

ADMINISTRATIVE PANEL DECISION

Tejarat Khalagh Hadaf (PSJ) v. Zahra Kolivand
Case No. DIR2023-0003

1. The Parties

The Complainant is Tejarat Khalagh Hadaf (PSJ), Iran (Islamic Republic of), represented Vindad, Iran (Islamic Republic of).

The Respondent is Zahra Kolivand, Iran (Islamic Republic of), self-represented.

2. The Domain Name and Registrar

The disputed domain name <khanoumi.ir> is registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 5, 2023. On March 10, 2023, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain name. On March 11, 2023, IRNIC 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 satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the "Policy" or "irDRP"), the Rules for .ir Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 15, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was April 4, 2023. The Response was filed with the Center on April 3, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on April 14, 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 Complainant is an Iranian company which, judging from its website at “www.khanoumi.com”, sells a very wide range of cosmetics and personal products.

The Complainant’s Chief Executive Officer owns two registered trademarks in Iran (Islamic Republic of) for a representation of, according to the description of the trademark certificates, the word “khanoumi” in Persian in fantasia:

- (a) Registered Trademark No. 251802, which was registered on July 16, 2016, with effect from March 7, 2016, in respect of “purchasing and selling on the Internet” in International Class 35; and
- (b) Registered Trademark No. 299630, which was registered on April 22, 2018, with effect from February 27, 2018, in respect of services for packing and delivery of goods and developing computer software in, respectively, International Classes 39 and 42.

The Respondent registered the disputed domain name on February 16, 2014. According to the Response, the Respondent has been using the disputed domain name for a website publishing a cultural educational magazine for women of all ages, providing information and advice in the fields of beauty, marriage, cooking, pregnancy, etc., and has a large female audience in Iran (Islamic Republic of). This service has been offered free of charge.

Google Analytics data included in the Response shows that between January 1, 2014, and March 27, 2023, there have been 5,898,219 page views of the website. Other Google Analytics data included in the Response shows that between January 1, 2020 and December 31, 2022, there have been 618,488 page views with 90.7 percent of visitors being new visitors.

According to the Respondent, in the last two years the Complainant has introduced the “Khanoumi Mag”, a magazine available from the Complainant’s website offering articles also in the field of make-up and beauty, fashion and style.

In late December 2022, the Respondent emailed the Complainant and, according to the Complainant, competitors of the Complainant offering to transfer the disputed domain name to them for a price. The website to which the disputed domain name resolves includes notice that the disputed domain name is for sale and the disputed domain name is also offered for sale on domain broker sites.

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; and
- (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 or 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 the Panel 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 two trademarks registered in Iran (Islamic Republic of) identified in section 4 above.

As is usual, it is appropriate to disregard the “.ir” country code Top-Level Domain (“ccTLD”) component of the disputed domain name as a functional aspect of the domain name system. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.11.¹ Disregarding the “.ir” ccTLD, therefore, the disputed domain name consists of the Complainant’s registered trademark in Latin letters.

The Respondent contends, however, that the Complainant’s trademarks are registered in fancy script and pink, not Latin letters and also for very different services than those provided by the Respondent.

This misunderstands the nature of the test under this requirement of the Policy which 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 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.

In applying that visual and aural comparison, it is also well established that a translation of a term will normally be found to be identical or confusingly similar. See e.g. [WIPO Overview 3.0](#), section 1.14. Bearing in mind the Complainant’s registered trademarks are in Persian script and the Respondent’s website is directed principally to an Iranian audience, the Panel finds it is appropriate to apply the normal rule in this case.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is identical to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] 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 [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

¹ In view of the close correspondence between concepts under the Policy and the Uniform Domain Name Dispute Resolution Policy (UDRP), the Panel considers it appropriate to apply the approach under the UDRP under the Policy too.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

In the present case, neither party has suggested that “khanoumi” has any common or dictionary meaning in Persian or any other language. Also, neither party has explained how it came to adopt the word “khanoumi” for its domain name or trademark. It appears from “translate.google.com”, however, that “khanoumi” may be a transliteration of the Persian word for “lady” or “a lady”. If so, the term would appear to be an understandable choice for both parties’ activities.

Further, the Respondent registered and began operating its website from the disputed domain name several years before the Complainant registered the first of its trademarks.

Further still, so far as the evidence before the Panel discloses, the Respondent’s website has garnered a very substantial audience over time. Although it does appear for reasons discussed next that the number of users re-visiting the site over the last two years is low.

The Complainant has not contended that the Respondent registered the disputed domain name in bad faith. The Complainant contends, however, that the Respondent has not published any new content on the website since 2020 and is just using the website now to advertise that the disputed domain name is for sale and offering it to the Complainant’s competitors now that the Complainant’s trademark has become a successful trademark.

The Respondent admits that, having operated the website from her own resources for many years and failing to find new investors, she decided in October 2022 to “sell” the disputed domain name to recoup some of her investment. The Respondent also admits that the amount of content produced on the website over the last two years has been “less than before”. However, the Respondent says that during this time she has continued to offer services through the website including answering users’ questions, programming maintenance and the like. Further, in light of the volume of use over the years, the Respondent contends that considerable value has been generated in the disputed domain name.

In these circumstances, the Panel considers the Complainant has failed to establish that the Respondent lacks rights or a legitimate interest in the disputed domain name.

It appears on the information before the Panel that the Respondent has been providing a service through the website to which the disputed domain name resolves which over time has attracted a significant audience. Given the limited, if any, new activity on the website over the last two years or so, the Panel accepts that there has been a significant falling off in that audience. Nonetheless, there still seems to have been a continuing stream of viewers to the website. The Respondent has some entitlement to seek to turn that value to advantage.

The Respondent’s attempts to “sell” the disputed domain name to the Complainant’s competitors would very likely seem to involve those competitors and potentially the Respondent in infringing conduct, especially if a competitor acquired the disputed domain name and sought to use it in competition with the Complainant. There may be other uses, however, which do not affect the Complainant’s rights. Given the Respondent’s lengthy use of the disputed domain name starting before the Complainant registered its trademarks, therefore, that conduct appears better addressed through the laws of trademark infringement or unfair competition and not under the Policy.

Accordingly, the Panel finds the Complainant has not established the second requirement under the Policy and the Complaint must fail.

C. Registered or Used in Bad Faith

As the Complaint must fail, no good purpose would be served by addressing this requirement.

D. Reverse Domain Name Hijacking

The Respondent contends that the Complaint has been brought in bad faith and, although the Respondent does not put it in this way, appears to be inviting the Panel to sanction the Complainant 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”.

According to the Respondent, changes in the Internet administration in Iran (Islamic Republic of) are under consideration and could lead to use of “.ir” domain names ahead of “.com” domain names. As a result, the electronic card payments processing authority in Iran (Islamic Republic of) appears to have indicated to Iranian companies using “.com” domain names that they should adopt domain names in the “.ir” domain. Therefore, the Respondent contends, the Complainant is trying to obtain the disputed domain name and also unfairly access the Respondent’s audience.

Ordinarily, the Panel would likely find Reverse Domain Name Hijacking in circumstances where a complaint is brought on the basis of trademarks registered well after the respondent registered the domain name in dispute and makes no attempt to show that the respondent was seeking to capitalise on the complainant’s trademark rights, albeit not registered. See e.g. [WIPO Overview 3.0](#), sections 3.8 and 4.16.

Under the Policy and unlike the UDRP, however, it is noteworthy that to make out the third element it is sufficient to show either registration in bad faith or subsequent use in bad faith. That is, the two requirements are disjunctive. Further, as a finding of Reverse Domain Name Hijacking is discretionary, a person seeking an exercise of discretion in their favour should themselves be acting in good faith. In this case, the Panel has found that the Complainant has not established the Respondent does not have rights or legitimate interests in the disputed domain name in circumstances where it appears that the Respondent has been carrying on a legitimate service for a number of years while some of its activities could well give rise to issues better dealt with under trademark law than the Policy. In these circumstances, therefore, the Panel does not consider it appropriate to make a formal finding of Reverse Domain Name Hijacking.

6. Decision

For the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: April 28, 2023