

ADMINISTRATIVE PANEL DECISION

**Sixsigma Networks Mexico, S.A. DE C.V. v. DYNAMO.COM
AUTORENEWAL AND DNS
Case No. D2022-4534**

1. The Parties

The Complainant is Sixsigma Networks Mexico, S.A. DE C.V., Mexico, represented by González Calvillo, S.C., Mexico.

The Respondent is DYNAMO.COM AUTORENEWAL AND DNS, United States of America (“United States”), internally represented.

2. The Domain Name and Registrar

The disputed domain name <kio.com> 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 November 28, 2022. On November 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 30, 2022, the Registrar 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 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 December 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 29, 2022. The Response was filed with the Center December 29, 2022.

On January 16, 2023, the Complainant filed an unsolicited supplemental filing headed “Counter-Arguments to the Response”. On January 26 and February 9, 2023, the Respondent filed unsolicited supplemental filings headed, respectively, “Supplement to Response” and “Addendum to the Response”. On February 14, 2023, the Complainant filed a further unsolicited supplemental filing headed “Counter-Arguments to the Supplement of the Response”.

The Center appointed Steven A. Maier, Kiyoshi Tsuru, and Andrew D. S. Lothian as panelists in this matter on February 14, 2023. The Panel finds that it was properly constituted. Each member of 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. The Parties' Unsolicited Supplemental Filings

As discussed in section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"):

"Paragraph 12 of the UDRP Rules expressly provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case.

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel.

On receipt of a request to submit an unsolicited supplemental filing or the actual receipt of such filing, the WIPO Center will confirm receipt of the request or filing to the parties, and forward such request or filing to the panel for its consideration as to admissibility.

In all such cases, panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (*e.g.*, owing to some "exceptional" circumstance)."

Having reviewed the parties' unsolicited supplemental filings in this case, the Panel does not consider that any of those filings contains significant material which could not have been included in the parties' original filings, or material which is of such importance that it is liable to be critical to the outcome of the case. In the circumstances, the Panel determines that none of the parties' unsolicited supplemental filings shall be admissible in the proceeding.

5. Factual Background

The Complainant is a company incorporated under the laws of Mexico. It is a provider of information technology infrastructure and operates high-security data centers located principally in Mexico and Central America.

The Complainant is the owner of various trademark registrations for or including the term KIO. Those registrations include, for example:

- Mexico trademark registration number 710687 for a combined mark KIO.COM and a design, registered on July 31, 2001 in International Class 38;
- Mexico trademark registration number 1343366 for a word mark KIO, registered on January 18, 2013 in International Class 38;
- European Union Trade Mark registration number 012620142 for a figurative mark KIO, registered on April 16, 2015 in International Classes 9, 38, 41, and 42; and
- European Union Trade Mark registration number 018022847 for a word mark KIO, registered on July 20, 2019 in International Classes 9, 38, 41, and 42

The Complainant is also the owner of a United Kingdom figurative mark KIO registered in 2014 and a word mark KIO registered in 2019, in addition to trademarks including the term KIO registered in the Dominican Republic and Guatemala in 2019 and 2020 respectively.

The disputed domain name was first registered on May 29, 1996. The Respondent submits, and the Complainant does not dispute, that the Respondent acquired the disputed domain name on February 8, 2015.

The disputed domain name has redirected to a page at the Respondent's website at "www.dynamo.com/assets". There is no evidence that that specific page had any active content at any material time. However, the Complainant produces evidence of the Respondent's homepage at "www.dynamo.com", which offers naming and branding services and displays a number of brand names and logos. It states that the names in question were conceived by the Respondent and selected by a number of internationally well-known companies.

5. Parties' Contentions

A. Complainant

The Complainant states that its business has obtained: "... recognition as KIO and KIO NET in the Mission Critical Information Technology Infrastructure services industry, currently operating forty high density, availability and density Data Centers to manage and monitor services in the public, private and hybrid Cloud, cybersecurity, business applications, automation and artificial intelligence with presence in Mexico, Panama, Guatemala, Dominican Republic, European Community and United Kingdom."

The Complainant submits that the disputed domain name is identical or confusingly similar to its trademarks including KIO.COM and KIO. It states that it has exclusive rights to use those marks in Mexico in connection with the goods and services for which they are registered and interests in those marks in other territories owing to international treaty obligations. The Complainant contends that, having continuously used the marks for over 20 years, their notoriety is clearly established.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has never authorized the Respondent to use its KIO.COM or KIO trademarks and that those marks cannot be considered to be in common usage. The Complainant submits that it "created and generated" the KIO name in order to distinguish itself in the technology services market. The Complainant states that it operates numerous websites and social media profiles which include the term KIO and provides examples of seven URLs, all of which include the term "kionetworks".

The Complainant submits that the Respondent has made no active use of the disputed domain name and that it would have done so if it had any rights or legitimate interests in respect of the disputed domain name. It adds that the existence of the disputed domain name merely blocks the Complainant from registering it and hinders the Complainant's marketing of its services and products under the KIO.COM and KIO marks. The Complainant further contends that the Respondent's ownership of the disputed domain name, in which it has no rights or legitimate interests, causes confusion to customers who are seeking the legitimate services of the Complainant.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. It repeats that it has owned relevant trademark rights since 2001 and that the Respondent has made no active use of the disputed domain name. It contends that the Respondent's website makes clear that it is a reseller of domain names and it is therefore evident that the Respondent acquired the disputed domain name in order to block the Complainant's use of it. The Complainant submits that the Respondent is also using the disputed domain name in an attempt to attract Internet users to its website for commercial gain.

The Complainant contends that the "passive possession" of a domain name does not preclude a finding of bad faith in appropriate circumstances (see *e.g.*, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Complainant exhibits an email to the Respondent dated August 4, 2022 in which it expressed an interest in purchasing the disputed domain name. The Complainant submits that, while this email indicates its own good faith in seeking to resolve this matter, the Respondent failed to reply.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent points out that the disputed domain name was first registered in 1996. It contends that the Complainant must therefore have been well aware that the disputed domain name preceded any trademark rights of its own.

The Respondent notes that the Complainant's Mexico trademark KIO.COM is figurative and argues that it would be revoked as misleading under Mexican trademark law. It submits that the Complainant has no word trademark registrations for KIO prior to 2013.

The Respondent denies that the term KIO is distinctive of the Complainant or at all. It says that, while the Complainant claims KIO to be a coined term, its own advertising states that it means "mirror" in Swahili. The Respondent submits that there are 616 filings for the term KIO in Mexico alone, including Kio beer, Kio detergent, Kio ice cream, Kio education, Kio pizza and others. The Respondent further contends that, in the WIPO Global Brand Database overall, there are over 17,000 trademark filings including the term KIO, dating back to the 1880s. It submits that KIO is also a common personal name and cites an individual named Kio Cyr, having nine million TikTok followers.

The Respondent states that it acquired the disputed domain name on February 8, 2015, having received an unsolicited email from a domain name broker. It states that it paid USD 31,275.90 for the disputed domain name, although it estimates its actual value as a "rare asset" at between USD 500,000 and two million.

The Respondent states that it is in the business of executing name conception, logos, branding and related activities for companies ranging from startups to corporations including Intel, Procter and Gamble, Netflix, and Time Warner. It states that it holds both generic and coined domain names in connection with this business and that there is nothing new or obscure about this field of trade. It contends that three-letter brands are particularly desirable and that it took up the opportunity of investing in the disputed domain name accordingly. The Respondent argues that the Complainant willfully disregards its website at "www.dynamo.com" which showcases its name creation activities. It adds that a domain name comprising a three-letter combination may legitimately be bought and sold for its inherent value (see *Grupo Nacional Provincial, S.A. v. Privacydotlink Customer 4270030 / Yancy Naughton*, WIPO Case No. [D2021-1136](#)).

The Respondent submits that it has rights or legitimate interests in respect of the disputed domain name by virtue of its business activities referred to above. It states that it does not benefit from or tarnish other parties' trademarks. The Respondent states in particular that no party may purchase the disputed domain name anonymously and quotes the following content from the "questions/answers" section of its website:

"For domain names, acquisitions require: 1) an initial written agreement that one intends to build a new, legitimate mark and compete in good faith (For instance, as to the domain 24Hour.com, Gold's Gym Inc. would not be eligible to buy it because Gold's Gym is a same-trade competitor of 24 Hour Fitness.), and 2) parties must use Dynamo's Transfer Agreement. The Agreement authorizes revocation of sale and reclamation of domain name if buyers misrepresent eligibility. This offers protection in the event of sale to a malicious ex-employee, a hacker who presents a security risk, or an infringing competitor of a party using a similar mark. It further prevents the prohibited sale of a domain to a trademark holder."

The Respondent states that it has never offered the disputed domain name for sale. It adds that the disputed domain name has never been used in connection with any inappropriate or malign content and that it has at all material times resolved to a blank page in order to preclude the possibility of any automated content which could infringe upon third-party rights.

The Respondent denies having registered or used the disputed domain name in bad faith. It “declares unequivocally” that it had no knowledge of the Complainant prior to this dispute. It states that, when it acquired the disputed domain name in 2015, the Complainant had only corporate clients in Mexico, Panama, Guatemala, and Santo Domingo, and in particular no trademark-related presence in the United States prior to an “intent to use” filing dated June 30, 2022.

The Respondent repeats that the Complainant has ignored its legitimate business activities as evidenced by its website, including its mandatory contractual provisions to protect the interests of trademark owners. It contends that these activities clearly indicate its good faith use of domains such as the disputed domain name.

The Respondent submits that the Complainant is attempting to engage in Reverse Domain Name Hijacking (“RDNH”) in this case and requests a finding to that effect. It contends that the Complainant has previously attempted to buy the disputed domain name and is engaging in this proceeding as a bargaining tool and/or as a last resort. It further submits that the Complainant’s legal representatives are well versed in domain name law.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are 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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name is identical to the Complainant’s trademark KIO, ignoring the generic Top-Level Domain (“gTLD”) “.com”, which is typically to be disregarded for the purpose of comparison under paragraph 4(a)(i) of the Policy. The Panel therefore finds that the disputed domain name is identical to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

It is well established in decisions under the UDRP, as reflected in section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), that: “... generally speaking, panels have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be *bona fide* and is not per se illegitimate under the UDRP.” In such cases, however, the panel must be satisfied that the registrant did not register the domain name in question with the relevant complainant’s trademark in mind and with the intention of “targeting” that trademark by taking unfair advantage of the complainant’s goodwill attaching to it.

The Panel also has regard to the decision in the *Grupo Nacional Provincial* case (supra) as cited by the Respondent and to earlier cases including, for example, *SK Lubricants Americas v. Andrea Sabatini, Webservice Limited*, WIPO Case No. [D2015-1566](#). The panels in these cases found that a three-character domain name may legitimately be purchased for its inherent value, and that in such cases the registration will usually be for *bona fide* purposes. This is described as “a matter of common sense” in the cases in question. Nevertheless, the right to register such domains is not unlimited and will not be *bona fide* in circumstances where the registrant has deliberately targeted the complainant’s trademark. Such targeting may, in appropriate cases, be demonstrated by direct evidence or alternatively inferred from the distinctiveness and fame of the relevant trademark.

The burden of proof in establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name falls upon the Complainant. In this case, the Complainant offers no direct evidence that the Respondent specifically targeted its KIO trademark mark and effectively invites the Panel to infer that it did so by virtue of the notoriety of that trademark. However, the Panel does not see any persuasive basis upon which to draw such an inference. The Panel does not find on the evidence that the name KIO was invented by the Complainant, nor is the Complainant by any means the only user of that name in commerce.

The Respondent has provided an explanation for its acquisition of the disputed domain name, namely that three-letter domain names have inherent value and may legitimately be used by parties having a *bona fide* interest in the acronym which they represent. The Respondent has further explained that it offers naming and brand services which supplement its holding of domain names for sale and that its terms and conditions of business include certain safeguards to prevent the abuse by purchasers of such domain names. So far as the disputed domain name is concerned, the fact that the Complainant is a prominent and widely-known user of the KIO trademark in certain territories does not negate the fact that there are multiple other entities worldwide which also own registrations for the mark KIO and/or use that name in the course of business and which, crucially, could legitimately use the disputed domain name in conjunction with their independent rights in that name.

In these circumstances, the Panel is unable to conclude, on the balance of probabilities, that the Respondent had the Complainant's trademark in mind, and targeted that trademark, when it registered the disputed domain name. The Panel finds, on the contrary, that the Respondent is likely to have acquired the disputed domain name owing to its inherent value as a three-letter domain name.

The Complainant has therefore failed to meet its burden under the second element and the Complainant must fail accordingly.

C. Registered and Used in Bad Faith

While the Panel's findings in respect of rights or legitimate interests are sufficient to dispose of this proceeding, the Panel also records its view that the disputed domain name was neither registered, nor has been used, in bad faith. The reason for that conclusion is broadly the same as that outlined above, namely, that in view of the various uses of the name "kio" in commerce and otherwise, the Complainant has failed to meet the burden of showing that the Respondent registered and has used the disputed domain name with the purpose of targeting the Complainant's KIO trademarks and the goodwill attaching to those marks. Further, the Complainant has produced no persuasive evidence in support of its contentions that the Respondent registered the disputed domain name in order to block the Complainant from doing so or in order to divert Internet traffic intended for the Complainant.

7. Reverse Domain Name Hijacking

Under paragraph 15(e) of the Rules: "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."

In this case, the Complainant has provided no evidence that the Respondent deliberately targeted its KIO trademark and relies upon an inference drawn from the alleged notoriety of that mark. However, in the view of the Panel, the Complainant knew or ought to have known that the term KIO was in widespread usage otherwise than to refer to the Complainant's trademark and that there was no reasonable basis for any such inference to be drawn. The Panel also takes account of the fact that the Complainant brought this proceeding after a failed attempt in August 2022 to purchase the disputed domain name from the Respondent (which included no suggestion of wrongdoing on the Respondent's part). The Panel also

observes that, being legally represented, the Complainant is held to a higher standard than an unrepresented party to ensure that any proceedings under the UDRP are brought on proper grounds.

The Panel finds in the circumstances that the Complainant was brought in bad faith and constitutes an abuse of the administrative proceeding.

8. Decision

For the foregoing reasons, the Complaint is denied.

/Steven A. Maier/
Steven A. Maier
Presiding Panelist

/Kiyoshi Tsuru/
Kiyoshi Tsuru
Panelist

/Andrew D. S. Lothian/
Andrew D. S. Lothian
Panelist
Date: February 28, 2023