

ADMINISTRATIVE PANEL DECISION

Kiwibank Limited v. Registration Private, Domains By Proxy, LLC / Debit Card Holder, Social Tester International
Case No. D2022-1607

1. The Parties

Complainant is Kiwibank Limited, New Zealand, represented by CSC Digital Brand Services Group AB, Sweden.

Respondent is Registration Private, Domains By Proxy, LLC, United States of America / Debit Card Holder, Social Tester International, New Zealand.

2. The Domain Name and Registrar

The disputed domain name <iwibank.com> (the “Domain Name”) 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 May 4, 2022. On May 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 5, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 Respondent of the Complaint, and the proceedings commenced on May 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 1, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 2, 2022.

The Center appointed Clive L. Elliott Q.C., as the sole panelist in this matter on June 22, 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

Complainant is a New Zealand bank. It was founded in 2002. It was set up as a locally-owned, locally-run bank that would operate in the interest of New Zealanders, with profits staying in the country rather than heading offshore. It was the first New Zealand bank to offer real-time mobile banking. It has become a B Corporation certified company with over one million customers.

Complainant is the owner of a number of trade mark registrations for the name KIWIBANK (“Complainant’s Mark”) including the following:

Trade Mark	Jurisdiction	Registration No.	Registration Date	Class
KIWIBANK	New Zealand	644724	2003.03.03	09
KIWIBANK	New Zealand	644725	2003.03.03	16
KIWIBANK	New Zealand	644726	2003.03.03	35
KIWIBANK	New Zealand	644727	2003.03.03	36
KIWIBANK	New Zealand	644728	2003.03.31	42

Complainant operates through its primary domain name and website linked to it, <kiwibank.co.nz>, registered since July 18, 2001.

According to the publicly available Whois, the Domain Name was registered on May 29, 2020, and resolves to a website featuring links to third-party websites, some of which relate Complainant’s business.

5. Parties’ Contentions

A. Complainant

Complainant relies on the registration of Complainant’s Mark New in Zealand.

Complainant asserts that the Domain Name is confusingly similar to Complainant’s Mark in that it varies from Complainant’s Mark by the purposeful misspelling of Kiwi by the removal of the letter “k”. Complainant claims that this is a prototypical example of typosquatting by Respondent intending to take advantage of Internet users who inadvertently type an incorrect address when seeking to access Complainant’s website.

Complainant states that Respondent is not sponsored by or affiliated with Complainant, and nor has Complainant given Respondent license, authorization or permission to use Complainant’s Mark in any manner. Complainant contends that Respondent is not commonly known by the Domain Name and at the time of filing the Complaint Respondent was using a privacy Whois service.

Complainant further states that Complainant’s Mark is a famous trade mark worldwide and it is unlikely that Respondent did not know of Complainant’s rights in Complainant’s Mark at the time of registration of the Domain Name, which was significantly after Complainant’s registration of Complainant’s Mark in 2003.

Complainant contends that Respondent is using the Domain Name to redirect Internet users to a website featuring links to third-party websites, some of which relate to Complainant’s business. By way of example, the website at the which the Domain Name resolves features multiple third-party links for “open new banking account online”, “apply for instant loan” and “banking account”. As such, Complainant submits that Respondent is not using the Domain Name to provide a *bona fide* offering of goods or services and has registered the Domain Name in bad faith by creating a likelihood of confusion and demonstrated an intent to capitalize on the fame and goodwill of Complainant’s Mark in order to increase traffic to the Domain Name for Respondent’s own pecuniary gain. Further, Complainant claims that Respondent has ignored Complainant’s attempts to resolve this dispute outside of this administrative proceeding, which Complainant’s submits is further evidence of bad faith registration.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

As noted above, Complainant relies on the registration of Complainant's Mark in New Zealand. Complainant also asserts that Complainant's Mark KIWIBANK is a famous trade mark, not just in New Zealand (having been used in that country since 2002) but worldwide. The latter assertion is inconsistent with the submission that Complainant was set up as a locally-owned, locally-run bank that would operate in the interest of New Zealanders. There is no evidence to support the submission that Complainant's Mark is famous worldwide.

Notwithstanding this, the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") records at section 1.2.1 ("Where the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.") The Panel is satisfied that Complainant has the necessary rights to establish this threshold requirement.

Complainant argues that the Domain Name is confusingly similar to Complainant's Mark, being a purposeful misspelling of "Kiwi" by the removal of the letter "k" and that this points to typosquatting. For purposes of this ground the relevant question is whether Domain Name is confusingly similar to Complainant's Mark. The Panel is satisfied that "kiwibank" is sufficiently recognizable in "iwibank" and the dropping of one letter does not detract from the confusingly similar nature of one to the other *i.e. iwibank v kiwibank*. See section 1.8 of the [WIPO Overview 3.0](#).

Accordingly, the first ground under the Policy is made out.

B. Rights or Legitimate Interests

Complainant submits that Respondent is not sponsored by or affiliated with Complainant; nor has Complainant given Respondent a license, authorization or permission to use Complainant's Mark in any manner.

Complainant contends that the Domain Name resolves to a website featuring links to third-party websites, some of which are related to Complainant's business. Complainant provides examples of such alleged use, which include multiple third-party links for "open new banking account online", "apply for instant loan" and "banking account". Complainant submits that this will create a likelihood of confusion. While there is no suggestion that the website with links to third-party websites points consumers to banking and loan services which are not legitimate or *bona fide*, there is no evidence that the website(s) clearly indicate the relationship between Respondent and Complainant. In the absence of such evidence, the Panel takes the view that such use cannot properly be described as a *bona fide* offering of the relevant services.

Further, Complainant argues that Respondent is using the Domain Name in a misleading and deceptive manner and has the intent to capitalize on the fame and goodwill of Complainant's Mark to achieve its own pecuniary gain. Respondent has failed to challenge or refute these allegations. The Panel infers that Respondent is unable to do so and that Respondent's website is being used for improper purposes and that in the present circumstances it does not represent a *bona fide* offering of goods and services or any other legitimate use or interest in the Domain Name.

Respondent has therefore failed to rebut Complainant's *prima facie* case.

The Panel finds that Respondent lacks rights or legitimate interests in the Domain Name.

Accordingly, the second ground under the Policy is made out.

C. Registered and Used in Bad Faith

As noted above, Complainant asserts that the Domain Name resolves to an active website displaying services of the type provided by Complainant and that Respondent seeks to capitalize on the fame and goodwill of Complainant's Mark in order to increase traffic to the Domain Name.

Even though Complainant has not established a worldwide reputation and goodwill, it has provided a foundation for alleging it has a significant goodwill and reputation in New Zealand in relation to banking services. The Registrar confirmed that the Respondent is Debit Card Holder, Social Tester International, of Auckland, New Zealand. While the situation is not entirely clear and limited weight is placed on this issue by the Panel, the Panel infers that Respondent might be based in or have some connection, whether direct or indirect, with New Zealand. As a result, the Panel infers that Respondent is likely to be aware of Complainant and Complainant's Mark. In doing so, the Panel takes into account the fact that Respondent has chosen to remain silent on what is a plainly relevant issue under this ground.

In any event, the Panel is satisfied that in the absence of an attempt to challenge these allegations, the fact that Complainant had registered Complainant's Mark approximately 20 years earlier and that Respondent or those associated with it supply banking services under or by reference to the Domain Name, the Panel finds that the Domain Name was registered and used in bad faith.

Complainant has therefore established the third ground under 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 Domain Name <iwibank.com> be transferred to Complainant.

/Clive L. Elliott Q.C./

Clive L. Elliott Q.C.

Sole Panelist

Date: July 6, 2022