

ADMINISTRATIVE PANEL DECISION

Humor Rainbow, Inc. v. Kwan Lee

Case No. D2022-3807

1. The Parties

The Complainant is Humor Rainbow, Inc., United States of America (“United States”), represented by Match Group Legal, United States.

The Respondent is Kwan Lee, Japan.

2. The Domain Name and Registrar

The disputed domain name <okcupid.org> (the “Disputed Domain Name”) is registered with Sea Wasp, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 11, 2022. On October 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 14, 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 (Jewella Privacy - e1b23, Jewella Privacy LLC Privacy ID# 984242) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 18, 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 amended Complaint on October 24, 2022.

The Center verified that the Complaint together with the amended 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 October 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 15, 2022.

The Center appointed Nick J. Gardner as the sole panelist in this matter on November 17, 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.

4. Factual Background

The Complainant has provided online dating services under the OKCUPID brand since 2003. The Complainant owns a number of registered trademarks for the term OKCUPID – see for example United States Trademark Registration No. 3,334,217 which was registered in November 2007. These trademarks are referred to in this decision as the OKCUPID Trademark. The Complainant’s website, which is linked to the domain name <okcupid.com> has been active since March 2003.

The Disputed Domain Name was registered on September 2, 2005. The Disputed Domain Name currently resolves to a website that comprises a number of pay-per-click (“PPC”) links. The Panel infers these are likely to be automatically generated. At least some of these lead to third party online dating services. At the time of filing the Complaint, the Disputed Domain Name redirected to various third-party websites.

5. Parties’ Contentions

A. Complainant

The Complainant contends the Disputed Domain Name is identical to the OKCUPID Trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name because the Respondent has not used the Disputed Domain Name in connection with a *bona fide* offering of goods or services. In particular, the Complainant contends that the Respondent’s use diverts consumers to other websites, to charge for unrelated goods and services, and gather personal and financial information.

The Complainant states that it has not authorized the Respondent to use the OKCUPID Trademark, that the Respondent does not appear to commonly known by the Disputed Domain Name, and that the Respondent does not appear to be making any legitimate noncommercial or fair use of the Disputed Domain Name.

As for evidence of bad faith, the Complainant alleges that the Complainant’s use of the term OKCUPID predated the registration of the Disputed Domain Name by two years. The Complainant further alleges that the Respondent’s use of the Disputed Domain Name to divert consumers to third party websites constitutes bad faith.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

Preliminary Matters – No Response

The Panel notes that no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent’s failure to file any Response. While

the Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent's default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

Preliminary Matters – Respondent Identity

The Panel also notes this is a case where the named Respondent in the original Complaint (Jewella Privacy - e1b23, Jewella Privacy LLC Privacy ID# 984242) appears to be a privacy or proxy service.

The Panel in this case adopts the approach of most UDRP panels, as outlined in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 4.4.5, as follows:

"Panel discretion

In all cases involving a privacy or proxy service and irrespective of the disclosure of any underlying registrant, the appointed panel retains discretion to determine the respondent against which the case should proceed.

Depending on the facts and circumstances of a particular case, e.g., where a timely disclosure is made, and there is no indication of a relationship beyond the provision of privacy or proxy registration services, a panel may find it appropriate to apply its discretion to record only the underlying registrant as the named respondent. On the other hand, e.g., where there is no clear disclosure, or there is some indication that the privacy or proxy provider is somehow related to the underlying registrant or use of the particular domain name, a panel may find it appropriate to record both the privacy or proxy service and any nominally underlying registrant as the named respondent."

In the present case the Panel considers the substantive Respondent to be Kwan Lee and references to the Respondent are to that person.

Preliminary Matters – Delay

The Panel also notes that the Disputed Domain Name has been held by the Respondent since 2005 without the Complainant taking any action. The Panel has considered whether that should prevent the Complaint now proceeding. The Panel in this regard agrees with the generally accepted approach of panels as set out in [WIPO Overview 3.0](#) at section 4.17 as follows:

"Does 'delay' in bringing a complaint bar a complainant from filing a case under the UDRP?"

Panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits.

Panels have noted that the UDRP remedy is injunctive rather than compensatory, and that a principal concern is to halt ongoing or avoid future abuse/damage, not to provide equitable relief. Panels have furthermore noted that trademark owners cannot reasonably be expected to permanently monitor for every instance of potential trademark abuse, nor to instantaneously enforce each such instance they may become aware of, particularly when cybersquatters face almost no (financial or practical) barriers to undertaking (multiple) domain name registrations.

Panels have therefore declined to specifically adopt concepts such as laches or its equivalent in UDRP cases.

Panels have however noted that in specific cases, certain delays in filing a UDRP complaint may make it more difficult for a complainant to establish its case on the merits, particularly where the respondent can show detrimental reliance on the delay."

In the present case there is no evidence of the Respondent carrying out any business activity under the Disputed Domain Name. Although a significant period has elapsed, there is therefore no evidence at all before the Panel of any sort of detriment to the Respondent still less any evidence of detrimental reliance. The Panel therefore does not find any reason for denying the Complainant its remedy.

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has rights in the OKCUPID trademark. The Panel finds the Disputed Domain Name is identical to this trademark. It is well established that the generic Top-Level Domain (“gTLD”), in this case “.org”, does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly the Panel finds that the Disputed Domain Name is identical to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

The Panel finds the OKCUPID trademark is, on the evidence before the Panel, a term in which the Complainant has developed a significant reputation. It is also a term, which as far as the Panel is aware has no meaning save in relation to the Complainant.

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use OKCUPID trademark. The Complainant has prior rights in the OKCUPID trademark, which precede the Respondent’s acquisition of the Disputed Domain Name. The Complainant has therefore established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the Disputed Domain Name. Accordingly the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.

The Panel concludes that (iv) applies as the Disputed Domain Name is likely to attract traffic because of confusion with the Complainant's mark, and the Respondent derives commercial gain as a result. The website linked to the Disputed Domain Name previously redirected to third-party websites and currently comprises a series of PPC links to other third-party websites. The Panel infers that some consumers, once at this website will follow the provided links and "click through" to other sites which offer products some of which may compete with those of the Complainant. The Respondent presumably earns "click through" linking revenue as a result. The Panel infers the website is automatically generated. This does not however matter. It is well established that where a domain name is used to generate revenue in respect of "click through" traffic, and that traffic has been attracted because of the name's association with the Complainant, such use amounts to use in bad faith, see for example *Shangri-La International Hotel Management Limited v. NetIncome Ventures Inc.*, WIPO Case No. [D2006-1315](#); *Owens Corning v. NA*, WIPO Case No. [D2007-1143](#); *McDonald's Corporation v. ZusCom*, WIPO Case No. [D2007-1353](#); *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. [D2007-1912](#); *Rolex Watch U.S.A., Inc. v. Vadim Krivitsky*, WIPO Case No. [D2008-0396](#).

See also [WIPO Overview 3.0](#) section 3.5: "Can third-party generated material "automatically" appearing on the website associated with a domain name form a basis for finding bad faith?"

Particularly with respect to "automatically" generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests).

Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith".

The Panel does not consider that it matters that the Complainant did not have any registered trademark rights at the time the Disputed Domain Name was registered. The Panel reaches this view bearing in mind

that the term OKCUPID is a distinctive term with no independent meaning (see *FinanceMalta v. Adriano Cefai*, WIPO Case No. [D2011-1246](#)) and the Complainant commenced business two years before the Respondent registered the Disputed Domain Name. See [WIPO Overview 3.0](#) section 3.8.2 “Domain names registered in anticipation of trademark rights. As an exception to the general proposition described above in 3.8.1, in certain limited circumstances where the facts of the case establish that the respondent’s intent in registering the domain name was to unfairly capitalize on the complainant’s nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

Such scenarios include registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further to the respondent’s insider knowledge (e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant’s filing of a trademark application”.

It seems to the Panel more likely than not that the Respondent registered the Disputed Domain Name because it corresponded to the Complainant’s developing business and with a view to capitalising on its developing reputation in that regard. The Panel considers that amounts to bad faith registration and use. Further, the Panel notes that the Respondent has not filed a Response nor provided any positive case as to good faith that it might have. The Panel infers that none exists.

Accordingly, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 <okcupid.org> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: December 1, 2022