Decision for dispute CAC-UDRP-102905

Case number	**CAC-UDRP-102905**
Time of filing	**2020-02-13 11:47:41**
Domain names	**kikocosmetics.ltd**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

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

Complainant representative

Organization	**Perani Pozzi Associati**

Respondent

Name	**Ayed Alotaibi**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks bearing the words “KIKO COSMETICS” and “KIKO” in several countries, such as:

- International trademark registration n. 1018064 “KIKOCOSMETICS”, granted on September 10, 2009 and duly renewed, in connection with class 3, also covering Australia, Egypt, Croatia, Iran, Norway and Oman;
- Italian trademark registration n. 302009901754308 “KIKOCOSMETICS”, filed on July 28, 2009, granted on December 3, 2009 and duly renewed, in class 3;
- Canadian trademark registration n. TMA788154 “KIKOCOSMETICS”, filed on September 14, 2009, granted on January 20, 2011 and duly renewed, in classes 3 and 35;
- International trademark registration n. 733058 “KIKO”, granted on March 24, 2000 and duly renewed, in connection with class 3;
- EU trademark registration n. 001141126 “KIKO”, applied on April 12, 1999, granted on May 15, 2003 and duly renewed, in class 3.

The Complainant also owns an important domain names portfolio bearing the words “KIKO COSMETICS” and “KIKO”, such as:

KIKOCOSMETICS.COM, KIKOCOSMETICS.STORE, KIKOCOSMETICS.SHOP, KIKOCOSMETICS.MA, KIKOCOSMETICS.NO, KIKOCOSMETICS.CO.NZ, KIKOCOSMET-ICS.ES, KIKOCOSMETICS.CO.UK, KIKOCOSMETICSHOP.COM.

FACTUAL BACKGROUND

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

The Complainant is a popular Italian brand that offers a line of professional makeup and cutting-edge face and body treatments. Established in 1997 by the Percassi family (well-known entrepreneurs), the Complainant is a company which puts innovation, colour and quality at the basis of its business.

The Complainant currently 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. In addition, the online e-commerce address ww.kikocosmetics.com is a point of reference for all the Complainant’s international clients.

The trademark “KIKO” is well-known in the public which is confirmed by remarkable sales on the e-commerce address ww.kikocosmetics.com, as well as by the official pages on social networks such as Facebook and Instagram, which collect over 4 million fans each. The official Youtube page also has around 75.000 followers and hundreds of videos seen by thousands of internet users. Also, “KIKO” is often mentioned in newspapers, renown magazines, advertising, posts on social media, at a national and international level.

The complainant uses, inter alia, the domain name <KIKOCOSMETICS.COM> and its trademarks “KIKO COSMETICS” and “KIKO” for its services and as company name.

The disputed domain name was registered on February 16th, 2019. It does not point to any web site (the server is not available).

There is no doubt the trademark KIKO is well-known among public and this is confirmed by the remarkable sales on the e-commerce www.kikocosmetics.com, as well as by the official pages on social networks such as Facebook and Instagram, which collect over 4 MILLIONS FANS EACH. The official Youtube page also has around 75.000 followers and hundreds of videos seen by thousands internet users.

KIKO is often mentioned in newspapers, renown magazines (such COSMOPOLITAN and GLAMOUR), advertising, posts on social media, at a national and international level: the distribution of this trademark is undeniable and widespread.

Panelists from both CAC and WIPO confirmed that the trademark KIKO shall be protected from domain name infringements, having already issued decision in favour of the Complainant for cases very similar to the present one (see, among others, CAC Case no. 102817, KIKO S.p.a. v. Mao Hui, WIPO Case No. D2019-1263, KIKO S.p.A. v. Whois Privacy Protection Service by onamae.com / Lee Black, WIPO Case No. D2019-1301, KIKO S.p.A. v. Registration Private, Domains By Proxy, LLC / Blake Spencer).

On February 16, 2019, the Respondent registered the domain name KIKOCOSMETICS.LTD.

It is more than obvious that the domain name at issue is identical, to the Complainant’s trademarks “KIKOCOSMETICS” and “KIKO”. As a matter of fact, KIKOCOSMETICS.LTD exactly reproduces the well-known trademark “KIKOCOSMETICS”, while it is also confusingly similar to the trademark “KIKO”, since it includes it with the mere addition of the word term “cosmetics”, the goods commercialized by the Respondent.

As widely known, 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, among other, M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts, WIPO Case No. D2015-1384, <daiwikresorts.com>, Nintendo of America Inc. v. Fernando Sascha Gutierrez, WIPO Case No. D2009-0434, <unlimitedwiidownloads.com> and Hoffmann-La Roche Inc. v. Wei-Chun Hsia, WIPO Case No. D2008-0923, <yourtamiflushop.com>).

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

The Respondent has no rights on the disputed domain name, since WhoisGuard, Inc., LLC has nothing to do with Kiko. In fact, any use of the trademarks “KIKOCOSMETICS” and “KIKO” has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned company to use the domain name at issue.

The domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, WhoisGuard, Inc. is not commonly known as “KIKOCOSMETICS”.

Lastly, we do not find any fair or non-commercial uses of the domain name at stake (as can be seen on the disputed domain name’s home-page).

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The domain name KIKOCOSMETICS.LTD was registered and is used in bad faith.

The Complainant’s trademarks “KIKOCOSMETICS” 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 trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wordings “KIKOCOSMETICS” and “KIKO”, the same would have yielded obvious references to the Complainant. The Complainant submits, an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant’s trademark on the part of the Respondent. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant’s trademarks. This is a clear evidence of registration of the domain name in bad faith.

In addition, the disputed domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that the Respondent has registered or 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 Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

The disputed domain name is not used for any bone fide offerings, even if it is not connected to any web site, by now. In fact, countless 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 (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, enclosed as Annex F, and also the panels’ consensus view on this point, as reflected in the “WIPO Overview of WIPO Views on Selected UDRP Questions” at paragraph 3.2.).

In particular, the consensus view of WIPO UDRP panelists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in circumstances in which, for example, a complainant’s mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the complainant’s trade mark rights.

As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademarks. For what

concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant's trademarks and that results so similar to the Complainant's domain names currently used by the latter to sell makeup products and similar goods.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc.).

Even excluding any possible illicit use of the domain name in the present case, anyway we could find no other legitimate use of KIKOCOSMETICS.LTD. The sole further aim of the owner of the domain name under consideration might be to resell it to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to par. 4(b)(i) («circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name»).

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

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

As the Respondent did not file an administratively compliant Response, pursuant to paragraph 14(b) of the Rules, the Panel may draw such inferences therefrom as it considers appropriate. Thus, the Panel accepts the contentions of the Complainant as admitted by the Respondent.

A. The disputed domain name is confusingly similar to the trademarks “KIKO COSMETICS” and “KIKO” of the Complainant.

The Complainant has, to the satisfaction of the Panel, shown that it has valid rights in the trademarks “KIKO COSMETICS” and “KIKO”.

Indeed, the disputed domain name includes both of the Complainant's trademarks in its entirety. Therefore, the disputed domain name is confusingly similar to the Complainant's registered trademarks “KIKO COSMETICS” and “KIKO”.

Furthermore, the addition of the gTLD suffix “.LTD” is not sufficient to escape the finding that the disputed domain name is identical to the Complainant's trademarks and does not change the overall impression of the designation as being related to the trademark of the Complainant.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of the Policy.

The Complainant has established a prima facie proof that the Respondent has no rights or legitimate interests in the disputed domain name since the Respondent is not a licensee of the Complainant nor has the Complainant granted any permission or consent to use its trademark in a domain name.

Furthermore, the disputed domain name does not correspond to the name of the Respondent and the Respondent is not commonly known as “KIKOCOSMETICS”.

In addition, the disputed domain name does not link to any website. This is an indication that the Respondent lacks rights and legitimate interests in the disputed domain name. There is no evidence for a use of the disputed domain name for any bona fide offer of goods or services or a legitimate non-commercial or fair use.

C. The disputed domain name has been registered and is being used in bad faith within the meaning of the policy.

The Complainant’s trademarks “KIKO COSMETICS” and “KIKO” are well known. Given the distinctiveness of the Complainant's trademarks and their reputation, it can be concluded that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks and for the purpose of either blocking the Complainant from the use of its trademark in an own domain name with the TLD ".ltd" or for the purpose of selling, renting or otherwise transferring the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **KIKOCOSMETICS.LTD**: Transferred

PANELLISTS

Name	**Dominik Eickemeier**

DATE OF PANEL DECISION 2020-03-24

Publish the Decision