

ADMINISTRATIVE PANEL DECISION

OLX B.V. v. Noor Jahan

Case No. D2017-1699

1. The Parties

The Complainant is OLX B.V. of Hoofddorp, Netherlands, represented by CSC Digital Brand Services AB, Sweden.

The Respondent is Noor Jahan of Karachi, Pakistan, self-represented.

2. The Domain Names and Registrar

The disputed domain names <olxcar.com>, <olxcars.com>, <olxsale.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 4, 2017. On September 4, 2017, the Center transmitted, by email, to the Registrar a request for registrar verification in connection with the disputed domain names. On September 5, 2017, the Registrar transmitted, by email, to the Center its verification response confirming that the Respondent is listed as the registrant for all the disputed domain names and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 6, 2017. In accordance with the Rules, paragraph 5, the due date for Response was September 26, 2017. Two email communications were received by the Center from the Respondent on September 22 and 23, 2017, suggesting a possible settlement with the Complainant. Accordingly, the Center informed the Parties on September 25, 2017, that if the Parties wished to explore settlement options, the Complainant should submit to the Center by October 2, 2017, a request to suspend the present proceeding. On September 28, 2017, the Complainant submitted such a request to the Center by email. In response, the Center notified the Parties on the same day that the proceeding was suspended until October 28, 2017. Shortly after the suspension started, email

exchanges occurred between the Parties. On October 25, 2017, the Complainant submitted a request to the Center to reinstate this proceeding. On October 26, 2017, the Center informed the Parties the proceeding was reinstated. A formal Response was not filed by the Respondent.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on November 16, 2017. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

As reflected in the registration records for the disputed domain names in the public Whois database (a copy of these records appears in Annex 2 to the Complaint), the disputed domain names <olxcars.com> and <olxcar.com> were both registered on September 20, 2012, and will expire on September 20, 2017 and September 20, 2018, respectively; and the disputed domain name <olxsale.com> was registered on September 21, 2012, and will expire on September 21, 2018.

A. The Complainant's OLX Marks (collectively the "OLX Marks")

The Complainant owns various trademark registrations in various countries worldwide for the term OLX (in block letters and also stylized, and with and without an additional design element), which of particular relevance here includes registrations in Pakistan. The Complainant has provided in Annex 6 to the Complaint copies of its registrations for those marks. Salient details of its earliest Pakistani registration are as follows.

OLX (stylized)

Pakistan trademark registration 254718; filed and registered: August 19, 2008

This mark is registered for use in connection with "Online advertising services for others, namely, providing advertising space on internet websites, online advertising on computer communication networks, providing classified advertising space via the global computer network, promoting the goods and services of others over the internet and providing online computer databases and online searchable database featuring classified listing and want ads" in international class 35.

B. The Parties and their Interactions

The Complainant was founded in 2006 in Hoofddorp, Netherlands and started using its mark OLX in commerce that year.

The Complainant, through various member companies, currently operates online classified websites in over 40 countries, including Pakistan. These sites enable users to: buy and sell goods, including vehicles, real estate, tickets and electronics; solicit and offer various services; design ads to post on the Complainant's website; display ads on profiles across social networking sites, such as Facebook; and search for jobs across numerous locations and industries. A screen shot of the home page of the Complainant's website at <olx.com> appears in Annex 10 to the Complaint with further details of the Complainant's business appearing in Annex 13 to the Complaint. Cumulatively, the Complainant's services are currently provided in approximately 50 languages. As a result of its activities, the Complainant now provides one of the largest online marketplaces in the world and the largest such marketplace in several countries, including Pakistan, India and Brazil.

The Complainant maintains offices in Buenos Aires, Cape Town, Delhi, Sao Paulo, Rio de Janeiro, Lisbon and New York and operates subsidiaries in Pakistan, Argentina and China. The Complainant, apart from its member companies, promotes its services through its primary website at <olx.com>. In the 30-day period ending August 9, 2017, this website received an estimated 187,036 unique visitors, ranking it, according to the

website activity measurement site Alexa.com (from which a corresponding report appears in Annex 9 to the Complaint) as the 53,852th most popular website worldwide.

Further, the Complainant together with its affiliated company, OLX Inc., has registered, through registrars located in various countries, over 1,000 domain names that incorporate the mark OLX. A list of these names appears in Annex 8 to the Complaint.

Currently, the disputed domain name <olxcars.com> resolves to a parked page which notes "Future home of something quite cool", the disputed domain name <olxsale.com> resolves to another parked web page which merely states in the top left corner in rather fine print "This domain is currently not approved for CashParking." and provides no further content, and the disputed domain name <olxcar.com> resolves to a completely blank web page. Screen shots of the Respondent's corresponding home pages at the time the Complaint was filed appear in Annex 11 to the Complaint. With exception of <olxcar.com> which then resolved to a parking page at the Registrar rather than a completely blank web page, the other two disputed domain names then resolved to the same web pages as they currently do.

The Complainant sent a cease-and-desist email letter to the Respondent on June 26, 2017, with identical copies subsequently sent on July 3, 2017 and July 10, 2017. The Complainant received no response to any of these letters.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that each of the disputed domain names is confusingly similar to its mark OLX.

Specifically, each of the disputed domain names contains the mark OLX to which the word "car", "cars" or "sale" has been appended, with each of those words being incapable of adding sufficient distinctiveness whatsoever to the name to mitigate any resulting user confusion between the name and the Complainant's mark. Furthermore, the Complainant's online classified services in Pakistan encompasses the sale of automobiles, thus the incorporation of the word "car", "cars" or "sale" into the corresponding disputed domain name significantly heightens a potential for confusion to occur among Internet users between the mark and that name.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in any of the disputed domain names pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

The Complainant did not authorize the Respondent to register any of the disputed domain names, nor does the Complainant maintain any relationship, including by sponsorship or affiliation, with the Respondent which permits the latter to use any of the Complainant's OLX Marks including within a domain name.

Further, the Respondent is not known and has never been commonly known by any name or trade name that incorporates the term OLX.

Lastly, as each of the disputed domain names does not resolve to an operational website, the Respondent is merely passively holding the disputed domain names. As such, the Respondent is not using any of the disputed domain names in connection with: a *bona fide* offering of goods or services under paragraph 4(c)(i)

of the Policy or a legitimate noncommercial or fair use, without intent for commercial gain, under paragraph 4(c)(iii) of the Policy.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using each of the disputed domain names in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Specifically, each of the disputed domain names completely incorporates the Complainant's mark OLX and was acquired well after that mark became sufficiently well known in Pakistan in connection with the Complainant's offering of its online classified services in that country. Moreover, as each of the disputed domain names simply appends one of the generic words "cars", "car" and "sale" to the Complainant's mark – each of these words reflecting an aspect of the Complainant's business, it is implausible that the Respondent, located in Pakistan, was not aware of the Complainant and its online activities when it registered each of these names and did not do so for the potential of that name to intentionally exploit the mark for its own benefit by ultimately causing Internet users to be confused, mistaken and deceived into believing that a relationship of some sort existed between the Parties when, in fact, it did not. Consequently, the Respondent's intentional registration of each of the disputed domain names, which all incorporate the mark OLX, reflects bad faith.

Further, each of the disputed domain names resolves to a non-operational website and is being passively held by the Respondent, thus evincing bad faith use.

B. Respondent

Collectively, the Respondent's email communications state the following:

- The Respondent has not used the disputed domain names to damage the Complainant by any means intentionally;
- If the Complainant believes that it has the right to own all domain names containing "OLX", it should register all of them;
- The disputed domain names were purchased for future use;
- The "OLX" in the disputed domain names is shorthand for "online exclusive"; and
- The Respondent has been working on projects associated with the disputed domain names that will go live as early as possible.

In view of the lack of any formal Response, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel decided this proceeding on the basis of the above and the Complainant's undisputed factual allegations, which the Panel finds are not inherently implausible.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that each of the disputed domain names is confusingly similar to the Complainant's mark OLX.

From a simple comparison of each of the names to the Complainant's mark OLX, no doubt exists that each disputed domain name is confusingly similar to the mark. The disputed domain names <olxcar.com>, <olxcars.com> and <olxsale.com> each consists of the term OLX followed by a generic word "car", "cars" or "sale". These words describe a particular good (*i.e.*, automobiles) offered by the Complainant under its mark

or activity (*i.e.*, sales) provided by the Complainant under its mark, and for which the Complainant has acquired significant market reputation, particularly in Pakistan where the Respondent is located. Each of these names also contains the generic Top-Level Domain (“gTLD”) “.com”. The addition of the gTLD is irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It has also become very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name, particularly a Second-Level Domain (“SLD”), to confer requisite and sufficient distinctiveness to the resulting domain name to avoid a finding of confusing similarity. Here, the Respondent’s addition of the word “car”, “cars” and “sale” to the Complainant’s mark OLX to form a corresponding SLD clearly constitutes such a minor variation. See, *e.g.*, *Alstom v. Zahir Khan, Palki Event Inc.*, WIPO Case No. D2017-1124; *SAP SE v. Lakshmi Reddy Bhumireddy and P. Hareesh*, WIPO Case No. D2017-0396; *Compagnie Générale des Etablissements Michelin v. Cameron Jackson*, WIPO Case No. D2016-2392; *Kumfs Brand Limited v. George*, WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; and *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148.

Therefore, the Panel finds that each of the disputed domain names is confusingly similar to the Complainant’s mark OLX. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to any of the disputed domain names under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the Complainant’s OLX Marks and does not have any relationship, affiliation or connection whatsoever with the Respondent.

Further, the Respondent apparently never did and does not now use nor has it ever made (despite its unsubstantiated claims) any demonstrable preparations to use any of the disputed domain names to resolve to an operational website through which it presently does or will make *bona fide* offerings of any goods or services. In that regard, the Panel infers from the lack of any formal Response, that, from the date each of the disputed domain names was originally registered to the present, each disputed domain name merely resolved and continues to resolve to either a parking page or a blank page, thus implying that none have ever resolved to an operational website.

Moreover, the evidence of record clearly reflects that the Respondent is not commonly known by the disputed domain names or the Complainant’s mark OLX. Given the Complainant’s exclusive rights in its mark OLX which in Pakistan predates, by at least some four years, the dates, September 20 and 21, 2012, on which the Respondent originally registered the disputed domain names, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to that of the Complainant – at least for the online classified services provided by the Complainant under its mark and the goods and services which the Complainant and its member companies offer through those online classified services – without interfering with the exclusive trademark rights of the Complainant. See, *e.g.*, *Alstom v. Zahir Khan, Palki Event Inc. and Compagnie Générale des Etablissements Michelin v. Cameron Jackson*,

both *supra*; *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; and *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill; Cummins Inc. v. Jamie Lent*; and *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, all *supra*.

Consequently, the Respondent does not satisfy any of paragraphs 4(c)(i)-(iii) of the Policy and thus has no rights or legitimate interests in any of the disputed domain names under paragraphs 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to each of the disputed domain names, constitutes bad faith registration and use.

The evidence of record does not indicate that the Respondent, from the day it registered each of the disputed domain names in 2012, has ever used that name to resolve to anything other than a parked or blank webpage, let alone to an operational website. This five-year period of passive use, on the record and in the absence of any valid reason justifying such extended non-use, constitutes bad faith use by depriving the Complainant of three opportunities to use its OLX mark in corresponding domain names, hence constituting a pattern of conduct which violates paragraph 4(b)(ii) of the Policy.

Further, the Panel infers, particularly from the lack of any substantive response and the Respondent's very choice of each of the names, that the Respondent was well aware of the Complainant and its mark OLX, the reputation and goodwill which that mark acquired and the exclusive rights which the Complainant held in that mark when the Respondent registered each of the disputed domain names. Yet, the Panel infers, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally registered each name for its potential to ultimately, at some future date, opportunistically exploit that reputation and goodwill of that mark for the Respondent's own commercial benefit by causing Internet users to think that a relationship of some sort exists between the Parties when, in fact, no such relationship then existed, or to sell the disputed domain names to the Complainant.

Consequently, when viewed in its entirety, the Respondent's conduct violates paragraph 4(b)(ii) of the Policy and otherwise clearly constitutes bad faith registration and use.

Thus, the Panel concludes that the Complainant has provided sufficient evidence of its allegations, with respect to each of the disputed domain names to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain names <olxcar.com>, <olxcars.com> and <olxsale.com> are to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: November 30, 2017