

ADMINISTRATIVE PANEL DECISION

Smartkoin, OPC v. Simong Kingsly
Case No. D2024-0362

1. The Parties

The Complainant is Smartkoin, OPC, Philippines, represented by Gowling WLG (Canada) LLP, Canada.

The Respondent is Simong Kingsly, United States of America

2. The Domain Names and Registrar

The disputed domain names <bsss-ph.com> and <smartk0in.net> (together “the Disputed Domain Names”) are registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 26, 2024. On January 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On January 30, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Redacted For Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 31, 2024, 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 amendment to the Complaint on February 13, 2024.

The Center verified that the Complaint together with the amendment to 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 February 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 5, 2024. The Center notified the Parties of its commencement of Panel appointment process on March 6, 2024.

The Center appointed Nick J. Gardner as the sole panelist in this matter on March 12, 2024. 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.

On March 13, 2024, the Panel issued a Procedural Order (the "Procedural Order") in the following terms:

"The Panel has reviewed the submissions from the Parties in this case. Pursuant to paragraphs 10 and 12 of the UDRP Rules, the Panel issues the following order:

The Panel requests that the Complainant confirm that the reference in paragraph 2 of the Complaint to the Complainant being Corning Incorporated is a mistake and is to be ignored, or if not, explain better the identity of the Complainant.

The Panel requests that the Complainant clarify the nature of the SMARTKOIN and BSS-PH.COM trademarks relied upon. In particular if registered trademarks are relied upon please provide registration details and copies of relevant certificates. If unregistered trademark rights are relied upon please provide actual evidence of reputation and first use date. Such evidence may include length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition. See in this regard WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition section 1.3 The Complainant should submit the above-requested evidence and comments by the end of March 18, 2024.

The Complainant's further submission should be limited to the above request.

The Respondent may if he wishes submit by the end of March 25, 2024 a filing limited to addressing matters arising out of the Complainant's further submission.

The Decision due date is extended to at least March 31, 2024".

Subsequent correspondence passed between the Complainant's representative and the Center concerning the Procedural Order. Details of this correspondence are set out in the discussion below. In this correspondence, the Complainant clarified certain matters (see below) but otherwise no further filing was made by either Party pursuant to the Procedural Order.

4. Factual Background

The Complaint is lacking significant detail. It seems the Complainant is a Philippines corporation.

It is not clear the nature and extent of the Complainant's business. The Complainant says it provides "technical and customer support services". It also says "The Complainant is a government registered enterprise which provides technical and customer support services such as customer relationship management services, data management and information processing services, customer care and information technology services to foreign and offshore clients who are primarily engaged in interactive gaming". The Complainant says it has trademark rights in the terms SMARTKOIN and BSS-PH.COM. The Complaint says that the Complainant has used the domain name <smartkoin.net> to resolve to a website promoting its business. The website in question (the "Complainant's Website") is discussed in detail below. The Complaint also says that the Complainant has used email addresses which use the domain name <bss-ph.com> as part of the email address. This is also discussed further below.

The Disputed Domain Names were registered on October 4, 2023. There is no evidence they have ever resolved to an active website. They have however been used to perpetrate a fraud on the Complainant. Emails with addresses at the Disputed Domain Names were used to send instructions to an employee of the Complainant. The emails purported to come from another employee within the Complainant and were used

to deceive the recipient into making a financial transfer. As a result, a very substantial sum of money was fraudulently obtained from the Complainant. A subsequent attempt to repeat the fraud was detected and stopped.

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 Names. The way in which the Complainant puts its case in relation to trademark rights is discussed below.

Additionally, the Complainant contends that the Disputed Domain Names have been used for email impersonation and perpetration of a fraud upon the Complainant by tricking an employee of the Complainant into making a substantial payment. It provides detailed evidence about this fraud and how it was perpetrated and says it was initially successful and resulted in a very large loss to the Complainant. It says the Respondent cannot have any rights or legitimate interests in the Disputed Domain Names and their fraudulent use is clear evidence they were registered and used in bad faith.

B. Respondent

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

6. Discussion and Findings

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with 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;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The first issue which arises is establishing whether the Complainant has shown the terms SMARTKOIN and/or BSS-PH.COM are trademarks in which the Complainant has rights. This is not straightforward.

The Complaint, in places, gave the impression that the Complainant held registered trademarks in respect of the terms SMARTKOIN and BSS-PH.COM. For example, the Complaint stated, "The Complainant is the owner of the trademarks SMARTKOIN and BSS-PH.COM" and "The Complainant is the registered owner of the SMARTKOIN Trademarks. By virtue of these registrations, the Complainant has rights in the SMARTKOIN Trademarks, and continues to have such rights". However, no details of any trademark registrations were provided.

Elsewhere in the Complaint, it seemed to be the case that the Complainant was relying upon unregistered trademark rights. In particular the Complaint stated:

"By virtue of extensive and continuous use since at least as early as March 2023, the Complainant is the owner of the SMARTKOIN trademark. The Complainant operates a website located at <https://smartkoin.net> and has since March 2023. By virtue of extensive and continuous use since at least as early as November 2018, the Complainant is the owner of the BSS-PH.COM trademark. The Complainant has used the BSS-PH.COM trademark as an email address in connection with the promotion of its services. The use of a trademark in this manner serves as a source identifier and was selected by the Respondent for that reason.

As well, the use of a domain name in association with the promotion of services constitutes statutory trademark use. Please find attached as Exhibit 1 printouts of the smartkoin.net website and attached as Exhibit 2 samples of the use of the BSS-PH.COM trademark used as part of an email address in association with the promotion of its services. The trademarks SMARTKOIN and BSS-PH.COM shall be collectively referred to as the 'SMARTKOIN Trademarks'.

The only evidence provided in relation to SMARTKOIN was the referenced printout of the Complainant's Website. The Panel has confirmed that printout was in substance the same as the live version of the Complainant's Website. That website comprises a single page (and an associated pop up "contact us" form - see below). The single page has at the top a logo and the words "Smartkoin OPC". Otherwise, the website is without detail as to the Complainant's services, or recognition thereof, and simply states, "Smartkoin, OPC is pioneering its way to deliver exceptional services to its clients. With unparalleled expertise in the vast market and experience in the latest technological developments, we aim to assist you in your operational needs in the best way possible". Further short passages of generic text follow, accompanied by photographs of office environments and the like. A testimonial is set out further down the page which reads as follows "I'm grateful for Smartkoin's exceptional service! Their team was professional, efficient, and provided valuable guidance. Highly recommended!". This is said to be from "Sophia". At the bottom of a page is a contact form which allows entry of a name, email address, and a message with a send button which presumably sends this information to the Complainant. There are also "contact us" buttons elsewhere on the page which bring up the same form. There is nothing else on the webpage and no details of the Complainant's address or telephone number or email address are provided, particularly the relied-upon BSS-PH.COM.

The only evidence as to use of the term BSS-PH.COM shows it has been displayed as an email address in recruitment advertisements for candidates to send their applications to. Otherwise, the evidence also reflects the use of BSS-PH.COM for internal emails by the Complainant's employees, with the evidenced email chain ultimately being used by the Respondent for its fraudulent scheme.

The Panel took the view that the Complaint was unclear and lacking in necessary detail as to the trademark rights upon which the Complainant was relying. On March 13, 2024, the Panel therefore issued the Procedural Order, the full text of which is set out above.

On April 2, 2024, the Complainant's representative wrote to the Center stating:

"Yes – the reference to Corning Incorporated is an oversight. The Complainant is the one indicated namely Smartkoin, OPC.

Please note that the Complainant has relied upon common law rights. The use relied upon predates the domain name registration date. Legal counsel for the Complainant has filed numerous complaints and the manner in which the common law rights have been framed has been sufficient in the past. If, however, it is insufficient, then it is respectfully requested that a 10 day extension of time be provided to provided further evidence of common law trademark use.

We look forward to the Panel's response and procedural order if necessary".

On April 4, 2024, the Center replied as follows:

"Dear Parties,

The Complainant's below communication [i.e. the April 2, 2024 email - above] has been forwarded to the Panelist for his consideration.

The Panel respectfully considers that further detail as to the common law trademarks relied upon is required as requested per the Administrative Panel Procedural Order No. 1. The Panel grants the Complainant's request for further time in this regard. Accordingly, the new date for the Complainant to submit its submission is April 14, 2024.

The Respondent may if he wishes submit by the end of April 18, 2024 a filing limited to addressing matters arising out of the Complainant's further submission.

The Decision due date is extended to at least April 25, 2024".

On April 15, 2024, the Center wrote as follows, "This is a kind reminder that today is the last day to submit your submissions in relation to the Administrative Panel Procedural Order No. 1". The Complainant's representative replied the same day stating, "Thank you for your email. The Complainant requests an additional 10 day extension of time on the basis that the client has been unavailable".

On April 16, 2024, the Center wrote as follows:

"Dear Parties,

The Complainant's below communication [i.e. the April 15, 2024 email – above] has been forwarded to the Panelist for his consideration.

The Panel respectfully considers that further detail as to the common law trademarks relied upon is required as requested per the Administrative Panel Procedural Order No. 1. The Panel grants the Complainant's request for further time in this regard. Accordingly, the new date for the Complainant to submit its submission is April 26, 2024.

The Respondent may if he wishes submit by the end of April 30, 2024 a filing limited to addressing matters arising out of the Complainant's further submission.

The Decision due date is extended to at least May 6, 2024".

On April 24, 2024, the Complainant's representative wrote as follows:

"Thank you for your emails. The Complainant is of the view that it has submitted sufficient evidence of common law trademark rights as it relates to the trademark SMARTKOIN by virtue of the inclusion of its website. As well, and as per the attached, the domain name smartkoin.net was registered in 2020 well before the impugned domain name was registered in 2023. As well, the smartkoin.net domain name was in use shortly after its registration. This is of course the reason the Respondent selected the impugned domain name. The Respondent's fraudulent scheme would only have worked if a domain name confusingly similar to the Complainant's trademark was selected.

The Complainant also respectfully submits that it has established that BSS-PH.COM has been used as a trademark or source identifier.

Ultimately, the two impugned domain names were chosen with purpose, namely, to confuse end users as to source. That only occurs if they are confusing with existing trademarks".

It is therefore the Panel's position that the Complainant has confirmed that it relies upon unregistered trademark rights in the terms SMARTKOIN and BSS-PH.COM. The Complainant has however declined the Panel's request to provide further information in this regard. This is despite the Panel having requested such information and providing the Complainant with additional time, as requested, to provide such information.

It is therefore necessary to analyse whether the Complainant has established unregistered trademark rights for purposes of the Policy.

Insofar as unregistered trademark rights are relied upon see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition section 1.3 as to the type of material required in this regard. Specifically:

“To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

(Particularly with regard to brands acquiring relatively rapid recognition due to a significant Internet presence, panels have also been considering factors such as the type and scope of market activities and the nature of the complainant’s goods and/or services.)

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.

As noted in section 1.1.2, for a number of reasons, including the global nature of the Internet and Domain Name System, the fact that secondary meaning may only exist in a particular geographical area or market niche does not preclude the complainant from establishing trademark rights (and as a result, standing) under the UDRP.

Also noting the availability of trademark-like protection under certain national legal doctrines (e.g., unfair competition or passing-off) and considerations of parity, where acquired distinctiveness/secondary meaning is demonstrated in a particular UDRP case, unregistered rights have been found to support standing to proceed with a UDRP case including where the complainant is based in a civil law jurisdiction.

The fact that a respondent is shown to have been targeting the complainant’s mark (e.g., based on the manner in which the related website is used) may support the complainant’s assertion that its mark has achieved significance as a source identifier”.

Considering the application of the above cited factors to the evidence in the Complaint, the Panel finds as follows.

The term SMARTKOIN is said to have been used since March 2023. No evidence as to the nature or extent of this use has been provided save for details of the Complainant’s Website (see above). The term BSS-PH.COM is said to have been used in email addresses since at least November 2018. The only public-facing evidence of such use is set out in Exhibit 2 to the Complaint which comprises a number of recruitment advertisements inviting interested candidates to send their details to an email address which uses the <bss-ph.com> domain name, but no further information is provided concerning the placement or success of such advertisements (e.g. how and where they were placed and for how long, or how many responses they generated). The Panel’s own searches indicate that the domain name <bss-ph.com> does not resolve to an active website.

Accordingly, the evidence presented provides the Panel with no information regarding public recognition of the Complainant and its relied upon trademarks.

No real information has been provided as to the type and scope of the Complainant's market activities and the nature of the Complainant's services. Indeed it is not clear to the Panel what business the Complainant carries out. The Complaint itself says "The Complainant is a government registered enterprise which provides technical and customer support services such as customer relationship management services, data management and information processing services, customer care and information technology services to foreign and offshore clients who are primarily engaged in interactive gaming". However, no evidence has been provided about the detail of the services in question and no detail at all has been provided as to who the foreign and offshore clients are. There is no information anywhere supporting the claim that the Complainant's clients are primarily involved with interactive gaming and nothing on the Complainant's Website suggests it has any interest or expertise in that area.

In fact there is no evidence at all that anybody even knows of the Complainant. Notably, the fraud that is at the center of the Complaint is a fraud upon the Complainant itself, not a fraud on a customer. The evidence shows that an employee of the Complainant was tricked by use of an email address using the <bsss-ph.com> disputed domain name but that does not on its own show that BSS-PH.COM is a trademark in the sense of being a source identifier to the public as to the Complainant's goods or services. It simply shows that the employee in question by mistake thought the email originated within her own company when it did not. Similarly the evidence as to use of the term BSS-PH.COM shows it has been used as an email address in recruitment advertisements for candidates to send their applications to. That does not show it is a trademark, particularly in view of the lack of any evidence demonstrating use by, or awareness of, such email address by the general public (or even prospective employees).

Insofar as the Complainant's Website (see above) is relied upon, the Panel finds as follows. The website is very brief, contains limited detail, and is expressed in entirely generic terms. It singularly lacks any real detail about the Complainant and the single testimonial on it is from someone simply identified as "Sophia". No information has been provided as to how many visitors the Complainant's Website receives or how much business it generates. It does not use the term BSS-PH.COM anywhere and it does not, in the Panel's opinion, establish that the term SMARTKOIN is recognised as a source identifier for whatever services it is that the Complainant actually provides.

Taking all of this as a whole the Panel concludes there is no evidence to show that the terms SMARTKOIN and BSS-PH.COM have become "a distinctive identifier which consumers associate with the complainant's goods and/or services" (see [WIPO Overview 3.0](#) 1.3 above).

This then leaves the Complainant's argument as expressed in its email communications with the Center (see above) which in essence is to say that the Respondent used the Disputed Domain Names as part of impersonating emails and that therefore proves the corresponding terms are trademarks. The Panel does not think that is correct. First, the emails in question were directed at an employee of the Complainant not a customer (the Complainant's representative referred to confusion of an "end user" in this regard which seems inaccurate). Second, the evidenced emails reflect that the Respondent somehow involved itself in a preexisting email chain between the Complainant's employees, with the Complainant's genuine emails still on copy along with those connected to the disputed domain names. The fraud in question no doubt intended that the employee should mistake the fraudulent email for a genuine email and indeed it succeeded. That shows the employee in question mistakenly believed the email in question originated from within the employee's own organisation. It does not show that the employee (still less any customer) identified the domain name element within the fraudulent email in question as a trademark. The employee simply mistakenly recognised the email as a whole as being an email that originated within her employer's organization.

In addition, the Complainant's argument is circular – if accepted it would mean any email fraud of this nature automatically results in the term in question being held to be a trademark – that is not necessarily the case. Whilst a domain name can often be a trademark, that still needs to be proved by appropriate evidence - which the Complainant has failed to do here. Contrast the present case with another email fraud case - *Austin Industries, Inc. v. Mike Wheeler, Douglas Wood*, WIPO Case No. [D2024-0756](#), wherein the complainant provided extensive evidence of its unregistered rights in the term "Austin" in line with section 1.3

of [WIPO Overview 3.0](#). The absence of such evidence in the present case leaves the Panel with no choice but to dismiss the Complaint on the basis that the first element of the Policy has not been established as the Complainant has failed to show it has the necessary Rights in the relevant trademarks. It may well be that the Disputed Domain Names have been used fraudulently, but that does not automatically entitle the Complainant to succeed. It still has to show it has the necessary standing for the Policy to be applicable. It has not done so.

Accordingly the Panel finds the first element of the Policy has not been established.

B. Rights or Legitimate Interests

The Panel does not need to address this issue given its finding above.

C. Registered and Used in Bad Faith

The Panel does not need to address this issue given its finding above.

7. Decision

For the foregoing reasons, the Complaint is denied. Given that it appears the Disputed Domain Names may have been used fraudulently, this decision is without prejudice to the Complainant's right to file a further complaint if the Complainant is able to overcome its lack of evidence of trademark rights. In this context note that the requirement for a relevant trademark right is satisfied by a registered trademark which post-dates the activity complained of – see [WIPO Overview 3.0](#), section 1.1.2. See also [WIPO Overview 3.0](#) section 4.18 as to a further complaint.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: May 6, 2024