

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

**Arbitration and Mediation Center**

**COMPLAINT PANEL DECISION**

**Google Inc. v. MubarKan Pvt Ltd**

**Case No. C2012-0002**

**Also in PDF C2012-0002**

**1. The Parties**

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

The Complainant has initiated the Complaint vide their authorized representatives, M/s Irfan & Irfan Attorneys-at-law, located at 85, The Mall, Lahore, Pakistan.

The Respondent is MubarKan Pvt Ltd, located at Office 16, 3rd Floor, Mehmood, Islamabad.

**2. The Domain Name and Registrar**

The domain name in dispute is <gmails.pk>, hereinafter referred to as the Disputed Domain Name and has been registered by MubarKan Pvt Ltd.

**3. Procedural History**

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

The Complaint was filed with the Domain Name Dispute Resolution Center (the “DNDRC”) on 27<sup>th</sup> February, 2012.

In accordance with the PKNIC - Internet Domain Registration Policy and the Rules of ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP], paragraphs 2(a) and 4(a), DNDRC formally notified the Respondent of the Complaint via email dated 04<sup>th</sup> March, 2012 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 within 7 days from the notification, the dispute would proceed *ex parte*.

The Respondent failed to submit the Response in the proper and specified manner and on the Response Form provided to the Respondent for ease of use. Under section 5(e) of the UDRP, the Panel has the authority, in the absence of a proper response, to commence with the proceedings in default and to determine the matter *ex parte* based upon the Complaint.

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

The language of the proceedings is English.

#### **4. Factual Background**

The Disputed Domain Name has been registered by the Respondent since 24<sup>th</sup> June, 2009 up till 24<sup>th</sup> June, 2013.

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

The Complaint contends the following:

1. *The domain name [www.gmails.pk](http://www.gmails.pk) (the “Domain Name”) is the subject of this Complaint.*
2. *The complainant Google Inc. is a Delaware corporation located in Mountain View, California. The Complainant's business under the name “GOOGLE” was founded by Larry Page and Sergey Brin in the year 1997. With its humble beginning, the Complainant has grown to become a multi-billion dollar business under the name / mark “GOOGLE”. The Complainant's primary website [www.google.com](http://www.google.com), which was registered on September 15, 1997, is widely recognized as the world's largest search*

*engine, easy-to-use free service that returns relevant results within seconds. The Complainant's mark "GOOGLE" is one of the world's best known brands almost entirely through word of mouth from satisfied users.*

3. *In addition to being accessible from desktop PCs, the Complainant's adaptable, highly scalable search technology can also be accessed from most mobile and wireless platforms. The Complainant's website [www.google.com](http://www.google.com) or one of the dozens of other GOOGLE domains provide information in many different languages. Users can check stock quotes, maps, and news headlines; lookup phonebook listings for every city in the United States; search billions of images and peruse the world's largest archive of Usenet messages numbering to more than 1 billion posts dating back to the year 1981.*

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

*A copy of the domain records of [www.gmails.pk](http://www.gmails.pk) is enclosed as **Exhibit 1**.*

5. *GMAIL is Complainant's free web mail service and originated as an abbreviation of Google Mail. For several years this software was only available internally as an email service for the Complainant's employees.*

6. *The GMAIL service, which is located at [www.gmail.com](http://www.gmail.com), is accessible worldwide and is available for use by customers globally, including those in Pakistan. The service offers email storage, email message threading, integrated email search and relevant text advertising.*

7. *The Complainant submits that the service was officially launched to the general public on 1<sup>st</sup> April 2004.*

*A copy of an international press article surrounding the first use of the mark/domain GMAIL by the Complainant and launch of the service are attached and marked as **Exhibit 2**.*

*Also attached is a third party summary of GMAIL history from Wikipedia which is marked as **Exhibit.3**. (It is widely known that Wikipedia is an encyclopedia edited by the masses. So this is information that is known by the general public and not necessarily people related to the Complainant).*

8. *The Complainant submits that its rights in the mark/domain name*

*GMAIL have been upheld in a dispute concerning ‘Gmail.nl’ which was referred to WIPO and Mediation Centre (being Case No. WIPO 2005 NL5). The award was passed in favour of the Complainant.*

*A copy of the decision (Case No. WIPO 2005 NL5) dated 14.07.2005 is attached and marked as **Exhibit 4**.*

*The Complainant, in particular, rely upon the observation that the public might think “given the degree of resemblance between the name and content of the parties’ services – there was an economic relationship”. Further, another complaint filed before the .IN Registry was also decided in favour of the Complainant.*

*A copy of the decision dated 25.04.2007 is attached and marked as **Exhibit.5**.*

9. *The Complainant submits that by mid-2005, one year after launch of the service, GMAIL service had millions of users and had issued thousands of invitations to the service. Currently GMAIL has registered user in excess of 150 million. According to comScore (a company specializing in tracking such statistics), our client’s GMAIL service is the third most popular webmail service, after MSN’s and Yahoo’s webmail services. GMAIL service was awarded the Business 2.0 Bottom Line Design Award (User Interface) and in 2005, was rated one of the 50 Coolest Website features by Time magazine. It also ranked number 2 on PC World’s list of 100 Best Products for 2005. In 2006, GMAIL was named the best web-based email service by Forbes.*

*Copies of a few articles indicating the award(s) are attached and marked as **Exhibit 6**.*

10. *The Complainant has applied for registration of mark GMAIL in over 150 countries of the world. The mark is registered in a number of these countries, including Albania, Andorra, Anguilla, Armenia, Aruba, Australia, Belize, Burundi, Cambodia, Chile, China, Costa Rica, Croatia, Denmark, Ecuador, El Salvador, Haiti, Honduras, Hong Kong, Iceland, Jamaica, Japan, Jordan, Laos, Lebanon, Liechtenstein, Macao, Mexico, Mongolia, Morocco, Myanmar, New Zealand, Netherlands, Antilles, Nicaragua, OAPI, Panama, Peru, Russia, Rwanda, St. Kitts & Nevis, Saudi Arabia, Switzerland, Taiwan, Turkey, Turks & Caicos Islands, and Uruguay. In Pakistan the GMAIL mark is registered in Class 38 (Telecommunication services; electronic mail services) under registration no. 211108 as early as in 2005.*

*Copies of the registration certificates of the mark GMAIL from Australia, Japan, India, Pakistan, United Kingdom and United States of America are attached and marked as **Exhibit 7**.*

*11. The Complainant submits that on account of its extensive use and popularity, the domain name/trade mark GMAIL has achieved the status of a 'well-known' mark. Therefore, the Respondent can have no plausible reason for adoption of an identical domain name. The Respondent intention is clearly to take advantage of the goodwill and reputation enjoyed by the Complainant's trade mark/domain name GMAIL.*

*12. As per the PKNIC domain records, the Registrant registered the Domain Name [www.gmails.pk](http://www.gmails.pk) on 24<sup>th</sup> June, 2009. However the domain seems to have been activated recently.*

**Remedies Sought by the Complainant:**

*In accordance with paragraph 4(1) of the Policy, for the reasons described in section V above, the complainant requests the Registrar / Administrative Panel appointed in the administrative proceeding to issue a decision that the Domain name <www.gmails.pk> be transferred to the complainant.*

**Respondent's Contention:**

**Improper response of the Respondent:**

DNDRC, vide email dated 04<sup>th</sup> March, 2012 notified the Respondent of the Complaint against them and provided them with a copy of the Complaint and a Response Form, inviting them to submit their response. However, the Respondent failed to do so. The Respondent, however, sent an email dated 09<sup>th</sup> March, 2012 to DNDRC.

The Respondent has not submitted the response in accordance with the UDRP. However, for the sake of clarity and completeness, the Panel will endeavor to discuss the email he sent, even though it does not constitute a proper and appropriate response in compliance with the Rules and without prejudice to the determination and observations to be made by the Panel.

The Respondent, vide his email dated 09<sup>th</sup> March, 2012 asserts the following:

*Dear Sir,*

*I read all the documents in details and we are sorry to say that I am not agree to close this domain name [www.gmails.pk](http://www.gmails.pk) reason we are not using*

*anything related to Gmail.com ... If you visited our website you can see that is totally different from Gmail.com For Example: Then Name we are using its Gmails.pk (we add "S" for differentiation) and we designed our own script nothing copy from Gmail*

*See right now hundreds of people using our services and we spend allot of time on it ... although we will give you the suggestion to solve this dispute ...*

*If Gmail interested to buy this domain name we are ready to sell but only one condition that Gmail Should accumulate our existing users to same account.*

*Let me know if you are interested in my proposal*

*Regards,*

*Khurram Shahzad*

## **6. Jurisdiction**

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

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

## **7. Discussion and Findings**

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Therefore, for the assessment of illegality, unlawfulness or otherwise invalidity of the Application & Registration of the domain name in dispute, the application and registration of the Disputed Domain Name shall be assessed under the following aspects:

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

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

The complainant has submitted that:

- *The pakwhois.com and whois.domaintools record indicate that the Respondent is the registrant of the domain [www.gmails.pk](http://www.gmails.pk).*

*The printouts from pknic, pakwhois.com and whois.domaintools are enclosed as **Exhibit-8**.*

- *The domain name <www.gmails.pk> includes the word **gmail**, which is identical and confusingly similar as a whole to the well known trademark and service mark “**gmail**” in which the Complainant has a statutory right as well as a right in common law by virtue of long and continuous user and being the registered proprietor thereof.*

- *The Respondent has no right or legitimate interest in the disputed domain name.*

- *The disputed domain name has been registered and is being used in bad faith.*

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

The Complainant asserts:

***Complainant's trademark registrations:***

*The Complainant is the registered proprietor of the trademark **gmail** in various countries including Pakistan. The following are the relevant details of a few such registrations:*

<b>Country</b>	<b>Registration No.</b>	<b>Registration Date</b>	<b>Class</b>	<b>Goods/Services</b>
Pakistan	211008	30.06.2005	38	Telecommunication services; electronic mail services
Australia	1049129	04.04.2005	38	Telecommunication services; electronic mail services
Japan	4959631	09.06.2006	38	Telecommunication (other than broadcasting); broadcasting
India	1349487	07.04.2005	09	Computer software
United Kingdom	2493281	14.04.2004	38	Telecommunications; Communications by computer terminals; message sending; electronic mail services
United States of America	3150462	03.10.2006	38	Communication services- Namely, Transferring of electronic messages for group of two or more people by means of a global computer network

As submitted by the Complainant and evidence of the same annexed with the Complaint, the Complainant holds trademark registration rights to GMAIL in several countries, including Pakistan. It can be seen that the Disputed Domain Name <gmails.pk> incorporates the registered trademark of the Complainant GMAIL in entirety along with the addition of an "s" which can be construed to be typosquatting. The Panel indubitably finds that this part of the domain name is identical to the numerous trademark registrations of the word <GMAIL> held by the Complainant. In addition, the Panel finds that the whole of the domain name in dispute is confusingly similar to the above mentioned trademark registrations.

Furthermore it is established law to disregard the ccTLD when considering the matter of confusing similarity or obvious derivation, as the addition of the suffix “.pk” does not create any distinctive distinction that may eliminate the possibility of confusion by the Complainant’s customers (see *Nokia Corporation v. Firdaus Adinegoro/Beli Hosting*, [WIPO Case No. D 2004-0814](#)). Therefore the Panel determines the Disputed Domain Name to be an obvious derivation of the Complainant’s registered trademark and correspondingly in obvious infringement of the same.

As per paragraph 1 of The PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2, if a Complainant simply establishes this one criterion of infringement upon a registered trade mark/name, the registration would be deemed illegal and unlawful and for all purposes invalid, furthermore due to the lack of Response from the Respondent, the Panel is required to decide the matter based upon the Complaint. Therefore subject to the above stated conclusion, the Panel may well determine the Disputed Domain Name to be transferred to the Complainant, however for the purpose of completeness (but not to create any binding precedent requiring the same to be followed in the future), the Panel will also assess and determine the remaining issues as listed above.

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

It has been asserted by the Complainant, and has not been refuted by the Respondent, that the Complainant is the registered owner of the trade mark/name GMAIL. The Complainant has registered its trademark and domain names world wide in order to reflect and protect the same. The facts illustrate that the entity Gmail is internationally renowned and highly recognizable. In light of the same, the Respondent could not help but be aware of the name Gmail, being the registered trademark of the Complainant, the Respondent’s registration of the Disputed Domain Name with the salient feature of the domain name i.e. “gmail” being identical to the registered trademark of the Complainant, does not appear to be bona fide. The Respondent’s motives are not entirely clear and a lack or otherwise of bona fide on the Respondent’s part is unclear as the Respondent, by its omission to provide any information, data, documentation etc. has not demonstrated any bona fide on its part before this Panel.

The Panel is of the view that it is highly unlikely that the Respondent would not have known of the Complainant’s name, trademark and business while registering the Disputed Domain Name, and that it is not reasonably credible that the Respondent’s purpose would be of a bona fide nature, as appropriation of a well known trademark of which a Respondent must have been aware, for the purposes of a domain name without authorization, is commonly a sufficient basis for a finding lack of bona fide (*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, [WIPO Case No. D2000-0163](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, [WIPO Case No. D2000-0226](#); *Société des Hôtels Méridien v.*

*LaPorte Holdings, Inc.*, [WIPO Case No. D2004-0849](#); *Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry – Succession Saint Exupéry – D'Agay v. Perlegos Properties*, [WIPO Case No. D2005-1085](#)).

In the absence of any information, data, documentation, or the like, the Respondent has failed to demonstrate that the registration of the Disputed Domain Name is bona fide.

**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 trademarks/names could be construed to be an offence on multiple accounts, and by operation, would not only give the impression to the Respondent that PKNIC (though PKNIC under International best practice would not have any liability if it had no knowledge but once it would have notice would have a duty to act) was allowing aiding, abetting, encouraging and conspiring with the Respondent and would also be liable to criminal offences under the above mentioned legislations.

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

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

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

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

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

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

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

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

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

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

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

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

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

The Complainant has contended the following:

**A. The Domain Name is identical or confusingly similar to the Complainants' trade marks in which they have rights**

*(Policy, para. 4(a) (i), Rules, paras. 3(b) (viii), (b) (ix) (1))*

*13. The Complainant has used the GMAIL mark/domain continuously since well prior to June 24, 2009, the registration date for the disputed Domain Name. The Complainant owns many registrations for the mark GMAIL as contained in **Exhibit 7**, issued prior to, or resulting from applications filed prior to June 24, 2009. Each remains valid and in full force. Thus, the Complainant has rights in the GMAIL mark that predate the registration date of the Domain Name.*

*14. A domain name is "nearly identical or confusingly similar" to a complainant's mark when it "fully incorporate[s] said mark." PepsiCo, Inc. v. PEPSI SRL, D2003-0696 (WIPO Oct. 28, 2003) (holding pepsiadventure.net, pepsitennis.com, and others confusingly similar to*

*complainant's PEPSI mark since they "incorporate[ed the] trademark in its entirety"). Here, the Domain Name [www.gmails.pk](http://www.gmails.pk) incorporates the famous GMAIL mark in its entirety, and is identical to it.*

*15. The Complainant owns the Domain name [www.gmail.com](http://www.gmail.com) and the Respondent's domain name '[www.gmails.pk](http://www.gmails.pk)' is derived by incorporating the Complainant's trademark "GMAIL" in its entirety to attract internet users and consumers for commercial gain. Therefore, there is a likelihood of confusion, and in fact suggests that the disputed domain name refers to the Complainant or that the Respondent is associated with the Complainant which is not the case.*

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

*Therefore, the Domain Name is identical to the Complainant's mark/domain GMAIL.*

The Respondent has failed to provide a Response in the required manner.

The Complainant is the registered trademark holder for the trademark "Gmail" which forms the main operative part of the Disputed Domain Name with the addition of an "s".

The Complainant's trademark GMail is a unique word, not holding any literary meaning, however the use of the word is arbitrarily is used in a manner that distinguishes the services provided by the Complainant and thus makes the term Gmail inherently distinctive. The Complainant's registration of the mark GMail shows that it has exclusive rights in the same in numerous countries demonstrated by the carrying out of all reasonable methods possible to protect its registered trademark.

As is evident, the Disputed Domain Name <gmails.pk> comprises of the entirety of the Complainant's registered trademark as the addition of the generic ccTLD indicator ".pk" cannot be taken into consideration when judging confusing similarity. It is well-established that the incorporation of a Complainant's mark in full within a disputed domain name may be sufficient

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

Confusing similarity is evident in the real world, but also, when considering the particular circumstances of use on the Internet. People in Pakistan, who are searching for the Complainant's GMail website, may expect to find it under its principal identifier "Gmail" combined with the ccTLD indicator, such as ".pk". Upon arriving at the Disputed Domain Name, they might be misled by the confusing similarity between the Disputed Domain Name and the Complainant's registered trademark.

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

The domain name in dispute reasonably creates likelihood that individuals will be confused into thinking that the domain name or the related site is owned, endorsed, licensed, sponsored, or maintained by the Complainant to promote its services therefore the Complainant has established the confusing similarity of the Disputed Domain Name with its own legitimate registered trademarks.

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

### **III. Legitimate interest or rights in the Domain Name**

**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)."***

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 has provided 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 has nothing on record on part of the Respondent to decide Legitimate Interest in favor of the Respondent under 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.”*

**The Complainant has submitted the following:**

*B. The Respondent has no rights or legitimate interests in respect of the Domain Name  
(Policy, para. 4(a)(ii), Rules, para. 3(b)(ix)(2))*

*17. The Complainant submits that there is no credible legitimate reason for the Respondent to have chosen to acquire the Domain Name. ‘GMAIL’ is not a natural word nor a common name, nor one which is a common or natural descriptor for the use which is being made of the Domain Name. The Respondent’s purpose in selecting the Domain Name was plainly to use the fame of the GMAIL mark to generate web-traffic and to confuse internet users visiting the Respondent’s site when looking for the Complainant and their famous suite of services.*

*18. The Respondent is not and has never been known by the GMAIL name or by any similar name.*

*19. Registration and use of the domain [www.gmails.pk](http://www.gmails.pk) by the Respondent is neither bonafide nor a legitimate noncommercial or fair use of the Domain Name. The goodwill in the GMAIL name rightfully belongs to the*

- Complainant and has been improperly appropriated by the Respondent. Such conduct can never constitute a legitimate interest.*
20. *The Complainant submits that when the Respondent registered the disputed domain name, it was aware of the Complainant's activities, its Trademarks and its domain name "GMAIL" and these facts establish a prima facie case that the Respondent has no right or legitimate interest in the disputed domain name and that pursuant to the Policy the burden shifts to the Respondent to show it does have a right or legitimate interests. Please refer to Croatia Airlines d.d. v. Modern Empire Internet Ltd., [WIPO Case No. D2003-0455](#) and Clerical Medical Investment Group Limited v. Clericalmedical.com (Clerical & Medical Services Agency), [WIPO Case No. D2000-1228](#).*
21. *On information and belief, Registrant is not commonly known by the name or nickname of the Domain Name, or any name containing Complainant's GMAIL Mark. Registrant's information on the domain records in connection with the Domain Name makes no mention of the Domain Name or the Mark as Registrant's name or nickname. See, [Popular Enterprises, LLC v. Sung-a Jang, FA0610000811921](#) (Nat. Arb. Forum Nov. 16, 2006) ("[r]espondent's WHOIS information does not suggest that [r]espondent is commonly known by the <ntester.com> domain name"). Registrant's name is MubarKan Pvt Ltd. As the Domain name is plainly registered for commercial purposes, it cannot constitute a legitimate non-commercial or fair use of the Domain Name. The adoption by the Respondent of the 'GMAIL' domain name is plainly designed to assist it in impersonating the Complainant.*
22. *As such, its use of the Domain Name cannot constitute a bona fide offering of goods or services or a bonafide company name or trading name and such conduct can never constitute a legitimate interest.*

The onus is on the Complainant to satisfy the Panel that the Respondent does not have rights or legitimate interests in the Disputed Domain Name <gmails.pk>. The Complainant has alleged that it has not authorized the Respondent to use its registered trademark in any manner or form.

It is for the Respondent to refute the Complainant's *prima facie* case as provided for in paragraph 4(c) of the Policy. The Respondent has not replied to the allegations made against its registration of the domain name in dispute, in the required form; therefore the Panel may decide the matter *ex parte* based upon the Complaint and the relevant facts contained therein.

Given the fame of the GMail mark and the popularity of the services provided by the Complainant, it is inconceivable that the Respondent was unaware of the Complainant's rights and interests prior to the registration of the Domain Name in dispute. It can, therefore, reasonably be ascertained, on the basis of the facts and documents provided by the Complainant that the Respondent did not create a fabricated name, which happened to consist of the trademark GMail of the Complainant. The Respondent has tendered no proof to claim registration to any trademark related to the Gmail name (see *Harrice Simons Miller v. H Rheyne*, WIPO Case No. D2004-0504)

The Complainant has not consented to the Respondent's use of the Disputed Domain Name which incorporates its trademark GMail entirely. Mere registration of the Disputed Domain Name by the Respondent does not create any right or legitimate interest in the same (see *Red Bull Gmbh v. Mario Maranda*, WIPO Case No. D2008-0941). Furthermore as the Respondent is not an authorized dealer, distributor, or licensee of the Complainant, nor has it been otherwise allowed by the Complainant to make any use of its trademarks, the use of the Complainant's registered trademark may then “*constitute a prima facie showing by Complainant of absence of rights or legitimate interest in the disputed domain name on the part of Respondent.*”(*Philip Morris Incorporated v. Alex Tsyarkin*, WIPO Case No. D2002-0946).

Paragraph 4(c) of the Uniform Policy, or of any other circumstances giving rise to a right to or legitimate interest in the domain name in dispute due to the fact that:

- i. the Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to apply for or use any domain name incorporating any of those marks, and;
- ii. the word Gmail appears to be an invented word, and as such is not likely that more than one entity would legitimately choose unless seeking to create an impression of an association with the Complainant.
- iii. There is no evidence that Respondent was making a *bona fide* use of the Disputed Domain Name. The Respondent is using the Disputed Domain Name to offer similar services to that of the Complainant's services provided under the entity of Gmail. The sale of competitive products/services using a complainant's trademark typically is not considered *bona fide* or “legitimate” or “fair” for purposes of paragraph 4(a)(ii). *LTD Commodities, LLC v. Nadeem Qadir*, NAF Claim No. FA0601000636445 (March 10, 2006) (“the Panel is entitled to and does presume that Respondent receives click-through fees in exchange for diverting Internet users to such websites. Respondent's use of the Disputed Domain Name in this fashion is not in connection with a *bona fide* offering of goods or services pursuant to Policy 4(c)(i) or a legitimate

noncommercial or fair use pursuant to Policy 4(c)(iii).”); *Humana Inc. v. Henry Tsung*, WIPO Case No. D2005-0221 (May 9, 2005) (“Use for a portal linking to websites of the Complainant’s competitors is not a *bona fide* offering, but rather one which seeks to profit from confusion with the Complainant”); *Interstate National Dealer Services, Inc. v. Selwyn Colley*, WIPO Case No. D2003-0934 (April 5, 2004) (“When Respondent is engaged in the commercial sale of competitive products, Respondent cannot take advantage of the rights or legitimate interests defenses of paragraph 4(c)(i) or (iii) of the Policy by relying on uses that are infringing, because such uses are not considered ‘*bona fide*’ or ‘legitimate’ or ‘fair use.’”).

The Complainant uses its trademark Gmail to offer free web mail services and the term Gmail is an abbreviation for Google Mail, being very closely associated with and recognized by masses to be that of the Complainant.

The Complainant has been offering the services of free web mail since 2004, before the Respondent registered the Disputed Domain Name. This indicates that the Respondent was aware of the Complainant and the Complainant’s offering of free web mail service under the head of Gmail. Furthermore, the Respondent has been using the Disputed Domain Name to offer services identical to those of the Complainant, i.e. free web mail service.

Since the Respondent has not submitted any documentation, information, evidence, data or the like, the Panel is unable to take into account any legitimate interests (if any) and or rights to the Disputed Domain Name on part of the Respondent.

In summary, it appears that the Respondent has not been known by the Disputed Domain Name since the same has been registered by the Complainant even before the Disputed Domain Name was registered.

The Panel, is unable to determine any rights or legitimate interests on part of the Respondent since the latter has not provided any information, documentation, evidence or the like to demonstrate that before any the Complaint to him, he was using or making demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Nor has the Respondent shown that it, (as an individual, business, or other organization) has been commonly known by the Disputed Domain Name, even if it had acquired no trademark or service mark rights. Furthermore, the Respondent has failed to show that it is making a legitimate noncommercial or fair use of the Disputed Domain Name, without

intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Accordingly, the Respondent has failed to demonstrate any rights or legitimate interests in respect of 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 Respondent has failed to submit a Response in the required form.

The Complainant has made the following assertions:

#### **C. The Domain Name was registered and is being used in bad faith**

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

23. *The nature of services being provided by the Respondent overwhelmingly supports the conclusion that Respondent registered and is using the Domain Name in bad faith. It is submitted that the Respondent's bad faith is further exemplified by the fact that they have registered the domain [www.gmails.pk](http://www.gmails.pk) on June 24, 2009, which is subsequent to the adoption and use of the mark GMAIL by the Complainant. First, the fame and unique qualities of the GMAIL mark make it extremely unlikely that the Respondent created the Domain Name independently. See, e.g., The J. Jill Group, Inc. v. John Zuccarini d/b/a RaveClub Berlin, FA0205000112627 (Nat. Arb. Forum July 1, 2002) ("Because of the famous and distinct nature of Complainant's mark and Complainant's J. JILL listing on the Principal Register of the USPTO, [r]espondent is thought to have been on notice as to the existence of Complainant's mark at the time [r]espondent registered the infringing <jjill.com> domain name. Thus, [r]espondent's registration despite this notice is evidence of bad faith registration"). Even constructive knowledge of a famous mark like GMAIL is sufficient. Google v. Abercrombie I, FA0111000101579 (Nat. Arb. Forum Dec. 10, 2001) ("because of the famous and distinctive nature of Complainant's GOOGLE Mark, [r]espondent is thought to have been on notice of the existence of Complainant's mark at the time [r]espondent registered the infringing [domain name]") (re googld.com domain name).*
24. *The Respondent has registered the Domain Name which is identical to the Complainant's well known mark and domain. In so doing, the Respondent has intentionally attempted to attract for commercial gain Internet users to the web site, by intentionally misleading them and creating a likelihood of confusion with the Complainants' trademark as to the source, sponsorship, affiliation, or endorsement of the website (Policy, paragraph 4(b)(iv)).*
25. *The Respondent's choice of domain name is not accidental and has clearly been made to derive unfair monetary advantage. In support of this submission, the Complainant contends:*

- (1) *At the time of registration of the domain name by the Respondent i.e., on June 24, 2009, the mark and domain name “GMAIL” was well-known and registered in several countries of the world including Pakistan. Therefore, the popularity and registration of “GMAIL” mark and domain name was a constructive notice to the Respondent on Complainant’s rights in the “GMAIL” mark and name. Thus, the adoption of an identical mark/domain name by the Respondent is in bad faith.*
- (2) *The word GMAIL is a unique coined word, which is exclusively referable to the Complainant and the suite of services provided by the Complainant. Thus, use of words and domain [www.gmails.pk](http://www.gmails.pk) by the Respondent is clearly to align its business/services with that of the Complainant.*
- (3) *The Complainant has made extensive use of the GMAIL mark for a considerable time, such that the GMAIL mark has acquired goodwill even in jurisdictions where it is has not been registered by the Complainant as a trade mark.*
- (4) *The Respondent first registered the Domain Name on June 24, 2009 (a significant period of time after the Complainant commenced trade under the GMAIL mark) internationally. Similarly, the registration of the Domain Name significantly post-dates the registration of the Complainants’ GMAIL Domain Names and trade mark.*
- (5) *As previously set out, the Respondent has adopted an identical mark GMAIL as part of the Domain Name. The entire business activity of the Respondent is to deceive the innocent trade and public by misrepresenting themselves as part of the Complainant’s company or to misrepresent that their activities have been authorised, approved or sponsored by the Complainant. The Respondent has wrongfully registered the Domain Name to deceive consumers. Thus, from the circumstances, it’s plain that the adoption of the GMAIL domain was not independent but parasitic and made in bad faith.*

(6) *The Respondent's bad faith is further evident from the search on [www.waybackmachine.org](http://www.waybackmachine.org) and the pages captured on 24<sup>th</sup> Jan, 2010 under the heading "about Gmails Pakistan" the following text appears on clicking the link*

*"About Us*

*2daybiz Multi User Email Script enables you to start your own email website like gmail, yahoo mail, hot mail made in CGI/PERL, tested over linux servers. Its features include advanced spam filtering, RBL blacklisting, completely MIME compatible, contact list members filter proof, multiple skins, limit users outgoing mail sort inbox with several criteria, fully customizable via HTML templates, mod\_perl compatible, new mail sounds, WYSIWYG mail interface, multiple tiered premium accounts, premium accounts using paypal & subscriptions, SMTP or send mail, functional calendar and scheduler, unlimited user folders, folder filtering email notifications of new mail, MySQL backend, backup, powerful admin panel, ban IP, advanced user editing, account suspensions, and user address book."*

*The above clearly shows Respondent's knowledge of GMAIL service and mark.*

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

The fact that the Respondent has deliberately disregarded the opportunity to submit a Response in the required form is particularly relevant to the issue of whether the Respondent has registered and is using the domain name in bad faith. Paragraph 14(b) of the Rules provides that, in the absence of exceptional circumstances, a Panel shall draw such inferences as it considers appropriate from the failure of a party to comply with a provision or requirement of the Rules. This Panel could not find any exceptional circumstances for Respondent's failure to submit a response; therefore the Panel draws the following inferences:

- i. Respondent does not deny the facts which the Complainant asserts, and;
- ii. Respondent does not deny the conclusions which the Complainant asserts can be drawn from these facts.

Nevertheless, the Panel still assumes the responsibility of determining which of the Complainant's assertions are established as facts, and whether the conclusions asserted by the Complainant can be drawn from the established facts (see, *Inter-IKEA Systems B.V. v. Hoon Huh*, WIPO Case No. D2000-0438).

The third element in paragraph 4(a) of the Policy requires the determination of the fact that the domain name in dispute "*has been registered and is being used in bad faith*" by the Respondent. The Panel highlights two essential facts. First, the provision contains the conjunction "and" rather than "or". Secondly, the provision refers to both the past tense ("has been registered") and the present tense ("is being used").

This draws attention to the fact that that paragraph 4(a)(iii) requires the Complainant to prove use in bad faith as well as registration in bad faith.

Paragraph 4(a)(iii) of the Policy utilizes both, past and present, tenses thereby inferring that upon determining bad faith on the part of the Respondent, the Panel should consider the circumstances at the time of registration as well as the subsequent behavior of the Respondent following the registration, with regards to the domain name in dispute.

The Panel cannot conceive of a plausible situation in which the Respondent would have been unaware of the popularity and success of the Complainant's services at the time of registration.

The second prong of the requirement for bad faith requires the Complainant to show that the Disputed Domain Name "is being used in bad faith" by the Respondent. The Disputed Domain Name is being used to offer services identical to those of the Complainant offered under its trademark GMAil.

Taking into account the submissions made by the Complainant, supported with documentation, the Panel is of the view that it is highly unlikely that the Respondent was not aware of the Complainant, its trademark Gmail, the nature of services rendered under the head of Gmail and the massive customer base of the Complainant. Furthermore, the Respondent is making use of the Disputed Domain Name to offer services similar to those offered by the Complainant. In effect, the Respondent has prevented the Complainant from registered the Disputed Domain Name for itself even though a right to do so vests with the Complainant, as is afforded to it under the Trade Marks Ordinance, 2001, by virtue of its trademark registration rights for the mark GMAil. By registering the Disputed Domain Name, which incorporates the Complainant's trademark, the Respondent has created a likelihood of users being confused and misled into believing that the Disputed Domain Name is being operated by the Complainant, which is not true. This could lead to consumers using the Respondent's web mail service, falsely believing to the same being operated and offered by the Complainant. In effect, if a user is dissatisfied and/or finds out that it has been misled, it could severely affect the customer base of the Complainant, along with its image, reputation, goodwill etc. being tarnished. Also, it appears that by

registering and using the Disputed Domain Name, the Respondent is encroaching on the Complainant's well established repute.

Both under past UDRP decisions (see for instance *Nike, Inc. v. B.B. de Boer*, [WIPO Case No. D2000-1397](#); and *Carolina Herrera, Ltd. v. Alberto Rincon Garcia*, [WIPO Case No. D2002-0806](#)) and under the Policy, a well-established principle is that when someone registers a domain name, it represents and warrants to the registrar that, to its knowledge, the registration of the domain name will not infringe the rights of any third party. In the case at issue, the Panel reasonably finds that since the Complainant's marks are widely known, it is unlikely that the Respondent, at the time of registration of the Disputed Domain Name or thereafter, was not aware that it was infringing the Complainant's marks.

Under the appropriate circumstances, bad faith can also be inferred based on the fame of the Complainant's marks, such that the Respondent was aware or should have been aware of the Complainant's mark and claims of rights thereto (particularly in view of the Complainant's use of its mark on the Internet). The Panel in light of the present circumstances finds it highly doubtful that the Respondent would have registered the Disputed Domain Name without having knowledge of the Complainant.

According to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In connection with the burden of proof, several decisions of UDRP panels have held that "[o]nce a Complainant establishes *prima facie* showing that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondent to rebut the showing" (see among others, *Universal City Studios, Inc. v. David Burns and Adam-12 Dot Com*, [WIPO Case No. D2001-0784](#); see also *International Hospitality Management - IHM S.p.A. v. Enrico Callegari Ecostudio*, [WIPO Case No. D2002-0683](#)).

The Complainant has asserted that the Respondent has no relationship with or authorization from the Complainant to use its mark; the Panel notes that there is nothing in the record to suggest that the Respondent has been commonly known by the Disputed Domain Name; the Panel further notes that the Respondent has not, and has never been, commonly known by the domain name. The Panel's view is that these facts may be taken as proven in the circumstances of this case provided that they have not been denied by the Respondent in a proper and appropriate response submitted to the DNDRC. In any case, all the arguments above cannot stand in the face of WIPO domain name decision in favor of Gmail. in the matter of *Google Inc. v Small Business Internet Solutions* decided by the WIPO Arbitration and Mediation Center, which is squarely applicable here.

Taking into account all of the above, and in particular, by omission of the Respondent to submit a proper Response in the required manner, the Panel is unable to determine that the Respondent did not register and is not using the Disputed Domain Name in bad faith.

Even though the Respondent did not submit the Response in the required manner/form, the Panel has made note of it. It is clarified that this does not form a binding precedent to be used in future cases/domain name disputes brought before DNDRC.

The Respondent has raised the addition of “s” to gmail in registering the Disputed Domain Name <gmails.pk>. It has been discussed under the head of “Identical and Confusingly Similar” that such addition only constitutes typosquatting. The operative part of the Disputed Domain Name incorporates the Complainant’s registered trademark, being Gmail.

Furthermore, the Respondent has stated that it is willing to sell the Disputed Domain Name. This clearly satisfies the first criterion of Registered and Used in Bad Faith issue.

The Panel, for the purpose of assessing the matter and this Decision, has taken into account, reviewed and made use of the Discussions & Findings in the WIPO Authorities mentioned and relied upon by the Complainant, in addition to the Arbitration Decision in the matter of Google Inc. v Chen Zhaoyang decided by Shri A.K. Singh.

## **8. Decision**

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

- i. The Respondent’s registration of the Disputed Domain Name is in violation of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2.
- ii. The Respondent has no legitimate interest in the Disputed Domain Name.
- iii. The Disputed Domain Name is identical to the Complainant’s trademark/names and registered domain names.
- iv. The Respondent is making mala fide use of the Complainant’s trade marks/names.
- v. Pursuant to Paragraphs 4 of the PKNIC - Internet Domain Registration Policy Aug 07, 2007 version 4.2, and Paragraph (i) of the UDRP the Panel therefore recommends to PKNIC to transfer the registration of the Disputed Domain Name to the Complainant, as prayed for within 48 hours of receipt of this decision by email or it being uploaded onto the DNDRC website [www.dndrc.com/cases\\_resolved/](http://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**



**Sole Panelist**

**Date: 01<sup>st</sup> April, 2012**