

ADMINISTRATIVE PANEL DECISION

Eastman Kodak Company and Kodak Alaris Inc. v. JT Lincoln Case No. D2023-0252

1. The Parties

The Complainants are Eastman Kodak Company and Kodak Alaris Inc., United States of America (“United States”), represented by Sipara, United Kingdom.

The Respondent is JT Lincoln, United States.

2. The Domain Name and Registrar

The disputed domain name <kodakalarislimited.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 19, 2023. On January 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 20, 2023, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainants on January 26, 2023, providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint. The Complainants filed an amended Complaint on January 27, 2023. The Center received two email communications from the Respondent on January 27, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on January 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2023. The Respondent did not submit a response. The Center notified the Parties of the commencement of the Panel appointment process on February 21, 2023.

The Center appointed William F. Hamilton as the sole panelist in this matter on February 28, 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 Eastman Kodak Company is a global technology company with revenues exceeding USD 1 billion for 2020. The Eastman Kodak Company dates its history to the development of the first successful in-roll film hand camera in 1888. The Eastman Kodak Company owns numerous trademark registrations in the United States and European Union for the trademark KODAK (the “KODAK Mark”), the earliest of which is United States Patent and Trademark Office (“USPTO”) Trademark Registration No. 195,218, dated February 17, 1925. The Eastman Kodak Company currently licenses the KODAK Mark to third parties for selected high quality consumer products. Eastman Kodak Company’s principal website is at “www.kodak.com”.

The Complainant Kodak Alaris Inc. provides digital transformation and artificial intelligence hardware, software, consumables, and services to commercial print, packaging, publishing, manufacturing, and entertainment industries. Kodak Alaris Inc. owns the USPTO Registration for the mark ALARIS No. 5,570,809 (the “ALARIS Mark”), dated September 25, 2018. Kodak Alaris Inc. supports customers in more than 100 countries with office locations in the United Kingdom, Germany, the United States, Mexico, and China. Kodak Alaris Inc.’s principal website is “www.kodakalaris.com”.

The affiliated Complainants, Eastman Kodak Company and Kodak Alaris Inc., may be collectively referred to herein as “the Complainants,” and the KODAK Mark and the ALARIS Mark will be referred to collectively as “the Marks”.

The disputed domain was registered on October 27, 2023. The Respondent’s physical address is California, United States. The disputed domain name originally resolved to a website offering beverages for sale. Annex No. 10. The disputed domain name currently does not resolve to an active website.

5. Parties’ Contentions

A. Complainants

The Complainants assert the disputed domain name is confusingly similar to the Mark because the disputed domain name is comprised of both Marks followed by the suffix “limited” which is a generic term. The Complainants assert that the Complainants never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, never operated a business under the disputed domain name, has not advertised the disputed domain name, and never engaged in any *bona fide* commercial activity in connection with the disputed domain name. The Complainants assert that the Respondent knew or should have known of the Mark with a reasonable investigation and registered and used the disputed domain name in bad faith.

B. Respondent

The Respondent did not submit a formal response to the Complainants’ contentions. Instead, the Respondent sent two email communications to the Center on January 27, 2023.

The first email communication stated: “This is a big mistake we didn’t file in for any complaints”.

The second email communication stated:

“Greetings

I see the domain name I build a website for that is kodakalarislimited.com is being disputed.

I have never been through this procedure

So I don't know what steps to take for now

Please can you direct me!”

6. Consolidation

The Panel finds that the consolidation of the Complainants' claims in a single proceeding against the Respondent is appropriate because the Complainants have a specific common grievance against the Respondent, and it would be equitable and procedurally efficient to proceed with a consolidated proceeding. See *Facebook, Inc. and Instagram, LLC v. Domain Administrator, Fundacion Privacy Services, Ltd.*, WIPO Case No. [D2019-2518](#).

7. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainants must satisfy the Panel that:

- (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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainants' Marks.

The disputed domain name is confusingly similar to the Marks because the disputed domain name is composed by joining the Marks and adding the term “limited” (which typically denotes a kind of business entity). The disputed domain name wholly incorporates both Complainants' Marks. The disputed domain name is composed of the KODAK Mark which is immediately followed by the ALARIS Mark rendering the entire disputed domain name confusingly similar to either Marks. *Giorgio Armani S.p.A Milan Swiss Branch Mendrisio v. Mage Enterprises Inc.*, WIPO Case No. [D2011-1172](#). A finding of confusing similarity results whether the analysis (i) begins with the KODAK Mark and concludes that the disputed domain name is confusingly similar to the KODAK Mark because the KODAK Mark is wholly adopted in the disputed domain name and only followed by the ALARIS Mark and the term “limited” or (ii) begins with the ALARIS Mark and concludes that the disputed domain is confusingly similar to the ALARIS Mark because the KODAK Mark is added as a prefix to the ALARIS Mark in the disputed domain name and the term “limited” is used as a suffix.

The addition of the suffix “limited” does not prevent confusing similarity. A domain name which incorporates a clearly identifiable component or dominant portion of a complainant's registered mark, or the Marks themselves as is the case here, may create confusingly similarity for the purposes of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8 (“where the relevant trademark is recognizable with the disputed domain name, the additions of other terms (whether descriptive, geographic, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”); *Nomura International Plc. v. Name Redacted*, WIPO Case No. [D2021-0654](#).

The Top-Level Domain of the disputed domain name, in this case “.com”, may be disregarded for the purposes of assessment under the first element, as it is viewed as a standard registration requirement. See [WIPO Overview 3.0](#), section 1.11.1. *Monster Energy Company, a Delaware Corporation v. J.H.M. den Ouden*, WIPO Case No. [D2016-1759](#).

The Complainants have met their burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel finds on the evidence presented that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainants have specifically disavowed providing the Respondent with permission to use the disputed domain name or the Mark. The confusingly similar disputed domain name was used in connection with a commercial website allegedly offering alcoholic beverages, but is now inactive. There is no evidence that the Respondent has conducted any *bona fide* business under the disputed domain name or is commonly known by the disputed domain name. The Complainants have established a *prima facie* case in their favor, which shifts the burden of production on this point to the Respondent. The Respondent, however, has failed to come forth with any evidence showing any rights or legitimate interests in the disputed domain name. Given the adoption of the Marks in composition of the disputed domain name, the disputed domain name will likely cause unsuspecting Internet users to believe that the disputed domain name will resolve to a website sponsored or affiliated with either, or both, of the Complainants.

The facts and circumstances presented to the Panel demonstrate that the Respondent does not have any rights or legitimate interests in the disputed domain name.

The Complainants have met their burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, bad faith may be established by any one of the following non-exhaustive scenarios:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Panel finds on the evidence presented that the disputed domain name was registered and is being used in bad faith.

The KODAK Mark is famous in the United States. The Respondent is a United States resident. The ALARIS Mark is also well-known in the United States. Any pretense of Respondent's innocence when registering the disputed domain name is dispelled by the Respondent's compound use of both Marks in the disputed

domain name. The addition of the suffix “limited” further indicates deception and bad faith because the term “limited” denotes a type of business organization that was likely added to the disputed domain name to enhance the impression that the disputed domain name will resolve to a website sponsored or affiliated with one or both Complainants. Moreover, even assuming the incredible, highly doubtful proposition that the Respondent was somehow unaware of the Marks before registering the disputed domain name, a simple Internet search, normally undertaken before registering a domain name, would have disclosed the Complainants’ Marks. On balance, the Panel finds that the Respondent was aware of the Complainants’ Marks when registering and using the disputed domain name to attract unsuspecting Internet users to the Respondent’s website for commercial gain.

The disputed domain name was previously used in connection with a commercial website which, considering the composition of the disputed domain name, lends itself to a finding that the Respondent intentionally sought to attract unsuspecting Internet users to its website by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website at the disputed domain name.

The current inactive status of the disputed domain name subsequent to its prior commercial use is irrelevant as the continued registration of the disputed domain name constitutes a threat hanging over the Complainant. Internet visitors may incorrectly draw negative inferences about the Complainant when seeing that the disputed domain name resolves to an inactive website. Under the circumstances of this case and the doctrine of passive holding, the fact that the disputed domain name does not currently resolve to an active website buttresses the conclusion of bad faith registration and use. See [WIPO Overview 3.0](#), sections 3.3 and 3.2.1.

The Complainants have met its burden under paragraph 4(a)(iii) of the Policy.

8. 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 <kodakalarislimited.com> be transferred to the Complainant Eastman Kodak Company, as requested in the amended Complaint, Section VII.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: March 14, 2023