ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION

Pick n Pay Retailers (Pty) Limited v. Md Ariful Islam
Case No. D2026-2217

1. The Parties

The Complainant is Pick n Pay Retailers (Pty) Limited, South Africa, represented by Adams & Adams Attorneys, South Africa.

The Respondent is Md Ariful Islam, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <picknpay.xyz> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 22, 2026. On May 22, 2026, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 25, 2026, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 27, 2026, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on May 27, 2026.

The Center verified that the Complaint together with the amendment to 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 June 3, 2026. The Respondent sent an email communication to the Center on June 3, 2026, and the proceedings were suspended upon the Complainant's request on June 9, 2026. The proceeding was reinstituted as of July 14, 2026. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2026.

The Center appointed William F. Hamilton as the sole panelist in this matter on August 7, 2026. 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 a South African company and a wholly owned subsidiary of Pick n Pay Limited. The Complainant states it has used the trademark PICK N PAY (the "Mark") in South Africa since 1967. The Complainant operates more than 1,600 stores in South Africa alone, directly employs over 90,000 people, and trades under the Mark in various formats, including PICK N PAY HYPERMARKETS, PICK N PAY SUPERMARKETS, PICK N PAY EXPRESS, PICK N PAY CLOTHING, PICK N PAY LIQUOR, and PICK N PAY PHARMACIES. The Complainant also operates in Namibia, Botswana, Zambia, Mozambique, Nigeria, eSwatini, and Lesotho. In addition to food, grocery, clothing, and health and beauty products, the Complainant sells appliances and electronics, including mobile phones, and offers online shopping and delivery through its "PICK N PAY ASAP!" mobile application. The Complainant states its annual turnover grew from ZAR 51.9 billion in 2011 to ZAR 118.6 billion in 2025.

The Complainant is the owner of numerous trademark registrations for PICK N PAY and the PICK N PAY logo, including South African registration No. 2007/27243, filed November 22, 2007; a series of South African design registrations Nos. 2014/13125-13152, filed May 26, 2014, covering classes 2 through 35 (including class 9, which covers mobile telephones); Kenyan registration No. 65923, registered on February 5, 2010; Lesotho registration No. LS/M/2009/00161, registered on May 14, 2009; Mozambican registration no. 14597, registered on June 20, 2009; Zambia registration No. 31/2009, registered on January 15, 2009; and Botswana registration No. BW/M/2010/00035, registered on July 30, 2010 (Annex 4 to the Complaint). . The Complainant is the registrant of the domain names <picknpay.co.za>, registered in May 1997, and <picknpay.com>, registered in September 1998, both of which resolve to the Complainant's official website (Annex 5 to the Complaint).

The disputed domain name <picknpay.xyz> was registered on September 28, 2025 (Annex 1 to the Complaint). At the time the Complaint was filed, the disputed domain name resolved to a website displaying the Mark and offering mobile phones for sale, with a checkout function and a WhatsApp contact number for orders.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the three elements required under the Policy for transfer of the disputed domain name. The Complainant contends that it has statutory and common law rights in the Mark, established through registrations in numerous jurisdictions and through five decades of extensive use, and that the disputed domain name wholly incorporates and is identical to the Mark, with the ".xyz" generic Top-Level-Domain ("gTLD") not distinguishing the disputed domain name from the Mark. The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name because the Complainant has never authorized the Respondent to use the Mark, there is no relationship between the parties, and there is no evidence that the Respondent is or has ever been commonly known by the disputed domain name. The Complainant contends that the Respondent's use of the disputed domain name to resolve to a website displaying the Complainant's Mark in connection with the sale of goods amounts to trademark infringement and passing off under the common law and does not constitute a bona fide offering of goods or services or a legitimate noncommercial or fair use. The Complainant contends that the disputed domain name was registered and is being used in bad faith, on the basis that the Respondent was aware of the Complainant's rights in the Mark at the time of registration, that the Respondent has used the disputed domain name to create a likelihood of confusion with the Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website for commercial gain, and that the Respondent's conduct disrupts the Complainant's business and takes unfair advantage of the distinctive character and repute of the Mark. The Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

The Respondent did not submit a formal Response to the Complaint. In an email communication to the Center dated June 3, 2026, the Respondent stated that the disputed domain name was registered through a lawful, publicly available registration process, and denied any intent to target the Complainant, disrupt its business, or take unfair advantage of the Complainant's trademark rights. The Respondent stated that the website content bearing the Complainant's branding was the work of an unnamed third-party developer and that the Respondent had not been aware that any such material had been used. The Respondent further referred, without supporting documentation, to unspecified remedial action taken after receiving the Complaint. The Respondent expressed willingness to engage in settlement discussions. The proceeding was suspended at the Complainant's request to permit such discussions, but no settlement was reached, and the proceeding was reinstituted. The Respondent did not submit a Response following reinstitution.

6. Discussion and Findings

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements to obtain a transfer of the disputed domain name: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) the disputed domain name has been registered and is being used in bad faith. The Panel addresses each element below in turn.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. 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 Select UDRP Questions, Third Edition ("WIPO Overview 3.1"), section 1.7.

The Complainant has shown rights in respect of a trademark for purposes of the Policy through its registrations for the Mark in multiple jurisdictions, including South Africa, Kenya, Lesotho, Mozambique, and Botswana. WIPO Overview 3.1, section 1.2.1.

The Mark is reproduced in its entirety within the disputed domain name, with only the spaces between the constituent words omitted, as is required by the technical restrictions on domain name syntax. Accordingly, the disputed domain name is identical to the Mark for purposes of the Policy. WIPO Overview 3.1, section 1.7. The gTLD is a standard registration requirement and is disregarded for purposes of this comparison.

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which a respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of proving a negative, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). WIPO Overview 3.1, section 2.1.

The Complainant has established a prima facie case. The Complainant has not authorized the Respondent to use the Mark, there is no relationship between the parties, and there is no evidence that the Respondent is or has ever been commonly known by the disputed domain name. Nor can the Respondent's use of the disputed domain name to resolve to a website displaying the Complainant's Mark, in connection with offering for sale goods within the scope of the Complainant's product categories, be considered a bona fide offering of goods or services. A respondent's offer of goods or services on a website does not of itself establish rights or legitimate interests where, as here, the website gives the false impression that it is the Complainant's own, without any disclosure of the true registrant or its lack of affiliation with the Complainant. Moreover, the composition of the disputed domain name itself carries a high risk of implied affiliation. WIPO Overview 3.1, section 2.5.1.

The Respondent has not rebutted the Complainant's prima facie showing. The Respondent's informal email communication, asserting without supporting evidence that the content of the website was the work of an unnamed third-party developer, does not constitute relevant evidence of rights or legitimate interests in the disputed domain name, nor does it explain why the Respondent selected a domain name reproducing the Mark in its entirety.

Panels have held that the use of a domain name for impersonation, passing off, or other deceptive conduct can never confer rights or legitimate interests on a respondent. WIPO Overview 3.1, section 2.13.1. Having reviewed the record, the Panel finds the Respondent's use of the disputed domain name to impersonate the Complainant precludes any finding of rights or legitimate interests.

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

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. Paragraph 4(b) sets out a non-exhaustive list of such circumstances, but other circumstances may also be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. WIPO Overview 3.1, section 3.2.1.

The Respondent registered the disputed domain name with knowledge of the Complainant's rights in the Mark. This is evident from the wholesale incorporation of the Mark in the disputed domain name and from the Respondent's subsequent use of the Mark, in the same stylization in which it is registered, on the website to which the disputed domain name resolved. WIPO Overview 3.1, section 3.2.2.

By using the disputed domain name to resolve to a website that reproduced the Complainant's Mark and offered for sale goods within the scope of the Complainant's product categories, the Respondent intentionally attempted to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the Mark as to the source, sponsorship, affiliation, or endorsement of the website. This constitutes bad faith registration and use under paragraph 4(b)(iv) of the Policy. Panels have held that using a domain name for impersonation or passing off constitutes bad faith. WIPO Overview 3.1, section 3.4.

The Respondent's email communication offered no explanation for its choice of a domain name that reproduces the Mark in its entirety, and its unsupported assertion that the infringing content was the work of an unnamed third-party developer does not disturb the Panel's finding, particularly as the Respondent offers no account of why a developer unconnected to the Complainant would have built a website replicating the Complainant's mark and offering goods within the Complainant's own product categories. The Respondent's unsubstantiated reference to unspecified remedial action taken after the Complaint was filed does not bear on whether the disputed domain name was registered and used in bad faith in the first instance.

Having reviewed the record, the Panel finds that the disputed domain name was registered and used in bad faith under the Policy. The Panel finds the third element of the Policy has been established.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <picknpay.xyz> be transferred to the Complainant.

/William F. Hamilton/
William F. Hamilton
Sole Panelist
Date: August 21, 2026