

ADMINISTRATIVE PANEL DECISION

Kao Kabushiki Kaisha (Kao Corporation) v. 张高源 (zhang gaoyuan)
Case No. D2022-4718

1. The Parties

The Complainant is Kao Kabushiki Kaisha (Kao Corporation), Japan, represented by SafeNames Ltd, United Kingdom.

The Respondent is 张高源 (zhang gaoyuan), China, self represented.

2. The Domain Name and Registrar

The disputed domain name <kaoshop.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on December 8, 2022. On December 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 12, 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 December 15, 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 in English on December 19, 2022.

On December 15, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On December 19, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent requested the language of the proceeding be Chinese on December 16, and 20, 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 in Chinese and English of the Complaint, and the proceedings commenced on December 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 11, 2023. Per the Respondent's request, the Respondent is granted the automatic four calendar day extension for response until January 15, 2023 in accordance with paragraph 5(b) of the Rules. The Response in Chinese was filed with the Center on January 11, 2023 and the amended Response in Chinese was received on January 15, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on January 19, 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 a company headquartered in Japan and active in the beauty industry. The Complainant was first founded in 1887 and underwent multiple name changes before adopting the company name "Kao Corporation" in 1985. The Complainant is a publicly listed company since 2000 and has a network of offices located, for example, in Japan, China, United States of America ("United States"), Canada with over 34,000 employees globally. In 2022, the Complainant generated an annual revenue of USD 12.9 billion.

The Complainant owns an international portfolio of trademark registrations for KAO, including but not limited to, United States trademark registration number 1516949, for the word mark KAO, registered on December 20, 1988; European Union trademark registration number 000011973, for the word mark KAO, registered on June 6, 2001; and Chinese trademark registration number 10629426 for the mark KAO with design element, registered on May 14, 2013. The abovementioned trademarks were all registered before the registration date of the disputed domain name, which was registered on October 26, 2016.

The Complainant's main website at the domain name <kao.com> (created in 1996) offers information about the Complainant's corporate practices and brands owned by the Complainant.

The Complainant provides evidence that the disputed domain name was linked to an active, parked page on the "Dan.com" domain name resales platform, offering the disputed domain name for sale for a listed "Buy now" price of USD 1,999 or a listed "Lease to own" price of USD 100 per month. The Panel notes that the Respondent points out that while the listed sales price was USD 1,999, offers could be submitted starting from USD 1,000.

The Complainant also provides evidence that it attempted to resolve this proceeding amicably by sending a cease-and-desist letter on September 6, 2022. The Respondent replied in English on September 21, 2022, which essentially stated that the Complainant's allegations are false, that the Complainant cannot prove that the three elements under paragraph 4(a) of the Policy are met and that these allegations may even constitute reverse domain name hacking.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its prior registered trademarks for KAO, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

In its Complaint and amended Complaint, the Complainant essentially contends that the Respondent chose to register the disputed domain name which is identical to the Complainant's trademarks for KAO. The Complainant also contends that the disputed domain name was clearly calculated to capitalize on the

reputation of the Complainant's KAO marks and can therefore not constitute good faith registration and use. The Complainant also argues that the top searches of "kao" (both prior to the date of registration of the disputed domain name and at present) on popular search engines result in the Complainant's offerings of goods and services in multiple countries. Furthermore, the Complainant argues that, based on the contents of the website linked to the disputed domain name, the Respondent has primarily registered the disputed domain name for the purpose of selling it to the Complainant for consideration in excess of the documented costs of the disputed domain name. Finally, the Complainant also argues that the Respondent has engaged in a pattern of abusive conduct by registering other domain names which encompass the marks of distinctive third-party brands.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

In its Response and amended Response, the Respondent essentially argues that the term "kao" is not a fanciful or distinctive term invented by the Complainant but is rather a generic term existing in various languages, including in Chinese, where it could be the pinyin transliteration of the common characters "考" and "烤". Moreover, the Complainant does not own a trademark for the entire term "kaoshop". Furthermore, the disputed domain name is merely linked to a parking page where the disputed domain name is offered for sale, which is not likely to cause any confusion with the trademarks or goods or services offered by the Complainant. Additionally, there are other domain names which incorporate the term "kaoshop" and which do not refer to the Complainant, which shows that this term may have universal use or significance.

The Respondent contends that she or he has rights in the disputed domain name because her/his middle name is "高" which is "Kao" in Wade-Giles (a romanization system for pinyin). The Respondent legally registered the disputed domain name and offered it for sale at a reasonable price which does not constitute bad faith. The Respondent also contends that it owns a number of domain names with other generic meanings and pronounceable combinations and that this does not constitute a pattern of bad faith behavior.

Finally, the Respondent also argues that the Complainant has filed the Complaint in bad faith and has committed reverse domain name hacking on the basis of its abuse of the proceedings and on the basis of a number of alleged abuses (including using alleged false evidence regarding the amounts for which the disputed domain name was offered for sale on the website of Afternic) which the Respondent considers abusive.

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

According to the Registrar's verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainant filed its Complaint and its amended Complaint in English, and requested that English be the language of the proceeding. The Respondent requested that the language of the proceeding be Chinese on December 16, and 20, 2022, and filed the Response and amended Response in Chinese.

The Panel has carefully considered all elements of this case, in particular, the Complainant's request that the language of the proceeding be English; the fact that the Respondent sent a reply in English on September 21, 2022 to the cease-and-desist letter sent by the Complainant in English, and that in the Response and amended Response, the Respondent directly responds to the specific claims made by the Complainant in its Complaint in English, from which the Panel deduces that the Respondent is familiar with the English

language; the fact that at the time of filing of the Complaint, the disputed domain name resolved to a website in English offering it for sale, and, finally, the fact that Chinese as the language of the proceeding could lead to unnecessary delay for the proceeding. In view of all these elements, the Panel grants the Complainant's request and decides that the language of the proceeding shall be English. However, in accordance with the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1, the Panel has reviewed and accepts all communications, submissions and documents in Chinese submitted by either Party, and does not require a translation thereof.

6.2 Discussion and Findings on the Merits

The Policy requires the Complainant to prove three elements:

- (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.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainant has provided sufficient evidence that it has valid and prior rights in the mark KAO, based on its international trademark portfolio of such marks, including the registered trademarks mentioned above.

Moreover, as to confusing similarity, the [WIPO Overview 3.0](#), section 1.7, states: "[...] 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". In this case, the disputed domain name incorporates the Complainant's trademark for KAO in its entirety, followed by the term "shop". Accordingly, the Panel considers that the disputed domain name contains the entirety of the Complainant's trademark for KAO, which remains easily recognizable in the disputed domain name, and the addition of the word "shop" does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8. The Panel also notes that the applicable generic Top-Level Domain ("gTLD") (.com in this case) is viewed as a standard registration requirement, and may as such be disregarded by the Panel, see in this regard the [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and the first element required by the Policy is fulfilled.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel finds that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee, or distributor of the Complainant, is not a good faith provider of goods or services under the disputed domain name and is not making legitimate noncommercial use or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1).

The Respondent essentially argues that the term "kao" is not a fanciful or distinctive term invented by the Complainant but is rather a generic term existing in various languages, including in Chinese, where it could be the pinyin transliteration of the common characters such as "考" (test in Chinese) and "烤" (bake in

Chinese). Additionally, there are other domain names which incorporate the term “kaoshop” and which do not refer to the Complainant, which shows that this term may have universal use or significance. Furthermore, the Respondent claims that the disputed domain name is merely linked to a parking page where the disputed domain name is offered for sale, which is not likely to cause any confusion with the trademarks or goods or services offered by the Complainant.

The Panel disagrees with the Respondent’s arguments. While it is correct that the term “kao” could be the pinyin transliteration for the Chinese characters “考” (test in Chinese) and “烤” (bake in Chinese) (and likely other terms in other languages), it is the settled view of panels applying the Policy that the mere registration of a domain name comprising a dictionary word or term does not establish rights or legitimate interests *per se* in such domain name. In this regard the [WIPO Overview 3.0](#), section 2.10.1 states: “[p]anel[s] have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent; panels have held that mere arguments that a domain name corresponds to a dictionary term/phrase will not necessarily suffice. In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights.” In this regard, upon review of the facts, the Panel notes that neither the current, nor the historical use made of the disputed domain name points to the Respondent’s genuine use in connection with the relied-upon dictionary meaning, or any use of the disputed domain name to offer any *bona fide* goods or services.

Further, upon review of the evidence submitted, the Panel notes that the Respondent only ever connected the disputed domain name to a parked page offering it for sale for a “Buy now” price of USD 1,999 or a “Lease to own” price of USD 100 per month, which are amounts most likely in excess of out-of-pocket costs relating to the disputed domain name. The Panel also notes that the allegations by the Respondent that offers could be submitted starting from USD 1,000 does not change this assessment.

As mentioned above, on one hand, the Respondent contends that “Kao” is the pinyin transliteration of the common characters such as “考” (test in Chinese) and “烤” (bake in Chinese); on the other hand, the Respondent also contends that her/his middle name “高” is “Kao” in Wade–Giles (a romanization system for pinyin). In addition, the Panel finds that the combination of the term “kao” (alleged to be the pinyin transliteration for the Chinese characters meaning “test” and “bake” in Chinese), with the English term “shop”, does not result in a common or dictionary phrase, but in the Panel’s opinion it is a rather obscure and self-serving explanation for the composition of the disputed domain name. The Panel notes that the Complainant’s domain name is <kao.com>, and its KAO trademark is incorporated in its entirety in the disputed domain name with an additional term “shop” which could be easily associated with the Complainant. Therefore, the Panel concludes that it is more likely than not that the Respondent has chosen “kao” in the disputed domain name to divert Internet users to the website linked to the disputed domain name for commercial gain, by taking unfair advantage of the goodwill and reputation of the Complainant’s trademarks for KAO and that the Respondent cannot derive any rights or legitimate interests from such registration and use.

On the basis of the foregoing, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the registration of the disputed domain name, which incorporates the Complainant’s intensively used trademark which has been registered years before the registration date of the disputed domain name including in China, by the Respondent, who is entirely unaffiliated with the Complainant, is by itself sufficient to create a presumption of bad faith of the Respondent (see in this regard *Alain Afflelou Franchiseur v. Lihongbo, Lihongbo*, WIPO Case No. [D2020-2075](#)).

Furthermore, the Panel has reviewed the Complainant's evidence of the top search results for "kao" (both prior to the date of registration of the disputed domain name and at the time of filing of the Complaint) on popular search engines, which result in the Complainant's offerings of goods and services in multiple countries, from which the Panel concludes that such results clearly refer to the Complainant's business. The Panel concludes that even a cursory Internet search at the time of registration of the disputed domain name would have made it clear to the Respondent that the Complainant owned prior rights in its trademarks for KAO. In addition, the Complainant promotes its business on the website at the domain name <kao.com> which was created in 1996. In the Panel's view, the preceding elements indicate that it is most likely that the Respondent chose the term "kao" in the disputed domain name because of the Complainant, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the evidence of use of the website linked to the disputed domain name and the Response from the Respondent demonstrate that the Respondent is attempting to sell the disputed domain name for an amount most likely in excess of the Respondent's out-of-pocket costs related to the disputed domain name, *i.e.*, a "Buy now" price of USD 1,999 or a "Lease to own" price of USD 100 per month. The Panel also notes that the allegations by the Respondent that offers could be submitted starting from USD 1,000 does not change this assessment.

This leads the Panel to conclude on balance of the probabilities that the Respondent is using the disputed domain name to try to sell it to the Complainant, who is the owner of the corresponding trademark for KAO, or to other parties and to obtain unjustified benefits through such sale. The Panel notes that this constitutes evidence of the bad faith of the Respondent under paragraph 4(b)(i) of the Policy. Finally, the Panel also finds that the Respondent has registered several domain names which appear to correspond to the marks of individual brand owners.

The Panel therefore finds that the Complainant has satisfied the requirements of the third element under the Policy.

D. Reverse Domain Name Hijacking

Noting that the Complainant has satisfied the three elements under paragraph 4(a) of the Policy, the Panel finds that the Complaint was not brought in bad faith and does not constitute an abuse of the administrative proceeding.

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 <kaoshop.com> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: February 2, 2023