

ADMINISTRATIVE PANEL DECISION

Kin, Inc. v. PrivacyGuardian.org / Lisa Elena, VPC
Case No. D2022-1261

1. The Parties

Complainant is Kin, Inc., United States of America (“United States” or “U.S.”), represented by Fross Zelnick Lehrman & Zissu, PC, United States.

Respondent is PrivacyGuardian.org, United States / Lisa Elena, VPC, United States.

2. The Domain Name and Registrar

The disputed domain name <xingyunkohls.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 8, 2022. On April 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 12, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on April 14, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 18, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on April 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 17, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 20, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on June 2, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of

Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Without contest by Respondent, Complainant asserts in its Complaint as amended, and its Annexes attached provide evidence sufficient to support that:

Complainant KIN, Inc., operates more than 1,100 retail stores under the trademark KOHL'S (the "KOHL'S Mark") and since its founding in 1962, has offered moderately priced apparel, shoes, accessories, beauty, and home products under both national brands and brands exclusive to Complainant. The KOHL'S Mark was used by Complainant's predecessor in interest, Maxwell Kohl, as "Kohl's Food Stores" since at least as early as 1951. Complainant also shows that on average over the past five years, Complainant's net annual sales have exceeded USD 18 billion. Complainant claims well-known recognition worldwide of the KOHL'S Mark based on its use for more than 70 years and submits content supporting its claims for such world-wide recognition in the Annexes to its Complaint. For example, the Annex evidence submitted shows that in addition to its physical retail store locations, Complainant sells products through its official ecommerce website, accessed through its domain name <kohls.com> at "www.kohls.com" (the "Official KOHL'S Website") and through its KOHL'S ecommerce app available for download at both the iTunes and Google Play app stores, the Google Play version having been downloaded more than 10 million times. In support of its claim of worldwide fame for the KOHL'S Mark, Complainant also submits evidence that Complainant has more than 14 million followers across its social media channels.

Complainant owns numerous registrations protecting the KOHL'S Mark in the United States and around the world, including:

United States Trademark Registration No. 1,772,009, KOHL'S, registered with the United States Patent and Trademark Office ("USPTO") on May 18, 1993, for services in International Class 42 claiming a first use date of January 1, 1951.

United States Trademark Registration No. 2,047,904, KOHL'S, registered with the USPTO on March 25, 1997, for services in International Class 42 and claiming a first use date as early as August 1, 1962.

China Trademark Registration No. 10927983, KOHL'S, registered April 14, 2015, for services in International Class 35.

Israel Trademark Registration No. 300555, KOHL'S, registered November 4, 2018, for services in International Classes 25 and 35.

Mexico Trademark Registration No. 735147, KOHL'S, registered February 26, 2002, for services in International Class 35.

The disputed domain name was registered on November 22, 2021, and as of December 3, 2021, when Complainant sent a demand letter to Respondent, the disputed domain name redirected all visitors to a copycat website that reproduced the Official KOHL'S Website in its entirety, but it now resolves to a website that has no content.

5. Parties' Contentions

A. Complainant

Complainant contends that the disputed domain name is identical or confusingly similar to Complainant's trademark, that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

There are no exceptional circumstances within paragraph 5(e) of the Rules to prevent this Panel from determining the present dispute based upon the Complaint (as amended), notwithstanding the failure of any person to lodge a substantive formal Response in compliance with the Rules. Under paragraph 14 of the Rules, where a party does not comply with any provision of the Rules, the Panel shall "draw such inferences therefrom as it considers appropriate".

Where no substantive Response is filed, however, Complainant must still make out its case in all respects under paragraph 4(a) of the Policy. To succeed, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied.

Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights and has, therefore, met its burden under paragraph 4(a)(i) of the Policy; and

Complainant has, to the satisfaction of the Panel, shown that Respondent has no rights or legitimate interests in respect of the disputed domain name and has, therefore, met its burden under paragraph 4(a)(ii) of the Policy; and

Complainant has, to the satisfaction of the Panel, shown that the disputed domain name has been registered and is being used in bad faith and has, therefore, met its burden under paragraph 4(a)(iii) of the Policy.

The Panel will address its findings on each of these requirements in more detail below.

The standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

A. Identical or Confusingly Similar

Ownership of a nationally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant claims trademark rights in the KOHL'S Mark for its retail store and mobile app products and services dating back to 1951. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting U.S. and international trademark registration documents in the name of Complainant and therefore, Complainant has demonstrated it has rights in the KOHL'S Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant's rights in the KOHL'S Mark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's KOHL'S Mark.

Prior UDRP panels have held the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks. [WIPO Overview 3.0](#), section 1.8 ("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 also *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); *Wal-Mart Stores, Inc. v. MacLeod*

d/b/a/ For Sale, WIPO Case No. [D2000-0662](#).

The disputed domain name incorporates Complainant's registered KOHL'S Mark in its entirety, minus the apostrophe, with the addition of the word "xingyun," as well as the disregarded ".com" gTLD.

Prior UDRP panels have found typographic differences, such as the inclusion or omission of hyphens and apostrophes, are inadequate to avoid a finding of confusing similarity. See, e.g., *McDonald's Corp. v. Wang*, WIPO Case No. [D2012-0624](#); *L'Oreal v. Tracey Johnson*, WIPO Case No. [D2008-1721](#).

Complainant contends and provides evidence in its Complaint to support that the term "xingyun," is a Chinese word that roughly translates to "lucky" in English and that the addition of such a term does not prevent a finding of confusing similarity. The Panel finds that the added term "xingyun," is meaningless to those people who do not understand Chinese language, and for those who do, the term would be recognized as a descriptive term which would not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), *supra*.

Finally, the Top-Level Domain ("TLD") in a domain name (e.g., ".com", "club", ".co") typically adds no meaning or distinctiveness to a disputed domain name and is viewed as a standard registration requirement; as such it is disregarded under the paragraph 4(a)(i) analysis. Accordingly, the TLD of the disputed domain name here, ".com", does not avoid a finding of confusing similarity. See, [WIPO Overview 3.0](#), section 1.11; see also *Research in Motion Limited v Thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#).

Based on the above, this Panel finds that the added term "xingyun" and omitted apostrophe do not prevent a finding of confusing similarity between the disputed domain name and Complainant's KOHL'S Mark. Complainant's well-known KOHL'S Mark is fully recognizable as it is incorporated in its entirety into the disputed domain name. Accordingly, the Panel finds the disputed domain name confusingly similar to the KOHL'S Mark in which Complainant has rights and Complainant has thus satisfied its burden under Paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, the complainant has to make out a *prima facie* case that the respondent does not have rights to or legitimate interests in the disputed domain name, and if successful the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the dispute domain name. If the respondent fails to come forward with such evidence, a complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also *The American Automobile Association, Inc. v. Privacy--Protect.org et al.*, WIPO Case No. [D2011-2069](#).

Paragraph 4(a)(ii) of the Policy also directs an examination of the facts to determine whether a respondent has rights or legitimate interests in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interests.

The first example, under paragraph 4(c)(i), is where "before any notice to you 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".

Here, the annexes to the Complaint show that while initially the disputed domain name resolved to a blatantly infringing copycat website featuring content copied from Complainant's Official KOHL'S Website, Respondent is currently passively holding the disputed domain name as it resolves to a website with no content. Prior UDRP panels have held that absence of use does not confer any rights or legitimate interests on a respondent. See *Indiamart Intermesh Ltd. v. Yi Zhi Ge, Ge Yi Zhi*, WIPO Case No. [D2019-0930](#). Similarly, prior UDRP panels have also found use of a disputed domain name to resolve to a blank or inactive web page does not represent a *bona fide* use of the disputed domain name. See *Microsoft Corporation v. Charilaos Chrisochou*, WIPO Case No. [D2004-0186](#); [WIPO Overview 3.0](#), section 2.9.

Whether based on Respondent's original copycat site or its current use of a blank or inactive web page,, applying the foregoing decisions to these facts this Panel finds the disputed domain name is not being used in connection with a *bona fide* offering of goods or services sufficient to demonstrate Respondent has any rights or legitimate interests in the disputed domain name under the factors specified by paragraph 4(c)(i) of the Policy.

The second example, under paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant states that there exists no relationship between Complainant and Respondent that would give rise to any license, permission, or authorization by which Respondent could own or use the disputed domain name. Complainant has never authorized Respondent to use the KOHL'S mark, or any marks confusingly similar thereto, for any purpose, including as a domain name. Prior UDRP panels have found a lack of rights or legitimate interests under the second element of the Policy based on such circumstances. See, e.g., *Charles Schwab & Co., Inc. v. Josh Decker d/b/a I GOT YOUR TIX*, WIPO Case No. [D2005-0179](#); *Guerlain S.A. v. H I Investments*, WIPO Case No. [D2000-0494](#).

Complainant also shows that Respondent is not commonly known by the disputed domain name because the original Respondent listed in the Whois record submitted with the initial Complaint displayed "PrivacyGuardian.org" of the United States. The Registrar identified the underlying registrant in its verification process, Lisa Elena, VPC" also of the United States, who has been added via the amended Complaint as a co-Respondent in addition to the original Respondent. Neither Respondent bears any resemblance to the disputed domain name whatsoever. Thus, there is no evidence in this case to suggest that Respondent is commonly known by the disputed domain name, that it is licensed or otherwise authorized to use Complainant's trademark, or that it has acquired any trademark rights relevant thereto. As such, the Panel finds this sub-section of the Policy is of no help to Respondent and the facts presented here support a lack of rights and legitimate interests in the disputed domain name. See *Expedia, Inc. v. Dot Liban, Hanna El Hinn*, WIPO Case No. [D2002-0433](#).

Complainant has met its initial burden as it is generally regarded as *prima facie* evidence of no rights or legitimate interests if a complainant shows that the disputed domain name is identical or confusingly similar to Complainant's trademark, that Respondent is not commonly known by the disputed domain name, and that Complainant has not authorized Respondent to use its mark (or an expression which is confusingly similar to its mark), whether in the disputed domain name or otherwise. See, *Roust Trading Limited v. AMG LLC*, WIPO Case No. [D2007-1857](#); see also *Abbott Laboratories v. Li Jian Fu, Li Jian Fu*, WIPO Case No. [D2016-0501](#).

As to the third and final example under paragraph 4(c)(iii) of the Policy, the Panel finds there is no evidence here that Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish Complainant's trademark. The disputed domain name does not resolve to an active website and therefore there is no *bona fide* offering nor any plausible fair use to which the disputed domain name may be put under the circumstances of this proceeding. See *Verisure Sàrl v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Minh Choi*, WIPO Case No. [D2021-1363](#); see also *Philip Morris USA Inc. v. Zou Yali*, WIPO Case No. [D2014-2164](#).

In light of the above, and with no Response or other submission in this case to rebut Complainant's assertions and evidence, the Panel finds that the facts of this case demonstrate that Respondent has no rights or legitimate interests in the disputed domain name. Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Finally, Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#). Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent. The panel

may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

First, as noted in 6B. above Respondent is passively holding the disputed domain name which resolves to a website with no content. Prior UDRP panels have found under the doctrine of passive holding that the non-use of a domain name that is confusingly similar to a complainant's mark constitutes use in bad faith. [WIPO Overview 3.0](#), Section 3.3.

Complainant also contends that given the KOHL'S mark is immediately recognizable and a well-known trademark. Respondent's use of the KOHL'S mark in its domain name, and unauthorized copycat version of Complainant's website, shows both Respondent's actual knowledge of the KOHL'S Mark and its fame, especially in the U.S. where Respondent is located, and the mark has been in use for decades before Respondent registered the disputed domain name. Prior UDRP panels have found that where, as here, it would be implausible to believe that Respondent selected and was using the disputed domain name for any other purpose than to trade on Complainant's rights and reputation, a fact pattern which repeatedly has been held to constitute bad faith registration and use. See *Houghton Mifflin Co. v. Weathermen, Inc.*, WIPO Case No. [D2001-0211](#); see also *Philip Morris Inc. v. Tsykin*, WIPO Case No. [D2002-0946](#).

Given the widespread recognition of Complainant's KOHL'S Mark in the U.S., where Respondent is located, and over 70 years of use of the KOHL'S Mark prior to Respondent's registration of the disputed domain name in 2022, the ultimate effect of any use of the disputed domain name will be to cause confusion with Complainant and therefore, the use and registration of the disputed domain name must be considered to be in bad faith. See *Embratel v. McCarthy*, WIPO Case No. [D2000-0164](#).

Prior UDRP panels have also held that a respondent's selection of a disputed domain name that comprises the complainant's mark in its entirety demonstrates a respondent's actual knowledge to support a finding of bad faith in registering and using the domain. See, e.g., *Lloyds Bank Plc v. Marc Wiese*, WIPO Case No. [D2015-0914](#); see also, *Heineken Brouwerijen B.V. v Mark Lott*, WIPO Case No. [D2000-1487](#).

The Panel finds Complainant's arguments and evidence persuasive and has received no arguments or evidence from Respondent to the contrary. Considering all the circumstances, the Panel concludes that Respondent has registered and used the disputed domain name in bad faith and Complainant has satisfied paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <xingyunkohls.com> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: June 15, 2022