

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Travelscape, LLC vs Travelocity Pakistan

Case No. C2017-0005

Also in PDF C2017-0005

1. The Parties

The Complainant is Travelscape, LLC having its office at 333 108th Avenue NE, Bellevue, WA 98004, U.S.A. The Complainant has initiated the Complaint vide their authorized representatives, Hassan Irfan Khan and S.M. Bilal Ahsan having their office at United Trademark & Patent Services, 85, The Mall, Lahore, Pakistan.

The Respondent's name is Travelocity Pakistan with its address at Shop# 16, 17 Upper Ground Floor, Koh-e-Noor 1 Plaza, Faisalabad.

2. The Domain Names and Registrar

The domain name in dispute is <travelocity.pk>, hereinafter referred to as the Disputed Domain Name. Vide email dated Friday 15 May 2017, PKNIC has informed DNDRC that the Agent Organization through which the registration was applied is Travelocity, Ground Floor Majeed Plaza Al Hamra Town, Faisalabad, Pakistan and its Create Date was 2008-02-09 with an Expire Date of 2018-02-09.

3. Procedural History

DNDRC was informed of the Complaint against the Respondent as per PKNIC - Internet Domain Registration Policy, by notification from the Complainant 10 May 2017.

The Respondent was issued notification of the dispute along with a copy of the Complaint and a Response Form on 21 June 2017 informing the Respondent that if a Response was not received 7 days from the notification, the dispute would be proceeded ex parte. DNDRC awaited the

submission by the Complainant of the Complaint as per the prescribed forms also available at www.dndrc.com/downloads. The Respondent failed to provide a response within the stipulated time period.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Mr. Abbas Lotia as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules.

Factual Background

The domain name upon which the Complaint is based is <travelocity.pk>.

PKNIC has confirmed via their email dated 15 May 2017 that the Disputed Domain Name has been registered by the Respondent named in the Complaint and that their email address is touseefq@gmail.com.

4. Parties Contentions

A. Complainant

1. Complainant, popularly known as Travelocity, founded in 1996, is a leading provider of consumer direct travel services for the leisure and business traveler. See Exhibit C, information regarding the Complainant, its predecessors-in-interest, and the TRAVELOCITY brand. Travelocity markets and distributes travel-related products and services directly to individuals using its mark TRAVELOCITY and its various brand websites and contact centers. Indeed, Travelocity is one of the most recognized on line travel brands, offering thousands of travel destinations to more than 20 million travelers per month .

2. Complainant is owned by Expedia, Inc. ("Expedia"), one of the world's largest travel companies. Expedia is well-known, like Travelocity, in countries around the world and has been recognized by a WIPO Panel as a "well-publicized Internet travel company." See Expedia, Inc. v. Alvaro Collazo. WIPO 02003-0716. Expedia's travel brands, including EXPEDIA.COM, HOTWIRE, HOTELS.COM. EGENC!A, TRIVAGO, and TRAVELOCITY, among others, offer travelers the world's most comprehensive selection of travel options backed by industry-leading technology and a team of hundreds of Expedia employees worldwide. See Exhibit D. From August 2013 through January 2015, Expedia powered the technology platforms of Travelocity's U.S. and Canadian websites, as well as

provided access to Expedia's supply and customer service platforms. In January 2015, Expedia acquired Complainant's predecessor-in-interest.

3. Travelocity's main website, TRAVELOCITY.COM, was launched in 1996. Through the site, travelers can take control of their bookings and reservations and research information about potential destinations. See Exhibit C and Exhibit E, printouts of representative pages from the TRAVELOCITY.COM website. TRAVELOCITY.COM is one of the most powerful one-stop travel sites on the Internet, providing secure online reservation capabilities for air, car, hotel, and vacation reservations, plus access to a vast database of destination and other travel information. The site provides reservation information for more than 700 airlines, more than 50,000 hotels, and more than 50 car rental companies. See Exhibit C. TRAVELOCITY.COM also offers more than 6,500 vacation packages as well as tour and cruise departures. Id. See Exhibit F, a printout of Who is information for TRAVELOCITY.COM.

4. Travelocity has been using the trademark TRAVELOCITY, either standing alone or in combination with other word and/or design elements, for its travel-related services since 1996. For twenty (20) years, Travelocity has continuously advertised and offered services and products under the TRAVELOCITY name and mark. See Exhibit K, supra. Travelocity accordingly has developed strong rights in the TRAVELOCITY Marks. See Exhibit G, printouts of representative third-party articles and Internet postings referring to Travelocity and TRAVELOCITY services.

5. Travelocity has, for years, extensively promoted its TRAVELOCITY services and TRAVELOCITY .COM website throughout the world through on line, print, and television advertising campaigns, and email communications. See Exhibit H, printouts concerning CoInplainant's promotion of its services under the TRAVELOCITY Marks.

6. Travelocity also uses its TRAVELOCITY mark for its various social media platforms. See Exhibit I, printouts from Complainant's TRAVELOCITY Facebook account and TRAVELOCITY Twitter account. Complainant also operates mobile applications, including the TRAVELOCITY apps available at <http://www.travelocity.com/app>. See Exhibit J, printouts concerning Complainant's mobile apps available at <https://itunes.apple.com/app/hotel-flight-car-booking-travelocity/id284803487?mt=8> and https://play.google.com/store/apps/details?id=com.travelocity.android&feature=search_result. The promotion and exploitation of the TRAVELOCITY Marks and all related sales, advertising, and promotional activities have generated, and continue to generate, significant sales of TRAVELOCITY services and products around the world.

7. Complainant owns trademark and service mark registrations on the Principal Register of the United States Patent and Trademark Office ("USPTO") for its TRAVELOCITY Marks, including TRAVELOCITY, TRAVELOCITY BUSINESS, and TRAVELOCITY PARTNER NETWORK for use in connection with the following services, among others:

- providing airline, car rental, tour package, and general travel information via a global computer network;
- providing hotel information and reservation services via a global computer network;
- making hotel reservations for others via a global computer network;
- providing information about vacation destinations via a global computer network; and
- travel agency services, namely, making reservations for temporary lodging, and for entertainment events, facilities and services.

See Exhibit K, copies of Complainant's U.S. registrations for its TRAVELOCITY Marks, all of which are valid and subsisting.

Travelocity also owns numerous registrations for the TRAVELOCITY Marks in countries around the world, including, but not limited to, India, Hong Kong, China, Australia, New Zealand, Canada, Mexico, Brazil, and countries of the European Community. See Exhibits Land M, printouts of database information pertaining to Complainant's Pakistan trademark applications for TRAVELOCITY mark, India registrations for the TRAVELOCITY mark, and other examples of Complainant's non-U.S. registrations for its TRAVELOCITY Marks, respectively, all of which are valid and subsisting.

Travelocity and the TRAVELOCITY.COM website have received several awards over the years, including the "World's Leading Travel Internet Site" for nine consecutive years; the 2006 Best in Business Travel Award: Best Website for Booking Travel; the 2007 Stevie Award for Best Marketing Campaign; and the 2008 Atlas Best Overall Branding Award. See Exhibit N.

10. Complainant's TRAVELOCITY.COM website received over 6.6 million visits in April 2016, and is ranked #542 in terms of websites visited in the U.S. and #1812 globally. See Exhibit O, a printout of a report from the online traffic tracking website at TRAEFFICESTIMATE.COM, as well as a printout from the ALEXA.COM website that ranks Internet traffic to websites. In addition to TRAVELOCITY.COM, Travelocity also

owns the country-specific domain name in neighboring India TRAVELOCITY.IN. See Exhibit F, Whois database information for TRAVELOCITY.COM and TRAVELOCITY.IN.

11. As a result of Travelocity's longstanding use and promotion of the TRAVELOCITY Marks, the consuming public and the trade recognize and associate the TRAVELOCITY Marks with Travelocity. Accordingly, the TRAVELOCITY Marks have acquired a high degree of public recognition and distinctiveness as a symbol of the source of high quality services and products offered by Travelocity, and embody valuable reputation and goodwill belonging exclusively to Complainant.

12. Complainant's services offered through the website TRAVELOCITY.COM have been accessible to consumers based in Pakistan and have been regularly used by customers based in Pakistan since long. Well over a thousand customers based in Pakistan have used the services on Complainant's TRAVELOCITY.COM website and made travel and hotel bookings. See Exhibit O, List of Pakistani Customer booking invoices along with the booking date from Pakistan.

13. According to Complainant's records, Complainant has around 384 active customers I subscribers of TRAVELOCITY.COM based in Pakistan. See Exhibit R, List of Pakistani subscribers I members of TRAVELOCITY.COM from Pakistan.

14. The Complainant submits that the overwhelming success of its TRAVELOCITY.COM services has resulted in the Complainant gaining extensive goodwill and reputation in the trademark TRAVELOCITY world-wide, and that on account of its extensive use and popularity, the domain name/trademark TRAVELOCITY has achieved the status of a 'well-known' mark.

15. This well-known status has been recognized by other Domain Name Dispute Resolution Bodies in their various decisions in favor of the Complainant. Numerous Panels over the years have confirmed Travelocity's ownership and use of the TRAVELOCITY Marks. Travelocity.com LP was the record owner of the TRAVELOCITY marks when a number of UDRP proceedings were filed in the past, including, inter alia, Travelocity.com LP v. Bladimir Boyiko, No. FAI205001446051 (NAF June 27, 2012); Travelocity.com LP v. Rampe Purda, No. FAI008001343690 (NAF Oct. 15, 2010); Travelocity.com LP v. Leing Maj, No. FA0905001260772 (NAF June 15, 2009). Ownership by Complainant was confirmed by a recent Panel on January 6, 2016 as well. See Travelscape, LLC v. James Calderon, Real Travel Network, Inc .. WIPO D2015-1960.

16. Most recently, the Panelists in the www.KASHMIRTRAVELOCITY.com dispute confirmed the ownership of the TRAVELOCITY trademark. [Travelscape, LLC. V Owais Mushtaq Case No:D2016-0901]. Attached as Exhibit Sis a list compilation of decisions passed by various Domain Name Dispute Resolution Bodies in the Complainant's favor with respect to the TRAVELOCITY domain name/ trademark.

The Complainant's brief contentions are reproduced below:

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

Therefore, the Complainant seeks the following remedy:

In accordance with paragraph 4(I) of the Policy, read in conjunction with paragraph 25, for the reasons described in section 5 above, the Complainant requests the Registrar/ Administrative Panel appointed in the administrative proceeding to issue a decision that the registration of the disputed domain name <www.TRAVELOCITY.pk> be transferred to the Complainant.

D. Respondent

The Respondent has not submitted any response to DNDRC.

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

5. Jurisdiction

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

The Respondent applied for and was granted registration of the Disputed Domain Name on the

basis of these regulations, and has submitted to, the PKNIC - Internet Domain Registration Policy Aug 7, 2007 ver. 4.2 and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

6. Discussion and Findings

In the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website (http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf), the Panel laid down the following four heads under which to analyze cases, under the PKNIC - Internet Domain Registration Policy, dated 07-Aug-2007, version 4.2 and the UDRP:

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

The decision of the dispute shall be addressed with respect to the following aspects:

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

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

The PKNIC - Internet Domain Registration Policy Aug-07-2007 version 4.2 states that it creates an exception for, and thus excludes the registration of a domain name that:

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

- c. in the opinion of PKNIC, a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,*
- d. has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law), or*
- e. in the opinion of PKNIC is not appropriate for registration.*

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

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

Therefore, for the purpose of assessing illegality, unlawfulness or otherwise invalidity of the Application & Registration of the Disputed Domain Name, the application and registration of the Disputed Domain Name shall be assessed in consideration of the following criteria:

- i. Whether the Disputed Domain Name infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the Disputed Domain Name is bona fide?
- iii. Whether the application and/or registration of the Disputed Domain Name contravenes the Pakistan Penal Code, 1860 (the “Penal Code”) or any applicable criminal law?

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

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

The Complainant has stated:

- 1. The Complainant has used the TRAVELOCITY trademark/domain name continuously since well prior to February 9, 2008, the registration date for the disputed Domain Name.*

The Complainant owns many registrations for the mark TRAVELOCITY as contained in Exhibit K, L AND M issued prior to, or resulting from applications filed prior to February 9, 2008 including its later trademark applications in Pakistan. Each remains valid and in full force. Thus, the Complainant has rights in the TRAVELOCITY mark that predate the registration date of the Domain Name.

2. Respondent's disputed domain name <travelocity.pk> is identical to Complainant's well-known TRAVELOCITY mark as it fully incorporates the TRAVELOCITY exactly and in its entirety. See PepsiCo. Inc. v. PEPSI. SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (a/k/a EMS), WIPO Case No. 02003-0696 ("incorporating a trademark in its entirety can be sufficient to establish that a domain name is identical or confusingly similar to a registered trademark"). Further there have been awards in the Complainant's favor with regard to disputes over the domain names containing the word TRAVELOCITY (See Exhibit S).

3. Given the renown of Complainant's TRAVELOCITY Marks, including Complainant's well-known TRAVELOCITY.COM website, the relevant consumers, on seeing the disputed domain name, will reasonably believe that it is related to Complainant. By adopting a domain name that incorporates the identical TRAVELOCITY mark, Respondent is attempting to capitalize on the TRAVELOCITY name and mark. Respondent is clearly hoping to mislead consumers into believing that the disputed domain name is affiliated with Travelocity in order to attract Internet users to Respondent's travel-related website for Respondent's commercial gain. Consumers who come across the disputed domain name and/or search the Internet for Complainant or Complainant's products or services by using Complainant's names and marks may be directed to the disputed domain name and associated website, thereby creating a likelihood of confusion. For these reasons, Respondent's disputed domain name is identical or confusingly similar to Complainant's TRAVELOCITY Marks.

4. Furthermore, it is established law to disregard the ccTLD when considering the matter of confusing similarity or obvious derivation as the addition of suffix ".pk" does not create any distinction that may eliminate the possibility of confusion by the Complainant's customers, as held in Google Inc. v Mubarkan Pvt. Ltd (Case No:C2012-0002) for the domain www.gmails.pk which was found to be similar to the trademark GMAIL of Google Inc.

5. The Complainant further submits that it has not licensed or otherwise permitted the Respondent to use the "TRA VELOC'ITY" trademark or any other trademark

incorporating the "TRAVELOCITY" 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 "TRAVELOCITY" mark. See Rediff.com India Ltd. v. Daniyal Waseem DNDRC (Case No. C2009-0005) where it was held that "Both under past decisions (see for instance Nike. Inc. v. H.B. de Boer, WIPO Case No. 02000-1397; 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 or 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." Here, the result should be no different as Respondent has registered a domain name that is identical to Complainant's TRAVELOCITY mark and name and, as shown below, has used such with travel-related services, the very services offered by Complainant under its TRAVELOCITY mark.

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

The Complainant has provided supporting documents showing that the Complainant applied for registration of the mark "TRAVELOCITY" prior to the registration of the Disputed Domain Name both in Pakistan and around the world. The Complainant has correctly submitted that the Disputed Domain Name incorporates in its entirety the trademark of the Complainant which is registered in several jurisdictions around the world and is a well-known mark.

The Panel finds that the Disputed Domain Name by incorporating the registered trademark of the Complainant in its entirety is an obvious derivation of such trademark. The Complainant has correctly stated that the mere addition of ".pk" suffix does not distinguish the Disputed Domain Name from the trademark in which the Complainant has rights.

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

Hence, the Panel may well determine, on this criteria alone, that the Disputed Domain Name be transferred to the Complainant. However, for the purpose of completeness, but not to create any

binding precedent requiring the same to be followed in the future, the Panel will also assess and determine the remaining sub-issues as identified above.

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

The Complainant has submitted detailed information in support of its contention that the registration of the Disputed Domain Name is not bona fide (discussed in further detail with subsequently in this decision). This includes the contention that prior to registration of the Disputed Domain Name, the Respondent was well aware of the existence of the trademarks and goodwill of the Complainant and its <travelocity.com> domain name which is a popular mark all around the world.

The Respondent has again not provided any information in support of the contention that the registration of the Disputed Domain Name by the Respondent was bona fide.

Thus, in view of the detailed information provided by the Complainant in support of the contention that the registration of the Disputed Domain Name is mala fide, and the absence of any information provided by the Respondent, the Panel finds that the registration of the Disputed Domain Name by the Respondent was not bona fide.

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

Prior to discussing this sub-issue, it is pertinent to clarify the grounds for examining relevant Pakistani law provisions. Although Pakistani law does not apply by force of law over PKNIC's jurisdiction, by operation of the PKNIC- Internet Domain Registration Policy Aug 07, 2007 version 4.2, it is necessary to examine provisions of the Penal Code and other applicable criminal laws. It is in this spirit and for this purpose alone that the following provisions of Pakistani law are being analyzed. The ordinances, and the sections mentioned herein below, have been discussed at length in *Standard Chartered PLC v. Hosting Campus Domain (case no. C2007-0001)*.

Trade Marks Ordinance, 2001

40. Infringement of registered trade mark.-

(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without consent of

the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.

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

Electronic Transactions Ordinance, 2002 (“ETO”)

3. Legal recognition of electronic forms.—

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

Penal Code

Of Trade, Property and Other Marks

478. Trade mark.

A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this Code the expression “trade mark” includes any trade mark which is registered in the register of trade marks kept under the Trade Marks Act, 1940 (V of 1940)

Upon a study of the above-quoted sections of the Trade Marks Ordinance, 2001 and the Penal Code, the Panel is of the view that the infringement of Trade Marks and Trade Names have been equated with domain names under Pakistani law. Therefore, the provisions of the Penal Code dealing with Trade Mark infringement appear to apply to domain names.

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

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

479. Property mark.

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

480. Using a false trade mark.

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

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

481. Using a false property mark.

Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.

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

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

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

The Complainant has provided proof that the Disputed Domain Name is being used for a business which is similar to that of the internationally reputed business of the Complainant. The Panel, therefore, is of the view that the Respondent's registration of the Disputed Domain Name may

attract the above-mentioned provisions of the Trade Marks Ordinance, 2001, Penal Code and ETO. The Panel may decide this Complaint on this basis alone. However, for the sake of completeness and procedural fairness, but not to create a binding precedent, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC- Internet Domain Registration Policy Aug 7, 2007.ver 4.2.

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

The Complainant has contended the following:

1. The Complainant has used the TRAVELOCITY trademark/domain name continuously since well prior to February 9, 2008, the registration date for the disputed Domain Name. The Complainant owns many registrations for the mark TRAVELOCITY as contained in Exhibit K, LAND M issued prior to, or resulting from applications filed prior to February 9, 2008 including its later trademark applications in Pakistan. Each remains valid and in full force. Thus, the Complainant has rights in the TRAVELOCITY mark that predate the registration date of the Domain Name.

2. Respondent's disputed domain name <travelocity.pk> is identical to Complainant's well-known TRAVELOCITY mark as it fully incorporates the TRAVELOCITY exactly and in its entirety. See PepsiCo. Inc. v. PEPSI. SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (alk!a EMS), WIPO Case No. 02003-0696 ("incorporating a trademark in its entirety can be sufficient to establish that a domain name is identical or confusingly similar to a registered trademark"). Further there have been awards in the Complainant's favor with regard to disputes over the domain names containing the word TRAVELOCITY (See Exhibit S).

3. Given the renown of Complainant's TRAVELOCITY Marks, including Complainant's well-known TRAVELOCITY.COM website, the relevant consumers, on seeing the disputed domain name, will reasonably believe that it is related to Complainant. By adopting a domain name that incorporates the identical TRAVELOCITY mark, Respondent is attempting to capitalize on the TRAVELOCITY name and mark. Respondent is clearly hoping to mislead consumers into believing that the disputed domain name is affiliated with Travelocity in order to attract Internet users to Respondent's travel-related website for Respondent's commercial gain. Consumers who come across the disputed

domain name and/or search the Internet for Complainant or Complainant's products or services by using Complainant's names and marks may be directed to the disputed domain name and associated website, thereby creating a likelihood of confusion. For these reasons, Respondent's disputed domain name is identical or confusingly similar to Complainant's TRAVELOCITY Marks.

4. Furthermore, it is established law to disregard the ccTLD when considering the matter of confusing similarity or obvious derivation as the addition of suffix ".pk" does not create any distinction that may eliminate the possibility of confusion by the Complainant's customers, as held in Google Inc. v Mubarkan Pvt. Ltd (Case No:C2012-0002) for the domain www.gmails.pk which was found to be similar to the trademark GMAIL of Google Inc.

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

On the other hand, the Respondent has not provided any information, and has not refuted the contention put forth by the Complainant with respect to its trademark.

Based on the information provided by the Complainant, it appears to the Panel that the Disputed Domain Name incorporates exactly and in its entirety the entirety of a mark belonging to the Complainant and registered in various countries. It is a settled principle that incorporation of a mark in its entirety in a domain name is sufficient for the purposes of establishing confusing similarity. It is also a well-established principle that the mere addition of a gTLD suffix ".com" or its equivalent (e.g..pk) is not relevant to the consideration of confusing similarity as it is an integral part of a domain name. This is also supported by precedents relied upon by the Complainant.

Moreover the Complainant has stated that the Complainant has not provided the Respondent with any license to use its trademark in its entirety within the Disputed Domain Name. The Panel is unable to infer that the Respondent is commonly known by the Disputed Domain Name in the absence of any response provided by the Respondent.

The Panel therefore finds that the Disputed Domain Name is identical to the Complainant's trademark under paragraph 4(a)(i) of the Policy.

III. Legitimate interests in a domain name

As per paragraph 4(c), the UDRP requires the Respondent's claim to be of legitimate interest and shall be:

“proved based on all evidence presented” that “shall demonstrate” the Respondent’s “rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii).”

Paragraph 4(a)(ii) states that:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

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

The Complainant has contended:

1. The Complainant submits that there is no credible legitimate reason for the Respondent to have chosen to acquire the disputed domain name. “TRAVELOCITY” 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 disputed domain name. The Respondent’s purpose in selecting the disputed domain name was plainly to use the fame of the TRAVELOCITY mark to generate web-traffic for a competing travel-related website and to confuse internet users visiting the Respondent’s site when looking for the Complainant and its famous suite of travel services.

2. Registration and use of the disputed domain name < travelocity.pk> by the Respondent is neither bona fide nor a legitimate noncommercial or fair use of the disputed domain name and is clearly aimed to derive unfair Commercial gain by the Respondent and infringes Complainant's rights in the TRAVELOCITY mark. The goodwill in the TRAVELOCITY name rightfully belongs to the Complainant

and has been improperly appropriated by the Respondent. Such conduct can never constitute legitimate interest.

3. The Complainant submits that when the Respondent registered the disputed domain name, it was aware of the Complainant's activities, its TRAVELOCITY Trademarks and TRAVELOCITY.COM domain name since Respondent used the disputed domain name to offer travel services that compete with those of Complainant and an Internet search would have readily disclosed Complainant's TRAVELOCITY website and travel related services. These facts alone 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. 02003-0455 and Clerical Medical Investment Group Limited v. Clericalmedical.com (Clerical & Medical Services Agency), WIPO Case No. 02000-1228.

4. Respondent is neither using the disputed domain name in connection with a bona fide offering of goods or services nor making a legitimate noncommercial or fair use of the disputed domain name. Respondent has used the disputed domain name, without permission or authorization from Complainant, to capitalize on the TRAVELOCITY Marks and TRAVELOCITY.COM domain name solely for commercial gain. Respondent has sought to profit by using the disputed domain name to promote itself and competing travel-related business and by piggy backing on the goodwill associated with Complainant's well known TRAVELOCITY Marks. The disputed domain name, which is likely to be confused as being linked to a Complainant controlled website in Pakistan, directs viewers to a website maintained and operated by Respondent, which serves to promote Respondent and his affiliated company and alleged travel services by fostering the appearance of an association with the TRAVELOCITY name and mark. Indeed, Respondent has made repeated use of the name "Travelocity" throughout the web site at the disputed domain name and has included a header that simply states "Travelocity A tourism house with complete travel solutions," all of which suggests a connection to Complainant and its TRAVELOCITY travel related services. Because Respondent is neither an authorized affiliate of Travelocity, nor a licensee of Complainant's marks, Respondent has no right to exploit Complainant's TRAVELOCITY mark in the course of selling or advertising any travel related services. Respondent's use of the disputed domain name to promote sales constitutes trademark infringement and unfair competition, and is clearly not a legitimate interest or use. National C'ol/egiarte Athletic Association and March Madness Athletic Association, I.L.C'. v. Mark Halpern and Front & C'enter Entertainment, WIPO Case No. 02000-0700; see also General Electric Company. GE Osmonics Inc v. Optima di Federico Papi, WIPO Case 02007-0645

(unauthorized use of a domain name that includes the identical trademark to create initial interest confusion does not constitute a legitimate interest).

5. In view of Travelocity's extensive use of its unique TRAVELOCITY Marks for years, and the fact that Respondent has no rights in the TRAVELOCITY Marks. Complainant reasonably believes that Respondent has registered and is using the disputed domain name not for any legitimate noncommercial or fair use purpose, but rather to profit from the traffic generated through the disputed domain name. Such use of the disputed domain name does not constitute a legitimate, bona fide offering of goods or services. See Madonna C'iccone, plkla Madonna v. Dan Parisi and "Madonna.com," WIPO 02000-0847 ("Use which intentionally trades on the fame of another cannot constitute a 'bona fide' offering of goods and services. To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy.").

On the other hand, the Respondent has failed to provide any information in support of the contention that the Respondent has a legitimate interest in the Disputed Domain Name.

The contention of the Complainant that the Respondent would have been aware at the time of registration of the Disputed Domain Name of the existence of the trademarks, goodwill and the domain name of the Complainant <travelocity.com> is supported by the popularity of said trademarks, goodwill and domain name. The registered mark incorporated in its entirety in the Disputed Domain Name is a somewhat distinctive mark and there is no information on part of the Respondent that would suggest that the Respondent was not aware of the Complainant's mark at the time of registration of the Disputed Domain Name, particularly given the popularity of the Complainant's mark around the world.

Thus the Panel finds that the Respondent has not been able to provide any information to suggest that the Respondent is commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or tarnish the trademark or service mark at issue. The Panel therefore finds that the Respondent does not have a legitimate interest in the Disputed Domain Name.

IV. Registration and use in bad faith

The Complaint has submitted:

1. The nature of services being provided by the Respondent by using the disputed domain name <travelocity.pk> are the same as those services services offered by the Complainant under its TRAVELOCITY mark, and thus overwhelmingly supports the conclusion that the Respondent registered and is using the disputed domain name in bad faith. It is submitted that the Respondent's bad faith is further exemplified by the fact that it has registered the disputed domain name <travelocity.pk> on February 9, 2008, which is many years subsequent to the adoption and use of the mark TRAVELOCITY by the Complainant. The fame and unique qualities of the TRAVELOCITY mark, and the purpose for which Respondent is using the disputed domain name, makes it extremely unlikely that the Respondent created the disputed disputed domain name independently. See, e.g., The J. Jill Group, Inc. v. John Zuccarini d/b/a RaveC!ub 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 TRAVELOCITY is sufficient. Google v. Abercrombie I. FAO 1 1 1000101579 (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). Indeed, a simple search of the Internet would have quickly revealed Complainant's rights in the TRAVELOCITY marks, particularly as Complainant's TRAVELOCITY services and website had won numerous awards in the travel industry (the very industry in which Respondent has used the disputed domain name) in 2006, 2007, 2008 and thereafter (see Page 6, paragraph 9 supra and Exhibit N).

2. The Respondent has registered the disputed domain name which is identical to the Complainant's well known mark and domain name. In so doing, the Respondent has intentionally attempted to attract commercial gain by misleading the Internet users of the web site and creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website (Policy, paragraph 4(b)(iv)). The commercial gain is evidenced from the fact that besides providing similar services to those of the Complainant, the disputed domain

name <travelocity.pk> contains third party advertisements/links, as shown below, which is likely aimed at commercial gain for the Respondent.

3. 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:

a. At the time of registration of the disputed domain name by the Respondent on February 9, 2008, the mark and domain name "TRAVELOCITY" was well-known and registered in several countries of the world. Therefore, the popularity and registration of "TRAVELOCITY" mark and domain name was a constructive notice to the Respondent on Complainant's rights in the "TRAVELOCITY" mark and name. Thus, the adoption of an identical mark/domain name by the Respondent is in bad faith.

b. The word TRAVELOCITY is a unique invented word which is exclusively referable to the Complainant and the suite of travel services provided by the Complainant. Thus, use of words and domain name www.TRAVELOCITY.pk by the Respondent is clearly to align its business/services with that of the Complainant. The Complainant has made extensive use of the TRAVELOCITY mark for a considerable time, such that the TRAVELOCITY mark has acquired goodwill globally as it has contents that cater to many different age groups, languages and cultures. 4. As previously set out, the Respondent has adopted an identical mark TRAVELOCITY as part of the disputed domain name. The entire business activity of the Respondent is to deceive the innocent trade and public by misrepresenting themselves as part of the Complainant's company or to misrepresent that their activities have been authorised, approved or sponsored by the Complainant. The Respondent has wrongfully registered the disputed domain name to deceive consumers. Thus, from the circumstances. It is plain to see that the adoption of the <travelocity.pk> disputed domain name, which is based entirely on the TRAVELOCITY trademark, was not independent but parasitic and made in bad faith.

The Respondent on the other hand has not provided any information in support of the contention that the Disputed Domain Name has been registered or is being used in bad faith.

The Complainant's contention that the nature of services provided by the Respondent and the Complainant appear to be similar is supported by detailed supporting documents submitted by the Complainant. Moreover, the Complainant has contended that the Respondent created the Disputed

Domain Name despite the famous and distinct nature of mark of the Complainant suggesting that the Disputed Domain Name was not registered independently but with full knowledge and intention to attempt to attract commercial gain by misleading the Internet users of the website and creating a likelihood of confusion with the Complainant's trademark.

Additionally, given the unique nature of the mark incorporated within the Disputed Domain Name and given the extensive popularity of the mark of the Complainant, the Complainant has contended that both registration and use of the Disputed Domain Name is in bad faith.

Thus the Panel finds that the Disputed Domain Name was registered and is being used in bad faith by the Respondent.

WIPO Authorities:

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

7. Decision

Analyzing the details provided by the Complainant, the Panel perceives that the TRAVELOCITY mark has been registered by the Complainant, hence the Complainant reserves crucial interest in such mark. Usage of these marks by the Respondent could endanger the reputation that the Complainant has worked hard at building and maintaining and result in confusion as to the registrant of the Disputed Domain Name.

Taking all of the case law and discussion above into consideration, the Panel concludes and decides that:

1. The Respondent's registration of the Disputed Domain Name is contrary to the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2
2. The Respondent has no legitimate interest in the Disputed Domain Name.
3. The Disputed Domain Name is identical to the Complainant's trademark/names and registered domain names.
4. The Disputed Domain Name was registered and being used in bad faith.

Pursuant to Section 4 of the PKNIC - Internet Domain Registration Policy August 7, 2007 version 4.2, and Section (i) of the Policy, the Panel therefore recommends that PKNIC transfer the registration of the domain name in dispute <travelocity.pk>, as prayed within 48 hours of receipt

of this decision by email or its being uploaded on to DNDRC's website www.dndrc.com/cases_resolved/, whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Mr. Abbas Lotia

Sole Panelist

Date: 12th December 2017