

ADMINISTRATIVE PANEL DECISION

K-Swiss Inc. v. Redacted for Privacy

Case No. D2022-3849

1. The Parties

- 1.1 The Complainant is K-Swiss Inc., United States of America (“United States”), represented by TechMark a Law Corporation, United States.
- 1.2 The Respondent is Redacted for Privacy, Germany.

2. The Domain Name and Registrar

- 2.1 The disputed domain name <kswissireland.com> (the “Domain Name”) is registered with 1API GmbH (the “Registrar”).

3. Procedural History

- 3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 13, 2022. On October 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 17, 2023, the Registrar transmitted by email to the Center its verification response. In that email and in response to the Center’s request for full contact details in relation to the Domain Name, the Registrar stated:

“Unfortunately, the reseller and his registrant didn’t provide us any registrant data as well as admin/tech/billing data. So we’re not able to share the real registrant data. The handle states ‘redacted for privacy’“.

- 3.2 On October 21, 2022 the Center submitted a complaint to ICANN Contractual Compliance in respect of that response. That complaint contained the following statement:

“The Center expects that an ICANN-accredited Registrar must have various means of obtaining registrant information for domain name registrations held by that registrar (and in fact is obliged to obtain such information), even if a domain name registration is initially sold via a reseller. In this regard the Center notes, in particular, the Registrar’s obligations as provided in sections 3.4 and 3.12 of the 2013 Registrar Accreditation Agreement, the Whois Accuracy Program Specification of the 2013 Registrar Accreditation Agreement, and the Temporary Specification for gTLD Registration Data.

Noting this is not an isolated incident with 1API GmbH, but has happened in at least one other case (see separate ICANN online complaint number 01157234 regarding WIPO Case No. [D2022-2885](#)), the Center kindly requests ICANN Compliance instruct 1API GmbH to reveal the full contact details associated with the domain name registration for as soon as possible, and put into place whatever processes (internally and/or with its resellers) are required to avoid such issues in future cases, in order to ensure the continued effective administration of the UDRP.”

- 3.3 On January 27, 2023 ICANN updated the Center in respect of this Complaint. In that update ICANN stated as follows:
- “... the [R]egistrar has identified an internal issue concerning the collection/transfer of registrant’s data, suspended the domain name as per its policies and is currently working on a remediation plan to prevent this issue from reoccurring.”
- 3.4 On February 23, 2023 the Complainant’s representatives confirmed to the Center that the Complainant wanted to proceed with the Complaint and on March 2, 2023 the Complainant submitted an amended Complaint modifying the mutual jurisdiction section of the same. 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 March 3, 2023.
- 3.5 In accordance with the Rules, paragraph 5, the due date for Response was March 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 27, 2023.
- 3.6 The Center appointed Matthew S. Harris as the sole panelist in this matter on March 31, 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

- 4.1 The Complainant is a company incorporated in the state of Delaware, United States. Since at least as early as 1966, the Complainant and/or its predecessors in title have dealt in footwear throughout the world under the K-SWISS brand and using a stripped shield device. Over the decades the Complainant and/or its predecessors in title have expanded the range of product sold under that brand so as to include clothing, various accessories, and retail services.
- 4.2 In 2002, the Complainant was ranked number 10 on Forbes list of 200 Best Small Companies and in 2005 its global sales passed USD 500 million. The Complainant won “Best New Shoe” and “Best Debut” in Running Network and Runners World magazines in 2009 and “Best New Shoe” by Running Network in 2010.
- 4.3 The Complainant is the owner of a family of worldwide trademarks which consist of or incorporate the term “K-SWISS” in connection with footwear, clothing items and retail store services featuring footwear and clothing, among other goods and services. These include:
- (i) United States registered Trademark No. 1275280 for K-SWISS as a word mark as a typed drawing in class 25 filed on September 30, 1982 and proceeding to registration on April 24, 1984;
 - (ii) United States registered Trademark No. 73669167 for K-SWISS as a word mark with words, letters, and/or numbers in stylized form in class 25 filed on June 29, 1987 and proceeding to registration on February 23, 1988; and
 - (iii) European Union registered Trade mark No. 4431508 for K-SWISS as a word mark in class 25 filed on May 10, 2005 and proceeding to registration on April 3, 2006.
- 4.4 The Complainant also is the owner of various registered trade marks for its stripped shield device.
- 4.5 The Complainant has promoted its products from websites operating from the <kwiss.com> and <kswiss.eu> domain names since 1994 and 2015 respectively. The products have also been promoted on various social media sites since 2008.

- 4.6 The Domain Name was registered on October 13, 2021. Since registration the Domain Name was used in respect of a website that prominently displays the term “K-Swiss” and the striped shield device and offers various “K-Swiss” branded shoes for sale. These shoes are priced in Euros. There was no statement on this website indicating that it was operated by any entity other than the Complainant.
- 4.7 On September 15, 2022 the Complainant submitted a Digital Millennium Copyright Act (“DMCA”) takedown notice to the original registrar of this website operating from the Domain Name, Hosting Concepts B.V. d/b/a Registrar.eu. In response to that notice the original registrar took down that website. A few days later, the Respondent transferred the Domain Name to the Registrar and the website was reinstated. However, as at the date of this decision, this website is no longer operational.

5. Parties’ Contentions

A. Complainant

- 5.1 The Complainant describes its business and marks in some detail. In addition to relying upon various registered trade mark rights it also claims common law right in the term “K-Swiss”. The Complainant further describes how the Domain Name has been used, including the change of registrars in September 15, 2022. It contends that counterfeit products have been offered for sale from the website operating from the Domain Name, but also contends that it is “unaware ... if any orders placed through the Respondent’s website would even be fulfilled” and goes on to maintain that “there is a strong likelihood that the website may be designed to phish for personal information and credit card details”.
- 5.2 The Complainant maintains that the Domain Name is confusingly similar to its K-Swiss trade marks and asserts that in particular consumers in Ireland are highly likely to be confused. The use made of the Domain Name is also said to demonstrate that the Respondent has no right or legitimate interest in the Domain Name and that use and the timing of the registration of the Domain Name are said to demonstrate bad faith registration and use. The Complainant further contends that the Respondent’s “underhanded tactics” in re-launching its website after it was already taken down by a prior registrar supports findings of bad faith. Similarly, it claims that the Respondent is deliberately concealing its identity and that this also supports findings of bad faith.

B. Respondent

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

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)); and
 - (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”.
- 6.4 Before addressing these substantive aspects of the Policy, the Panel notes (as is recorded in greater detail in the Procedural History section of this decision) that the conduct of the Registrar, and in

particular its failure to provide underlying registration details in respect of the Domain Name, has already been the subject of a complaint to ICANN.

- 6.5 That this Complaint was necessary is particularly disappointing given that (as was recorded in the Center's complaint to ICANN) this is not the first time that the Center has faced these difficulties with the Registrar. Similar issues were faced by the Center in *Cummins Inc. v. Peyman Shahidnoorai, Roshangar Rayaneh Tehran*, WIPO Case No. [D2022-2885](#), (a case involving the same panel as in the present case). In the *Cummins Inc.* case *supra* this Panel remarked, in respect of the Registrar's excuse that the relevant reseller had not provided the underlying registration data, as follows:

"... [I]f what the Registrar claims is correct, it is troubling that (a) the Registrar has allowed this to occur in the first place, and (b) when this was brought to the Registrar's attention no attempt appears to have been made by the Registrar to take this up with the reseller in question to obtain the relevant underlying data (notwithstanding the Center's direct request that it do so)."

- 6.6 Exactly the same questions raise their head in this instance and the fact that this has now happened more than once suggest that the Registrar's processes in respect of its dealings with its resellers are inadequate. Indeed, it would appear from ICANN's email of January 27, 2023 to the Center that the Registrar now accepts that there were problems with its processes and as at that was "working on a remediation plan to prevent this issue from reoccurring". It is not clear why these issues were not identified at the time of the *Cummins Inc.* case *supra*. But the Panel trusts that these matters are now in hand and there will not be a third occasion when the Registrar is unable to comply with the Center's verification request. The Panel also requests that the Center specifically brings to the Registrar's attention paragraphs 6.4 to 6.6 of this Decision.

A. Identical or Confusingly Similar

- 6.7 The Complainant has satisfied the Panel that it has registered trade mark rights in the term "K-Swiss" in a number of jurisdictions including the European Union. In order to demonstrate the first element of the Policy it is usually sufficient for a complainant to show that the relevant mark is "recognizable with the disputed domain name" (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).
- 6.8 The Domain Name can only be sensibly understood as the term "K Swiss" combined with the word "Ireland" and the ".com" Top-Level Domain. The Complainant's mark is, therefore, clearly recognisable in the Domain Name. The Complainant has therefore demonstrated that the Domain Name is confusingly similar to a trade mark or service mark in which the Complainant has rights and has, thereby, made out the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests and Registered and Used in Bad Faith

- 6.9 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.
- 6.10 The Panel accepts that the Domain Name has been deliberately registered and held with the intention of falsely impersonating the Complainant. First, there is the Domain Name itself. The term "K Swiss" has no obvious likely meaning which is unrelated to the Complainant's trade mark and the Panel accepts that the Domain Name has been deliberately chosen by the Registrant to take the form of that mark combined with a geographical term. As is recorded in section 2.4.1 of the [WIPO Overview 3.0](#), a domain name that deliberately takes the form of a trade mark combined with a geographical term is likely to involve an impermissible impersonation of the trade as such a combination is "seen as tending to suggest sponsorship or endorsement by the trademark owner".
- 6.11 Second there is the content of the website that has operated from the Domain Name. The Panel accepts that the prominent use of the Complainant's marks, the way that the goods on the website are presented for sale and the fact that nowhere on the website is any obvious text making it clear that the website is operated by an entity other than the Complainant, all mean that any internet user reaching this website is likely to conclude that this is a website operated by the Complainant.
- 6.12 The Complainant contends that the reason why the Respondent has done this is to engage in the sale of counterfeit goods or illegal phishing. That may be so, although it would have assisted the Panel

somewhat if the Complainant had more clearly advanced an explanation or reasoning as to why this is the case (as to which see section 2.13.2 of the [WIPO Overview 3.0](#)). Nevertheless, the Panel's conclusions that the Respondent is falsely impersonating the Complainant is sufficient for the Complainant to make out its case in respect of the second and third limbs of the Policy. There is no right or legitimate interest in holding and using a domain name in a manner that falsely impersonates another (see, for example, *Vestey Group Limited v. George Collins*, WIPO Case No. [D2008-1308](#)). Similarly, registering and holding a domain name in such a manner involves registration and use in bad faith. The Respondent's activities in this case also fall within the example of circumstances indicating bad faith registration and use set out in paragraph 4(b)(iv) of the Policy.

- 6.13 Last but not least there is the Registrant's conduct in moving the Domain Name between registrars and re-setting up the website operation following a DCMA complaint, is also further evidence that the Respondent holds no right or legitimate interest in the Domain Name and that the Domain Name was not registered in bad faith. A *bona fide* business that believed its activity from the Domain Name to have been legitimate, is unlikely to have acted in this fashion.
- 6.14 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, <kswissireland.com> be transferred to the Complainant.

/Matthew S. Harris/

Matthew S. Harris

Sole Panelist

Date: April 11, 2023