website <fizanews.com> is also either a subsidiary of the Complainant, or in related to it in some way. This would not only tarnish the brand name of the Complainant, but would also affect the sales/revenue of the Complainant.

The sub provision requires the Respondent to demonstrate making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of the Complainant. However, this has not been done so in this case by virtue of omission to submit a Response by the Respondent. In such a situation, the Panel cannot help but decide that the Respondent has failed to and has been unable to demonstrate any such element.

The Disputed Domain Name, having been registered and being operated by the Respondent for a business similar to that of the Complainant could very well be affecting the prestige, repute, goodwill and image of the Complainant. This is further reinforced by the Complainant's contentions in the Complaint, that their customers are being misled and confused into believing that the Disputed Domain Name is that of the Complainant. Also, the Complainant alleges that the Respondent's act of registering the Disputed Domain Name is affecting its goodwill and reputation. Since the Complainant also manages an online news portal vide one of its registered domain names, it is highly likely that an internet user looking for the Complainant's website/online news portal ends up on one of the Disputed Domain Name and seeing that it is being directed onto a completely difference domain name would get confused as to the status of the Complainant's offering of online news and its affiliation and association with/to some other company. This could severely harm and adversely impact the Complainant's business, which, it is reasonably construed, depends substantially on its online presence, especially for users who are not residing in Pakistan but are avid and loyal customers of the Complainant. As such, in this way, not only would the Complainant's brand name be tainted, it could also affect the Complainant's business, revenue, profits, customer loyalty and, inter alia, good will of the Complainant.

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often impossible task of proving a negative proposition, requiring information that is primarily if not exclusively within the knowledge of the Respondent. Thus, the consensus view is that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in the Domain Name, once the Complainant has made a *prima facie* showing indicating

the absence of such rights or interests. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270. In this case, the Complainant has provided evidence of its bona fide rights in the Disputed Domain Name which incur by virtue of its trade mark registrations in its favor not only in Pakistan but also internationally. These trade mark registrations, by virtue of the Trade Marks Ordinance, 2001, also afford the Complainant the right to use the same in domain names. It has been held in previously decided domain disputes that it is for the Respondent to rebut, counter and/or deny the allegations levied against it by the Complainant. In absence of the same, the panel(s) are empowered to decide the matter ex parte and/or draw reasonable inferences from whatever information is available.

The Panel has relied upon the Discussions and Findings in previously decided WIPO Authorities which are mentioned below herein:

- Orange Brand Services Limited v. Cinematurka Film Yapım ve Organizasyon, Ismail Atıl Turk, Case No. D2011-0002:

B. Rights or Legitimate Interests

Under the circumstances of this case, there are no indications before the Panel of any rights or legitimate interests of the Respondent in respect of the disputed domain name.

The Complainant, having made a prima facie case which remains unrebutted, has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

- TV Azteca, S.A.B. de C.V. v. Spiral Matrix, Case No. D2011-0008:

B. Rights or Legitimate Interests

Once the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name, the burden is on the Respondent to rebut that case. Here there has been no Response from the Respondent and the Panel is entitled to draw inferences from that.

The Panel finds that the Complainant has established its case under paragraph 4(a)(ii) of the Policy and that the Respondent has no rights or legitimate interests in the disputed domain name.

- Johnson & Johnson Corporation v. Gidget's Active Organics, Janet Rossi, Case No. D2011-0015:

B. Rights or Legitimate Interests

There is no Response in the current proceeding, and no attempt to rebut the Complainant's prima facie case. The record does not indicate that the

Respondent has been known by a name corresponding to the Domain Name, nor that it has acquired trademark rights in a corresponding name. The Respondent advertises a product with a name that is similar to the Complainant's mark, "Ludovica Active Natural Skincare". There is nothing in the record that establishes whether this is the Respondent's own product and, if so, when the Respondent began to use this name or make demonstrable preparations to use it for a skin care product. There is also no evidence in the record that the Respondent is a reseller with rights to use a portion of that product name as a domain name.

The Panel finds no persuasive evidence, on this record, that the Respondent has rights or legitimate interests in the Domain Name. The Panel concludes that the second element of the Complaint has been established.

The Panel has also taken into account the Discussions and Findings in previous DNDRC Complaints:

- Telenor v. Mohammad Tahir, Case No. C2008-0001

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).

- Pakistan Herald Publications (Pvt.) Ltd. v. Averroes Sapertise Management, Case No. C2011-0001:

the Panel cannot establish any legitimate interest on the part of the Respondent to the Disputed Domain Name as the Respondent is not linked to the Complainant or its business in any manner of form nor does it act on the Complainant's behalf in any capacity as the Complainant has contended that no authorization has been given to the Respondent to make use of its registered trade name or any obvious derivations of it, as part of the Disputed Domain Names.

As such, the Panel is not satisfied that the Respondent has any legitimate interest in the Disputed Domain Names.

Based on the above discussions and in absence of a Response by the Respondent, the Panel cannot establish any legitimate interest on the part of the Respondent to the Disputed Domain Name as the Respondent is not linked to the Complainant or its business in any manner of form nor does it act on the Complainant's behalf in any capacity as the Complainant has contended that no authorization has been given to the Respondent to make use of its registered trade name.

As such, the Panel is not satisfied that the Respondent has any legitimate interest in the Disputed Domain Name.

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

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

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

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

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

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

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

The Panel will take into account each sub section and discuss the same for the purposes of this Decision:

(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

As has already been mentioned, discussed, assessed and evaluated above herein, the Respondent has not submitted any Response to the Complaint. In the absence of any material, data, record, information, evidence or the like available for the Panel to consider, the latter can only deduce discussions based on reasonable inferences. As far as the Respondent's registering the Disputed Domain Name is concerned, the Panel is unable to construe any legitimate, bona fide and/or fair use that the Respondent intended or could have intended to make of the Disputed Domain Name.

Since the Respondent has not communicated with the DNDRC, nor submitted any information of any sort at all, the Panel is unaware of the Respondent's registering the Disputed Domain Name primarily for the purposes as envisaged in subsection (i).

(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

The Complainant has demonstrated that it has registered the trade mark “dawn”, which is not only registered in Pakistan but also internationally. Furthermore, the Complainant is not only publisher of the daily Dawn Newspaper, but has also registered domain name in order to publish news over the internet. As such, it is imperative for the Complainant and its online presence that it registers all domain name(s) corresponding to its registered trade mark “dawn”. Since the Respondent has registered the Disputed Domain Name, the Complainant is unable to register the same for itself even though a prior right to the same arises in favor of the Complainant, such rights being afforded to the Complainant by virtue of the Trade Marks Ordinance, 2001.

The Disputed Domain Name is being used to offer services that are identical and confusingly similar to those offered by the Complainant in the course of their business. The Complainant are one of the leading news portal in Pakistan, with their newspaper not only being a popular, but their business expanding and adopting other courses of news transmission as well, for example, on the motion media (television). It is reasonable and quite obviously so that the Complainant would want to mark its presence on the internet portal as well and offer services in the cyber space. However, it is clearly unable to do so. The Complainant is prevented from registering a domain name on the ccTLD .pk by virtue of the Respondent having registered the same. Since it is the Complainant that is the trade mark owner of the mark “Dawn”, it quite naturally follows that it has rights to use the same for any/all purposes, especially those related to its course of trade. Furthermore, such rights are also vested and granted to the Complainant statutorily, by virtue of the Trade Marks Ordinance, 2001. As such, it is reasonable that the Complainant, being the owner of the trade mark Dawn, incorporate it into a corresponding domain name. However, in this case, the Complainant is prevented from doing so since the Respondent has registered the Disputed Domain Name, carrying the trade mark Dawn of the Complainant in entirety.

As such, the Panel cannot reasonably infer anything but that the Respondent has registered the Disputed Domain Name to disrupt the Complainant, who is the owner of the registered trade mark “dawn” to use the same for registering domain names for its own use/business purposes.

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

Since the Respondent has not submitted any Response, nor has provided any information with respect to the Disputed Domain Name, the Panel has no knowledge, data, evidence, or any information whatsoever at all as to the purpose(s) for which the Respondent has registered the Disputed Domain Name. In such a case, the Panel is unaware of the business that the Respondent is in and/or what is the trade, profession, course of business etc of the Respondent. This further hinders the Panel from determining who/what are the competitors of the Respondent. What the Panel does reasonably opine is that the Respondent is itself a competitor of the Complainant since it is offering services similar to those of the Complainant and is doing so by using the registered trade mark of the Complainant in a corresponding domain name, which is further directed to another domain name. The Panel is at a loss to deliberate what the true intentions of the Respondent are in doing such a thing, but since the Respondent has not put forth any information, the Panel is unable to deduce anything on its part. However, the Panel does, reasonably believe that the Respondent has registered the Disputed Domain Name to make use of

the repute, goodwill and customer/consumer portfolio/fan following that is associated with the Complainant. Not only this, but also that, quite possibly, the Respondent has registered the Disputed Domain Name to affect the business of the Complainant, by, inter alia, pulling the users of the Complainant to itself and thereby generating revenue/profit for itself and thus depriving the Complainant of the same.

As such, the Panel, is of the reasonable belief that the Respondent has registered the Disputed Domain Name to disrupt the business of the Complainant, being a competitor.

(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

Since the Respondent has not availed the opportunity to respond that was afforded to it under the Policy, the Panel has had to decide this matter ex parte. However, the Panel has taken initiatives on its own accord and visited the Disputed Domain Name to deliberate the use that the same is being put to. The Panel, reasonably, is not left with any other belief but that the Respondent has registered the Disputed Domain Name and is using it to solicit and procure business for itself based on the repute, goodwill and massive customer base that is associated with the Complainant. The Respondent has done so by registering the Disputed Domain Name and thereafter directing it onto another domain name, thereby misleading the users of the Complainant looking for the latter's website on the .pk ccTLD. The Panel opines, that in such a manner and by virtue of such an act, the Respondent has not only caused the genuine and innocent users of the Complainant into (incorrectly) believing that the Disputed Domain Name is theirs but also that the content and information placed on the website that the Disputed Domain Name directs to has been put up by the Complainant. In this manner, the prestige and repute of the Complainant is put to massive risk, since, the Complainant cannot vouch for the authenticity, genuineness and factualness of the news items, information, etc. placed on the website.

Furthermore, any user looking for the Complainant's website on the .pk ccTLD would not end up at a webpage that is placed on the same domain, but is actually directed to another website which is entirely unrelated to the Complainant. In such a fashion, any user would end up (falsely) believing and/or being of the view that the website to which they have been directed to is also that of the Complainant. In this manner, any user, not being satisfied with what he/she sees or reads on the webpage could end up disliking the Complainant and thereby not using the products/services of the Complainant and thus affecting the sales/revenue/repute/goodwill of the Complainant. Any such user could also, incorrectly, believe or opine that the Complainant has authorized, permitted, consented or the like to the registration of the Disputed Domain Name and/or the use of it by the Respondent and/or a third party.

The Panel, in absence of any information put forth on its part by the Respondent, is unable to deduce that the Respondent is not encashing on the goodwill and repute associated with the Complainant by creating a likelihood that it is in related, affiliated, endorsed by, or the like by the Complainant.

The failure on part of the Respondent to submit any Response, and thereby not rebut, challenge and/or counter any of the allegations levied against it by the Complainant, the Panel cannot be

reasonably satisfied that the Respondent has registered the Disputed Domain Name for any other purpose than to attract internet users by misleading and confusing them to believe that the Respondent is affiliated to the Complainant. The Panel is led to reasonably infer that since the Complainant's trade mark is famous, well established, well reputed and recognized by the masses, it would consequent in fame and popularity for the Respondent too since the users would be confused about the true identity of the Respondent and would be unaware of the fact that there is no relationship between the Complainant and the Respondent. Furthermore, since the Complainant also manages an online news portal and provides for a website whereby the daily newspaper is available for users to read, many of the users might end up at one or more of the Disputed Domain Name, thus generating traffic and revenue for the Respondent.

The Panel has made use of the Discussions and Findings in previously decided WIPO Authorities while rendering this Decision:

- Godrej Consumer Products Private Limited v. Chris Peri, Case No. D2011-0023

D. Registered and Used in Bad Faith

Thus, the Panel finds on the balance of probabilities that the Respondent registered the Domain Name, knowing it to be the unique and very well-known Indian household brand name of the Complainant and with intent to capitalize in some way on the value of the Complainant's trade mark.

In the view of the Panel that continuing threat of abusive use hanging over the head of the Complainant is sufficient to constitute an abusive use for the purposes of paragraph 4(a)(iii) of the Policy.

The Panel finds that the Domain Name was registered and is being used in bad faith.

- Trimble Navigation Limited v. Goodstead Limited, Case No. D2011-0025

C. Registered and Used in Bad Faith

Given the strength of both the Complainant's trademarks and the likelihood of confusion in this case, and given that the Respondent's site appears to include links to other commercial websites, it is highly likely that the disputed domain name is being used to attract customers to the Respondent's site and thereby to reap commercial gain. In addition, the Complainant has brought evidence of a pattern of similarly confusing registration by the Respondent. Together these facts suggest that the disputed domain name was registered in bad faith, and that it would constitute bad faith for the Respondent to continue to use the disputed domain name.

The Panel therefore finds that the Complainant has established the third element of paragraph 4(a) of the Policy.

- VIRBAC v. PrivacyProtect.org, Mantow Tian, Preventic China Systems, Isaac Goldstein, Case No. D2011-0026

D. Registered and Used in Bad Faith

The Panel also considers that, in the circumstances of this case, the failure of the Respondent to respond to the Complainant's letters of demand and to file a Response further supports an inference of bad faith (Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc., WIPO Case No. D2002-0787).

The Panel therefore finds the requisite element of bad faith has been satisfied, under paragraph 4(b)(iv) of the Policy.

For all the foregoing reasons, the Panel concludes that the disputed domain name has been registered and is being used in bad faith. Accordingly the third condition of paragraph 4(a) of the Policy has been fulfilled.

Since both Complainant and Respondent operate in the same country, the same is suggestive of the fact that the Respondent was aware of the existence and of the business of the Complainant. The fact that the trademark of the Complainant was registered long before the registration of the disputed domain name is suggestive of bad faith on the Respondent's part. The Panel opines that the registered trade mark of the Complainant is well entrenched with the Complainant's entity and is used unstintingly, both in the print and the motion media under the control of the Complainant. The facts therefore indicate conclusively that the Complainant is a relatively well-known enterprise and that its trade mark would hence be recognized publicly and the Respondent could not help but be aware of this trade mark being associated with the Complainant as well as have knowledge of the services and products offered by the Complainant.

The Respondent has provided no evidence to demonstrate lack of bad faith, additionally since both the Parties are located within the same geographical jurisdiction, it is the Panel's view that, on the balance of probabilities, the Respondent had actual knowledge of the trademark of the Complainant and the products/services in connection with which the trademark is used by the Complainant and therefore, the registration of the Disputed Domain Name by the Respondent amounts to bad faith. As it was noted in *Herbalife International, Inc v. Surinder S. Farmaha*, WIPO Case No. D2005-0765:

"the registration of a domain name with the knowledge of the complainant's trademark registration amounts to bad faith."

In the current proceedings, no indication of any correspondence between the Complainant and/or any representative of Complainant, on one side, with Respondent, on the other, or similar evidence, have been determined to suggest or imply that the Complainant may have approved of or condoned the Respondent's use of their registered trade mark. Without any form of substantial evidence to indicate that the Complainant approved of or condoned the Respondent's use of their trade mark in the disputed domain name, the Panel cannot infer that such a relationship of association/affiliation existed between the Respondent and the Complainant. (See *Tom Cruise v. Network Operations Center / Alberta Hot Rods*, WIPO Case No. D 2006-0560).

The Panel has also considered the Discussions and Findings in the previous DNDRC Cases:

- Rediff.com India Ltd. v. Daniyal Waseem, Case No. C2009-0005

Lastly, the Complainant informed the Respondent of the infringement of its registered trademarks taking place by its registration of such a domain name via the cease and desist letter sent to the Respondent, however the Respondent failed to acknowledge or respond to the letter thereby laying further credence to the existence of bad faith on the part of the Respondent.

In light of these circumstances, the Panel concludes that the Respondent's registration of the domain name in this particular case satisfies the requirement of paragraph 4(a)(iii) that the domain name "is being used in bad faith" by Respondent.

- Telenor v. Pakpoint Network, Case No. C2008-0004

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)

Based on the above cited precedents, discussions and findings thereof and the absence of a Response on part of the Respondent, the Panel can only reasonably infer that the Respondent has registered the Disputed Domain Name in bad faith.

09. Decision

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

- i. The Respondent's registration of the Disputed Domain Name is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
- ii. The Respondents have no legitimate interest in the Disputed Domain Name.
- iii. The Disputed Domain Name is identical to the Complainant's trade mark and registered domain names.
- iv. The Respondent is making mala fide use of the Complainant's trade mark.
- v. Pursuant to Paragraphs 4 of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2, and Paragraph (i) of the UDRP the Panel therefore recommends to PKNIC to transfer the registration of the Disputed Domain Name to the Complainant, as prayed for within 48 hours of receipt of this decision by email or it being uploaded onto the DNDRC website www.dndrc.com/cases_resolved/, whichever takes place earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Ms. Fozia Umar

Dated: 21st September, 2011