Decision for dispute CAC-UDRP-102883

Case number	**CAC-UDRP-102883**
Time of filing	**2020-02-05 09:54:20**
Domain names	**KIKOMILANO.BLOG**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Kiko S.p.A.**

Complainant representative

Organization	**Perani Pozzi Associati**

Respondent

Name	**Yong Sik Choi**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registrant of the international trademark registration No. 733058, “KIKO”, registered on March 24, 2000, in class 3, and of the EU trademark registrations No. 001141126, “KIKO”, registered on May 15, 2003, in class 3, and No. 014575443, “KIKO MILANO”, registered on January 11, 2016, in class 3.

The disputed domain name was registered by the Respondent on July 8, 2019.

FACTUAL BACKGROUND

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

The Complainant states that it is an Italian company, established in 1997, which operates in the field of professional makeup and of face and body treatments.

The Complainant points out that it has a network of over 1000 single-brand stores bearing the "KIKO" trademark, including Italy, Germany, France, Portugal, Spain, England, Austria, Switzerland, Holland, Belgium, Poland, USA, Hong Kong, Turkey, Sweden, Russia, Brazil, India, UAE, Qatar, Lebanon and Kuwait.

The Complainant adds that it is also present online by the e-commerce website at www.kikocosmetics.com.

The Complainant considers that the trademark "KIKO" is well-known, as it can be assumed from the remarkable sales on the above-mentioned e-commerce website, from the number of fans on its official pages on social networks such as Facebook and Instagram, as well as from the number of followers of its official YouTube page.

The Complainant underlines that "KIKO" often appears in newspapers, renowned magazines, advertising, posts on social media, at national and international level.

The Complainant submits that it is also the owner, among others, of the following domain names: "KIKOMILAN.COM", "KIKOMILAN.IN", "KIKOMILANO.CO.UK", "KIKOMILANO.TOP", "KIKOMILANO.ES", "KIKOMILANO.SHOP", "KIKOMILANO.GR".

The Complainant argues that the disputed domain name is identical to the Complainant's trademark "KIKO MILANO" because it exactly reproduces the trademark "KIKO MILANO", while it is confusingly similar to the trademark "KIKO", since it includes the trademark "KIKO" with the mere addition of the term "MILANO".

The Complainant observes that 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.

The Complainant considers that the Respondent has no rights in the disputed domain name.

The Complainant states that:

- nobody has been authorized or licensed by the Complainant to use the disputed domain name;

- the disputed domain name does not correspond to the name of the Respondent, who is not commonly known as "KIKOMILANO";

- it does not find any fair or non-commercial use of the disputed domain name.

The Complainant considers that the disputed domain name has been both registered and used in bad faith by the Respondent.

The Complainant argues that, given that its trademarks "KIKO MILANO" and "KIKO" are distinctive and well known all around the world, the fact that the Respondent has registered a domain name that is confusingly similar to them indicates that the Respondent had knowledge of the Complainant's trademarks at the time of registration of the disputed domain name.

The Complainant adds that if the Respondent had carried out even a basic Google search for "KIKO MILANO" and "KIKO", the same would have yielded references to the Complainant.

The Complainant observes that the disputed domain name is not used in connection with a bona fide offering of goods or services.

The Complainant considers that there are circumstances indicating that the Respondent has registered or acquired the disputed 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 the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name.

The Complainant notes that many UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use.

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.

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(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.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership, among others, of the registered trademark "KIKO MILANO", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark only by the addition of the top-level domain ".BLOG".

It is well established that merely adding a top-level domain to a trademark is not sufficient to distinguish a domain name from a trademark (see, for example, CAC Case No. 100831).

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- the Respondent has nothing to do with the Complainant;

- the Respondent has no license or authorization to make any use of the disputed domain name;

- the Respondent is not commonly known by the disputed domain name;

- the Respondent is not using for any fair or non-commercial use the disputed domain name.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any

use in connection with a bona fide offering of goods or services. Indeed, the disputed domain name is not used in any active website.

Taking into account that the Respondent is not commonly known as the disputed domain name, that the Respondent has no connection with the Complainant, that the Complainant has not authorized the Respondent to make any use of the disputed domain name, that the disputed domain name is not used in any active website, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] 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 Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] 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 Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

The Panel observes that it is well established that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative. Therefore, even where a complainant is not able to demonstrate the literal application of one of the above-mentioned scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behaviour detrimental to the complainant’s trademark would also satisfy the complainant’s burden.

Taking into account the distinctiveness and reputation of the trademark “KIKO MILANO” also recognized by other Panels, the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark “KIKO MILANO” when registering the disputed domain name. Other panels considered that knowledge of a corresponding mark at the time of the domain name’s registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and the Panel share this view.

The fact that the disputed domain name is not currently used does not prevent a finding of bad faith (see, for example, WIPO

Case No. D2018-1264). Previous panels have indeed confirmed that the prerequisites under paragraph 4(a)(iii) of the Policy can be met under the doctrine of passive holding, giving close attention to all circumstances of the Respondent's behaviour (see, for example, WIPO Case No. D2000-0003).

Without the need to assess whether paragraph 4(b)(i) of the Policy is applicable to the present case, the Panel, having taken into account the distinctiveness and reputation of the Complainant's trademark, the fact that no response to the Complaint has been filed, and the passive holding of the disputed domain name, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **KIKOMILANO.BLOG**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2020-03-09

Publish the Decision