

ADMINISTRATIVE PANEL DECISION

Star Assets & Investments, S.L. v. Yang Kyung Won
Case No. D2022-1475

1. The Parties

The Complainant is Star Assets & Investments, S.L., Spain, represented by Ponti & Partners, S.L.P., Spain.

The Respondent is Yang Kyung Won, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <optiprix.com> is registered with Megazone Corp., dba HOSTING.KR (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2022. On April 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 26, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 5, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on May 13, 2022.

On May 5, 2022, the Center notified the Parties in both English and Korean that the language of the registration agreement for the disputed domain name is Korean. On May 6, 2022, the Complainant requested for English to be the language of the proceeding. On May 9, 2022, the Respondent requested for Korean to be the language of the proceeding.

The Center verified that the Complaint together with the amendment to 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2022. The Response was filed with the Center on May 31, 2022.

The Center appointed Kathryn Lee as the sole panelist in this matter on June 27, 2022. 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.

Due to unforeseen circumstances, the Panel found it necessary to extend the due date for the decision to July 15, 2022, and the Parties were so notified.

4. Factual Background

The Complainant did not indicate the nature of its business. Based on the information provided in the Complaint, the Complainant appears to be a Spanish company in the business of trademark licensing. The Complainant owns several trademark registrations to a mark consisting of the term OPTIPRIX and a device registered in Spain in 1992: Registration Number M1684526(9) filed on February 14, 1992, in class 9, Registration Number M1681996(9) filed on February 4, 1992 in class 39, and Registration Number M1721580(3) filed on September 23, 1992 in class 42. The marks are licensed to another Spanish entity, BQR Optical SL, which uses the OPTIPRIX and device marks in connection with eyeglasses and lenses.

The Respondent appears to be an individual with an address in the Republic of Korea.

The disputed domain name was registered on August 19, 2012, and at the time of the filing of the Complaint, resolved to a domain parking site with pay-per-click links.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the OPTIPRIX and design trademark in which the Complainant has rights. Namely, the Complainant asserts that the disputed domain name consists of the Complainant's trademark OPTIPRIX, and the lack of the design element does not avoid confusing similarity.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name and confirms that it has not authorized or licensed rights to the Respondent in any respect.

Finally, the Complainant contends that the disputed domain name was registered and is used in bad faith. The Complainant points out that the Complainant's trademark was registered in 1992 and given the volume of services rendered using the OPTIPRIX mark, it is highly unlikely that the Respondent did not know of the existence of the Complainant's trademark at the time of registration of the disputed domain name. Further, the Complainant argues that the Respondent's use of the disputed domain name to display pay-per-click links does not constitute a *bona fide* offering of goods and services. The Complainant also contends that the Respondent offered the disputed domain name for sale on "www.godaddy.com" and at the website linked to the disputed domain name with the statement: "This domain name is for sale at www.VipBroker.com. Please click here to inquire." The Complainant adds that its intermediary contacted the owner of the disputed domain name and received an email from a "[...], Marketing Manager, Trademark Worx, LLC, Site: www.VipBroker.com" using the email address "[...]@naver.com" who relayed an offer from the Respondent to sell the disputed domain name for USD 47,800. The Complainant argues that this is further evidence of the Respondent's bad faith.

B. Respondent

In the Response, the Respondent does not address the first element.

As for the second element, the Respondent asserts that he has legitimate interests in the disputed domain name. He explains that he is using the disputed domain name for a website that advertises shared office space and housing with more than 270,000 website members and that the value of the disputed domain name is incalculable.

Finally, the Respondent denies that he engaged in bad faith registration or use of the disputed domain name. He contends that he did not know of the Complainant or the Complainant's mark at the time of registration of the disputed domain name. He argues that the Complainant and its trademark are not known in the Republic of Korea, nor registered before the Korean Intellectual Property Office. He also contends he has not offered to sell the disputed domain name to the Complainant and explains that he does not know anyone using the email address "[...][@naver.com](mailto:[...]@naver.com)". He further explains that even if he did offer sale of the disputed domain name, it is simply an offer and not an attempt to seek unreasonable profit from the sale of the disputed domain name to the Complainant.

6. Discussion and Findings

A. Language of Proceedings

Paragraph 11(a) of the Rules provides that the language of the proceeding shall be the language of the registration agreement, unless otherwise agreed to by the parties, subject to the authority of the panel to determine otherwise. In this case, the language of the Registration Agreement is Korean, and both Parties have had an opportunity to argue their positions on this point. The Center issued a notice in Korean and English stating that it would accept the Complaint filed in English, and that the Response would be accepted in either Korean or English. The Respondent thereafter submitted a Response in Korean.

The Panel finds it proper and fair to render this decision in English. According to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1, the Panel can take into consideration prior cases involving the respondent in a particular language. In this regard, the Respondent was the respondent in 14 prior WIPO UDRP decisions and the panels in all but one of the cases rendered decisions in English, deciding that the Respondent has sufficient knowledge of English to be able to understand the decision in English, or that the Respondent would not be unduly prejudiced by rendering the decision in English. Moreover, both parties were permitted to and in fact did present their cases in the language of their preference, so it appears that fairness has been maintained in view of the overall circumstances.

B. Identical or Confusingly Similar

The Complainant owns registrations to trademarks that consist of the text OPTIPRIX and a design. According to [WIPO Overview 3.0](#), section 1.10, design elements are largely disregarded for purposes of assessing confusing similarity, except in limited circumstances such as when the design element comprise the dominant portion of the mark such that it overtakes the textual elements. Here, the disputed domain name corresponds to the text portion of the Complainant's mark exactly and the design element can be disregarded from consideration since it constitutes a minor portion of the mark.

For the reasons mentioned above, the Panel finds that the first element has been established.

C. Rights or Legitimate Interests

At the time of filing of the Complaint, the disputed domain name resolved to a page with pay-per-click links including links related to eyeglasses and lenses which is the business sector for which the Complainant's

trademark is used, which thus does not constitute *bona fide* use. Sometime after the Complaint was filed, the Respondent redirected the disputed domain name to a blog on the platform Naver advertising shared office space and housing. However, the term “optiprix” appears nowhere on any of the blog entries and the timing of the redirection leads the Panel to conclude that it was an attempt to give the appearance of *bona fide* use for the benefit of the WIPO proceeding. The Panel finds that this attempt was not convincing to show that the Respondent has rights or legitimate interests in the disputed domain name. Further, there is nothing in the record to suggest that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or has been commonly known by the disputed domain name, nor is there any evidence of the Respondent’s demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services

For the reasons provided above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, and that the second element has been established.

D. Registered and Used in Bad Faith

The Panel finds that there is sufficient evidence to find bad faith in this case.

Firstly, the term “optiprix” is a coined term with no particular meaning. Therefore, it should be considered quite a coincidence for the Respondent to have registered the disputed domain name which consists exactly of the text portion of the Complainant’s trademark. The Respondent has given no explanation for having registered this particular term, and there does not seem to be any plausible good faith explanation for the registration and use of the disputed domain name.

Further, by linking the disputed domain name with a parking page displaying pay-per-click links including links related to eyeglasses and lenses which is the business sector the Complainant’s trademark is used, the Respondent created a likelihood of confusion and benefited commercially from the confusion of Internet users that visited the site by mistake as per paragraph 4(b)(iv) of the Policy.

The Respondent asserts that he had no bad faith, arguing that the disputed domain name now forwards to a Naver blog displaying information on shared offices and housing which is dissimilar to the goods and services of the Complainant. But as mentioned above, it appears that the redirection occurred shortly after he was notified of the Complaint. Further, the blog has no reference to the term “optiprix” at all, and the Respondent has not explained the reason for the use of the disputed domain name for the blog, nor the reason for the redirection at that point in time. Rather, the circumstances lead the Panel to conclude that the Respondent sought to manufacture *bona fide* use to mislead the Panel, and after reviewing other WIPO decisions rendered against the Respondent, the Panel found that the Respondent has asserted a similar questionable defense which the panels concluded as evidence of bad faith. For instance, in one case, the domain name at issue was linked first to a page with pay-per-click links to the services of the complainant’s competitors, then to a page on – coincidentally - “local hive co-working & co-living space,” and then after the complaint was filed, to a site for managing an automobile fan club, all within the space of a few months, and the fan club had no ascertainable connection to the domain name at issue. *Vet Planet Sp. Z o.o. v. Yang Kyung Won*, WIPO Case No. [D2021-1874](#). In that case, the panel found bad faith on part of the Respondent based on the fact that the Respondent failed to explain the reasons for domain name moves within such a short period of time or for choosing that particular domain name. In another case, the Respondent linked the domain name at issue to a website for fans of Audi cars, while the domain name had no connection at all to Audi cars nor to the contents of the website. *Renée Blanche S.r.l. v. Yang Kyung Won*, WIPO Case No. [D2018-0541](#). In the case, the Respondent asserted that he registered the domain name at issue for an environmental campaign, and as evidence, pointed to another of his websites with contents related to the environment, but the domain name happened to be registered right after the filing of the complaint. The panel decided that “the questionable timing, along with the fact that the disputed domain name has kept, and still is, diverting people to the website for Audi fans, raises a suspicion that the Respondent only created the website to come up with an improvised excuse for the wrongful use of the dispute domain name.” These cases support a pattern of bad faith activity by the Respondent. Besides these two prior decisions, there are ten other negative WIPO UDRP decisions against the Respondent involving domain names incorporating

trademarks of varying levels of fame: e.g. <sulon.com>, <lokeo.com>, <3brasseurs.com>, <adaptit.com>, and <legoonline.com>. The Respondent was the respondent in 17 prior decisions and the panels in all but two ordered the transfer of the disputed domain names, which the Panel finds constitutes a pattern of conduct of preventing trademark holders from reflecting their marks in domain names.

Based on the information submitted by the Complainant and the overall circumstances, including the distinctiveness of the Complainant's trademark, the fact that the Complainant's trademark registrations would have been discoverable through a trademark search, and the Respondent's history of bad faith registration and use of domain names, the Panel finds that the Respondent more likely than not registered and used the disputed domain name with knowledge of the Complainant and its trademark in order to profit from the likelihood of association with the Complainant's trademark and the products using the trademark.

For the reasons given above, the Panel finds that the third and final element has been established.

7. Decision

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

/Kathryn Lee/

Kathryn Lee

Sole Panelist

Date: July 15, 2022