

Decision for dispute CAC-UDRP-104767

Case number	CAC-UDRP-104767
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Time of filing	2022-08-03 09:18:01
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Domain names	kiltandkilts.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	Saad Aftab
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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

Complainant states that it has a trademark for the term HIGHLAND KILT COMPANY registered with the US Patent and Trademark Office May 14, 2019, US Reg. No. 5,748,766 in connection with “tartan fabrics” and “kilts, t-shirts, tartan kilts” (the “HIGHLAND KILT Trademark”). The words “Kilt Company” are disclaimed. Complainant also alleges common law rights dating to 2007 although the Certificate of Registration which it attached to its complaint shows a first use in commerce as December 4, 2015.

FACTUAL BACKGROUND

Complainant states that it has been using the HIGHLAND KILT Trademark since 2007 and that it operates a website using the domain name <highlandkilt.com> that offers for sale kilts, clothing, and accessories. It states further that it had a recent encounter with Respondent in a UDRP proceeding for the domain name <highlandkiltstore.com>: Highland Kilt Company v. adnan younas, CAC 104199 (ADR.eu December 29, 2021) (the “Highland Kilt Store” case). Respondent did not appear in that case and, as the Panel in that case found that the evidence supported cybersquatting, it issued a decision awarding Complainant the Disputed Domain Name.

In this case, Complainant alleges that <kiltandkilts.com> is confusingly similar HIGHLAND KILT for several reasons further discussed below. It also contends that “both [the HIGHLAND KILT Trademark and the Disputed Domain Name] contain element(sic) ‘andkilt’” ---the “and” being the three final letters of “Highland.”

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Having prevailed in the Highland Kilt Store case, Complainant alleges in this case that Respondent simply turned around and registered another confusingly similar domain name, <kiltandkilts.com> (hereinafter, “the Disputed Domain Name”). The website to which the Disputed Domain Name resolves offers kilts and accessories under the name of “Highland Kilts Store.” Again, as in the Highland Kilt Store case, the Respondent (according to Complainant) is continuing to use Complainant’s trademark although not in the domain name this time but on its website to sell kilts and accessories.

Complainant contends that Respondent lacks rights or legitimate interests in the Disputed Domain Name in that it has not authorized Respondent to use of the HIGHLAND KILT Trademark, that Respondent is not known by the name of the Disputed Domain Name, and that the “Domain Name merely refers to an online store [. . .] selling products. Furthermore, the Domain Name is used with the intent to misleadingly divert consumers by misleading the customers of the Complaint into believing that the Website is associated with the Complainant’s trademarks.”

Complainant also states that Respondent has copied its copyright protected photographs. It draws from this litany of allegations that Respondent registered the Disputed Domain Name “intentionally attempt[ing] 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.” In short, Complainant alleges that the Disputed Domain Name was registered and is being used in bad faith.

RESPONDENT:

This time around is different, however. Respondent has now appeared to defend its registration of <kiltandkilts.com> with an explanation of its default in the Highland Kilt Store case. It states that it did not know about the UDRP until its website disappeared and it learned about the transfer of <highlandkiltstore.com>. It alleges that it is a Pakistani producer of kilts and accessories. It includes in its Response a copy of a “Taxpayer Profile Inquiry” from the Pakistani Federal Board of Revenue that shows Respondent is a registered business in Pakistan under the name of “Highland Kilt Store” registered July 20, 2020.

The Panel has visited the parties’ websites. They are similar in that both are offering to sell kilts and accessories. The illustrations of kilts are identical or closely so. But the websites are also different in their colors and designs. The word “Highland” in Complainant’s website is a plain word, whereas the same word in Respondent’s website has a figurative design that replaces the letters “igh” in H - - LAND. I will address this issue further below in discussing rights and legitimate interests. With regard to photographs, Respondent states that “As far as Complainant’s claim of copying images is concern, we took those images from open and free source.”

SUPPLEMENTAL SUBMISSIONS

COMPLAINT

Complainant submitted a supplemental submission in which it explains that it “was not able to submit the evidence prior to the respondent’s submission because the complainant was not aware of respondent’s allegations that the respondent is registered in Pakistan and conducts business activities in Pakistan.” Complainant is correct that it could not have known of Respondent’s business filing and its Supplemental Submission is accepted in that connection. The Panel has considered it to the extent that it addresses matters that could not reasonably have been included in Complainant’s initial submission. However, much of the supplemental submission is a repetition of its argument in the complaint and adds nothing new that could not have been said in the complaint.

In summary, Complainant argues that “Despite the allegations that the respondent is registered in Pakistan and conducts

business activities in Pakistan, the respondent has added to his web-site an address in the United States. Thus, the visitors of his website will be misled into believing that the respondent conducts business activities in the United States.” Complainant also states that it is “[m]ost likely [that] at the time of registering the disputed domain name, the respondent was aware of the complainant’s trademark, but decided to register the disputed domain name to benefit from the complainant’s trademark.” Complainant also repeats an allegation in the Complaint that the photographs on Respondent’s website are copyright infringements.

RESPONDENT

Respondent responded to Complainant’s supplemental submission with particularity and is accepted into the record. It states in material part that it is “based in Pakistan but our website is not intended for any specific region or country. Our offering of goods is for all customers around the globe, and this world includes the USA too.” It states that it has a US address for US-based customers and a UK address for UK-based customers. It states that “[b]eing a service provider it helps in reducing the cost and time,” adding that “[b]y adopting this method we tried to facilitate our customers, facilitating customers is not a sin.” Respondent also states that it uses stock photographs.

RIGHTS

For the reasons discussed further below, the Panel finds

1. The Disputed Domain Name <kiltandkilts.com> is not identical or confusingly similar to the HIGHLAND KILT Trademark;

NO RIGHTS OR LEGITIMATE INTERESTS

2. Respondent has demonstrated that it has rights and legitimate interests in the Disputed Domain Name; and

BAD FAITH

3. the Disputed Domain Name was not registered and is not being used in bad faith.

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

- (i) the 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 domain name; and
- (iii) the respondent has registered and is using the domain name in bad faith.

A. Identical or Confusingly Similar, Para. 4(a)(i)

There are two elements to this first requirement: a) that complainant has a trademark, and b) that the Disputed Domain Name is either identical or confusingly similar to that mark. Here, Complainant has demonstrated that it has a trademark for the term HIGHLAND KILT COMPANY. It is also evident from Complainant’s proof that its rights under common law principles for the term HIGHLAND KILT COMPANY precede by several years its USPTO registration. However, this does not help its case. The Certificate of Registration indicates that the words "Kilt" and "Company" are disclaimed, as they must be in that "Kilt" is purely descriptive of the goods Complainant offers and "Company" is simply its corporate form.

Determining whether a disputed domain name is identical or confusingly similar to a complainant’s mark involves a side-by-side comparison of disputed domain name and mark. Here, the domain name is “Kilt and Kilts.” While it contains the word Kilt in both its singular and plural forms the word is “so generic or descriptive that the objective bystander could not responsibly conclude that [it was] evoking the trademark,” *Skycam, Inc. v. Administrator, Domain / Vertical Axis, Inc.*, FA1102001372311 (Forum April 29, 2011); also *Naturalawn of America, Inc. v. Jeff Edwards*, FA1102001372111 (Forum March 16, 2011). The Disputed

Domain name in no way evokes or conjures up the HIGHLAND KILT Trademark. There can be no claim to exclusive rights of terms that others may need to use to describe their goods in the marketplace. The dominant element of the mark is HIGHLAND, not "Highland Kilt."

Complainant attempts to overcome this problem by arguing that "confusion is caused by the use of the words 'HIGHLAND KILT STORE' by the Respondent and by the use of a Domain Name that includes the elements "kilt", "and", and "kilts", all of which (except "s") are included in the Complainant's trademark." The domain name is similar only with respect to the word "Kilt" but Complainant cannot claim monopoly rights to that word. This argument (or at least a part of it) may have been persuasive in the Highland Kilt Store case, but it is not persuasive in this case.

For these reasons, the Panel finds that Complainant has not succeeded on Para. 4(a)(i).

B. Rights and Legitimate Interests, Para. 4(a)(ii)

Complainant nevertheless argues that Respondent lacks rights or legitimate interests. In rebuttal Respondent proffers evidence that as a registered company in the business of producing kilts it has both a right and a legitimate interest. Some of Complainant's argument replicates its claims in the Highland Kilts Store Case. For example, it states that the "Domain Name merely refers to an online store [. . .] selling products." While this may have been the case with <highlandkiltsore.com> it cannot be carried over as an argument for <kiltandkilts.com>.

The Panel finds that Complainant has not presented a prima facie case that Respondent lacks rights or legitimate interests. Rather, Respondent has appeared with a full rebuttal of Complainant's contentions. It is obvious that the parties are competitors. It is equally clear that they are operating in a crowded field. Who would ever have imagined that there are so many companies manufacturing kilts? But so it appears from Respondent's evidence and a review of kilt websites referred to therein.

The UDRP provides in Para. 4(c) three circumstances that if any one of which is present "shall demonstrate your rights or legitimate interests to the domain name for the purposes of Paragraph 4(a)(ii). These are

- (i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are 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.

Respondent has shown that it is a Pakistani company in the business of producing kilts. The fact that its website under the tab "About Us" shows a US address for the sale of its goods and does not identify itself as a Pakistani business is not evidence that it lacks rights or legitimate interests. If the US address is material, it would be Complainant's burden to explain why it is as it relates to the Disputed Domain Name. On the whole, the Panel finds there is no merit to Complainant's theory that because the Disputed Domain Name includes the word "kilt," it must therefore follow that Respondent lacks rights or legitimate interests. First of all, the word "kilt" describes the goods Respondent offers, and secondly Respondent is conducting a business registered in Pakistan that produces kilts.

The Panel finds that the Disputed Domain Name is being used in connection with a bona fide offering of goods or services (Para. 4(c)(i)). Para. 4(c)(ii) (the "commonly known as" defense) does not apply to <kiltandkilts.com>, although based on Respondent's registered business name it might have been persuasively invoked in the Highland Kilt Store case had it appeared and argued its case.

While suspicion is understandable, the Panel has no doubt that Respondent is engaged in a bona fide business in the field of kilts albeit as a competitor of Complainant and that it has a registered business in the name of "Highland Kilts Store." It therefore has both rights and legitimate interests to market its wares through the Disputed Domain Name.

For these reasons, Complainant has not succeeded under Para. 4(a)(ii).

C. Conjunctive Bad Faith, Para. 4(a)(iii)

Complainant argues that "[s]ince the Complainant and the Respondent operate in the same field, the Respondent was likely aware of the Complainant's trademark and registered the Domain Name to prevent the Complainant from reflecting the trademark in a domain name that is confusingly similar to the Complainant's trademark." There are three problems with this argument. The first is that since there are many kilt companies on the Internet offering kilts and accessories it is equally likely that Respondent had no specific knowledge of Complainant, or if it did, that it was simply that it was one of many competitors. The second problem is that the Disputed Domain Name is not identical or confusingly similar to Complainant's mark so it cannot be said that its registration "prevent[ed] the Complainant from reflecting the trademark in a domain name." And third, Complainant has no right to the Disputed Domain Name as it does not reflect its mark.

In contrast to the Highland Kilt Store case in which the disputed domain name was virtually identical to the trademark, here the only identity is with the word "Kilt" which, even if had not been disclaimed "could not be regarded as associated exclusively with the Complainant in the minds of consumers," *Deep Focus Inc. v. Domain Admin, Abstract Holdings, International LTD*, D2018-0518 (WIPO June 6, 2018) (for the name "Cassandra"). Having a trademark comprised in part of a common word that has also been disclaimed does not grant monopoly rights to prevent others from using the alleged offending word.

It is conspicuous that Respondent does not deny knowledge of Complainant, thus it is more likely than not it was actually aware of Complainant but not necessarily of its trademark. The question, though, is at what point in time did Respondent have that knowledge. Certainly, Respondent knew from its after-the-fact examination of the complaint in the Highland Kilt case, but whether it was motivated in the first instance in 2020 to call itself HIGHLAND KILT STORE is in doubt. See *Harvest Dispensaries, Cultivations & Production Facilities, LLC v. Rebecca Nickerson / Rock City Harvest*, FA2004001892080 (Forum June 26, 2020) ("Although the Panel harbors doubts that Respondent would be oblivious to Complainant's position within the cannabis market mere doubt does not satisfy the burden of proof that rests with Complainant."). The resolution of this doubt would require more factual development than is possible in a UDRP action, and in any event, it is irrelevant to the disposition of this claim because the domain name is neither identical nor confusingly similar to Complainant's mark.

Complaint also argues that "the copyright infringement activities of the Respondent and the UDRP case lost by the owner of the domain name HIGHLANDKILTSTORE.COM, it is clear that, before registering the Disputed Domain Name, the Respondent was aware of the Complainant's trademark and website. Furthermore, at the time of registering the Disputed Domain Name, the trademark was publicly available and a potential bona fide registrant of a domain name should have conducted a trademark search." The problem here, first of all, is that the phrase "kilt and kilts" is distinct from HIGHLAND KILT COMPANY despite the "and" and "kilt" words. "Kilt and kilts" does not conjure up or evoke Complainant's mark. It is true that Respondent is a competitor, one of many in a crowded field. It is unnecessary to say more about the alleged copyright infringement contention than it is not a subject for consideration under the UDRP. From the Panel's brief look at kilt companies advertising on the Internet, if Respondent is infringing Complainant's copyright then so too are the other competitors that appear to be using stock photographs of kilts.

There is also the argument that Respondent is using Complainant's trademark on its website, but this suggests trademark infringement not cybersquatting, and this theory too, as with copyright infringement claims is outside the scope of the UDRP. The Panel in *AutoNation Holding Corp. v. Rabea Alawneh*, D2002-0581 (WIPO May 2, 2002) pointed out that "[assertions of trademark infringement are] entirely misplaced and totally inappropriate for resolution in a domain name dispute proceeding because the UDRP Policy applies only to abusive cybersquatting and nothing else"; and *Force Therapeutics, LLC v. Patricia Franklin, University of Massachusetts Medical School*, D2017-2070 (WIPO) (the UDRP "involves a more limited assessment than trademark infringement." The Panel in dismissing the complaint in *Maven Esthetics, LLC v. Diana Roth, The Browtique*, D2021-3499 (WIPO December 18, 2021) stated that "it renders no opinion on the issue whether Complainant may have a viable trademark infringement claim under the federal Lanham Act."

While it is obvious the parties are competitors, the totality of the circumstances before the Panel in this case does not establish that the Respondent registered the Disputed Domain Name in bad faith as that concept is understood under the UDRP; and as

a producer of Kilts for an Internet market neither can it be found that the Respondent is using the Disputed Domain Name in bad faith.

For these reasons, the Panel finds that Complainant has not succeeded on Para. 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

- 1. **KILTANDKILTS.COM**: Remaining with the Respondent

PANELLISTS

Name	Gerald M. Levine, Ph.D, Esq.
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DATE OF PANEL DECISION 2022-09-02

Publish the Decision