

ADMINISTRATIVE PANEL DECISION

**Kiwibank Limited v. Privacy Protection / Brands Delight / Prime Market
Case No. D2022-1041**

1. The Parties

1.1 The Complainant is Kiwibank Limited, New Zealand, represented by CSC Digital Brand Services Group AB, Sweden.

1.2 The Respondent is Privacy Protection, United States of America (“United States”) / Brands Delight / Prime Market, India.

2. The Domain Name and Registrar

2.1 The disputed domain name <kiwibank.xyz> (the “Domain Name”) is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 25, 2022. At that time the publicly available Whois details for the Domain Name identified the Respondent as the “Privacy Protection”, which appears to be a privacy or proxy service provided by the Registrar in respect of its domain names.

3.2 On March 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 25, 2022, the Registrar transmitted by email to the Center its verification response disclosing the underlying registrant and contact information held for the Domain Name. The Center sent an email communication to the Complainant on March 27, 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 March 28, 2022.

3.3 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”).

3.4 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 11, 2022. In accordance with the Rules, paragraph 5,

the due date for Response was May 1, 2022. The Respondent sent an email to the Center on April 12, 2022, but did not submit any formal response. The Center informed the Parties of the Commencement of Panel Appointment Process on May 3, 2022.

3.5 The Center appointed Matthew S. Harris as the sole panelist in this matter on May 18, 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

4.1 The Complainant is a bank founded in 2002, incorporated and providing services in New Zealand. Its operating income as of July 2021 was NZD 577 million, with a total net asset growth of NZD 2.9 billion, and NZD 126 million in profits. It currently has over one million customers.

4.2 The Complainant is the owner of a number of New Zealand registered trade marks for the word mark KIWIBANK. They include:

- (i) New Zealand registered trade mark no. 644724 dated March 3, 2003 in class 9;
- (ii) New Zealand registered trade mark no. 644725 dated March 3, 2003 in class 16;
- (iii) New Zealand registered trade mark no. 644726 dated March 3, 2003 in class 35; and
- (iv) New Zealand registered trade mark no. 644727 dated March 3, 2003 in class 36.

4.3 The Complainant has for a number of years promoted and provided its services from a website operating from the domain name <kiwibank.co.nz>.

4.4 The Domain Name was registered on January 5, 2022. It has been used since registration to display a web page produced by the “Dan.com” website, offering the Domain Name for sale for USD 799.

4.5 The Respondent would appear to be an individual or entity using the name “Brands Delight / Prime Market” and located in India.

4.6 As at the date of this decision, the Domain Name still is being used to display a “Dan.com” generated web page, but it declares that the “domain listing is deleted”.

5. Parties’ Contentions

A. Complainant

5.1 The Complainant refers to its business and marks and the manner in which the Domain Name has been used. It contends that the Domain Name is identical to its registered trade marks. It further contends that the Respondent has no rights or legitimate interests in the Domain Name, and that the fact that the Domain Name has been offered for sale does not provide such a right or interest and demonstrates that the Domain Name was registered and has been used in bad faith. So far as bad faith is concerned, it contends that the use made of the Domain Name falls within the scope of both paragraph 4(b)(i) and paragraph 4(b)(iv) of the Policy.

B. Respondent

5.2 The Respondent did not submit a formal Response, but sent an email where it contends:

“I never had any malicious intention with the domain name nor I did not approach anyone to sell it.

I am not really interested in the domain name either. If the domain name is what is required, you can take it and I am happy to transfer to whoever it is required”.

6. Discussion and Findings

6.1 There are no exceptional circumstances within paragraph 5(f) of the Rules so as to prevent this Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to lodge a formal Response.

6.2 Notwithstanding the default of the Respondent, it remains incumbent on the Complainant to make out its case in all respects set out in paragraph 4(a) of the Policy. Namely, the Complainant must prove that:

(i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights (paragraph 4(a)(i));

(ii) the Respondent has no rights or legitimate interests in respect of the Domain Name (paragraph 4(a)(ii)); and

(iii) the Domain Name has been registered and is being used in bad faith (paragraph 4(a)(iii)).

6.3 However, under paragraph 14(b) of the Rules, where a party does not comply with any provision of the Rules, the Panel shall “draw such inferences therefrom as it considers appropriate”.

A. Identical or Confusingly Similar

6.4 The Panel accepts that the Complainant is the owner of a number of registered trade marks for the word mark KIWIBANK. The Domain Name takes the form “kiwibank” which is an exact match to the Complainant’s mark, combined with the “.xyz” new generic Top-Level Domain (“new gTLD”). It follows that the Complainant has made out the requirements of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests, and Registered and Used in Bad Faith

6.5 It is usual for panels under the Policy to consider the issues of rights or legitimate interests, and registration and use in bad faith in turn. However, in this case it is more convenient to consider those issues together; as contemplated by section 2.15 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the [“WIPO Overview 3.0”](#)).

6.6 The Complainant’s trade mark obviously involves a combination of the words “kiwi” and “bank”. “kiwi” is a word that has a number of meanings or connotations, including as the name of a fruit and as the name of a New Zealand flightless bird. However, “Kiwi” is also a very well-known informal non-disparaging (and often affectionate) name for someone who comes from New Zealand. No doubt that is why the Complainant chose the name “Kiwibank” for its New Zealand focused banking business.

6.7 The Panel accepts that the only sensible interpretation of the Domain Name is as involving a deliberate reference to the Complainant’s mark and business. As far as the Panel is aware no matter how the term “kiwi” is understood, the words “kiwi” and “bank” together have no sensible meaning independent of their association with the Complainant. Also, the Panel is persuaded absent any argument or evidence to the contrary, that the Respondent deliberately chose the Domain Name with that association in mind. The “.xyz” new gTLD element of the Domain Name also does not immediately signal a lack of connection with the trade mark owner.

6.8 It follows from this that the Domain Name, is problematic in that it takes the form <[trade mark].[gTLD]> and inherently and deliberately impersonates the Complainant's mark and business. There is no right or legitimate interest in holding such a domain name and the registration and holding of such a domain name is registration and use in bad faith (see section 2.5.1 and the first paragraph of section 3.2.1 of the [WIPO Overview 3.0](#)).

6.9 Further, and in any event the Panel accepts that the offer for sale of the Domain Name through "Dan.com", demonstrates that the Domain Name was registered with the intention of sale to the Complainant or a competitor for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the Domain Name. This falls within the scope of the example of circumstances indicating bad faith set out in paragraph 4(b)(i) of the Policy. Such conduct also constitutes positive evidence of a lack of rights or legitimate interests.

6.10 The Complainant has, therefore, made out the requirements of paragraph 4(a)(ii) and (iii) of the Policy.

7. Decision

7.1 For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <kiwibank.xyz>, be transferred to the Complainant.

/Matthew S. Harris/

Matthew S. Harris

Sole Panelist

Date: June 1, 2022