



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

#### **BWT Brands, Inc. v. Domains By Proxy, Inc.**

**Case No. D2005-0105**

#### **1. The Parties**

The Complainant is BWT Brands, Inc, a Delaware corporation, Winston-Salem, North Carolina, United States of America. The Complainant is represented by Jones Day, Columbus, Ohio, United States of America.

The Respondent was formerly Domains by Proxy Inc, Scottsdale, Arizona, United States of America, but is now Robin Becherrawy, Paris, France.

#### **2. The Domain Name and Registrar**

The disputed domain name is <kool.com>. The Registrar with whom the domain name is registered is Go Daddy Software, Inc.

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 1, 2005. On February 1, 2005, the Center transmitted to the Registrar a request for Registrar verification in connection with the domain name in issue. The Registrar responded indicating that the then named Respondent was not the current Registrant. The Center notified this to the Complainant by email on February 3, 2005 and pointed out that the Registrar had indicated that the Registrant was "Robin Becherrawy". Accordingly on February 3, 2005 the Complainant submitted a First Amendment to the Complaint in which it indicated that it did not waive such claims as it might have against Domains by Proxy Inc but amended the Complaint to the effect that the Respondent was Robin Becherrawy, Paris, France. It annexed as Annex A to the amendment a copy of a "WHO IS" search dated February 3, 2005, confirming that the Registrant was the said Robin Becherrawy.

The Center has verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy ("the Policy"), the Policy rules ("the Rules") and the Policy supplemental rules.

On February 11, 2005 notice of the complaint as amended was given to the Respondent Robin Becherrawy by email and by hard copy. A receipt from the courier company DHL indicates that a number of attempts were made to deliver the papers at the address given but that it failed to do so.

On March 4, 2005, notice of Respondent's default was sent by email to the Respondent. No further response has been received from the Respondent.

On March 14, 2005, an administrative panel consisting of a sole member Mr. Clive Duncan Thorne was appointed. In accordance with the rules he has submitted a statement of acceptance and declaration of impartiality and independence to the Center. No interlocutory proceedings have taken place and no interlocutory orders have been issued by the Panel. The Panel considers it was properly constituted.

#### **4. Factual Background**

The Complainant in its Complaint and amended Complaint adduces evidence of the Complainant's registered and unregistered trade mark rights. In particular the Complainant relies upon the Complainant's rights in the mark "KOOL" which it asserts is one of the most recognised and distinctive trade marks in the United States for use on cigarettes. The trade mark has become well known throughout the United States by virtue of its extensive use and registration either by the Complainant and its parent company or its predecessors in title.

The Complainant's parent company is R. J. Reynolds Tobacco Company ("RJRT") which is the second largest manufacturer of cigarettes and tobacco products in the United States. RJRT's major brands include Kool, Camel, Winston, Salem, Lucky Strike, Pall Mall and Doral.

Although the Complainant asserts in paragraph 11 of its Complaint that RJRT owns the trade mark "KOOL" for use in connection with cigarettes and tobacco products in the United States. The Panel notes from the US certificates of registration exhibited at Annex C that title in the trade marks relied upon is registered in the name of BWT Brands Inc which is the Complainant. It is therefore satisfied that the registered trade marks relied upon are in the name of the Complainant.

Amongst the trade marks relied upon are the mark "KOOL" in stylised form Registration Number 508538 in Class 34 registered on April 12, 1949, and Registration Number 747482 for the mark "KOOL" registered on April 2, 1963, in Class 34. There are other registered versions of the mark "KOOL" relied upon.

Evidence is also adduced by the Complainant of extensive use of the mark "KOOL" in respect of cigarettes and tobacco products so as to give rise to common law rights in the mark. Evidence is adduced that Kool cigarettes were launched into the US market in February 1933. At Annex D to the Complaint is a document setting out the history of the "KOOL" mark.

Sales figures and advertising figures are given by the Complainant in respect of the Kool cigarette brand from 1999 to 2004. It should be noted in particular that in 2004 expenditure on promoting the brand Kool were considerable.

Having considered the evidence of both registered and unregistered trade mark rights the Panel is satisfied that the Complainant has rights in the mark "KOOL".

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant submits that:-

- (i) The domain name in dispute is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.
- (ii) The Respondent has no rights or legitimate interests in respect of the domain name.
- (iii) The domain name in dispute was registered and has been used in bad faith.

### **B. Respondent**

The Respondent has taken no part in the current proceedings.

## **6. Discussion and Findings**

In order to succeed in its Complaint the Complainant has the burden of proof in showing that each element within the Policy is present. These are as follows:-

- (i) The domain name in dispute is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name is registered and is being used by the Respondent in bad faith.

The Panel proceeds to deal with each of these in turn:-

### **A. Identical or confusingly similar.**

The Panel has already found that the Complainant has registered and unregistered rights in the mark "KOOL". The issue which the Panel has to decide is whether the domain name in dispute is identical or confusingly similar to the trade mark "KOOL".

Having considered the domain name in dispute <kool.com> it is apparent that the only distinction between the trade mark "KOOL" and the domain name is the top level domain name ".com". In the Panel's view the domain name in dispute is therefore identical to the trade mark "KOOL".

The Panel therefore finds for the Complainant in relation to this element.

### **B. Rights or Legitimate Interests**

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name the subject of the dispute for the following reasons:-

- (i) The evidence shows that the use of the domain name is to capture customers of the Complainant who are seeking the Complainant's or its parent group's products and redirecting them to other websites for profit.
- (ii) The Respondent is not a licensee of or otherwise currently affiliated with the Complainant or its parent group.

Dealing with the first point the evidence of the use of the domain name is set out as a print out at Annex E to the Complaint. This is a print out of the home page generated by Domainsponsor.com. Domainsponsor.com specialise in greeting "landing" home pages generated off search engines which provide relevant links based upon the domain name being visited. The landing page will then provide links tied to the domain name which offer the domain owner a "pay per click" source of revenue. The landing page contains a number of cigarette related links none of which are links to an official cigarette website maintained by the Complainant. Thus links onto the website include links entitled "Kool Cigarette", "Cigarette Coupons" and "Kool". Clicking on any of these links generates a page of further links. If the Internet user follows any of those further sponsored links the Respondent, Robin Becherrawy, obtains payment.

In the Panel's view there is no evidence or explanation of any legitimate right or interest in the website. The Panel therefore finds that the domain name uses the trade marks for the purposes of capturing customers of the Complainant who are seeking the Complainant's group products.

The Panel also notes that there is no evidence of any legitimate relationship, by licence or otherwise, between the Respondent and the Complainant.

The Panel therefore finds that the Respondent has no rights or legitimate interest in respect of the domain name and finds for the Complainant in respect of this element.

### **C. The domain name was registered and is being used in bad faith**

The Complainant submits that, taking into account, the use made of the domain name by the Respondent and the fact that the Respondent has no right or legitimate interest in the domain name leads to the conclusion that the original Respondent who is Designs by Proxy, Inc. registered and Robin Becherrawy is using <kool.com> in bad faith. This was to prevent the RJRT Group from acquiring it and to profit from confused RJRT Group consumers who are seeking information on RJRT, the Complainant and its products and services. It points out that consumers are likely to be confused into believing that the domain name is associated with the Complainant and its parent RJRT and asserts that the Respondent has a clear intent to profit from confusion.

In the Panel's view the evidence of the Complainant's trade mark rights shows that the Complainant's rights are widely known by the world at large and that in the absence of any legitimate interest it would be very difficult for there to be any bona fide use of the domain name by the Respondent given the evidence of the use of the domain name <kool.com>. The Panel also has in mind that there is no response from the Respondents.

In the Panel's view the evidence adduced by the Complainant is clear cut and indeed leads to the conclusion that the Respondent is acting in bad faith to "benefit from misdirected traffic in search of information in respect of the Complainant's cigarette product".

**7. Decision**

For the foregoing reasons and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel finds for the Complainant and orders that the domain name <kool.com> be transferred to the Complainant.

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Clive Duncan Thorne  
Sole Panelist

Dated: March 31, 2005