

## **ADMINISTRATIVE PANEL DECISION**

### **Kuomiokoski Oy v. Web Commerce Communications Limited, Client Care Case No. D2022-4643**

#### **1. The Parties**

The Complainant is Kuomiokoski Oy, Finland, represented by Backström Co Ltd., Attorneys-at-Law, Finland.

The Respondent is Web Commerce Communications Limited, Client Care, Malaysia.

#### **2. The Domain Name and Registrar**

The disputed domain name <kuomaale.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 5, 2022. On December 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on December 8, 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 amendment to the amended Complaint on December 9, 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 of the Complaint, and the proceedings commenced on December 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 10, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on January 24, 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 the owner of the European Union trademark registration (word) for KUOMA, registered on October 20, 2000, Registration no. 1913995, and the Finnish trademark registration (word) for KUOMA, registered on October 30, 1998, Registration no. 211622, both in the class 25 (Annex 2 to the Complaint).

The Complainant's website is available under the domain name <kuoma.fi> offering shoes and kit's outdoor clothing (Annex 4 to the Complaint)

The disputed domain name was registered on November 21, 2022 (Annex 1 to the Complaint).

The disputed domain name resolved (at least until December 2, 2022) to a website which purportedly offered KUOMA products under the KUOMA trademark (Annex 3 to the Complaint); currently the disputed domain name is not actively used, it resolves to a website indicating "Access denied Error code 1020 You do not have access to www.kuomaale.com. The site owner may have set restrictions that prevent you from accessing the site".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant is a well-known kid's outerwear manufacturer founded in 1928. The most famous and successful products of the Complainant are the KUOMA shoes. The main website provided by the Complainant is addressed under the domain name <kuoma.fi>.

The Complainant owns the Finnish trademark registration no. 211622 and the European Union trademark registration no. 1913995 for the word KUOMA for clothing, footwear, headgear, insoles (class 25).

The disputed domain name is confusingly similar to these trademark registrations since it only adds the word "ale" which means "discount" or "rebate" in Finish language.

The Respondent has no rights or legitimate interests in respect of the disputed domain name: It is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register its trademark, or to seek registration of any domain name incorporating said trademark. Hence, the Respondent cannot claim legitimate interests in the disputed domain name and is not commonly known by the disputed domain name or the name KUOMA.

The Respondent has registered and is using the disputed domain name in bad faith. The disputed domain name addresses a website on which KUOMA products were offered; in fact, the content of the official website of the Complainant was copied and used on the website addressed by the disputed domain name.

Moreover, the Respondent registered the domain name <kuomaale.fi> which was deleted after an administrative proceeding in Finland initiated by the Complainant. This behavior of the Respondent shows its clear intention, which is exploiting the Complainant's high reputation and well-known products for its own commercial benefit.

##### **B. Respondent**

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

## 6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (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 with respect to the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

To make out a successful Complaint under the Policy all three conditions must be demonstrated by the Complainant.

### A. Identical or Confusingly Similar

The Complainant submitted evidence of various trademark registrations, which clearly establishes rights in the trademarks KUOMA.

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:

The disputed domain name is confusingly similar to the Complainant's registered trademark KUOMA since it only adds the word "ale" which means "rebate" or "discount" in Finnish language. It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition "[WIPO Overview 3.0](#)").

Finally, it has also long been held that generic or country-code Top-Level-Domains are generally disregarded when evaluating the confusing similarity of a disputed domain name.

Hence, the Complainant has satisfied paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant's mark in its entirety and only add the word "ale" which means "rebate" or "discount" cannot be considered fair as these falsely suggest an affiliation with the Complainant that does not exist (see section 2.5 of the [WIPO Overview 3.0](#)).

Noting the above and all of the evidence put forward by the Complainant in the Complaint, as well as the Complainant's contentions that the Respondent has no rights or legitimate interests in the disputed domain names, that the Respondent has no connection or affiliation with the Complainant, and the Respondent has

not received any license or consent, express or implied, to use the Complainant's trademark KUOMA in a domain name or in any other manner as well as the fact that the Respondent has not rebutted these allegations, it is undeniable for this Panel that the conditions set out in paragraph 4(a)(ii) of the Policy have been met by the Complainant.

### **C. Registered and Used in Bad Faith**

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

(a) In the present case the Complainant has registered trademark rights in the mark KUOMA since 1998, long before the registration of the disputed domain name in 2022. Moreover, the Complainant has a strong internet presence and is using the domain name <kuoma.fi> for addressing its main website on which it offers its products.

It is inconceivable for this Panel that the Respondent registered the disputed domain name without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name consists of the Complainant's trademark and the word "ale" (rebate/discount) which in fact rather strengthens the impression that the disputed domain name is in some way connected to the Complainant.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(b) Although the disputed domain name currently is not actively used, the Complainant put forward evidence that the disputed domain was used until at least December 2, 2022 to address a website on which products of the Complainant were offered.

In doing so, the Respondent intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website according to paragraph 4(b)(iv) of the Policy – this constitutes bad faith use of the disputed domain name.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and has been using the disputed domain name in bad faith according to paragraph 4(a)(iii) 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 <kuomaale.com> be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: February 8, 2023