

## **ADMINISTRATIVE PANEL DECISION**

Descon Engineering Limited v. Basu Sil, Descon Automation Control System LLC

Case No. D2024-1964

### **1. The Parties**

The Complainant is Descon Engineering Limited, Pakistan, represented by United Trademark & Patent Services, United Arab Emirates (“UAE”).

The Respondent is Basu Sil, Descon Automation Control System LLC, UAE, represented by Gowling WLG (UK) LLP, UAE.

### **2. The Domain Name and Registrar**

The disputed domain name <desconllc.com> is registered with eNom, LLC (the “Registrar”).

### **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 the Registrar a request for registrar verification in connection with the disputed domain name. On May 10, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant 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” or “UDRP”), 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 May 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 12, 2024. The Response was filed with the Center on June 10, 2024.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on June 17, 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

The Complainant is an engineering and consultancy company established in 1977 under the laws of Pakistan, with headquarters in Lahore, Pakistan and subsidiaries established in UAE since 1984. It appears from documents included in the record that the Complainant's original name was Design Engineering Services and Construction Limited, which was changed in 1982 to the present form, Descon Engineering Limited. Thus, the trade name and mark DESCON is not a dictionary word but a coined term abbreviating the name, "Design Engineering Services and Construction".

The Complainant does business in many other countries, including Saudi Arabia, Kuwait, Qatar, Oman, Iraq, South Africa, and Kenya. The Complainant employs over 20,000 persons and specializes in design and construction in several fields, including automation projects. The Complainant operates a website at "www.descon.com", a domain name that it registered in September 1996.

The Complainant has numerous trademark registrations in several jurisdictions for the word mark DESCON or a figurative logo featuring the name DESCON in stylized letters. These include the following:

MARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE	GOODS OR SERVICES
DESCON (word)	Pakistan	71391	March 18, 1980	Common metals, metal goods used in buildings, etc., IC 6
DESCON (word)	UAE	162585	April 3, 2012	Machines and machine tools; motors and engines (except for land vehicles), etc., IC 7
DESCON (word)	UAE	162584	June 2, 2013	Metals and alloys, building materials, cables and wires, metal hardware, pipes and tubes, etc., IC 6

The record includes a copy of the business license for a subsidiary of the Complainant issued by the UAE Ministry of Economy showing that it was first licensed on June 4, 1984, with the English "business name" "Descon Engineering".

The Registrar reports that the disputed domain name was created on February 7, 2002, and is registered to the Respondent Basu Sil of Descon Automation Control System LLC, showing a postal address in Dubai, UAE and a contact email address using the disputed domain name. The disputed domain name resolves to the Respondent's website, advertising the business of the Respondent, a limited liability company established in Dubai, UAE that has been offering system engineering, testing, and maintenance services for automated control systems in water utilities, oil and gas refineries, and other industry sectors for more than "two decades".

The Response includes a copy of a business license dated March 22, 1994, under the name "Descon Automation Control System". The Response also attaches purchase orders over the years with the names "Descon Trading LLC" and "Descon Automation Control System", including purchase orders and email communications with the Complainant and its subsidiaries in 2009 and 2013.

The Complainant served a notice letter on the Respondent through court process on June 13, 2022, demanding that the Respondent cease using the Complainant's DESCON mark and transfer the disputed domain name. The Parties met but did not agree to a transfer or a co-existence agreement.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its registered DESCON mark, which it incorporates in its entirety. The Complainant asserts that it has prior rights to the DESCON mark and that the Respondent has no permission to use it and is not associated with the Complainant. The Complainant infers bad faith, as the Complainant's mark was already established and in use, internationally and specifically in UAE, in the same line of business, when the Respondent registered and subsequently used the disputed domain name. The Complainant points to several projects in UAE in which the Complainant was involved from 1992-2000, as well as media articles in the UAE and worldwide, supporting the argument that the Respondent would necessarily be aware of the Complainant. The Complainant argues that the disputed domain name was meant to divert Internet users for commercial gain and disrupt the business of a competitor.

### **B. Respondent**

The Respondent does not challenge the Complainant's trademarks but argues that the Parties actually offer different services and have co-existed in UAE for decades, without customer confusion. According to the Respondent, the Complainant does not provide control and instrumentation services or assembly of control panels as the Respondent does, and such services are not mentioned in the Complainant's UAE business licenses. The Respondent is an approved service provider to many UAE government bodies, which the Complainant is not. The Respondent furnishes evidence that two of the Complainant's UAE entities were customers of the Respondent for several years beginning in 2009, without questioning the Respondent's use of the name "Descon". Thus, the Respondent challenges the conclusion that the disputed domain name is "confusingly similar" to the Complainant's mark.

The Respondent argues that it has rights or legitimate interests in using the disputed domain name, as it has been using it for a bona fide business for more than thirty years, a business that it has been licensed to operate in UAE under a "Descon" name. The Respondent has completed over 600 projects in the UAE alone and more in other Gulf countries. The Respondent has been trading under the "Descon" name since 1994 and registered the disputed domain name in 2002, using it to advertise services different from the Complainant's. The Parties share some customers because they offer different services; they do not compete for customers and have done business with each other. Thus, the Respondent has not sought to use the disputed domain name to engender confusion, and there is no evidence of such confusion or disruption of the Complainant.

To the contrary, the Respondent seeks a finding that the Complainant brought the Complaint in bad faith and constitutes an abuse of the administrative proceeding ("reverse domain name hijacking"), as the Complainant was aware of these facts and the Respondent's long-standing use of the disputed domain name in its legitimate business.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that a complainant must demonstrate each of the following:

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

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. For UDRP purposes, the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark (DESCON) for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. This Panel notes that this is not necessarily the same as an analysis of confusing similarity for purposes of establishing an infringement under national trademark law.

Although the addition of other terms (here, the abbreviation “llc”) may bear on assessment of the second and third elements, the Panel finds the addition of such a term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests; Registered and Used in Bad Faith**

The Panel finds that for some twenty years, before notice to the Respondent of the dispute in 2022, the Respondent used the disputed domain name in connection with a bona fide offering of services. [WIPO Overview 3.0](#), section 2.2. Moreover, the record includes email correspondence from 2013 between one of the Complainant’s UAE entities and the Respondent, using the disputed domain name, in connection with the business they conducted together at that time.

Further, the Panel finds that the Respondent has been commonly known by a name closely corresponding to the disputed domain name for over thirty years, as the Respondent has been licensed under a “Descon” name in UAE since March 1994. See [WIPO Overview 3.0](#), section 2.3.

These facts support a conclusion that the Respondent has rights or legitimate interests in the disputed domain name that accrued before the dispute arose, as contemplated by the Policy, paragraph 4(c).

This conclusion would be undermined if there were persuasive evidence that the Respondent selected its company names, under which it has been licensed to do business in UAE in 1994 and has operated commercially since, in order to exploit the Complainant’s DESCON trademark. In that case, this could not be deemed a “legitimate” interest in the disputed domain name for Policy purposes. But the burden of proof here is on the Complainant, and the evidence is hardly conclusive:

- The Respondent does not state why it chose the name “Descon” for its business in 1994 but denies the implication that it was seeking to create confusion by imitating the Complainant. The Respondent furthermore challenges the Complainant’s asserted fame at that time, especially in UAE.

- The Complainant did not have a domain name corresponding to “Descon” until September 1996, two years after the Respondent was established.
- The Complainant did not obtain a UAE trademark registration until 2012.
- The Complaint attaches UAE and international media references to the Complainant, but the earliest date from 2014.
- The Complainant asserts that the Parties are in the “same line of business”, but the Respondent argues persuasively that they are not. The Complainant had a subsidiary with a “Descon” name licensed in UAE since 1984, but the descriptions of pre-1994 UAE projects attached to the Complaint (for piping, fabrication, and maintenance) tend to support the Respondent’s assertion that the Parties do not perform the same services. It appears that the Respondent’s expertise is narrower (in automated control systems) and not historically replicated by the Complainant. In fact, the record shows that in the period 2009-2013, the Complainant’s UAE entities contracted for materials and specialized services from the Respondent. On some occasions, the Parties serve the same clients, but it is not clear that they compete for the same work as the Complainant suggests. There is evidence in the record that the Parties have done business with each other, but there is no evidence in the record of actual customer confusion, intentional or otherwise.

The Panel finds on this record that the Complainant has not demonstrated that the Respondent, more likely than not, set up its business in 1994 under a name imitative of the Complainant’s mark, which was not then registered in UAE, in order to exploit the Complainant’s reputation. Therefore, the Respondent had a legitimate interest in subsequently registering a corresponding domain name, which it maintains to this day for the same business.

Accordingly, the Panel finds that the second and third elements of the Policy have not been established.

### **C. Reverse Domain Name Hijacking**

The Respondent asks for a finding of reverse domain hijacking (“RDNH”). Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at RDNH or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute RDNH. [WIPO Overview 3.0](#), section 4.16.

The Complainant was well aware of the Respondent’s long-term business under the “Descon” name and the corresponding domain name. Indeed, the Complainant’s entities in UAE had done business with the Respondent over a period of several years, long after the Respondent registered and began using the disputed domain name, including corresponding with the Respondent by email using the disputed domain name. The Complainant did not mention these facts in the Complaint or more than cursorily address the obvious impediment to the second element of the Complaint: because the Respondent registered a domain name corresponding to its existing business name, the Complainant would have to demonstrate the probability that the Respondent chose its business name illegitimately in 1994, in an effort to exploit the Complainant’s mark. Yet the Complainant offered little to show that its mark, unregistered in UAE at the time, was nevertheless known to the Respondent and that the Respondent likely targeted the mark when the Respondent set up its company in the UAE in 1994. The Parties have done business together at times over the years since, and it was nearly 30 years before the Complainant decided to characterize the disputed domain name as an instance of cybersquatting. It appears more a case of RDNH, especially at this remove of time. Accordingly, the Panel finds that the Complaint has been brought in bad faith and constitutes an attempt at RDNH.

## 7. Decision

For the foregoing reasons, the Complaint is denied.

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Sole Panelist

Date: June 30, 2024