

ADMINISTRATIVE PANEL DECISION

Kohler Co. v. Gonzalo Gil, 3dCart
Case No. D2023-4412

1. The Parties

The Complainant is Kohler Co., United States of America (“United States” or “U.S.”), represented by Elster & McGrady LLC, United States.

The Respondent is Gonzalo Gil, 3dCart, United States.

2. The Domain Name and Registrar

The disputed domain name <shopkohlergear.com> (the “Disputed 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 October 24, 2023. On October 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 26, 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 (Registration Private / Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 1, 2023, 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 November 6, 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 November 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 13, 2023.

The Center appointed Douglas M. Isenberg as the sole panelist in this matter on December 27, 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 states that it was founded in 1873, “[w]ork[s] on the frontier of several industries, including kitchen and bath products and supplies,” “is a market leader and offers the highly recognizable KOHLER brand. Complainant’s ideas, craftsmanship, and technology lead the industry in product design,” and has “44 manufacturing plants, 26 subsidiaries and affiliates, and dozens of sales offices spread over every continent but Antarctica.”

The Complainant states, and provides evidence to support, that it owns the following trademark registrations (the “KOHLER Trademark”):

- U.S. Registration No. 94,999 for KOHLER (registered January 20, 1914) for use in connection with “bath-tubs, lavatories, sinks, water-closets, closet-tanks, urinals, slop-sinks, traps, sitz-baths, receptors for use in connection with showers, lavatory bowls, drain-boards, closet-bowls and closet-tanks”
- U.S. Registration No. 2,851,217 for KOHLER WATERS SPA (registered June 08, 2004) for use in connection with, *inter alia*, “wearing apparel, namely, shirts, sweatshirts, robes, hats”.

The Disputed Domain Name was created on July 11, 2018. The Complainant states that “Respondent uses the Disputed Domain to redirect Internet Users to its website for New Bath Today Gear, which sells goods and services competitive with Complainant’s goods and services.” An annex provided by the Complainant in support of this statement shows a website for “New Bath Today” at “www.shopnewbathgear.com.” Prior to notification of the Complaint, the Center obtained a screenshot of what appears to be the same website, and the Panel has confirmed that the Disputed Domain Name redirects to such website. ¹

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, the Complainant contends that:

- the Complainant has rights in the KOHLER Trademark as a result of the registrations cited above, and the Disputed Domain Name is confusingly similar to the KOHLER Trademark because “it fully incorporates the KOHLER mark as the dominant element in the Disputed Domain” and “the Disputed Domain adds the misleading, generic terms ‘shop’ and ‘gear,’ and the generic top-level domain ‘.com,’” which “do not sufficiently differentiate the Disputed Domain from the KOHLER marks for a confusingly similar analysis.”
- the Respondent has no rights or legitimate interests in the Disputed Domain Name because, *inter alia*, “Respondent has never been commonly known as ‘shopkohlergear.com’ and has never used any trademark or service mark similar to the Disputed Domain by which they may have come to be known, other than the infringing use noted herein”; “Complainant has not granted Respondent any license, permission, or

¹ “[A] panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name.” WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 4.8.

authorization by which it could own or use any domain name registration that is confusingly similar to any of the KOHLER marks”; and “Respondent has never operated any *bona fide* or legitimate business under the Disputed Domain and is not making a protected non-commercial or fair use of the Disputed Domain” but “[i]nstead, Respondent uses the Disputed Domain to redirect Internet Users to its website for New Bath Today Gear, which sells goods and services competitive with Complainant’s goods and services in a manner that trades on Complainant’s goodwill and is likely to confuse users as to affiliation with the Complainant and disrupt Complainant’s business.”

- the Disputed Domain Name was registered and is being used in bad faith because, *inter alia*, “[g]iven the nature and use of the Disputed Domain, Respondent registered the Disputed Domain with actual knowledge of Complainant’s marks based on Complainant’s registration of its marks with the Trademark Office in the United States, where the Complainant and Registrar are located, and to where Respondent’s acts of cybersquatting are directed”; “[t]here is no reason for Respondent to have registered the Disputed Domain other than to trade-off of the reputation and goodwill of Complainant’s mark”; “Respondent is currently using the Disputed Domain to capitalize on Internet users’ efforts to find Complainant’s website”; and “[e]ven if Respondent were to argue that it was somehow unaware of Complainant’s rights in the KOHLER marks, had Respondent conducted a preliminary trademark search or even a simple browser search, it would have found Complainant’s various trademark registrations in the KOHLER marks and the websites associated with the marks on the Internet, and in publications, evidencing Complainant’s use of its marks in connection with the Complainant’s goods and services.”

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “shop” and “gear”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered and used a domain name containing a trademark that was registered at least 104 years before creation of the domain name, which is protected by multiple registrations and used by a company that, as described by the Complainant, has “44 manufacturing plants, 26 subsidiaries and affiliates, and dozens of sales offices spread over every continent but Antarctica” – indicating that the KOHLER Trademark is famous or widely known. “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names... incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.” [WIPO Overview 3.0](#), section 3.1.4.

Further, the Respondent uses the Disputed Domain Name in connection with a website selling goods similar to those associated with at least one registration for the KOHLER Trademark. This is “indicia generally suggesting that the respondent had somehow targeted the complainant” and is further evidence of bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Based on the available record, the Panel finds that the Complainant has established the third element of 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 disputed domain name <shopkohlergear.com> be transferred to the Complainant.

/Douglas M. Isenberg/

Douglas M. Isenberg

Sole Panelist

Date: December 27, 2023