



## NATIONAL ARBITRATION FORUM

### DECISION

Ko Olina Intangibles, LLC v. Nimiety Group, LLC  
Claim Number: FA0912001297883

#### PARTIES

Complainant is **Ko Olina Intangibles, LLC** (“Complainant”), represented by **Lane Hornfeck**, of **Starn O’Toole Marcus & Fisher**, Hawaii, USA. Respondent is **Nimiety Group LLC** (“Respondent”), Hawaii, USA.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<koolinaactivities.com>**, registered with **Wild West Domains, Inc.**

#### PANEL

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

Hon. Karl V. Fink (Ret.) as Panelist.

#### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on December 7, 2009; the National Arbitration Forum received a hard copy of the Complaint on December 10, 2009.

On December 8, 2009, Wild West Domains, Inc. confirmed by e-mail to the National Arbitration Forum that the **<koolinaactivities.com>** domain name is registered with Wild West Domains, Inc. and that the Respondent is the current registrant of the name. Wild West Domains, Inc. has verified that Respondent is bound by the Wild West Domains, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On December 15, 2009, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of January 4, 2010 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to [postmaster@koolinaactivities.com](mailto:postmaster@koolinaactivities.com) by e-mail.

A Response was received and determined to be deficient on January 4, 2010, pursuant to ICANN Rule # 5 because the Response was not received in hard copy prior to the Response deadline.

On January 8, 2010, a timely additional submission was received from Complainant.

On January 11, 2010, a timely additional submission was received from Respondent.

All submissions were considered by the Panel.

On January 12, 2010, pursuant to Complainant’s request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Hon. Karl V. Fink (Ret.) as Panelist.

#### RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

## **PARTIES' CONTENTIONS**

### **A. Complainant**

Complainant is Ko Olina Intangibles, LLC, a limited liability company organized under the laws of Delaware.

The registrant of koolinaactivities.com, the Disputed Domain Name, and Respondent in this administrative proceeding is Nimiety Group, LLC, a Hawaii limited liability company.

The Disputed Domain Name was registered on April 24, 2006.

Since 1985, Complainant and/or its assignor has continuously and actively used the "Ko Olina" trade name throughout the United States and worldwide in connection with the development and operation of a resort, residential and commercial destination area on Oahu, State of Hawaii.

West Beach Estates, the predecessor in interest to Complainant, registered the trade name "Ko Olina" on December 9, 1985.

In 1998, Complainant purchased real property and certain intangibles from West Beach Estates, including the trade name "Ko Olina." Complainant renewed and registered the trade name "Ko Olina" to May 7, 2014.

"Ko Olina" is an arbitrary term that was coined by Complainant's predecessor and has no assigned meaning to it in any language apart from being associated with Complainant. "Ko Olina" is not a Hawaiian word. It is also not a geographical location or name.

Complainant has authorized the use of the trade name "Ko Olina" to related entities including, but not limited to, Ko Olina Activities, LLC. In addition to the trade name "Ko Olina," Ko Olina has registered numerous trade names incorporating the term "Ko Olina" with State of Hawaii Department of Commerce and Consumer Affairs.

The use of the trade name "Ko Olina" has not been authorized by Ko Olina in connection with Respondent's registration and use of the Disputed Domain Name.

The "Ko Olina" trade name is well known through long, continuous and exclusive use, as well as extensive promotion, advertising and publicity relating to the Ko Olina Entities.

The Ko Olina Entities have an active presence on the Internet, including operating the website koolina.com, which is devoted exclusively to the promotion of the Ko Olina Entities.

Respondent's Disputed Domain Name is identical and/or confusingly similar to the "Ko Olina" trade name

On December 4, 2009, Complainant filed a Petition for Revocation with the State of Hawaii Department of Commerce and Consumer Affairs' Business Registration Division for the revocation of the registration, existing use and possible future use of the trade name "Koolina Activities.com" and any similar iteration of these words by Respondent and any individuals or entities related to Respondent.

### **B. Respondent**

Respondent is registered with the Department of Commerce and Consumer Affairs of the State of Hawaii doing business as Koolina Activities.com.

"Ko Olina" is not a Trademarked name, "Ko Olina Resort and Marina" is what was trademarked.

The name Ko Olina was selected by Reverend Abraham K. Akaka. The word Ko means to fulfill and Olina means joy. Ko Olina was a fishing camp and it became a retreat for Oahu's highest chief, Kakuhihewa. Paradise Cove is located at Ko Olina.

Nimiety Group LLC, is in the tour and activity business and provides tours and activities to visitors coming to Oahu and all of its destinations.

The website Koolina.com does not sell any activities or tours from the website, thus there is no confusion to visitors viewing Koolinaactivities.com.

The State of Hawaii also recognizes that “Ko Olina Resort and Marina” does not have the monopoly on the name Koolina or KoOlina. The State of Hawaii has and does recognize the geographical location on the West side of the Island of Oahu as KoOlina, it is a destination. State Department and Transportation signage also includes the distance to KoOlina on the Highway Road Sign system.

### C. Additional Submissions

#### Complainant’s Additional Submission:

“Ko Olina” has been and continues to be an appropriately registered trade name.

The term “Ko Olina” is one relating to business or entities instead of “products” of such business or entities, and the term is appropriately registered as a trade name instead of a trademark.

Respondent improperly registered <koolinaactivities.com> without permission of Complainant. Registration of a trade name with the Department of Commerce and Consumer Affairs (DCCA) in and of itself does not grant ownership of the trade name.

The State of Hawaii has determined that Complainant, through its predecessor-in-interest, is the rightful owner of the trade name “Ko Olina” as it was first in making continuous and active use of the trade name.

The DCCA has made a determination that Complainant is the owner of the trade names “Ko Olina” and “Ko Olina Resort” based on a preponderance of the evidence.

The DCCA found and/or held:

- (a) The “Ko Olina” trade name was specifically coined by Complainant’s predecessor-in-interest, West Beach Estates, and has been continuously and actively used since 1985.
- (b) Although the term “Ko Olina” is derived from two Hawaiian words, it is not a Hawaiian word. It is also not a geographic location.

The geographic area where Ko Olina Resort & Marina is located has not been known as “Ko Olina.” Paradise Cove is located with the gates of the Ko Olina Resort & Marina.

The State of Hawaii, Department of Transportation highway signage indicates the distance to Ko Olina Resort & Marina as opposed to “Ko Olina” as a geographic location.

It is undisputed that Respondent is competing directly with Ko Olina Activities, LLC and/or Ko Olina Resort Activities, LLC by offering to book identical activities on its website.

#### Respondent’s Additional Submission:

As stated in the Complainant’s last “Additional Submission” Ko Olina Intangibles, does not own and/or manage Ko Olina Activities LLC. Therefore the Complainant’s argument the Disputed Domain Name is identical and/or confusingly similar to the trade name of “Ko Olina” and entity names “Ko Olina Activities LLC” is not valid.

There is no confusion between the names or domain names <koolina.com> and the domain name <koolinaactivities.com>.

The Complainant would have to have an Underscore in the domain name for it to be valid. Ko\_olina.com would be the correct and legal name that could be disputed.

The State of Hawaii recognizes the difference as well as the DCCA, with the registration of several entities using the name “Koolina” without a space in their registration. No such names have been revoked by the DCCA. Whereas the registrations using the name “Ko Olina” have been shown revoked.

There is no business name registered as “Koolina” included in the Director’s Final Order as the Complainant has

submitted, only names “Ko Olina” Transportation or Limousine, etc.

The State of Hawaii also does not include on their Department of Transportation Road System the distance to “Ko Olina Resort and Marina.” The geographical location that is used on the State of Hawaii DOT road signs is Ko Olina proper.

## FINDINGS

For the reasons set forth below, the Panel finds Complainant is not entitled to the relief requested.

## DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

### **Identical and/or Confusingly Similar**

While Complainant, Ko Olina Intangibles, LLC, asserts that it holds numerous trademark registrations with Hawaii’s Department of Commerce and Consumer Affairs (“DCCA”) for its KO OLINA mark, Complainant does not claim to hold a federal trademark registration for the mark. The Panel finds that a governmental trademark registration is not necessary to establish rights under Policy ¶ 4(a)(i). Previous panels have determined that a federal registration is not required so long as the Complainant can establish common law rights through proof of sufficient secondary meaning associated with the mark. *See SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that the complainant’s trademark or service mark be registered by a government authority or agency for such rights to exist); *see also Artistic Pursuit LLC v. calcuttawebdevelopers.com*, FA 894477 (Nat. Arb. Forum Mar. 8, 2007) (finding that Policy ¶ 4(a)(i) does not require a trademark registration if a complainant can establish common law rights in its mark).

Complainant alleges it, and its predecessors in interest, have used the KO OLINA mark to develop and operate a resort in the area of Kapolei on the island of Oahu. Complainant contends it has utilized the KO OLINA mark since 1985. Complainant argues it created the KO OLINA mark and the KO OLINA mark lacked meaning until Complainant created it. Complainant asserts it operates the <koolina.com> domain name and has continuously promoted its mark and resort on the Internet and throughout the United States. Complainant claims it has registered its KO OLINA mark, and variations of the mark, with Hawaii’s DCCA beginning in 1985. The Panel finds Complainant has established common law rights in the KO OLINA mark through continuous and extensive commercial use predating Respondent’s registration, on April 24, 2006, of the disputed domain name under Policy ¶ 4(a)(i). *See George Weston Bakeries Inc. v. McBroom*, FA 933276 (Nat. Arb. Forum Apr. 25, 2007) (finding that the complainant could establish common law rights in its GW BAKERIES mark through consistent and continuous use of the mark, which helped the mark become distinctive and generate “significant goodwill”); *see also Artistic Pursuit LLC v. calcuttawebdevelopers.com*, FA 894477 (Nat. Arb. Forum Mar. 8, 2007) (concluding that the complainant had established common law rights in the ARTISTIC PURSUIT mark by using the mark in commerce before Respondent registered the disputed domain name).

Complainant claims Respondent’s <koolinaactivities.com> domain name is confusingly similar to Complainant’s KO OLINA mark. Complainant alleges the disputed domain name combines Complainant’s mark, after removing a space, with the generic term “activities” and the generic top-level domain (“gTLD”) “.com.” Previous panels have found the removal of a space from a complainant’s mark, the addition of a generic term, and the addition of a gTLD all fail to adequately distinguish a disputed domain name from a complainant’s mark. *See Am. Int’l Group, Inc. v. Domain Admin. Ltd.*, FA 1106369 (Nat. Arb. Forum Dec. 31, 2007) (finding that “spaces are impermissible and a generic top-level domain, such as ‘.com,’ ‘.net,’ ‘.biz,’ or ‘.org,’ is required in domain names. Therefore, the panel finds that the disputed domain name [<americangenerallifeinsurance.com>] is confusingly similar to the complainant’s [AMERICAN GENERAL] mark.”); *see also Google Inc. v. Xtraplus Corp.*, D2001-0125 (WIPO Apr.

16, 2001) (finding that the respondent's domain names were confusingly similar to Complainant's GOOGLE mark where the respondent merely added common terms such as "buy" or "gear" to the end); *see also Reese v. Morgan*, FA 917029 (Nat. Arb. Forum Apr. 5, 2007) (finding that the mere addition of the generic top-level domain ".com" is insufficient to differentiate a disputed domain name from a mark). Therefore, the Panel finds Respondent's <koolinaactivities.com> domain name is confusingly similar to Complainant's KO OLINA mark pursuant to Policy ¶ 4(a)(i).

While Respondent contends that the <koolinaactivities.com> domain name is comprised of common and geographic terms and as such cannot be found to be confusingly similar to Complainant's mark, the Panel finds that such a determination is not necessary under Policy ¶ 4(a)(i) as this portion of the Policy considers only whether Complainant has rights in the mark and whether the disputed domain name is identical or confusingly similar to Complainant's mark. *See Vance Int'l, Inc. v. Abend*, FA 970871 (Nat. Arb. Forum June 7, 2007) (finding that because the complainant had received a trademark registration for its VANCE mark, the respondent's argument that the term was generic failed under Policy ¶ 4(a)(i)); *see also David Hall Rare Coins v. Tex. Int'l Prop. Assocs.*, FA 915206 (Nat. Arb. Forum Apr. 9, 2007) ("Respondent's argument that each individual word in the mark is unprotectable and therefore the overall mark is unprotectable is at odds with the anti-dissection principle of trademark law.").

Complainant has proven this element.

### **Rights or Legitimate Interests**

The Panel finds that Complainant has not established a *prima facie* case in support of its arguments that Respondent lacks rights and legitimate interests under Policy ¶ 4(a)(ii). *See Terminal Supply, Inc. v. HI-LINE ELECTRIC*, FA 746752 (Nat. Arb. Forum Aug. 24, 2006) (holding that the complainant did not satisfactorily meet its burden and as a result found that the respondent had rights and legitimate interests in the domain name under UDRP ¶ 4(a)(ii)); *see also Workshop Way, Inc. v. Harnage*, FA 739879 (Nat. Arb. Forum Aug. 9, 2006) (finding that the respondent overcame the complainant's burden by showing it was making a *bona fide* offering of goods or services at the disputed domain name).

Respondent claims that while it competes with Complainant, its offering of different activities and services are a *bona fide* offering of goods and services under Policy ¶ 4(c)(i). Respondent argues it owns the right to sell its activities and services to customers interested in visiting the Ko Olina area. Respondent asserts it is a legal business in the state of Hawaii and that it owns a travel agent license. The Panel finds Respondent's use of the <koolinaactivities.com> domain name is a *bona fide* offering of goods and services under Policy ¶ 4(c)(i). *See Russell & Miller, Inc. v. Dismar Corp.*, FA 353039 (Nat. Arb. Forum Dec. 20, 2004) (finding that the respondent used the <salesigns.com> domain name for a *bona fide* offering of goods or services, which was established by the respondent's "longstanding involvement in the 'sale sign' market and its use of a descriptive domain name to further its competition in that market").

Respondent also argues that the terms of the <koolinaactivities.com> domain name are common and geographic, and therefore, Complainant does not have an exclusive monopoly on the terms on the Internet. Respondent argues Complainant's KO OLINA mark is made up of two Hawaiian words meaning "fulfillment of joy." Respondent contends the area where Complainant's resort is located was given this name by Reverend Abraham Akaka and the land became a retreat for Oahu's royalty. Respondent argues the terms in Complainant's mark are therefore common and geographic. The Panel finds that Respondent can establish rights or legitimate interests in the disputed domain name pursuant to Policy ¶ 4(a)(ii). *See Kaleidoscope Imaging, Inc. v. V Entm't*, FA 203207 (Nat. Arb. Forum Jan. 5, 2004) (finding that the respondent was using the <kaleidoscope.com> domain name for a *bona fide* offering of goods or services because the term was "generic" and respondent was using the disputed domain name as a search tool for Internet users interested in kaleidoscopes); *see also Qwest Commc'ns Int'l v. QC Publ'g Grp., Inc.*, FA 286032 (Nat. Arb. Forum July 23, 2004) (stating that "Complainant's rights in the QWEST mark are limited to its application to the tele-communications industry," where a variety of other businesses used the mark in unrelated fields).

Complainant has not proven this element.

### **Registration and Use in Bad Faith**

Since the Panel has concluded that Respondent has rights or legitimate interests in the <koolinaactivities.com> domain name pursuant to Policy ¶ 4(a)(ii), the Panel also finds that Respondent did not register or use the disputed

domain name in bad faith pursuant to Policy ¶ 4(a)(iii). *See Lockheed Martin Corp. v. Skunkworx Custom Cycle*, D2004-0824 (WIPO Jan. 18, 2005) (finding that the issue of bad faith registration and use was moot once the panel found the respondent had rights or legitimate interests in the disputed domain name); *see also Vanguard Group Inc. v. Investors Fast Track*, FA 863257 (Nat. Arb. Forum Jan. 18, 2007) (“Because Respondent has rights and legitimate interests in the disputed domain name, his registration is not in bad faith.”).

Respondent contends that the <**koolinaactivities.com**> domain name is comprised entirely of common and geographic terms that have many meanings apart from use in Complainant’s KO OLINA mark. Moreover, Respondent contends that the registration and use of domain name comprising such common terms is not necessarily done in bad faith. A respondent is free to register a domain name consisting of common terms and the domain name currently in dispute contains such common terms. The Panel finds that Respondent did not register or use the <**koolinaactivities.com**> domain name in bad faith under Policy ¶ 4(a)(iii). *See Zero Int’l Holding v. Beyonet Servs.*, D2000-0161 (WIPO May 12, 2000) (“Common words and descriptive terms are legitimately subject to registration as domain names on a ‘first-come, first-served’ basis.”).

Complainant has not proven this element.

## **DECISION**

Complainant having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the <**koolinaactivities.com**> domain name remain with Respondent.

Hon. Karl V. Fink (Ret.), Panelist  
Dated: January 26, 2010

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