

ADMINISTRATIVE PANEL DECISION

Blistex Inc. v. Dns Admin, Noktala Co. Ltd.

Case No. D2012-1220

1. The Parties

The Complainant is Blistex Inc. of Oak Brook, Illinois, United States of America (“US”), represented by Ladas & Parry, US.

The Respondent is Dns Admin, Noktala Co. Ltd., Noktala Co. Ltd. of Kowloon, Hong Kong, China, represented by The Muscovitch Law Firm, Canada.

2. The Domain Name and Registrar

The disputed domain name <kanka.com> is registered with Moniker Online Services, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 15, 2012. On June 15, 2012, the Center transmitted by email to Moniker Online Services, LLC a request for registrar verification in connection with the disputed domain name. On June 16, 2012, Moniker Online Services, LLC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced June 26, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response July 16, 2012. The Response was filed with the Center July 16, 2012.

The Center appointed Isabel Davies, Ian Lowe and The Hon Neil Brown Q.C. as panelists in this matter on August 15, 2012. Isabel Davies was appointed as Presiding Panelist. The Panel finds that it was properly constituted. Each member of 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.

On August 23, 2012, the Panel issued an order for the Complainant to file supplemental filing within 5 days of the date of receipt of the Administrative Panel Procedural Order No. 1. Under Administrative Panel Procedural Order No. 1 the Respondent was permitted file a Response to this supplemental filing within 5 days of receipt of the Complainant's supplemental filing. Both parties filed supplemental filings in accordance with the Administrative Panel Procedural Order No. 1.

4. Factual Background

The Complainant contends that it has registered KANK-A as a US trademark, the European Community and in other countries around the world. The registrations include US trademark no. 539027 which was issued on March 6, 1951. The KANK-A trademark is registered in connection with pharmaceutical, veterinary and sanitary preparations.

The Complainant contends that the Kank-A brand of products, manufactured and distributed by the Complainant, is designed to treat oral pain. Each product in the Kank-A brand line offers maximum strength benzocaine to ease pain as well as unique formulas and application systems that deliver relief in the optimal method for each type of sore.

The Respondent registered the disputed domain name <kanka.com> on August 7, 2001.

The Respondent contends that it is in the business of investing in common Turkish-language dictionary term/descriptive domain names.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Complainant's trademark

The Complainant contends that the disputed domain name consists entirely of the Complainant's KANK-A mark wording in its entirety merely omitting the hyphen between the "K" and the "A". It contends that the Panel should therefore find that the disputed domain name is confusingly similar to the Complainant's trademarks because the KANK-A mark is the principal element of the disputed domain name.

Further the Complainant contends that the generic top-level domain (gTLD) ".com" serves no purpose in distinguishing the disputed domain name from the KANK-A mark because gTLD suffixes are a functional necessity.

The Respondent has no rights or legitimate interests in the disputed domain name

The Complainant contends that the Respondent registered the disputed domain name without the Complainant's authorization or consent and is using the disputed domain name to divert Internet users to the websites of the Complainant's direct competitors. It contends that the Panel should find that such use demonstrates neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use.

The Complainant contends that there is nothing in the Whois information indicating that the Respondent is commonly known by the disputed domain name.

Registered and used in bad faith

The Complainant contends that the Respondent has registered the disputed domain name confusingly similar to the Complainant's mark and used it to divert Internet users to the Respondent's website, where the Respondent likely garners click-through fees for each Internet user who selects one of the links. Further, the

Complainant contends that the links on the Respondent's website divert Internet users to websites that promote the goods and services of the Complainant's direct competitors.

The Complainant contends that the disputed domain name was registered for the purpose of disrupting the business of a competitor.

Further, it contends that the Respondent was clearly aware of the Complainant's rights in its KANK-A mark when the Respondent registered the disputed domain name, because the disputed domain name consists entirely of the KANK-A mark wording (merely omitting the hyphen), the associated website contains links concerning dental and mouth pain and the website content links to websites advertising the direct competitors of the Complainant. It contends that the Respondent was likely to be attempting to imply a false connection with the Complainant without the Complainant's consent or authorization.

It further contends that the Respondent is offering the disputed domain name for sale and this evidences bad faith as the price for such a "premium domain" will most surely exceed the out-of-pocket costs for the registration. This offer for sale is shown in a general banner at the top of the webpage to which the disputed domain name resolves. It contends that as the Respondent has offered the disputed domain name for sale to the general public it is reasonable to conclude that the Respondent harbors the intent of profiting either from selling the disputed domain name or participating in its exploitation for a commercial website.

B. Respondent

The disputed domain name is identical or confusingly similar to the Complainant's trademark

The Respondent contends that the inclusion of a dash is a prominent component of the Complainant's mark. It contends that its omission transforms the disputed domain name into a very different looking and sounding term.

The Respondent has no rights or legitimate interests in the disputed domain name

The Respondent contends that its legitimate interest stems from the fact that the disputed domain name is wholly comprised of a common Turkish word. It contends that it has been long-held in UDRP disputes that where a domain name is descriptive or generic, the first person to register it in good faith is entitled to the domain name.

Registered and used in bad faith

The Respondent contends that the Complainant's allegations of bad faith are bald, self-serving and entirely unsubstantiated.

The Respondent states that the purported search results submitted by the Complainant do not uniformly relate to mouth sores, nor do even the majority. It contends that any "Related Searches" were automatically generated by the website's automated pay per click (PPC) platform without any manipulation by the Respondent. Further, it contends that the automated platform identifies search terms that the algorithm links to the user, possibly through the use of cookies and other Internet Protocol address-related geographical data, and it may very well be that just prior to visiting the disputed domain name, the Complainant or its representative happened to be looking for a car rental in the Miami or Los Angeles areas, and the algorithm detected that, and that is why 4 out of 10 "Related Searches" relate to car rentals. Or perhaps, the Complainant manipulated the search results by typing "sore mouth" into the search bar, thereby gaming the system, although the Respondent is unable to prove this.

The Respondent contends that "kanka" means "buddy" in Turkish and the fact that the disputed domain name is composed solely of a common descriptive term in Turkish weighs heavily against a finding of bad faith registration. Further, it contends that without direct proof that a dictionary-word domain name was registered solely for the purpose of profiting from the Complainant's trademark rights, there can be no finding

of bad faith registration.

It contends that it was “never aware of the existence of the Complainant’s trademark rights until it received notice of this dispute nearly 12 years after his initial registration”. Further, the Respondent contends that it never approached the Complainant to sell the disputed domain name nor did the Respondent do anything intentionally to interfere with the Complainant’s business.

The Respondent contends that there is no reasonable basis to conclude that the Respondent targeted the Complainant in any manner whatsoever.

In response to the Complainant’s contention that the Respondent is offering the disputed domain name for sale and this evidences bad faith, it contends that the automated and general “this domain might be for sale” tag line is not evidence of bad faith as this is automatically generated by the website platform. The Respondent contends that it did not target the Complainant at all.

The Respondent contends that the Complainant has failed to disclose exculpatory evidence. It contends that on January 19, 2012 and on February 21, 2012, the Complainant’s representative in this proceeding and Respondent’s principal, Mr. Istanbulluoglu, were in contact by email. In this email exchange, the Respondent’s principal stated “Kanka means dude, buddy in Turkish and I am Turkish...Hope it is clear now.” The Complainant’s attorney made an offer to purchase the disputed domain name on behalf of its client for USD 250. The Respondent’s principal responded by stating “Sorry, but I have no interest to sell it to your client.” The Complainant increased its offer to USD 1,000. However, the Respondent’s principal did not reply to this offer.

Delay

The Respondent contends that the Complainant fails to adequately explain why it waited nearly twelve years to make a claim to the Respondent. It contends that “it is difficult to comprehend considering that if the disputed domain name was so truly confusingly similar and had genuinely been used in bad faith from the get-go, surely the sophisticated Complainant would have pounced”.

Reverse Domain Name Hijacking

The Respondent contends that the Complainant knew of the meaning of “kanka” in Turkish, knew that the disputed domain name was registered 12 years ago, knew or ought to have known that it was used in good faith for nearly 12 years, failed to disclose this to the Panel and proceeded as if this was a straight-forward case of typo-squatting when it knew or ought to have known otherwise. The Respondent contends that this is bad faith.

Supplemental filing

In relation to the Complainant’s failure to disclose exculpatory evidence, the Complainant contends that the offer to purchase the disputed domain name included in its cease and desist letter is irrelevant as it did so to avoid the cost of the UDRP proceeding.

It contends that because the Respondent is not using the disputed domain name in connection with a purpose relating to the generic/descriptive meaning of the term “kanka” in Turkish, this is not exculpatory. The definition of “kanka” in Turkish is “buddy”. It contends that the disputed domain name has resolved to a parking page for over eight years (which content has redirected Internet users to the Complainant’s direct competitors), and the Respondent has not shown it is using the disputed domain name in connection with the Turkish definition of “kanka” and/or demonstrable preparations to use it. Therefore, it contends that the Respondent has failed to show that it has rights or legitimate interests in the disputed domain name because its use of the disputed domain name is in no way connected to the generic meaning of “kanka”.

In relation to the Respondent’s contention that the Complainant’s allegations of bad faith are bald, self-

servicing and entirely unsubstantiated, the Complainant denies that its counsel was “gaming” the system. It contends that the print outs attached to the Complaint show the website of the disputed domain name “as is” and as it would be seen by any person accessing the disputed domain name without typing in any terms into the search engine.

Response to the supplemental filing

The Respondent contends that the supplemental filing changes nothing and does not even address the most crucial element of the UDRP, namely, bad faith registration.

It contends that it is relevant that “kanka” has a common ordinary meaning in the Turkish language. It means “buddy”.

It contends that the Complainant entirely ignores and fails to rebut the Respondent’s substantial evidence that the Respondent is in the business of registering similarly generic/descriptive domain names in the Turkish language, and that this has been held to constitute a *bona fide* business and a legitimate interest.

6. Discussion and Findings

The Policy establishes three elements, specified in paragraph 4(a) that must be established by the Complainant to obtain relief. These elements are:

- (i) the disputed domain name is identical or confusingly similar to the 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;
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted. The Complainant bears the onus of production of evidence of its case on the balance of probabilities. The Complainant must therefore establish all three of the elements specified in paragraph 4(a) of the Policy on the balance of probabilities before a decision can be made to cancel or transfer the disputed domain name.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant is the owner of trademark rights in KANK-A in connection with pharmaceutical, veterinary and sanitary preparations.

Compared to the Complainant’s trademark, the disputed domain name <kanka.com> consists of the trademark KANK-A omitting the hyphen between the “K” and the “A”. The disputed domain name is not identical to the trademark held by the Complainant, and the question is therefore whether there is confusing similarity.

The Panel agrees with the Complainant that the addition of the hyphen between the “K” and the “A” is not sufficient to render the disputed domain name dissimilar or to prevent consumer confusion. The panel in *Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525, stated that “when a domain name wholly incorporates a complainant’s registered mark that is sufficient to establish identity or confusing similarity for the purposes of the Policy”.

For the reasons stated above, the Panel holds that the disputed domain name is confusingly similar to the Complainant’s trademark and the Complainant has met the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraphs 4(c)(i) – (iii) of the Policy contain a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in a domain name. The list includes: (i) using the domain name in connection with a *bona fide* offering of goods and services; (ii) being commonly known by the domain name; or (iii) making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

The Complainant contends that the Respondent registered the disputed domain name without the Complainant's authorization or consent and is using the disputed domain name to divert Internet users to the websites of the Complainant's direct competitors.

The Respondent contends that its legitimate interest stems from the fact that the disputed domain name is wholly comprised of a common Turkish word. In Turkish, "kanka" means "buddy". The Complainant responded to this in its supplemental filing contending that the Respondent has failed to show that it has rights or legitimate interests in the disputed domain name because its use of the disputed domain name is in no way connected to the generic meaning of "kanka".

Factors a panel tends to look for when assessing whether there may be rights or legitimate interests in a domain name comprised of a dictionary word would include the status and fame of the trademark, whether the respondent has registered other domain names containing dictionary words or phrases and whether the domain name is used in connection with a purpose relating to its generic or descriptive meaning (see paragraph 2.2. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0").

In this case the Panel has not seen persuasive evidence of the status and fame of the Complainant's trademark. The Complainant has not provided any evidence of facts which might indicate that the Respondent knew or should have known of its trademark registrations. Nothing in the Policy can be construed as requiring a person registering a domain name to carry out a prior trademark search in every country of the world.

Since it is not shown that the Respondent knew or should have known of the existence of the Complainant's registered trademarks for KANK-A, there is no evidence suggesting that the disputed domain name has been chosen with the intent to profit or otherwise abuse the Complainant's trademark rights.

The Respondent has registered other domain names containing dictionary words or phrases. The Complainant has not disputed the fact that the Respondent owns other domain names which represent words in the Turkish dictionary. Whilst in the past the Panel accepts that the disputed domain name resolved to a homepage which included links titled "For Mouth Pain" and "Kanka chat", the Panel considers that the Complainant's evidence indicates the two different meanings of "kanka" - one a buddy and the other a trademark - which algorithms in the website platform used to form the Related Searches.

In conclusion, the Panel finds that the Respondent has legitimate rights and interests in the disputed domain name in accordance with paragraph 4(c)(i) of the Policy.

C. Registered and Used in Bad Faith

The Policy provides in paragraph 4(b) that certain circumstances, "in particular but without limitation", will be evidence of bad faith registration and use of a domain name, and lists four possible circumstances which shall be evidence of registration and use of a domain name in bad faith for the purposes of paragraph 4(a)(iii) of the Policy. These circumstances include:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable

consideration in excess of documented out-of-pocket costs directly related to the domain name; or

- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

As stated in relation to rights or legitimate interests, it is not shown that the Respondent knew or should have known of the existence of the Complainant's registered trademarks for KANK-A.

The Complainant has submitted evidence that for eight years the disputed domain name resolved to a homepage which showed various Related Searches including links titled "For Mouth Pain", "Kanka chat" and "Car rental discounts". The Respondent contends that the Related Searches are formed by algorithms that recognize through the use of cookies the Internet user's recently searched terms.

The Panel considers that the Complainant's evidence indicates the two different meanings of "kanka"- one a buddy and the other a trademark - and that these were both recognized by the algorithms used on the website platform to generate automated searches. The Panel does not find that the Respondent intentionally used the disputed domain name to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

Currently the disputed domain name resolves to a search engine, the homepage of which has links to websites for roommates, pen pals and classmates which relate to the Turkish meaning of "kanka". To reach websites that promote the goods and services of the Complainant's direct competitors, the Internet user must insert a term into the search engine which relates to the goods and services of the Complainant's competitors. This is how an Internet user would carry out a search through any other search engine. The Panel finds that the Respondent has not used the disputed domain name in bad faith.

Further, the Panel finds that the Respondent did not register the disputed domain name for the purpose of disrupting the business of a competitor.

In relation to the offer to sell the disputed domain name, this is shown in a banner which is automatically generated by the website platform not the Respondent. This is not something that is within the control of the Respondent. Further, the Respondent did not accept the Complainant's offers to buy the disputed domain name. Therefore, the Panel finds that the Respondent did not register or acquire the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name.

The Panel finds that the Complainant has failed to substantiate the essential third limb of its Complaint under paragraph 4(a)(iii) of the Policy.

Reverse Domain Name Hijacking

The Respondent contends that the Complainant has acted in bad faith by bringing these UDRP proceedings.

The Panel notes the definition of Reverse Domain Name Hijacking under the UDRP Rules as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name.” In this case, the Panel does not believe that the Complainant was using the UDRP in bad faith. The Complainant could understandably have thought that the Respondent had registered the disputed domain name to make a profit from the Complainant’s trademark rights.

In conclusion, the Panel does not find there to be Reverse Domain Name Hijacking under paragraph 15(e) of the Policy.

7. Decision

For all the foregoing reasons, the Complaint is denied.

Isabel Davies
Presiding Panelist

Ian Lowe
Panelist

The Hon Neil Brown Q.C.
Panelist
Dated: September 13, 2012