

## **ADMINISTRATIVE PANEL DECISION**

KIN, Inc. v. Private by Design, LLC / Hasan Iqbal  
Case No. DME2022-0008

### **1. The Parties**

The Complainant is KIN, Inc., United States of America (“United States”), represented by Fross Zelnick Lehrman & Zissu, P.C., United States.

The Respondent is Private by Design, LLC, United States / Hasan Iqbal, Bangladesh.

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

The disputed domain name <mykohlscharge.me> is registered with Porkbun, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 5, 2022. On May 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 6, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 6, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on May 6, 2022.

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 May 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 14, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on June 27, 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 operates a department store retail chain which was founded in 1962 and currently includes more than 1,100 KOHL'S stores in the United States. The Complainant offers a branded credit card under the brand MY KOHL'S CHARGE.

The Complainant is the owner of the United States trademark KOHL'S with registration No. 1772009, registered on May 18, 1993 for services in International Class 42 (the "KOHL'S trademark"). The Complainant is also the owner of the United States trademark MY KOHL'S CHARGE with registration No. 3060269, registered on February 21, 2006 for services in International Class 36 (the "MY KOHL'S CHARGE trademark").

The Complainant sells products through its commercial website at the domain name <kohls.com> and through its KOHL'S ecommerce application for mobile phones available for download at the iTunes and Google Play app stores. The application available at Google Play has been downloaded more than 10 million times.

The disputed domain name was registered on August 16, 2021. It resolves to a website that appears to be the "Official Login Portal" of the Complainant's MY KOHL'S CHARGE credit card and contains information about the Complainant's credit card and the Complainant's credit card portal.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant states that the disputed domain name is confusingly similar to its MY KOHL'S CHARGE trademark, as it reproduces the trademark entirely with the only differences being the omission of the apostrophe and of the spaces between the words composing the trademark. The Complainant notes that the disputed domain name is also confusingly similar to its KOHL'S trademark, which it incorporates in its entirety without the apostrophe together with the words "my" and "charge". The Complainant notes that it is impossible to include an apostrophe in a domain name given ICANN limitations.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant points out that the registration of the disputed domain name occurred after it had extensively used the KOHL'S and MY KOHL'S CHARGE trademarks and had obtained registrations for them. According to the Complainant, the renown of the KOHL'S and MY KOHL'S CHARGE trademarks evidences the absence of any legitimate use of the disputed domain name by an unauthorized party like the Respondent that would not violate the Complainant's rights. The Complainant notes that there is no relationship between the Parties and it has never authorized the Respondent to use the KOHL'S or MY KOHL'S CHARGE trademarks for any purpose, including as a domain name.

The Complainant notes that the disputed domain name is currently being used in connection with a website that purports to be the "Official Login Portal" of the Complainant's MY KOHL'S CHARGE credit card and purports to provide information about the Complainant's credit card and the Complainant's credit card portal. According to the Complainant, a significant part of this information is untrue and would confuse visitors of the Respondent's website.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It states that the KOHL'S and MY KOHL'S CHARGE trademarks are immediately recognizable in the disputed domain name and that KOHL'S is a well-known trademark that exclusively identifies the Complainant and its goods and services. According to the Complainant, the Respondent's registration and use of the disputed

domain name for a website pertaining to the Complainant's credit card shows the Respondent's familiarity with the Complainant's trademarks and the Respondent's recognition of their renown at the time of registration of the disputed domain name.

The Complainant maintains that there is no reason for the Respondent to have chosen the disputed domain name unless the Respondent was seeking to create an association with the Complainant. The Complainant adds that the website at the disputed domain name shows the Respondent's intention when registering the disputed domain name to trade off the goodwill in the Complainant's KOHL'S and MY KOHL'S CHARGE trademarks and to cause confusion among visitors to the website associated with the disputed domain name. According to the Complainant, given the renown of the Complainant's trademarks and the fact that the disputed domain name and website references the Complainant's KOHL'S business and MY KOHL'S CHARGE credit card and copies images and text from the Complainant's websites, the visitors to the website associated with the disputed domain name are likely to mistakenly believe that it is owned by or associated with the Complainant.

The Complainant notes that the website at the disputed domain name includes at the bottom of each of its pages a statement in small print that the website is "not associated with MyKohlsCharge." According to the Complainant, this disclaimer would not avoid the confusion that Internet users will experience when visiting the website, because the disclaimer is only viewable after much scrolling through content that purports to originate from the Complainant, and does not disclaim a relationship with the Complainant itself and does not disclose the fact that the website and the disputed domain name are not authorized by the Complainant.

The Complainant notes that on November 18, 2021, it wrote to the Respondent, objecting to the registration and the use of the disputed domain name, but the Respondent did not reply.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met by the Complainants to obtain the transfer of the disputed domain name:

- (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 and is being used in bad faith.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]".

The Respondent has however submitted no Response and has not disputed the Complainant's contentions and evidence in this proceeding.

### **A. Identical or Confusingly Similar**

The Complainant has submitted evidence and has demonstrated its rights in the MY KOHL'S CHARGE trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate

circumstances the Top-Level Domain (“TLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)). The Panel sees no reason not to follow the same approach here, so it will disregard the “.me” TLD of the disputed domain name.

The relevant part of the disputed domain name reproduces the MY KOHL’S CHARGE trademark in its entirety without the addition of any other elements. The only differences with this trademark are the lack of the apostrophe in “kohls” and the removal of the spaces between “my”, “kohls”, and “charge”. These small differences in the disputed domain name do not affect its confusing similarity with the MY KOHL’S CHARGE trademark, which remains easily recognizable in the disputed domain name. As discussed in section 1.7 of the [WIPO Overview 3.0](#), 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.

Therefore, the Panel finds that the disputed domain name is identical or confusingly similar to the MY KOHL’S CHARGE trademark.

## **B. Rights or Legitimate Interests**

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, stating that there is no relationship between the Parties and the Complainant has not authorized the Respondent to use the MY KOHL’S CHARGE trademark. According to the Complainant, the Respondent uses the disputed domain name in connection with a website that purports to be the “Official Login Portal” of the Complainant’s MY KOHL’S CHARGE credit card and purports to provide information about the Complainant’s credit card and the Complainant’s credit card portal, a significant part of which information is untrue and would confuse the visitors of the Respondent’s website. The Complainant has thus established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not disputed the Complainant’s statements and the evidence submitted by it. It has not provided any plausible explanation of its actions. The evidence submitted by the Complainant shows that the Respondent’s website has indeed used the disputed domain name that is confusingly similar to the MY KOHL’S CHARGE trademark to resolve to a website created to appear as the official login portal for the Complainant’s credit card offered under the MY KOHL’S CHARGE trademark. The website prominently displays the Complainant’s KOHL’S logo. The Complainant’s allegation that a significant part of the information on the Respondent’s website is untrue has not been denied or disproved by the Respondent. In such circumstances, there is the risk that the Respondent’s website may cause disruptions to the Complainant’s business.

In the absence of any evidence to the contrary, it therefore appears more likely that the Respondent has registered and used the disputed domain name in an attempt to impersonate the Complainant and mislead Internet users that the disputed domain name and the associated website that has not been authorized by the Complainant are affiliated to it and offer access to the Complainant’s credit card services and provides incorrect information about them. The Panel does not regard such conduct as legitimate or giving rise to rights or legitimate interests in the disputed domain name.

On the basis of the above, the Panel finds that the Complainants’ *prima facie* case has remained un rebutted,

and that the Respondent does not have rights or legitimate interests in the disputed domain name.

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

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(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 website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

In the present case, the disputed domain name is identical or confusingly similar to the Complainant’s MY KOHL’S CHARGE trademark, and is being used for a website with the header “MyKohlsCharge –Official MyKohlsCharge.Com Login Portal.” The Respondent’s website thus refers to the Complainant’s official website for the MY KOHL’S CHARGE credit card. It prominently displays the Complainant’s logo KOHL’S and redirects through a button titled “Login Portal” to the actual login portal for the Complainant’s credit card services offered under the MY KOHL’S CHARGE trademark. The website also contains sections for “Reset Credentials”, “Pay”, and “Card Activation”, which may lead to situations where unsuspecting visitors share their confidential information with persons unrelated to the Complainant without being aware of this. The Respondent’s website has not been authorized by the Complainant and allegedly contains incorrect information.

In view of the above, the Panel finds that the Respondent was aware of the Complainant and of its KOHL’S and MY KOHL’S CHARGE trademarks when registering the disputed domain name, and that by registering and using it, the Respondent has engaged in an attempt to attract the Complainant’s customers to the disputed domain name and to the associated website by confusing them that they represent an official online location of the Complainant for its MY KOHL’S CHARGE credit card, and then offer them unauthorized access to the Complainant’s credit card online portal and unauthorized services in relation to it. Such conduct appears to be illegitimate and may cause disruptions to the Complainant’s business and compromise the security of the confidential information of the customers of the Complainant’s credit card.

The Panel notes the Complainant’s statement that the Respondent’s website at the disputed domain name contains a disclaimer that “This website is not associated with the MyKohlsCharge”. This statement however contradicts the header of the website and its “Login Portal” button, the clicking of which redirects visitors to the actual login portal of the Complainant, and in any case is not a proper disclaimer that the disputed domain name and the associated website have no relationship with the Complainant. Nevertheless, even if this disclaimer properly disclosed the lack of relationship between the Parties, the Panel believes that its presence does not avoid the finding of bad faith under the Policy. When Internet users have a chance to read the disclaimer they have already been attracted to the Respondent’s website, under the mistaken impression that the disputed domain name and the website are associated with the Complainant and its MY KOHL’S CHARGE trademark and credit card, and would be exposed to the unauthorized offer of access to the Complainant’s credit card online services portal and to other unauthorized services related to the

Complainant's credit card on it and to information about it that the Complainant maintains being incorrect.

The above leads the Panel to the conclusion that the Respondent has registered and is using the disputed domain name in bad faith.

## **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 name <mykohlscharge.me> be transferred to the Complainant.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: July 7, 2022