

## **ADMINISTRATIVE PANEL DECISION**

Miroshnichenko Nikolay Viktorovich v. Abid Ali  
Case No. D2022-1367

### **1. The Parties**

The Complainant is Miroshnichenko Nikolay Viktorovich, Kazakhstan, represented by Brand Monitor Limited Liability Company, Russian Federation.

The Respondent is Abid Ali, Pakistan.

### **2. The Domain Name and Registrar**

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 15, 2022. On April 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 20, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint [together with the amendment to the Complaint/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 the Respondent of the Complaint, and the proceedings commenced on May 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2022. Upon request by the Respondent, the response due date was extended to May 27, 2022 under paragraph 5(b) of the Rules. On May 27, 2022, the Respondent submitted the Response.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on June 9, 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

The Complainant is the founder of a business which is the exclusive distributor of more than 60 professional beauty brands and also professional tools and equipment for beauty salons. The business dates back to the mid-1990s.

According to the Complaint, the exclusive distributorship is for “the CIS and EU countries”. The Respondent appears to dispute this, contending the Complainant operates mainly in Russia and Kazakhstan.

The Complainant says the business has been operating under the name “Nickol” since it commenced. The business has two websites: one at “www.nickol.ru” and the other at “www.nickol.kz”. Both present to the world in Cyrillic characters without an apparent option to view them in English or Roman characters.

The Complainant is the owner of:

- (a) Russian registered trademark number 642764 (the “764 Mark”):



for a range of services in International Class 35 and which was registered on January 23, 2018 with a priority date of March 14, 2016;

- (b) Russian registered trademark number 814519, NICKOL DOING BEAUTY, where “Nickol” is on a rectangular black background and “Doing Beauty” is on a lozenge-shaped pink or flesh coloured background (the “519 Mark”). This trademark is registered from June 7, 2021 with a priority date of November 12, 2019 in respect of a wide range of goods and services in International Classes 5, 10, 35, and 44; and
- (c) an International Trademark Registration, No. 1660589, derived from the 519 Mark, registered on December 17, 2021 designating Kazakhstan and Ukraine.; and
- (d) Kazakhstani registered trademark number 11983 (the “11983 Mark”):

“Никол”

(which the Complainant says is the transliteration of Nickol into Cyrillic) which was registered on June 4, 2001 for goods and services in International Classes 3, 35, 41, and 44.

The Respondent has also noted that the Complainant has a pending trademark application in Ukraine, No. 202130050, for the “Nickol” component of the “Nickol Doing Beauty” trademark, which was filed on December 16, 2021.

According to the Complainant, the disputed domain name was first registered by a third party on August 25, 2003. The Complainant became the registrant on September 27, 2019. The Complainant paid USD 5,194 to obtain the registration. At the time, the Complainant “planned to use [the disputed domain name] for his ‘NICKOL’ business after its rebranding”. From the stationery and marketing examples included in the Complaint, the rebranding appears to have been to adopt “NICKOL” in white letters on a rectangular, black background.

It does not appear, however, that the Complainant launched the planned website. Instead, due to some mix-up with the credit card being used for renewals, the Complainant failed to renew the registration and it lapsed.

On October 6, 2020, the Respondent became the registrant of the disputed domain. It is not clear how much the Respondent paid for the disputed domain name.

The Respondent is a self-described web developer and domain investor. In the Response, he states he holds more than 500 domain names which he offers for sale.

After he secured the disputed domain name, it began resolving to a parked webpage which stated that the disputed domain name is for sale. The Respondent also listed it on the “www.dan.com” website for sale for USD 25,000.

The Complainant discovered the Respondent’s registration of the disputed domain name in May 2021.

Between July 2021 and October 2021, there was correspondence between the parties. In the first of these, the Complainant or his agent offered to buy the disputed domain name for USD 3,000. After the Complainant increased his bid to USD 4,000, the Respondent countered with an offer of USD 8,000. The Complainant then increased his bid to USD 5,000. Ultimately, the Respondent offered to accept USD 7,200 “Buy it now” or USD 7,500 if paid in 12 equal monthly instalments. The Complainant did not accept either offer.

## 5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

### A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the registered trademarks referred to in section 4 above. However, the pending trademark application in the Ukraine does not qualify as trademark rights for this purpose (at least without evidence, of which there is none in the Complaint, of acquired distinctiveness/reputation). See *e.g.* WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.1.4.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the date of the registration or other accrual of the rights, the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See *e.g.*, [WIPO Overview 3.0](#), section 1.7.

The Respondent contends that the disputed domain name is not confusingly similar to the Complainant's trademarks. First, he points out that the 764 Mark is for a device. Secondly, noting the prominent "N & O" element of the 764 Mark, he contends that the word element would be understood as Nick OI.

However, it is usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. Where the textual elements have been disclaimed in the registration or cannot fairly be described as an essential or important element of the trademark, however, different considerations may arise. See for example, [WIPO Overview 3.0](#), section 1.10. The alpha-numeric string "Nickol" is in a smaller font than the initials "N & O". However, it is not so subsidiary that it can fairly be said to be overborne by the initials or otherwise insignificant. So, the Panel will treat the 764 Mark as reading "N & O Nickol (or NickOI).

Secondly, disregarding the ".com" gTLD (see e.g., [WIPO Overview 3.0](#), section 1.11), the disputed domain name consists of the same alpha-numeric string as the "Nickol / NickOL" component of the Complainant's registered trademark.

As explained in [WIPO Overview 3.0](#), section 1.7:

"While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The "Nickol / NickOL" component, however pronounced, is a dominant or essential feature of the 764 Mark being the or an element which a member of the public would be likely to recall and refer to the mark by. As the letters making up the component are the same as the alpha-numeric string in the disputed domain name, therefore, the Panel considers the disputed domain name is confusingly similar to the 764 Mark.

Similarly, the word "Nickol" is the distinguishing feature of the 519 Mark and so the Panel also finds the disputed domain name confusingly similar to the 519 Mark.

The Respondent also disputes that the disputed domain name is confusingly similar to the 11983 Mark which is in Cyrillic characters. The Complainant contends, however, a transliteration of this trademark into English is "Nickol". Accordingly, the Panel finds the disputed domain name is identical or confusingly similar to the 11983 Mark as well. See e.g., [WIPO Overview 3.0](#), section 1.14.

Accordingly, the first requirement under the Policy is satisfied.

## **B. Registered and Used in Bad Faith**

In the circumstances of this case, it is appropriate to consider the third requirement next.

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. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g. *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd.*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

The Complainant contends that, when the Respondent registered the disputed domain name, he should have been aware of the Complainant and its trademark because the Complainant's business, "Nickol", is widely known in its sector and even a cursory investigation by the Respondent would have disclosed the Complainant's official websites. The Complainant also refers to the price at which the disputed domain

name was offered for sale, USD 25,000 which, the Complainant contends, shows the Respondent registered the disputed domain name for the purpose of selling it to the Complainant or his competitors. The Complainant points out that the Respondent is a self-described domain investor who registers domain names to resell them. The Complainant further contends, therefore, that the Respondent should be regarded as engaging in a pattern of abusive registration. In addition, the Respondent as a domainer was bound to make sure that registration of the disputed domain name did not infringe a third party's trademarks.

In support of his claim that his business is widely known, the Complainant submits a Google search showing his two websites were returned "above the fold" on the first page. The search results are in Cyrillic, which may indicate the search was conducted in Russia or Kazakhstan. Otherwise, the Complainant does not provide specific information such as sales volumes or advertising expenditures or website traffic to support his claim that his business is widely known or in which jurisdictions.

In rebuttal, the Respondent denies any knowledge of the Complainant. The Respondent claims he registered the disputed domain name as a short, common name or word, for sale in the ordinary course of his business selling such names.

He claims that "Nickol" is a family or personal name as evidenced by numerous hits on Facebook, Twitter, and LinkedIn. It is also a town or suburb in Western Australia, which features high up the search results for the term. The Respondent contends that the Complainant's business is not well-known, at least outside Russia and Kazakhstan. In support of that claim, he submits Google searches which show that the Complainant and its business are not returned on the first three pages of results in the Respondent's location or in France, Germany, the Netherlands, Romania, or Norway. The Respondent points out that the Complainant's websites are both in Russian with no translation option or English (or any other) language versions.

The Panel accepts that the word "Nickol" is not an inherently distinctive term and appears to be a fairly common name for people and businesses. It does appear to be the type of word which the Respondent registers in the ordinary course of his business. On the evidence before the Panel, it is possible to accept that the Complainant's business has a profile in Russia and Kazakhstan but the evidence falls far short of showing a presence, let alone an extensive reputation, outside those two countries.

Accepting the responsibility of a person engaging in the type of business the Respondent carries on ([WIPO Overview 3.0](#), section 3.2.3), the nature of the term "Nickol" and the Google search results submitted by the Respondent provide support for the Respondent's claim that he was unaware of the Complainant and the Complainant's business when registering the disputed domain name. The contents of the search results do not appear to provide a reason for a person based in Pakistan to search out whether there was a business operating in Russia or Kazakhstan with claims over the word. Nor would those search results have provided a reason to undertake trademark searches in those jurisdictions. Nor would the fact that the Complainant previously held the disputed domain name necessarily assist its case. The process by which the Respondent became the registrant is not clear. However, the Respondent has claimed to have been unaware of the Complainant and its trademark as discussed above. Further, the Complainant does not claim to have used the disputed domain name to host any website, nor does the Internet Archive WayBack Machine show any captures in the period it was held by the Complainant. In other words, when acquiring the disputed domain name, there are no indications apparent in the record that the Respondent would have been on notice of the Complainant's rights or use of the disputed domain name.

The Panel also notes that when the Respondent was approached by the Complainant's agent, the prices the Respondent quoted to transfer the disputed domain name were well below the price advertised on the "www.dan.com" website.

Having regard to these matters, the Panel considers it is not appropriate to go behind the Respondent's denial of awareness of the Complainant's trademark when registering the disputed domain name. Accordingly, the Complaint must fail.

### **C. Rights or Legitimate Interests**

As the Complaint must fail, no good purpose would be served by considering this issue.

### **D. Reverse Domain Name Hijacking**

The Respondent contends that the Complaint has been brought in bad faith and, accordingly, the Complainant should be sanctioned by a finding of reverse domain name hijacking.

Paragraph 15(e) of the Rules provides, in part:

“If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.”

Paragraph 1 of the Rules defines “Reverse Domain Name Hijacking” to be “using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name”.

The fact that a Complaint has failed is not in itself sufficient to warrant a finding of reverse domain name hijacking.

The Respondent contends that the unsuccessful negotiations for the Complainant to obtain a transfer of the disputed domain name show that the Complaint is really just an improper “Plan B” case. See *e.g.*, *BERNINA International AG v. Domain Administrator, Name Administration Inc. (BVI)* WIPO Case No. [D2016-1811](#) and *Reboxed Limited v. Adesoji Adeyemi*, WIPO Case No. [D2021-0886](#).

Bearing in mind that the Complainant does have registered trademarks based on “Nickol” and the offering of the disputed domain name for sale on the “www.dan.com” website for an asking price of USD 25,000, however, the Panel considers this is not an appropriate case for a finding of reverse domain name hijacking. The Respondent has succeeded on the basis of his own personal knowledge and information about the Complainant. In particular, the Respondent’s lack of knowledge or otherwise of the Complainant and his trademark was not objectively apparent from the price which the Respondent advertised the disputed domain name for sale.

### **6. Decision**

For the foregoing reasons, the Complaint is denied.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: June 23, 2022