

ADMINISTRATIVE PANEL DECISION

Kohler Co. v. Mo Linfang
Case No. D2023-3350

1. The Parties

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

The Respondent is Mo Linfang, Hong Kong, China.

2. The Domain Names and Registrar

The disputed domain names <kohlerofficial.com> and <onlinekohler.com> are registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 3, 2023. On August 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, 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 (PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 9, 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 August 14, 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 August 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 6, 2023.

The Center appointed David Stone as the sole panelist in this matter on September 12, 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 a US-based manufacturing company that was founded in 1873 and which produces and sells a wide range of products, and provides a wide range of services, to a global customer base. It has 44 manufacturing plants, 26 subsidiaries and affiliates, and dozens of sales offices situated around the world. The goods made by the Complainant range from shampoo to clothing to furniture, glassware and bathroom accessories, and the services provided by the Complainant include travel planning; hotel, resort and restaurant hospitality; and health spa services.

The Complainant owns numerous trade marks, including the following (the “Marks”).

- KOHLER: United States registration number 3744769 registered on February 2, 2010, in international class 42;
- KOHLER: United States registration number 3759343 registered on March 9, 2010, in international class 35;
- KOHLER: United States registration number 3070969 registered on March 21, 2006, in international class 3;



-  : United States registration number 2851217 registered on June 8, 2004, in international classes 9, 25 and 42;
- KOHLER: United States registration number 94999 registered on January 20, 1914, in international class 11;
- KOHLER: United States registration number 3297346 registered on September 25, 2007, in international class 21;
- KOHLER: United States registration number 3285651 registered on August 28, 2007, in international class 30;
- KOHLER: Hong Kong, China registration number 19780409AA registered on March 29, 1978, in international classes 7 and 11; and
- KOHLER: Hong Kong, China registration number 200305259AA registered on April 2, 2003, in international classes 6, 19, 20 and 21.

The Complainant advertises its goods and services, and provides customer support, at the websites “www.kohler.com” and “www.kohlercollection.com”.

The disputed domain names were both registered on September 29, 2022. When the Complaint in these proceedings was filed, each of the disputed domain names resolved to a website on which products bearing the Marks were purportedly available for sale.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to the Marks. They fully incorporate the Marks that comprise the single word KOHLER, and differ from these marks only in the addition of the generic Top-Level Domain “.com” and one or other of the common terms “official” and “online”. None of these additions serves to distinguish the disputed domain names from the Marks.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names. The Respondent is not commonly known by either of the disputed domain names and has received no licence, permission or other authorisation from the Complainant to use the disputed domain names. The Respondent's use of the disputed domain names to sell goods featuring the Marks is neither a *bona fide* offering of goods nor a legitimate noncommercial or fair use of the disputed domain names.

The Complainant contends that the Respondent registered and is using the disputed domain names in bad faith. Given the use being made of the Marks, the Respondent must have registered the disputed domain names with actual or constructive knowledge of the Marks and must have done so with the intent to trade off the Complainant's reputation and goodwill in the Marks. The Respondent is using the disputed domain names to capitalize on Internet users' efforts to find the Complainant's website, which amounts to both diversion of Internet traffic for the Respondent's commercial gain and an attempt to disrupt the Complainant's business. The use of two domain names in this way is evidence of a pattern of such disruptive behaviour, which indicates bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets out the three requirements that the Complainant must prove in order to succeed:

- (i) that the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

On the evidence provided by the Complainant, the Panel is satisfied that the Complainant has rights in the Marks. In assessing the confusing similarity between the disputed domain names and the Marks, it is permissible to ignore the generic Top-Level Domain. The disputed domain names contain the text of the KOHLER marks in its entirety and differ from it only by the addition of the terms "official" and "online". In neither case does the additional term prevent a finding of confusing similarity with the KOHLER mark.

The Panel therefore finds that the disputed domain names are confusingly similar to the KOHLER marks, and concludes that the condition in paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the criteria that determine whether a domain name registrant has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business or other organisation) has been commonly known by the disputed domain name, even if the respondent has acquired no trade mark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the trade mark or service mark at issue.

The Complainant makes out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names, and the Respondent has provided no evidence to contradict it.

On the facts and contentions before the Panel, the Respondent is not commonly known by either of the disputed domain names, is not authorised to use the Marks and cannot claim any rights or legitimate interests in them by virtue of prior registration.

The disputed domain names include the KOHLER marks in its entirety with the terms “official” and “online”, respectively. The addition of “online” suggests an online source of information, and the addition of “official” suggests an authoritative source of information, but in both cases the use of KOHLER implies that the information will relate to the Complainant.

The Complainant has supplied in evidence screenshots of the websites to which the disputed domain names resolved. These show that the Respondent has been using the disputed domain names to purportedly sell goods such as clothing, glassware and bath products prominently featuring the Marks. Comparison with the goods sold by the Complainant on its website at “www.kohlercollection.com” shows that many of the goods advertised by the Respondent are purported cut-price versions of the Complainant’s goods, and that the Respondent has advertised its goods using copies of images from the Complainant’s website. The Respondent has not contended that it is making *bona fide* use of its websites to resell the Complainant’s genuine branded goods, and so the Panel assumes that the Respondent is using the disputed domain names to sell counterfeits (see the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 2.13), which illegal activity does not constitute a *bona fide* offering of goods or a legitimate noncommercial or fair use of the disputed domain names (*Philipp Plein v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Norma Brandon, cheapphilipplein*, WIPO Case No. [D2015-1050](#)).

The Panel concludes that the condition in paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out the non-exhaustive criteria for bad faith. Generally, for the purposes of the Policy, bad faith constitutes registration and use of a domain name in order to:

- (i) sell, rent or transfer the domain name to the trade mark owner (or a competitor thereof) for a profit;
- (ii) prevent the trade mark owner from registering its trade mark in a domain name, provided that the respondent is engaged in a pattern of such conduct;
- (iii) disrupt the business of a competitor; or
- (iv) divert Internet traffic for commercial gain.

The disputed domain names are confusingly similar to the KOHLER marks and are being used to purportedly sell goods bearing one or more of the Marks. Neither of these uses of the Marks has been authorized by the Complainant, and, as explained above, the Panel assumes that the goods are counterfeit. In the absence of an alternative explanation from the Respondent, the Panel concludes that the Respondent was aware of the Complainant and its business, and devised and registered the disputed domain names to create a false and misleading impression of association between the disputed domain names and the Complainant. The Respondent’s objective was to disrupt the Complainant’s business and divert Internet traffic for the Respondent’s commercial gain. The registrations were therefore in bad faith. The Respondent’s subsequent use of the disputed domain names to purportedly sell counterfeit goods branded using the Marks clearly amounts to bad-faith use, for the same reason: “the exploitation of consumer confusion for the purpose of selling counterfeit goods, with evident knowledge of the Complainant’s rights in its trade marks, is one of the strongest examples of registration and use in bad faith” (*Goyard St-Honoré v. Lin Honghai*, WIPO Case No. [D2012-1165](#)).

The condition in Paragraph 4(a)(iii) of the Policy is therefore satisfied.

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 names, <kohlerofficial.com> and <onlinekohler.com>, be transferred to the Complainant.

/David Stone/

David Stone

Sole Panelist

Date: September 25, 2023