

## Decision for dispute CAC-UDRP-104199

Case number CAC-UDRP-104199

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Time of filing 2021-12-01 09:10:11

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Domain names HighlandKiltStore.com

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### Case administrator

Organization Denisa Bilík (CAC) (Case admin)

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### Complainant

Organization Highland Kilt Company LLC

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### Complainant representative

Organization Dimov Internet Law Consulting

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### Respondent

Name adnan younas

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#### OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Name.

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#### IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of U.S. Reg. No. 5,748,766 for the mark HIGHLAND KILT COMPANY (registered May 14, 2019) for use in connection with "tartan fabrics" and "kilts, t-shirts, tartan kilts" (the "HIGHLAND KILT Trademark").

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#### FACTUAL BACKGROUND

Complainant states that it has been using the HIGHLAND KILT Trademark since 2007 and operates a website using the domain name <highlandkilt.com>, which apparently offers for sale kilts, clothing, and accessories.

The Disputed Domain Name was created on November 4, 2020, and, according to the Complaint, is being used in connection with a website offering kilts for sale that copies images of the kilts from Complainant's website. In support thereof, Complainant provided copies of emails from customers who apparently were misled into believing that they had ordered products from Complainant's website when, in fact, they had ordered from Respondent's website.

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that the Disputed Domain Name is confusingly similar to the HIGHLAND KILT Trademark because “the Domain Name consists of three elements ‘HIGHLAND’, ‘KILT’, and ‘STORE’ and the first two of those elements are identical to the first two elements of the trademark ‘HIGHLAND KILT COMPANY’”; “the third element ‘STORE’ of the Domain Name is not distinctive as it merely indicates that the Domain Name is used for the sale of products”; and “the third element is located in the end of the trademark, thus its importance for assessing the confusing similarity between the compared terms is lower.”

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, the Disputed Domain Name “has been used to mislead the users of the Complainant’s website into believing that the website associated with the Domain Name is somehow related to the Complainant’s website”; “Respondent does not have any trademarks corresponding to the Domain Name” and “is not commonly known by the Domain Name”; and “Respondent is not making a legitimate non-commercial 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” because “the Domain Name merely refers to an online store... selling products” indicating that “the Domain Name is used with the intent to misleadingly divert consumers.”

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, “Respondent intentionally attempts to attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website and or the products sold through the Respondent’s website. To mislead Internet users, the Respondent has incorporated the Complainant’s unregistered trademark ‘HIGHLAND KILT’ and the first two elements of the Complainant’s registered trademark in its Domain Name and copied the copyright-protected materials of the Complainant. Since the Complainant and the Respondent operate in the same businesses segment, consumers will likely be misled by the similarity in the trademarks and the photos available on the two websites.”

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#### PARTIES CONTENTIONS

No administratively compliant response has been filed.

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#### RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP).

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#### NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Disputed Domain Name (within the meaning of paragraph 4(a)(ii) of the UDRP).

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#### BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the UDRP).

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#### PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

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#### PRINCIPAL REASONS FOR THE DECISION

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registration cited by Complainant, it is apparent that Complainant has rights in and to the HIGHLAND KILT Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the HIGHLAND KILT Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., “highlandkiltstore”) because “[t]he applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” WIPO Overview of WIPO Overview 3.0, section 1.11.1.

Here, the Disputed Domain Name contains the first two (of three) words of the HIGHLAND KILT Trademark in its entirety plus the word “store”. As set forth in section 1.7 of WIPO Overview 3.0, “where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.” Further, section 1.8 of WIPO Overview 3.0 states: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”

Accordingly, the Panel finds that Complainant has proven the first element of the UDRP.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, the Disputed Domain Name “has been used to mislead the users of the Complainant’s website into believing that the website associated with the Domain Name is somehow related to the Complainant’s website”; “Respondent does not have any trademarks corresponding to the Domain Name” and “is not commonly known by the Domain Name”; and “Respondent is not making a legitimate non-commercial 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” because “the Domain Name merely refers to an online store... selling products” indicating that “the Domain Name is used with the intent to misleadingly divert consumers.”

WIPO Overview 3.0, section 2.1, states: “While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant’s documented out-of-pocket costs directly related to the domain name; or (ii) the registrant 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 the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant’s website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the registrant’s website or location or of a product or service on the registrant’s website or location.

Based upon the (unrefuted) evidence provided by Complainant, customers have been misled into believing that they had ordered products from Complainant's website when, in fact, they had ordered from Respondent's website. As set forth in section 3.1.4 of WIPO Overview 3.0, such "actual confusion" is evidence of bad faith, as is "redirecting the domain name to the complainant's (or a competitor's) website."

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **HIGHLANDKILTSTORE.COM**: Transferred

## PANELLISTS

Name	Douglas M. Isenberg
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DATE OF PANEL DECISION 2021-12-29

Publish the Decision