



URS | DETERMINATION
(URS Procedure 9, URS Rules 13)

URS DISPUTE NO. 7FB0F188

Determination DEFAULT

I. PARTIES

Complainant(s): K-Way S.p.a. (IT)

Complainant(s)'s authorized representative(s): Studio Legale Sindico e Associate

Respondent(s): Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf (IS)

II. THE DOMAIN NAME(S), REGISTRY OPERATOR AND REGISTRAR

Domain Name(s): KWAYFR.SHOP

Registry Operator: GMO Registry, Inc.

Registrar: Namecheap, Inc.

III. PROCEDURAL HISTORY

Complaint submitted: 2022-04-13 11:22

Lock of the domain name(s): 2022-04-20 03:35

Notice of Complaint: 2022-04-20 12:43

Default Date: 2022-05-05 00:00

Notice of Default: 2022-05-05 15:44

Panel Appointed: 2022-05-05 15:45

Default Determination issued: 2022-05-09 10:11

IV. EXAMINER

Examiner's Name: Igor Motsnyi

The Examiner certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as the Examiner in this administrative proceeding.

V. RELIEF SOUGHT

The Complainant requests that the domain name be suspended for the balance of the registration period.

The Respondent has not submitted a Response.

VI. STANDARD OF REVIEW

Clear and convincing evidence.

VII. DISCUSSIONS AND FINDINGS

A. Complainant:

The Complainant claims to be a prominent Italian company, a market leader in the design and marketing of clothing, footwear and accessories, mostly sportswear or leisurewear, sold under various trademarks including “K-WAY”. The Complainant is the owner of numerous trademarks with the word element “K-WAY”. The Complainant is the owner of several domain names including the trademark “K-WAY” and it has never authorized any third party to register domain names referring to its “K-WAY” mark. The Complainant also conducts business through its e-commerce channels and make sales on its official web sites, such as www.k-way.fr. On this website, potential customers can view all models and offers and then proceed with the purchase.

1. The disputed domain name is confusingly similar to the trademark “K-WAY” as it fully includes the “K-WAY” trademark coupled with the geographical term .fr (which explicitly refers to France) that could be seen as descriptive. The trademark of the Complainant is clearly recognizable and neither the geographical term .fr nor the .shop zone adds to the distinctiveness of the disputed domain name.
2. The Complainant asserts that the Respondent has no legitimate right or interest to the domain name.
3. The Complainant claims that by using the disputed domain name, the Respondent intentionally attempted to attract for commercial gain, Internet users to the Respondent's web site 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 web site or location or of a product or service on the Respondent's web site or location. The risk of confusion is reinforced by the fact that the abusive site is very similar to the official website of the Complainant: www.k-way.fr, clearly contains the “K-WAY” brand as well as offering the same “K-WAY” products for sale. There is a concrete risk of confusion between the disputed domain name and the “K-WAY” trademarks in which the Complainant has rights and all of the above confirms the bad faith of the Respondent whose sole objective is to take advantage of the reputation of “K-WAY” to attract consumers for (abusive) commercial gain.

B. Respondent:

The Respondent did not submit a Response.

C. Procedural findings:

Having reviewed the communications records, the Examiner finds that MFSD has discharged its responsibility under the URS Procedure paragraphs 3 and 4 and URS Rules paragraph 4. In accordance with URS Rules Paragraph 9(d), in absence of a Response, the language of the Determination shall be English.

The Examiner notes that the Respondent in this proceeding is identified as “Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf”.

The Examiner finds that this information is sufficient for the purpose of making determination in this proceeding and having a privacy shield or proxy service indicated as a respondent is not uncommon in URS proceedings (see e.g. URS DISPUTE NO. 91F39116 and URS DISPUTE NO. CCB18C9E).

D. Findings of fact:

The disputed domain name was registered on March 16, 2022.

The Complainant has demonstrated that it owns the following registered trademarks:



- International word trademark No. 854200, registered since January 19, 2005, effective in various jurisdictions including, but not limited to, the US, Australia, China, Switzerland, Japan, the EU.
- European Union trademark registration No. 011396521 (word+design), registered since May 02, 2013.

The Complainant also provided an extract of its portfolio of “K-WAY” trademark registrations in various countries of the world.

The Complainant provided proof of use of its trademarks including its catalogues of products and screenshots from one of its websites: <https://www.k-way.fr>.

E. Reasoning:

1. The domain name(s) is(are) identical or confusingly similar to a word mark

The Complainant is the owner of both a word mark and combined marks with both device and word elements. As noted by other Examiners *"the use of the words "word mark" in URS 1.2.6.1 does not specifically exclude trademarks which are combined of a word element and a graphical element, provided the word element is clear, and sufficiently distinct and separate from the graphical element...As is also acceptable under the UDRP body of law, and without derogating from the URS goals, the word element in the trademark should not have been disclaimed leaving the design element the only element having the source of distinctiveness"* (see URS appeal determination, Forum case FA1604001672049 where this issue was analyzed in detail and MFSD URS DISPUTE No. 369B0FE1).

In the combined mark the "K-WAY" word is a dominant element. Therefore, the Examiner finds that both the word trademark and the combined (word + device) mark referred to by the Complainant in this dispute shall be taken into account. The Complainant has also provided evidence of use of the trademarks.

Therefore, the Examiner finds that the Complainant has trademark rights for the purpose of URS. As stated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) *“where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”* (see par. 1.8).

The disputed domain name fully incorporates the “K-WAY” mark with the addition of the “fr” element that can be seen as a geographical term referring to France. The trademarks are clearly recognizable in the disputed domain name and the degree of similarity is very high. The “shop” gTLD shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name. It actually adds more to the confusion referring to a place of sale of the products of the Complainant.

The Examiner finds that the requirements set forth under Paragraph 1.2.6.1. of the URS Procedure have been satisfied.

2. Respondent has no rights or legitimate interests to the domain name(s)

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests; and once such prima facie case is made, the burden shifts to the Respondent who has to demonstrate his rights or legitimate interests.

The Complainant in this dispute has made a prima facie case and the Respondent failed to respond and explain any rights or interests in respect of the disputed domain name.

The website by the disputed domain name appears to be inactive on the date of this determination, however the disputed domain name has been used for a website that marketed, promoted and offered for sale various “K-WAY” products.

From the screenshots of the website by the disputed domain name dated March 24, 2022 and provided by the Complainant it is clear that the website contains pictures of the Complainant’s products and prices and various sections referring to various products of the Complainant.

The website is in French. It appears to be an online shop targeting French speaking consumers. It is unclear whether the products offered via the website by the disputed domain name were genuine or fake. The Respondent could potentially have been a reseller (even unauthorized one) of the Complainant’s products and even unauthorized resellers can have rights or legitimate interests in the domain name under the “Okidata” test (see *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903 and par. 2.8.1 of the WIPO Overview 3.0).

However, this is not the case here as the Respondent did not meet the requirements of the “Okidata” test by failing to “accurately and prominently disclose the registrant’s relationship with the trademark holder”.

From the provided screenshots there is no information on the Respondent’s website about the relationship with the Complainant. Moreover, the website indeed looks very similar to the Complainant’s own French website, <https://www.k-way.fr>.

The Examiner notes that in applying the “Okidata” test the risk of misrepresentation has led panels to find that a respondent lacks rights or legitimate interests in cases involving a domain name identical to the complainant’s trademark (see par. 2.8.2 of the WIPO Overview 3.0).

The degree of similarity between the disputed domain name and the Complainant’s mark is very high, close to identity, as the trademark is fully incorporated into the disputed domain name and the addition of the “fr” element actually increases confusion with the Complainant’s own website.

The overall look of the Respondent’s website increases confusion and creates an impression that this website is somehow affiliated with the Complainant.

Based on the above, the Examiner finds that the Respondent lacks any rights or legitimate interests with respect to the disputed domain name as per the requirements set forth under Paragraph 1.2.6.2. of the URS Procedure.

3. The domain name(s) was(were) registered and is(are) being used in bad faith

The disputed domain name is inactive on the date of this Determination. The Complainant provided screenshots from the website by the disputed domain name dated March 24, 2022 and from the provided evidence the website appears to be an online shop where Complainant’s products were offered for sale. The website also reproduces Complainant’s logo and Complainant’s combined (word + design) EU trademark. The screenshots provided by the Complainant indeed create an impression that the website by the disputed domain name is somehow affiliated with the Complainant, endorsed by the Complainant or is operated by the Complainant.

Based on the evidence provided, the Respondent attempts to impersonate the Complainant and its business by using the disputed domain name fully incorporating the trademarks of the Complainant and by placing Complainant’s logo on its website by the disputed domain name. The trademarks of the Complainant were registered before the registration of the disputed domain name.

Based on the arguments and evidence submitted by the Complainant, the Examiner finds that the Respondent has indeed intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the “K-WAY” trademark of the Complainant as to the source, sponsorship, affiliation or endorsement of its website (see e.g. URS dispute No.12BC5237: “the Examiner considers that the domain name resolves to a website that reproduces elements and the look and feel of the Complainant’s website and this indicates that the purpose of the disputed domain name is to deceive potential consumers, by



giving appearance that the website belongs to the Complainant” and URS dispute NO. F306BC2E: “the Respondent, in having redirected Internet users to online stores depicting the Complainants’ trademarks and products and not disclosing the lack of relationship with the Complainants clearly confirms that he must be aware of the Complainants and the well- known trademark and products”).

The Examiner finds that the requirements set forth under Paragraph 1.2.6.3. of the URS Procedure have been satisfied by the Complainant.

4. Abusive Complaint

The Examiner finds that the Complaint was neither abusive nor contained material falsehoods.

VIII. DETERMINATION

A. Demonstration of URS elements

Demonstrated

B. Complaint and remedy

Complaint: Accepts

Domain Name(s): KWAYFR.SHOP Suspends for the balance of the registration period

C. Abuse of proceedings

Finding of abuse of proceedings: Not finds

D. Publication

Publication: Publish the Determination

SIGNATURE

Name: Igor
Surname: Motsnyi
Date: 2022-05-09