

ADMINISTRATIVE PANEL DECISION

Descon Engineering Limited v. Descon Automation Control System LLC,
Malek, Saeed Abdullah Manakher Al Khaily
Case No. DAE2024-0009

1. The Parties

Complainant is Descon Engineering Limited, of Pakistan, represented by United Trademark & Patent Services, United Arab Emirates.

Respondent is Descon Automation Control System LLC, Malek, Saeed Abdullah Manakher Al Khaily, of United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <desconautomation.ae> (the “Domain Name”) is registered with AE Domain Administration (.aeDA).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 10, 2024. On May 10, 2024, the Center transmitted by email to AE Domain Administration (.aeDA) a request for registrant verification in connection with the Domain Name. On May 15, 2024, AE Domain Administration (.aeDA) transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the UAE Domain Name Dispute Resolution Policy for – UAE DRP approved by .aeDA (the “Policy”), the Rules for UAE Domain Name Dispute Resolution Policy – UAE DRP (the “Rules”), and the Supplemental Rules for UAE Domain Name Dispute Resolution Policy – UAE DRP (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on May 21, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was June 10, 2024. Respondent submitted a response on June 10, 2024.

The Center appointed Robert A. Badgley as the sole panelist in this matter on July 2, 2024. 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

Complainant alleges as follows:

“The Complainant is a world renowned leading multinational company based in Pakistan, founded in 1977 and is operating a 30,000 TPA Plant with the largest market share in Pakistan. It is leading in design consultancy, civil design, electrical design, mechanical design and Engineering management with its global presence in many countries covering the GCC (including Kingdom of Saudi Arabia, UAE, Kuwait, Qatar, Oman), Iraq, Pakistan, South Africa & Kenya. In a span of over four decades, the Complainant has expanded its engineering services to the fields of engineering, power, chemicals, construction, maintenance/industrial services, infrastructure, manufacturing and inspecting and testing services along with turnkey solutions and immense expertise in sectors as Oil & Gas, Cement, Power, Hydro Power, Dams/Barrages/ Canals, Fertilizer, Renewable Energy, Sugar, Industrial, Chemical and Petrochemicals. The Complainant is a renowned specialist in EPC, Construction, Maintenance/Industrial Services, Infrastructure, Manufacturing, and Automation & Control projects. It has four major business lines: Engineering, Power, Chemicals and other Lines. It employs over 20,000 employees of more than 29 nationalities and has a reputable presence in the GCC region and over than 9 countries worldwide.”

Complainant asserts that it has registered trademarks for the mark DESCON and other marks containing DESCON. Annexed to the Complaint are copies of several trademark registrations for DESCON, including in countries such as Pakistan (going back to 1980) and United Arab Emirates (going back to 2011). Complainant states that it has operated a licensed firm in the UAE called Descon Engineering since April 1984.

Complainant has owned the domain name <descon.com> since September 3, 1996, and uses that domain name to host its main commercial website.

Annexed to the Complaint are various articles and other documents related to Complainant's activities in the United Arab Emirates and other jurisdictions.

It is common ground that Complainant and Respondent are not related entities.

The Registrar informs that the Domain Name was created on December 22, 2013, and registered – presumably by the Respondent – on December 8, 2023; the Complainant alleges that the Domain Name was registered by the Respondent on July 2, 2002. The Domain Name resolves to a commercial website where Respondent promotes its business. The website bears the header, “DESCON AUTOMATION CONTROL SYSTEM - Solutions for Measurement and Automation Technology.”

Respondent's website bears a logo that does not resemble Complainant's logo. Respondent's site states, in part:

“DESCON TECHNOLOGY LLC is an approved manufacturer in ADWEA group of companies and Abu Dhabi Sewerages Services Company (ADSSC) for control panel integration (Non OEM). The assembly is performed in the state-of-the-art facility in Dubai. Our solutions for instrumentation and automation are mostly used in every industry, at present in dynamic sectors / industry segments in the country as follows.

Potable Water / Waste Water, District Cooling

Oil & Gas

Refineries

Power & Energy

Petrochemical / Chemical

Pumping stations (Water / Waste Water / STP plants / Desalination).”

Respondent asserts that it is “an approved service provider to many utilities and other companies in the UAE, including UAE Government related bodies.”

In its Response, Respondent alleges as follows:

“Respondent has been trading using the ‘DESCON’ (the ‘Sign’) tradename since at least 1994, offering instrumentation and automation process solutions for public utilities and related companies, as well as major industries in the region. The Respondent also assembles various types of control panels, providing sophisticated, tailor-made solutions for control systems.”

“The Respondent's current trade license details are included in Annex 1. Although this shows the ‘issue date’ as 6 February 1999, the Respondent has been trading under their Dubai related entity since 1994. The trade license for the Respondent's Dubai related entity is included in Annex 2. The ‘Descon’ element has been included in the Respondent's registered company name and its trading name since at least 1999 and since at least 1994 through its Dubai related entity, long before it registered the domain name in question, and long before the notice of this dispute. The Respondent is known as ‘Descon Automation’ as the shortened form of its trading name, and examples of purchase orders addressed to the Respondent using the Sign are set out under Annex 3. The Respondent contends that this is clear evidence of its legitimate interests in the domain name, through its long-standing and bona fide offering of services as Descon Automation, a name it is commonly known by.”

“The parties have offered different services for a long period and have co-existed without confusion arising. It must be noted that no evidence of confusion has been brought forward by the Complainant in support of its claims. The Respondent's view is that the parties have peacefully co-existed in the UAE for 30 years. Notably, the Complainant, and two of its UAE based related entities were customers of the Respondent during the period 2009 and for several years thereafter, at least until 2013, providing clear evidence that the parties offered different services, and also that the Complainant has been long aware of the Respondent's legitimate interests and use in the name.”

Annexed to the Response are some purchase orders showing that Complainant had been a client of Respondent (the latter trading as “Descon Trading LLC”) from 2009 to 2013. According to Respondent, Complainant does not offer “control and instrumentation services or assembly of control panels.” That, according to Respondent, is why Complainant had to contract with Respondent for such services.

On June 13, 2022, Complainant's counsel sent Respondent a “Legal Notice” asserting Complainant's rights in the DESCON mark and related rights, and asserting that Respondent's use of DESCON was infringing on Complainant's rights. By letter dated August 13, 2022, Respondent's counsel responded, denying Complainant's allegations and asserting Respondent's longstanding use of DESCON in the United Arab Emirates. Respondent stated that the companies and their marks had peacefully co-existed, that there was no evidence of actual confusion, that Complainant had acquiesced in Respondent's use of DESCON, and that Complainant had even been a client of Respondent.

5. Parties' Contentions

A. Complainant

Complainant submits that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent asserts that it has legitimately been using the Domain Name in connection with its business and trademark, which it has been using for more than 20 years. The details of Respondent's allegations are summarized above in the “Factual Background” section.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

A. Identical or Confusingly Similar

The Panel concludes that Complainant holds rights in the mark DESCON through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to Complainant's mark. The Domain Name entirely incorporates the DESCON mark, and adds the term "automation." Complainant's mark remains clearly recognizable within the Domain Name, notwithstanding the additional word.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] 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 [Respondent] (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 [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In view of the Panel's conclusion (below) that Complainant has failed to establish the essential "bad faith" element required under the Policy for a transfer of the Domain Name, the Panel need not address the issue whether Respondent has any rights or legitimate interests vis-à-vis the Domain Name.

C. Registered or Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration or use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Complainant has failed to carry its burden of proving that the Domain Name was registered and used in bad faith within the meaning of the Policy. Based on the record presented by the Parties here, this appears to be a genuine dispute over competing trademark rights in the United Arab Emirates. Whoever might actually prevail if the Parties' dispute were pursued in a court of law is not for this Panel to say. In any event, this proceeding does not present a clear case of cybersquatting, and is ill-suited to address and resolve the Parties' dispute.

Complainant has not established Policy paragraph 4(a)(iii).

D. Reverse Domain Name Hijacking

Respondent asks the Panel to make a finding of Reverse Domain Name Hijacking ("RDNH") against Complainant, arguing principally that Complainant knew for more than a decade that Respondent was trading in the United Arab Emirates under the name DESCON, and was even a client of Respondent's for several years.

The Panel agrees that this Complaint should never have been brought. The clinching fact for the Panel is the Parties' correspondence between June 2022 and August 2022, outlined above. After receiving Respondent's August 13, 2022 reply to Complainant's June 13, 2022 Legal Notice, Complainant would have been aware of Respondent's longstanding use (28 years) of the name DESCON in the United Arab Emirates, of the fact that Respondent's business name was registered with the government, and of the fact that, for several years, Complainant was even a client of respondent.

After learning the foregoing information about Respondent, Complainant should have known that, whether it still had a viable trademark infringement or other action at law against Respondent (the Panel offers no view on that issue), Complainant clearly had no viable case against Respondent under the Policy. Put another way, after receiving Respondent's communication in August 2022, Complainant should have known that a complaint would be foredoomed and hence should not be pursued.

7. Decision

For the foregoing reasons, the Complaint is denied. The Panel finds that Complainant has engaged in Reverse Domain Name Hijacking.

/Robert A. Badgley/

Robert A. Badgley

Panelist

Date: July 16, 2024