

ADMINISTRATIVE PANEL DECISION

Basic Trademark S.r.l. and Basic Net S.r.l. v. Fenglan Wang and Client Care,
Web Commerce Communications Limited
Case No. D2023-0479

1. The Parties

The Complainants are Basic Trademark S.r.l., Italy, and Basic Net S.r.l., Italy, represented by Sindico e Associate, Italy.

The Respondents are Fenglan Wang, China, and Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrars

The disputed domain name <kappaindirim.com> is registered with Alibaba.com Singapore E-Commerce Private Limited. The disputed domain name <kappaus.com> is registered with Name.com, Inc. (the “Registrars”). Each disputed domain name is referred to as a “Disputed Domain Name” in this decision and together they are referred to as the “Disputed Domain Names”.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2023. On February 2, 2023, the Center transmitted by email to the Registrars requests for registrar verification in connection with the disputed domain names. On February 2 and 3, 2023, the Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the disputed domain names, which differed from the Respondent Client Care, Web Commerce Communications Limited (who had been identified as “unknown” in the Complaint as originally filed) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 3, 2023, providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on February 7, 2023, and submitted further arguments regarding consolidation of the Respondents on February 14, 2023.

The Center verified that the Complaint together with the amendment to the 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 Respondents of the Complaint, and the proceedings commenced on February 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on March 8, 2023.

The Center appointed Nick J. Gardner as the sole panelist in this matter on March 13, 2023. 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 Complainants are part of the BasicNet Group, which designs and markets clothing, footwear and accessories sold under the brand name KAPPA. The Complainant Basic Net S.r.l. is the operating company within the group whilst the Complainant Basic Trademark S.r.l. is the holder of trademarks within the group. For present purposes nothing turns on the distinction between the two Complainants who are referred to in this decision as "the Complainant".

The Complainant holds various trademarks for the term KAPPA – see for example International trademark registration number 820762 for KAPPA, registered on October 13, 2003, designating multiple jurisdictions, specifying goods in classes 9, 16, 18, 25 and 28. That trademark registration remains current. The Complainant has also registered domain names, including <kappa.com> and <kappa-usa.com>, that it uses in connection with websites where it offers its products for sale.

The Disputed Domain Name <kappaus.com> was registered on August 9, 2022. It resolves to a website (the "Respondents' US Website") which purports to be a website operated by the Complainant and which offers for sale goods which purport to be those of the Complainant. The Disputed Domain Name <kappaindirim.com> was registered on February 25, 2022. It does not presently resolve to an active website but the filed evidence shows that it previously resolved to a website (the "Respondents' Turkish Website") the contents of which were substantially the same as the contents of the Respondents' US Website save that the relevant textual elements were in Turkish rather than English. Photography and layout appears to be substantially identical. The Respondents' US Website and the Respondents' Turkish Website are together referred to as the "Respondents' Websites". The word "indirim" means "discount" in Turkish.

5. Parties' Contentions

A. Complainant

The Complainant says that the proceeding against the two Respondents is appropriate as the Disputed Domain Names are under common control. It mainly relies on the fact that the content of each of the Respondents' Websites is substantially identical (save for the language of the textual elements).

The Complainant says that each of the Disputed Domain Names is confusingly similar to the Complainant's KAPPA trademark. In one case the word "indirim" (meaning "discount") is added. In the other case the geographical designation "us" is added. In neither case do these additional terms distinguish the Disputed Domain Names from the Complainant's trademark.

The Respondents have no rights or legitimate interests with respect to the Disputed Domain Names. The Complainant has never authorized any third party to register any domain names including the KAPPA trademark.

In consequence the Complainant alleges that the Disputed Domain Names were registered and are being used in bad faith. The Complainant says that the Respondents must have known of the Complainant's KAPPA trademark. It says that by using the Disputed Domain Names, the Respondents are intentionally

attempting to attract, for commercial gain, Internet users to the Respondents' Websites, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondents' Websites or of a product or service on the Respondents' Websites.

B. Respondents

The Respondents did not reply to the Complainant's contentions.

6. Discussion and Findings

Preliminary Matters – Multiple Respondents

This is a case which is in formal terms brought against the two Respondents, one for each of the Disputed Domain Names.

A complaint is allowed to proceed with multiple respondents when the domain names or websites are under common control. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 4.11.2 where it states: "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario."

With reference to the above, the Panel agrees with the Complainant that the Disputed Domain Names are likely under common control given that the Respondents' Websites shared substantially the same content and layout (save for textual elements being in different languages). This cannot be coincidental and it is highly likely that both of the Disputed Domain Names are being controlled by a single entity, and thus are subject to common control. See *Eli Lilly and Company v. Darren K. Headley, Tim B. Hartman, Lana D. Cummings, Dante K. Ruiz, Esther G. Roberts, Joey W. Durfee*, WIPO Case No. [D2013-1303](#) and the cases therein cited. Further, the Respondents did not object to the Complainant's request for consolidation of multiple Respondents. The Panel therefore accepts the Complainant's consolidation request.

Preliminary Matters – No Response

The Panel notes that no communication has been received from the Respondents. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondents' failure to file any Response. While the Respondents' failure to file a Response does not automatically result in a decision in favour of the Complainant, the Panel may draw appropriate inferences from the Respondents' default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel in respect of each Disputed Domain Name that:

- (i) each Disputed Domain Name is identical with or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondents have no rights or legitimate interests in respect of each Disputed Domain Name;
- (iii) each Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has rights in the KAPPA trademark. The Panel finds that each of the Disputed Domain Names is confusingly similar to this trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that 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 is normally considered to be confusingly similar to that mark for purposes of UDRP standing (see [WIPO Overview 3.0](#) at section 1.7).

It is also established that the addition of other terms (such as here “indirim” meaning “discount” in Turkish, and “us” being a common geographical designation for the “United States”) to a disputed domain name has little, if any, effect on a determination of confusing similarity between the domain name and the mark; furthermore, the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see [WIPO Overview 3.0](#) at section 1.8).

It is also well established that the generic Top-Level Domain, in this case “.com”, does not affect the Disputed Domain Names for the purpose of determining whether they are identical or confusingly similar to the Complainant’s trademark. See [WIPO Overview 3.0](#) at section 1.11.

Accordingly, the Panel finds that each of the Disputed Domain Names is confusingly similar to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, the respondent’s 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) the respondent has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial 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.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondents to register or use the Disputed Domain Names or to use the KAPPA trademark. The Complainant has prior rights in the KAPPA trademark, which precedes the Respondents’ acquisition of the Disputed Domain Names. The Complainant has therefore established a *prima facie* case that the Respondents do not have any rights or legitimate interests in the Disputed Domain Names and thereby the burden of production shifts to the Respondents to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Names (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondents have failed to produce any evidence to establish their rights or legitimate interests in the Disputed Domain Names. Accordingly, the Panel finds that the Respondents have no rights nor any legitimate interests in the Disputed Domain Names and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

In the present circumstances the fact that the Disputed Domain Names were each linked to the Respondent's Websites which in effect each masqueraded as being an official website operated by or with the permission of the Complainant, leads the Panel to conclude that the registration and use of the Disputed Domain Names have been made in bad faith.

The Panel concludes that the Respondents chose to register a name comprising the Complainant's trademark combined with the descriptive word "indirim" (meaning "discount") or the geographic designator "us" in order to facilitate a scheme where the Respondent's Websites impersonated that of the Complainant and offered for sale products which purported to be those of the Complainant.

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (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; or
- (ii) you have registered the 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.

In the present circumstances, the Panel agrees with the Complainant that the above factor (iv) applies as the Respondent was seeking to achieve commercial gain by in effect impersonating the Complainant. The Panel also notes that the Respondents have not filed a Response and hence have not availed themselves of the opportunity to present any case of good faith that they might have. The Panel infers that none exists.

Accordingly, the Panel finds that the Disputed Domain Names have been registered and are being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 Names, <kappaus.com> and <kappaindirim.com>, be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: March 27, 2023