

ADMINISTRATIVE PANEL DECISION

W.K. Kellogg Foundation v. Md Arif Hossain, eMedia Germany e.K.
Case No. D2024-3431

1. The Parties

The Complainant is W.K. Kellogg Foundation, United States of America (“United States”), represented by Mayer Brown LLP, United States of America.

The Respondent is Md Arif Hossain, eMedia Germany e.K., Germany.

2. The Domain Name and Registrar

The disputed domain name <wkellogg.foundation> is registered with Spaceship, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 21, 2024. On August 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 25, 2024, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 28, 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 September 10, 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 September 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 3, 2024. The Respondent sent several email communications to the Center on August 29, September 18 and September 23, 2024.

The Center appointed John Swinson as the sole panelist in this matter on October 23, 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 was established in 1930 as an independent, private foundation by breakfast cereal innovator and entrepreneur Will Keith Kellogg.

The Complainant is the owner of many trademark registrations around the world for marks comprising or incorporating "W.K. KELLOGG FOUNDATION". An example trademark registration owned by the Complainant is United States Trademark Registration No. 4228732 for W.K. KELLOGG FOUNDATION that was filed on August 10, 2011, and registered on October 23, 2012.

The disputed domain name was registered on December 7, 2023.

The disputed domain name resolves to a website with a heading "WKKELLOGG FOUNDATION. IT SERVICE PROVIDER" and with a banner that states "Happy Holidays" that is positioned below the words "eMedia Advertising network". The website appears to advertise or link to websites for an IT service provider and a business providing cybersecurity services, website maintenance and software development services.

The website at the disputed domain name also includes text that states: "Trademark rights and domain name ownership overlap in many ways, but they are not the same. Domain name ownership does not necessarily establish trademark rights, and trademark ownership does not necessarily give you the right to own the corresponding domain name".

The Respondent claims to operate "for profit" businesses in Bangladesh, Germany, and the United States under the name eMedia. These businesses appear to be IT services businesses. The Respondent also claims to operate three non-profit organizations, namely eMedia Foundation, RUPSA (Rural and Urban Poor's Partner for Social Advancement) and MK Foundation. The Respondent provided no details regarding these non-profit organizations.

The Respondent's email footer includes the domain name <e.sv> that diverts to <emedia.foundation>. This website includes the following text: "eMedia is an award-winning software and IT services company. We have been providing custom software development and IT services since 2005, Operating from Bangladesh, Germany, France, Luxembourg, Italy, Libya, Australia, The UAE & USA."

On March 26, 2024, the Complainant sent a letter the Respondent notifying the Respondent that the registration of the disputed domain name violates the Complainant's rights and requested that the disputed domain name be transferred to the Complainant. Despite repeated follow-ups, no response to this letter was received.

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 the Complainant's trademarks are distinctive and have acquired significant goodwill and reputation with almost 100 years of worldwide use. The Complainant has been operating its charity for nearly a century and has spent a considerable amount of time, money, and effort in the development, promotion, and marketing of its trademarks in the United States and around the world.

The Complainant asserts that the Respondent registered the disputed domain name intentionally trying to mislead consumers and cause consumer confusion. The Respondent has set up the disputed domain name to divert visitors of the Complainant's website to Respondent's fraudulent website for business or to sell the disputed domain name to the Complainant.

The Complainant further asserts that the Respondent clearly registered the disputed domain name in an attempt to falsely appear associated or affiliated with the Complainant and to perpetrate fraud, and the Respondent did not use or have any intention to use the disputed domain name in connection with a bona fide offering of goods or services.

B. Respondent

The Respondent filed an informal response. The Respondent's argument is that the disputed domain name was available for registration from 2013 to 2023. The Respondent registered the disputed domain name last year for a foundation project in Bangladesh. The domain name was available to register via the Registrar, and there "is no indication of it being restricted due to the 'W.K. Kellogg' trademark."

The Respondent also makes a high level argument apparently about reform of the Policy as follows: "Before the launch of the gTLD, ICANN and WIPO should have established a constitution to reserve the domains for 5-10 years according to Trademark or UDRP names. After that, if it's available for public registration, no one should be able to file a complaint under UDRP rules."

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

The onus of proving these elements is on the Complainant.

An asserting party needs to establish that it is more likely than not that the claimed fact is true. An asserting party cannot meet its burden by simply making conclusory statements unsupported by evidence. To allow a party to merely make factual claims without any supporting evidence would essentially eviscerate the requirements of the Policy as both complainants or respondents could simply claim anything without any proof. For this reason, UDRP panels have generally dismissed factual allegations that are not supported by any bona fide documentary or other credible evidence. *Snowflake, Inc. v. Ezra Silverman*, WIPO Case No. [DIO2020-0007](#); *Captain Fin Co. LLC v. Private Registration, NameBrightPrivacy.com / Adam Grunweg*, WIPO Case No. [D2021-3279](#).

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 mark is 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 Panel also notes that as part of a holistic review of the facts, it may be appropriate to “span the dot” and consider the generic Top-Level Domain (gTLD) (see, e.g., *Mr Green Ltd. v. Alfred Zeiselberger, Mediapool Communications Limited*, WIPO Case No. [D2017-1944](#); *Zions Bancorporation v. Mohammed Akik Miah*, WIPO Case No. [D2014-0269](#)). On this basis, the entirety of the mark is reproduced within the disputed domain name with considering the gTLD part of the disputed domain name. Accordingly, on this basis, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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. The Respondent states, without providing evidence, that the Respondent operates three foundations, but none of these foundations are legally named “W.K. KELLOGG” nor have a reason to use “W.K. KELLOGG” in or as part of their name or domain name.

As discussed below in respect of the third element of the Policy, the Respondent has not submitted a reasonable explanation for its registration and use of the disputed domain name, or evidence of rights or legitimate interests on its part in the disputed domain name, whether in the circumstances contemplated by paragraph 4(c) of the Policy or otherwise. Furthermore, the Panel finds that the Respondent has used the disputed domain name misleadingly to divert Internet users to a website that promotes Respondent’s IT services business, which circumstances cannot give rise to rights or legitimate interests.

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 Respondent is using the disputed domain name to resolve to a website promoting the Respondent’s IT services business.

The Respondent provides no reason for its own choice of the disputed domain name.

The Panel finds that the Respondent was aware of the Complainant when the Respondent registered the disputed domain name. The Complainant is long-standing and extremely well-known worldwide. The Respondent claims to do business in the United States, where the Complainant's trademark is famous. The Complainant's trademark is distinctive, and it could not be a good faith coincidence that the disputed domain name is identical to the Complainant's trademark.

Further, the Respondent's claimed basis for registering and using the disputed domain name is that the Complainant should have registered the disputed domain name, but for more than 5 years did not do so and thus abandoned rights in the disputed domain name.

The Respondent's view of the law is mistaken. There is no obligation on a trademark owner to register domain names corresponding to the trademark owner's trademark. In contrast, there is an obligation on a domain name registrant not to register domain names in breach of the Policy or the relevant domain name registration agreement.

The disputed domain name comprises an unadorned appropriation of the Complainant's trademark. In the view of the Panel, the disputed domain name is likely in these circumstances to imply to Internet users that it is owned, operated or otherwise legitimately commercially affiliated with the Complainant. The disputed domain name is in fact unconnected with the Complainant. The Panel finds, therefore, that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel is also aware of two recent decisions involving the Respondent, which suggest a pattern of registering famous trademarks as domain names. See *American Airlines, Inc. v. Md Arif Hossain, eMedia Bangladesh Ltd.*, WIPO Case No. [D2024-3834](#) and *VEON Amsterdam B.V. v. Md Arif Hossain, eMedia Bangladesh Ltd.*, WIPO Case No. [D2024-0562](#).

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 <wkkellogg.foundation> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: November 5, 2024