

Decision for dispute CAC-UDRP-104657

Case number	CAC-UDRP-104657
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Time of filing	2022-06-28 09:12:18
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Domain names	kiwi-avia.com
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Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	Kiwi.com s.r.o.
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Respondent

Name	Tufano Marco
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

In this proceeding the Complainant relies on the following trademarks:

- The US trademark "KIWI.COM" (word) No. 5268315, registered on August 22, 2017;
- The UK trademark "KIWI.COM" (figurative: word and device) No. UK00915321888, registered on September 1, 2016;
- The EU trademark "KIWI.COM" (figurative: word and device) No. 15321888, registered on September 1, 2016;
- The EU trademark "KIWI.COM" (word) No. 15218472, registered on August 4, 2016;
- The Czech trademark "KIWI.COM" (word) No. 355177, registered on August 24, 2016;
- The Czech trademark "KIWI.COM" (figurative: word and device) No. 355226, registered on August 24, 2016.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant provides reservation of air transportation, reservation of seats for travel, air passenger travel and similar services and its trademarks are protected for services in classes 35, 39 and 42 of the Nice classification. The main website of the Complainant is www.kiwi.com.

The Complainant has registrations for the “KIWI.COM” marks referred to above and it also provided details of its company registration in the Czech Republic.

The Complainant claims that it uses the marks and names “kiwi” and “kiwi.com” in relation to products and services on the market related to such areas as IT and carriage services and such marks are known to relevant consumers.

The Complainant contends the disputed domain name is confusingly similar with the Complainant’s “KIWI.COM” trademarks with the addition of the postfix “avia” which does not change the overall perception of the disputed domain name.

The risk of confusion is exacerbated by the content of the website by the disputed domain name including use of the Complainant’s logo, a reference and link to Complainant’s own website www.kiwi.com and false claims of affiliation with the Complainant.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant claims that the Respondent does not have any trademark rights or any other rights in respect of the disputed domain name or any business relationship with the Complainant.

The Respondent has purposefully selected the disputed domain name due to its confusing similarity with the Complainant’s marks and the Respondent does not provide any bona fide services under the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant alleges the disputed domain name has been registered and used for the purpose of imitating the Complainant and its website to create an online scam with the goal to achieve a financial profit.

The website by the disputed domain name has a similar design with the Complainant’s own website, contains the Complainant’s logo, Complainant’s company registration details and a link to Complainant’s own site.

The internet users can be easily confused by visiting the website by the disputed domain name and could provide their personal information to the Respondent. This can constitute fraudulent behaviour, which can result in a commercial gain of the Respondent.

The Complainant claims the disputed domain name was registered and being used in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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 Policy).

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 Policy).

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 Policy).

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.

Language of the Proceeding

The Panel needs to address the issue of the language of this proceeding.

According to the Registrar's verification the language of the registration agreement is Russian.

The Complainant in its submissions has asked to proceed in English based on the following:

- The Complainant cannot communicate in Russian and conducting the proceeding in Russian would increase its costs;
- The Respondent can communicate in English as the website by the disputed domain name is in English; and
- Conducting this proceeding in English is necessary to make the proceeding fair to both parties and not to disadvantage the Complainant.

Under par. 11 (a) of the UDRP Rules unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Panel needs to provide the balance of interests of both parties to the proceeding and provide them with a fair opportunity to present their case and at the same time to ensure that the administrative proceeding takes place with due expedition.

The Panel notes that the website by the disputed domain name is in English. According to the Registrar's verification response the Respondent is based in Spain and has no apparent connection to Russia.

The Respondent failed to respond and challenge the change of the language of the proceeding.

As noted in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement and such scenarios include inter alia:

- (i) evidence showing that the respondent can understand the language of the complaint,
- (ii) the language/script of the domain name particularly where the same as that of the complainant's mark,
- (iii) any content on the webpage under the disputed domain name, potential unfairness or unwarranted delay in ordering the complainant to translate the complaint and
- (iv) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement (see par. 4.5.1).

The Panel finds the circumstances above are present in this proceeding, namely the Respondent appears to understand English based on the content of the website by the disputed domain name.

Both script of the disputed domain name and content of the website by the disputed domain name (content is entirely in English) indicate that the Respondent understands English.

The fact that the Respondent is based in Spain, whereas the Complainant is from the Czech Republic makes English a proper and fair choice as the language of this proceeding. It is the language both parties can understand and use for communication.

Based on the above the Panel agrees with the Complainant and decides to proceed in English.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar with Complainant's trademark

The Complainant owns "KIWI.COM" trademark registrations effective in various jurisdictions, including the EU.

As confirmed by WIPO Overview 3.0, see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain name fully incorporates the word trademark/ word element of the figurative marks of the Complainant with the addition of the "avia" element that can be seen as descriptive of Complainant's business related to reservation of airplane tickets and air passenger travel services.

As stated in WIPO Overview 3.0 "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" (see par. 1.8).

In the present case, the Complainant's word trademark (word element) is included in the disputed domain name with a descriptive element added and the trademark is recognizable within the disputed domain name.

The "avia" element does not eliminate confusion and may even be seen as increasing a risk of confusion as it refers to Complainant's services.

The gTLD ".com" is to be disregarded under the confusing similarity test as it does nothing to eliminate confusion.

In this particular case <.com> gTLD is actually a part of Complainant's trademarks ("KIWI.COM").

By choosing the <.com> gTLD suffix the Respondent actually adds more to the confusion with the Complainant's mark.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

- (i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and
- (ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see *Julian Barnes v. Old Barn Studios*, WIPO Case No. D2001-0121; *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. D2004-0110 and CAC Case No. 101284.

According to the whois data the disputed domain name was registered on January 11, 2022 and currently resolves to a website containing Complainant's logo and reference to the Complainant's own website www.kiwi.com in the left-hand upper corner, Complainant's company registration details and the following statement:

"SOLUTION FOR COMPANIES.

Request a discount

You can get a discount on tickets for your employees. Enter your e-mail and we will contact you".

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules).

Based on the evidence available in this dispute the only purpose of the website by the disputed domain name seems to imitate and impersonate the Complainant.

This cannot create any rights or legitimate interests of the Respondent.

As noted by WIPO Overview 3.0 "the use of a domain name for illegal activity (e.g., impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent" (see par. 2.13.1 of WIPO Overview 3.0 and see also UDRP cases illustrating this principle, e.g. CAC Case No.102256 "the Respondent utilized the Complainant's trademark and reproduced the look and feel of one of the Complainant's websites, giving the appearance that the Disputed Domain Name is directly related to the Complainant" and CAC Case No.102136 – "Such use of the disputed domain name does not constitute the bona fide use and there is no legitimate interest in creating an association in visitors' minds with the Complainant...").

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see par. 3.1 of WIPO Overview 3.0).

Targeting is important in establishing bad faith under UDRP.

The Panel finds the present dispute is precisely a case of bad faith registration and use as envisaged by UDRP based on the following:

- 1) The disputed domain name was registered years after registration of the Complainant's trademarks;

- 2) There is direct evidence of Respondent's targeting of the Complainant confirmed by the use of the disputed domain name and use of both Complainant's logo and trademarks on the Respondent's website, direct references to the Complainant and a link to Complainant's own website;
- 3) False claims of affiliation or endorsement of Respondent's website by the Complainant, e.g. by placing Complainant's company registration details such as Complaint's company name, address and company registration number;
- 4) The Respondent's failure to respond in this proceeding; and
- 5) Totality of facts and circumstances of this dispute demonstrate both Respondent's awareness of the Complainant's "KIWI.COM" trademark and Respondent's intent to take an unfair advantage of the trademarks of the Complainant and targeting of the Complainant.

As noted above, the Respondent attempts to impersonate the Complainant by both choosing the disputed domain name coupled with a descriptive term "avia" and by putting relevant content on his website indicating targeting of the Complainant and Respondent's intent to profit from Complainant's trademarks.

Impersonation is one of the instances of bad faith and as noted in WIPO Overview 3.0 "given that the use of a domain name for per se illegitimate activity can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith. Similarly, panels have found that a respondent redirecting a domain name to the complainant's website can establish bad faith insofar as the respondent retains control over the redirection thus creating a real or implied ongoing threat to the complainant" (see par. 3.1.4 and also numerous relevant UDRP cases such as CAC Case No. 101949, CAC Case No.102256 and CAC Case No. 103829 – "The Respondent is therefore unduly impersonating the Complainant and is seeking to create a misleading impression that the disputed domain name and the website that it resolves to are operated by, or otherwise affiliated with, the Complainant").

The Panel finds that Respondent's registration and use of the disputed domain name fall within the bad faith scenario described in 4 b (iv) of UDRP, namely to attract, for commercial gain, Internet users to the website corresponding to the disputed domain name, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such web site or location or of a product or service on such web site or location.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **KIWI-AVIA.COM**: Transferred

PANELLISTS

Name	Igor Motsnyi / Mocni Konsalting doo
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DATE OF PANEL DECISION	2022-07-23
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Publish the Decision