

ADMINISTRATIVE PANEL DECISION

Kohler Co. v. Xiaoyu Huang
Case No. D2024-0078

1. The Parties

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

The Respondent is Xiaoyu Huang, China.

2. The Domain Name and Registrar

The disputed domain name <homekohler.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 9, 2024. On January 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 11, 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 amended Complaint on January 12, 2024.

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 January 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 6, 2024.

The Center appointed Anna Carabelli as the sole panelist in this matter on February 14, 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.

4. Factual Background

The Complainant designs, manufactures and market a wide range of kitchen and bath products and supplies under the trademark KOHLER. Founded in 1873, the Complainant now counts 44 manufacturing plants, 26 subsidiaries and affiliates, and dozens of sales offices over the world.

The Complainant owns multiple trademark registrations incorporating the word element KOHLER throughout the world, including the following:

- United States word mark KOHLER, registered under No. 94999 on January 20, 1914;
- United States word mark KOHLER, registered under No. 3352028 on December 11, 2007;
- China word mark KOHLER, registered under No. 142982 registered on December 5, 1980; and
- China word mark KOHLER, registered under No. 8624696 registered on February 28, 2013.

The disputed domain name was registered on November 7, 2022. The evidence in the Complaint shows that the disputed domain name resolves to a website allegedly selling KOHLER-branded products at considerably discounted prices. The Respondent's website reproduces the Complainant's KOHLER mark and appears to be a replica of much of the Complainant's official website.

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 name.

Notably, the Complainant contends that

- It has established rights in the KOHLER trademark by virtue of longstanding use and registration in numerous jurisdictions worldwide. The Complainant's KOHLER mark has become famous around the world due to extensive use and advertising;
- The disputed domain name is confusingly similar to a trademark in which the Complainant has rights, since it consists of the Complainant's KOHLER mark. The addition of the term "home" does not prevent a finding of confusing similarity;
- The Respondent has no rights or legitimate interests in the disputed domain name since:
 - (i) the Complainant has not authorized or somehow given consent to the Respondent to register and use the disputed domain name, (ii) the Respondent is not commonly known by the disputed domain name, and (iii) the Respondent's use of the disputed domain name is neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use. In this connection the Complainant points out that the disputed domain name redirects to a website that largely replicates the Complainant's official website, and sells competing and/or counterfeit products. The heavy discounting evident in the Respondent's website supports the possibility that the products may be counterfeit in nature;
- The disputed domain name was registered and is being used in bad faith. The Respondent registered the disputed domain name having in mind the Complainant's KOHLER trademark, with the clear intention to trade off the reputation and goodwill of the Complainant's mark, by diverting Internet users seeking the Complainant's website to its own website for commercial gain.

Based on the above the Complainant requests the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

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

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the Complainant's registered trademarks KOHLER is reproduced and recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the generic Top-Level Domain such as ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

Although the addition of other terms here, "home", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of

proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, as noted in Section 6.A. above, the disputed domain name is confusingly similar to the Complainant's KOHLER mark and carries a risk of implied affiliation with the Complainant. This cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

While the Complainant has pointed to the discounted prices of the goods offered at the website to which the disputed domain name resolves reflect the potential counterfeit nature of the goods, the Panel needs not come to a determination on the nature of the goods being offered, noting that the Respondent's website displays the Complainant's KOHLER mark, largely replicates the Complainant's official website and provides no information concerning the website's relationship (lack thereof) to the Complainant. See sections 2.8 and 2.13.2 of the [WIPO Overview 3.0](#). Further to the so-called "Ok! Data test" enshrined in *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), even if the goods offered at the website to which the disputed domain name resolves were of a genuine nature, the use of the disputed domain name cannot constitute fair use given its lack of disclaimers.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Complainant's KOHLER trademark has been continuously and extensively used for many years and has as a result acquired reputation and goodwill worldwide. It is difficult to believe that the Respondent did not have in mind the Complainant's KOHLER trademark when registering the disputed domain name. Prior panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

In the present case, the Panel notes that the disputed domain name fully incorporates the Complainant's KOHLER registered trademark, and is being used by the Respondent to direct to a website allegedly offering KOHLER-branded products. All of the above indicates that the Respondent had the Complainant or its trademark in mind when selecting the disputed domain name, and suggests that the disputed domain name was registered and is being used in bad faith, with a deliberate intent to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website.

The Panel finds that the Complainant has established the third element 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 <homekohler.com> be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: February 28, 2024