

ADMINISTRATIVE PANEL DECISION

Kumfs Brand Limited v. George
Case No. D2016-1272

1. The Parties

The Complainant is Kumfs Brand Limited of Auckland, New Zealand, represented by James & Wells, New Zealand.

The Respondent is George of Lagos, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <zeirashoes.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 23, 2016. On the same date, the Center transmitted to the Registrar, by email, a request for registrar verification in connection with the disputed domain name. On June 25, 2016, the Registrar transmitted to the Center, by email, its verification response confirming that the Respondent is listed as the registrant and providing the Respondent's contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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 that the proceedings commenced on June 28, 2016. In accordance with the Rules, paragraph 5, the due date for Response was set to July 18, 2016. The Respondent did not submit any response. Accordingly, on July 19, 2016, the Center notified the Parties of the Respondent's default.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on July 27, 2016. 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

As reflected in the registration record for the disputed domain name in the Whois database (a copy of the record appears in Annex KBL-2 to the Complaint), the disputed domain name <zeirashoes.com> was registered on December 30, 2015, and is due to expire on December 30, 2016.

A. The Complainant's ZIERA Marks

The Complainant owns various trademark registrations for the term ZIERA (in block letters), alone or stylized along with a design element, in New Zealand, Australia, Singapore, Malaysia, the United States of America ("United States") and China. The Complainant has provided in Annex KLB-8 to the Complaint a list of these registrations and in Annex KBL-9 to the Complaint copies of either print-outs of corresponding registration records from publicly available databases provided by national trademark offices or the registration certificates themselves. The following are salient details from a sample of the Complainant's registrations.

1. ZIERA

New Zealand trademark registration 798293; registration date: April 30, 2009.

This mark is registered for use in connection with: "Carry bags, hand bags, purses, luggage, umbrellas, trunks and travelling bags" in international class 18; "Clothing, scarves, footwear, including boots, shoes, slippers, headgear and belts (clothing)" in international class 25; and "Retail and wholesale services in relation to: carry bags, hand bags, purses, luggage, umbrellas, trunks and travelling bags, clothing, scarves, footwear, including boots, shoes, slippers, headgear and belts (clothing), preparations for the care of footwear, shoe storage racks and containers; business advisory services; advertising" all in international class 35.

2. ZIERA (stylized with design)

New Zealand trademark registration 837893; registration date: September 1, 2011.

This mark is registered for use in connection with: "Clothing, scarves, footwear, including boots, shoes, slippers, headgear and belts (clothing)" in international class 25.

3. ZIERA (block letters)

United States trademark registration: 3835874

Registration date: August 17, 2010; filed March 3, 2009

(claiming foreign priority filing of October 30, 2008, for goods in international class 25)

This mark is registered for use in connection with: "All purpose carry bags, hand bags, purses, luggage, umbrellas, trunks and travelling bags" in international class 18; "Footwear; shoes; clothing, namely tops, bottoms, and jackets; scarves; boots; slippers, headwear and belts" in international class 25; and "Retail and wholesale services featuring all purpose carry bags, hand bags, purses, luggage, umbrellas, trunks and travelling bags, clothing, scarves, footwear, boots, shoes, slippers, headgear and belts, preparations for the care of footwear, shoe storage racks and containers" all in international class 35. This registration claims a foreign priority date of October 30, 2008, for the goods in international classes 18 and 35, and for "footwear; shoes" in international class 25. The registration indicates that both first use and first use in commerce of the mark in conjunction with the remaining goods in international class 25 commenced as of March 12, 2010.

B. The Parties and Their Activities

The Complainant is a New Zealand based company owned by Kumfs Group Limited (see Annexes KBL-5 and KBL-6 to the Complaint which provide abstracts for these entities as recorded in the New Zealand Companies Office). The Complainant owns intellectual property rights which it licenses to its sister company Ziera Shoes New Zealand Limited. The latter company conducts business as "Ziera" and, in that capacity, designs, manufactures, distributes and retails ZIERA branded footwear.

Currently, ZIERA branded footwear is distributed and sold in the United States, Canada, the United Kingdom of Great Britain and Northern Ireland, Ireland, Malaysia, Singapore, China, Australia, New Zealand and the Norfolk Islands (see Annex KBL-7 to the Complaint which provides a copy of a print-out from the Complainant's website listing locations worldwide where ZIERA branded footwear is distributed and sold.). The Complainant has also registered, as indicated by the Whois registration records provided in Annexes KBL-10 through KBL-16 to the Complaint, various domain names, including <zierashoes.com> which it specifically registered in October 2008.

The Complainant originally traded under the mark KUMFS and subsequently, through a re-branding effort that extended over several years (and described in a copy of an article provided in Annex KBL-17 to the Complaint and having appeared in the *New Zealand Herald* on September 6, 2010), transitioned to using its ZIERA marks. This effort was completed during September 2010, when the Complainant first operated its website at "www.zierashoes.com". The Complainant has continuously operated since then using its ZIERA marks (see screen shots of various pages taken from that site as of June 17, 2016, and which appear in Annex KBL-21 to the Complaint).

The disputed domain name does not resolve to an operational website, as shown by the screen shot provided in Annex KBL-24 stating that such a website cannot be reached.

The Respondent used the disputed domain name, as the second-level domain ("SLD") in an email address, as part of a scheme that relied on successfully impersonating the Complainant, through false email communications and forged business documents, in order to purposefully deceive personnel at one of the Complainant's wholesale customers in Hong Kong, China, into believing that they were communicating with their counterparts at the Complainant when, in fact and completely unknown to them, they were communicating with the Respondent instead.

Specifically, starting on December 31, 2015 — a day after the Respondent registered the disputed domain name, the Respondent sent email messages to that customer but set the alias ("name") in the sender's email address on each of the messages as the personal name of the Complainant's credit controller or financial controller together with the disputed domain name as the SLD in each email address (to form addresses in the form of: "[name]@zeirashoes.com") — essentially mimicking the email address convention used by the Complainant. The correct email addresses of these personnel, at the Complainant, use the same personal names as aliases and are of the form: "[name]@zierashoes.com". Through impersonating the Complainant's personnel, these messages informed the customer that the Complainant was changing its bank account, when in actuality the Complainant never did so. Copies of these email messages appear in Annex KBL-26 to the Complaint. Later the same day, the Respondent, through further such impersonated messages, supplied the customer with details of what the Respondent represented as being the Complainant's new bank account which, in actuality, was the Respondent's account at a Chinese bank. Copies of these messages appear in Annexes KBL-32 and KBL-33 to the Complaint. The Complainant does not use a Chinese bank account, as seen from its legitimate banking instructions provided in Annex KBL-34 to the Complaint and which have remained the same for several years.

Further impersonated email correspondence, a copy of which appears in Annex KBL-27 to the Complaint, occurred during January 11, 2016, and January 13, 2016 between the Respondent and the customer. These communications advised the customer that it had "mistakenly sent the wrong bank information to [customer]" and it would need to "revert payment immediately to [the Respondent's] approved bank account [...]". Between March 14, 2016, and March 23, 2016, the Respondent again impersonated the Complainant, through the same manner, stating that it had not received payments from the customer. Copies of these messages appear in Annex KBL-28 to the Complaint.

On March 1, 2016, the Respondent sent, by email, forged statements of accounts to the customer. These statements, dated January 21, 2016, and February 31, 2016, were identical in format and content to those used by the Complainant and claimed certain amounts were then overdue from the customer. At that time, these amounts were in fact overdue to the Complainant. Annex KBL-29 contains a copy of the impersonated message from the Respondent dated March 1, 2016, which contained, as attachments, the forged

statements of account. The amount due, noted in the summary table at the bottom of each forged statement, reflects the payment previously made by the customer into the Respondent's Chinese bank account. Copies of these forged statements appear in Annex KBL-30 to the Complaint, with, for comparison purposes, copies of the genuine statements from the Complainant appearing in Annex KBL-31 to the Complaint. As a result of the impersonation, the customer made two fraudulent payments to the Respondent: USD 9,655 on January 20, 2016 and USD 5,000 on February 2, 2006. By email dated March 29, 2016 — a copy of which appears in Annex KBL-35 to the Complaint, the Complainant informed the customer of the Respondent's fraudulent scheme and also instructed the customer not to communicate using the impersonated email addresses and to inform the Complainant of the amounts it paid into the Chinese bank account. On or about March 30, 2016, the Complainant reported the Respondent's fraudulent activities to the New Zealand Police which resulted in a summary letter of complaint to the New Zealand Police, a copy of which appears in Annex KBL-37 to the Complaint.

Further, the Respondent has registered several other domain names which are similar to domain names, trademarks, or trade names of well-known third-party businesses. Lists of those other domain names appear in Annexes KBL-38, KBL-39 and KBL-40 to the Complaint. A table provided in paragraph 12.54 of the Complaint shows, for comparison purposes, certain of those registered names listed against corresponding domain names of their third-party owners (copies of the Whois records for all these names appear in Annexes KBL-41 through KBL-54 to the Complaint).

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its ZIERA marks.

Specifically, the disputed domain name contains an intentional misspelling of the Complainant's mark ZIERA as "zeira", where the placement of the letters "i" and "e" have been juxtaposed. This misspelling and the addition of the word "shoes" to the mark are incapable of adding sufficient distinctiveness whatsoever to the disputed domain name to mitigate any resulting user confusion between the disputed domain name and the Complainant's marks.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Respondent is not affiliated or connected with the Complainant and has never been licensed or authorized to use any of the Complainant's ZIERA marks, or register or use the disputed domain name.

Further, there is no evidence indicating that the Respondent is commonly known by the term "zeirashoes" nor could there ever be any by virtue of the exclusive trademark rights residing in the Complainant in the mark ZIERA – rights that existed before the Respondent registered the disputed domain name. In that regard, a Google search (the results of which appear in Annex KBL-23 to the Complaint) for the name "Zeira" reveals no entity related to the Respondent. In addition, online searches made through databases publicly provided by the national trademark offices of New Zealand, Australia, the United States, the United Kingdom, China and Singapore do not reveal any pending or registered marks existing in any of these offices for the term "zeira".

The Respondent is also not using the disputed domain name in conjunction with any website, let alone in conjunction with a site through which a *bona fide* offering of goods or services is being made, and not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent registered and used the disputed domain name to perpetrate a fraud on one of the wholesale customers of the Complainant. In that regard, the Respondent intercepted, in some fashion, email communication between the Complainant and that customer. From that communication, the Respondent extracted information regarding certain individuals at the Complainant's business who handled the customer's financial account with the Complainant, including their corresponding positions and email addresses. The Respondent then registered the disputed domain name for its high degree of similarity to the Complainant's domain name <zierashoes.com> which incorporates its mark ZIERA, and then proceeded to use the registered disputed domain name as part of email addresses through which the Respondent was able to successfully impersonate those individuals and send false messages to the customer. By doing so, the Respondent deliberately deceived the customer into believing that it was communicating with those individuals at the Complainant when, in fact, it was communicating with the Respondent instead.

Early in the fraud, the Respondent, through its false messages, informed the customer that the Complainant had changed its bank account to an account located in China which, totally unknown to the customer, was owned by the Respondent.

A few months later, the Respondent attached forged statements of account to additional false messages it sent to the customer. These forged statements stated that certain amounts were then overdue for payment. These statements, produced by the Respondent, were identical in format and content to statements which the Complainant had previously sent to that customer.

Through the statements and the banking information provided through the false messages, the Respondent fraudulently induced the customer to remit approximately USD 15,000 to what it believed to be the Complainant's bank account when the payments were actually directed, based on the banking information which the Respondent had provided to the customer, into the Respondent's Chinese bank account instead.

Further bad faith is shown by the Respondent having registered several other domain names that are confusingly similar to domain names, trademarks or trade names of various third parties and which the Respondent apparently uses in conjunction with email impersonation schemes similar to that which it engaged in here with the Complainant.

B. Respondent

In view of the lack of a Response filed by the Respondent, this proceeding has proceeded by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's marks.

From a simple comparison of the disputed domain name to the Complainant's mark ZIERA, no doubt exists

that the disputed domain name is confusingly similar to it. The disputed domain name <zeirashoes.com> consists of a misspelled variant of the mark and the generic word “shoes”, which has been appended along with the generic Top-Level Domain (“gTLD”) “.com”. The addition of the gTLD is generally irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that domain name to avoid user confusion. Here, the Respondent’s misspelling of the Complainant’s mark ZIERA as “zeira” and the addition of the word “shoes” to form “zeirashoes” clearly constitute such a minor variation. See, e.g., *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; and *National Association of Professional Baseball Leagues, Inc., d/b/a Minor League Baseball v. John Zuccarini*, WIPO Case No. D2002-1011.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s ZIERA marks. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant’s mark ZIERA nor does the Complainant have any relationship, affiliation or connection whatsoever with the Respondent.

Further, the Respondent never did and does not now use nor has it made any demonstrable preparations to use the disputed domain name to resolve to an operational website, let alone one through which it will make *bona fide* offerings of any goods or services. Further, the Respondent does not use the disputed domain name in connection with any legitimate noncommercial or fair use. Moreover, the evidence of record clearly

reflects that the Respondent is not commonly known by the disputed domain name or one of the Complainant's ZIERA marks. Given the Complainant's exclusive rights in its marks which predate, by at least five years, the date (December 30, 2015) on which the Respondent registered the disputed domain name, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to those of the Complainant — at least for the goods and services provided by the Complainant under its marks — without interfering with the exclusive trademark rights of the Complainant. See, e.g., *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; and *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill and Cummins Inc. v. Jamie Lent and Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, both *supra*.

Hence, the Respondent does not fall within any of paragraphs 4(c)(i)-4(c)(iii) of the Policy.

It is undeniable that the Respondent was well aware of the Complainant, its mark ZIERA and the Complainant's exclusive rights in that mark, yet nonetheless illicitly exploited that knowledge. The Respondent, relying on the high degree of similarity (near identity) between the Complainant's domain name <zierashoes.com> (which incorporates the Complainant's mark ZIERA) and the disputed domain name <zeirashoes.com>, intentionally impersonated the Complainant through phishing email messages it sent to one of the Complainant's wholesale customers which incorporated the disputed domain name as the SLD in the sender's email addresses it used. That action allowed the Respondent to exploit that similarity through deceiving that customer into remitting payments to the Respondent.

Even apart from the illustrative criteria set forth in paragraphs 4(c)(i)-4(c)(iii) of the Policy, the Respondent's use of the disputed domain name, as part of a scheme to deliberately impersonate the Complainant in order to lead another into believing that it is dealing with the Complainant, when in actuality it is not, and then to induce that party to make payments ultimately to the Respondent based on the impersonation and to which the Respondent is not entitled, is itself illegitimate. Consequently, on that basis alone, the Respondent could not acquire rights and legitimate interests in the disputed domain name.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

It is clear to this Panel that the Respondent, prior to having registered the disputed domain name, obtained prior legitimate email messages that occurred between the Complainant and its customer. From those messages, the Respondent extracted sufficient information, regarding the email addresses and positions and names of certain individuals on the Complainant's staff who had corresponded with the customer regarding its accounts with the Complainant, to impersonate those individuals.

Based on that information, the Respondent then registered the disputed domain name for its nearly identical resemblance to the Complainant's domain name <zierashoes.com>, which incorporates its mark ZIERA and resembles the Complainant's mark to the point of being not only confusingly similar to that mark but also sufficient to actually perpetrate a fraud on that customer by impersonating the Complainant's personnel (*i.e.*, by using email addresses containing the names of the Complainant's personnel but substituting the disputed domain name for the Complainant's domain name in those email addresses). The Respondent then sent false messages, using those impersonated email addresses, to the wholesale customer.

Through some of the initial false messages, the Respondent deceived the customer into believing that the Complainant had changed its bank account and specifically, though completely unknown to the customer, to an account belonging to the Respondent, when, in actuality, the Complainant did not. Later, email

messages in which the Respondent again impersonates the Complainant's personnel were accompanied by statements of account forged by the Respondent to highly resemble statements actually used by the Complainant. In response, the customer made payments totaling approximately USD 15,000 against those statements into the bank account specified by the Respondent, having been deceived by the Respondent into thinking it was remitting payment to the Complainant. Consequently, the Respondent intentionally and successfully led that customer into believing that it was communicating with the Complainant, when in fact it was not, and instead was communicating with the Respondent and also into making payments to the Complainant when, in actuality, those payments were ultimately directed to the Respondent.

There is no question whatsoever in this Panel's mind that the Respondent's impersonation of the Complainant was predicated on having intentionally registered the disputed domain name for its similarity to an existing domain name of the Complainant, which incorporates the Complainant's mark, so as to likely cause confusion with the latter and then using the disputed domain name as part of email addresses to send email messages to one of the Complainant's customers in furtherance of a scheme to perpetrate a fraud on that customer. This constitutes bad faith registration and use prohibited under the general bad faith provisions of paragraph 4(a)(iii) and 4(b) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <zeirashoes.com> is to be transferred to the Complainant.

Peter L. Michaelson
Sole Panelist
Date: August 8, 2016