

ADMINISTRATIVE PANEL DECISION

Olé Mexican Foods, Inc. v. David Oh, Sk Market Inc
Case No. D2024-3884

1. The Parties

Complainant is Olé Mexican Foods, Inc., United States of America (“United States”), represented by Holland & Knight LLP, United States.

Respondent is David Oh, Sk Market Inc, United States, represented by Lewis Roca Rothgerber Christie LLP, United States.

2. The Domain Name and Registrar

The disputed domain name <olecitymarket.com> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 23, 2024. On September 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Respondent Information Hidden by Private Service) and contact information in the Complaint. The Center sent an email to Complainant on September 25, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on September 27, 2024.

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 Respondent of the Complaint, and the proceedings commenced on October 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 21, 2024. The Response was filed with the Center on October 21, 2024.

The Center appointed Robert A. Badgley as the sole panelist in this matter on October 28, 2024. 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

Complainant alleges:

“Since at least as early as 1988, Complainant has operated a business specializing in the provision of certain food products and food-related services under the OLÉ trademark and service mark.”

“Over the years, Complainant has adopted variations of the OLÉ trademark and service mark, including OLÉ (standard characters); OLÉ (with design variations, seen below); OLÉ MEXICAN FOODS EST. 1988 (with design variations, seen below); and EST. 1988 OLÉ MEXICAN FOODS (with design variations, seen below) (collectively, the ‘Marks’). [...]

“Today, Complainant is well-known, both to consumers and the public at-large, doing business not just in the United States of America, but also throughout the world. As an example of this global recognition, Complainant is the owner of many trademark registrations, national and/or international, for the Marks throughout the world, [...]”

“Complainant’s Marks have become widely known to consumers across the globe to identify certain food products and food-related services.”

Complainant does not provide any evidence in this proceeding regarding the extent to which its OLÉ trademark is renowned.

Complainant’s registered trademarks with the United States Patent and Trademark Office (“USPTO”) include: OLÉ (Reg. No. 2,740,014), registered on July 22, 2003 for “tortillas; tortilla chips”; OLÉ (Reg. No. 3,223,608), registered on April 3, 2007 for “Mexican style food products, namely, chorizo, queso and cheese dips, chicharrones” and “Mexican style food products, namely, tortillas, tostadas, tortilla chips, Mexican pastries, Mexican snack foods, namely, corn chips, salsas”; OLÉ (Reg. No. 6,897,890), registered on November 15, 2022 for “hams, cheese dips, crema Mexicana” and “spice and seasoning, namely, cinnamon sticks”; and OLÉ (Reg. No. 7,025,654), registered on April 11, 2023 for “Mexican seasonings and spices”.

Complainant has registered the OLÉ mark in several other jurisdictions, including Canada, Australia, Costa Rica, Dominican Republic, Mexico, and the European Union.

Complainant owns the domain name <olemex.com> and uses that domain name to host its main commercial website.

The Domain Name was registered on July 1, 2022. The Domain Name resolves to a website promoting Respondent’s four retail stores in the Los Angeles, California area. The website states, among other things:

“Looking for deals on fresh produce & groceries? Click to view our weekly ad.”

“We are a supermarket retail chain, consisting of four stores in Los Angeles County.”

“Our Story”

“Started with Villa Market in Long Beach 1998, then acquired Best Bargain in Inglewood in 2003 taking over a 25,000 sq ft market initially an Alpha Beta in the late 60’s. After a couple years later, SK Market Inc. took over Advance Food Market which was rebuilt from the ground up after it was burned down in the 1992 LA

riots. It took only one year to rebuild with the support of all the previous employees who petitioned in the community to get grants from the city to rebuild.”

On July 26, 2022, Respondent filed with the USPTO a trademark application, Serial No. 97520047, for the standard character word mark OLÉ CITY MARKET in connection with “retail grocery store services” and “retail grocery stores” (the “Word Application”). The next day, Respondent filed with the USPTO an application, Serial No. 97522087, for a design mark OLÉ CITY MARKET, also in connection with “retail grocery store services” and “retail grocery stores” (the “Logo Application”).

Respondent alleges:

“On or about February 3, 2023, Respondent received a letter from Complainant’s counsel [‘POA’], alleging a likelihood of confusion between Complainant’s OLÉ marks on food products and Respondent’s marks which are the subject of the Word Application and Logo Application (‘Respondent’s Marks’).”

“After an exchange of letters disputing the existence of any likelihood of confusion between Complainant’s marks on food products and Respondent’s Marks, on March 21, 2023, [POA] sent Respondent a Trademark Agreement to settle the parties’ potential dispute.”

“The Trademark Agreement provides as follows:

Olé Mexican Foods agrees and consents to SK Market’s use and registration of the OLÉ CITY MARKET word mark (Application No. 97/520,047) and the OLÉ CITY MARKET and Design mark (Application No. 97/522,087) in connection with ‘retail grocery store services; retail grocery stores,’ and will not object to or oppose such applications.”

According to a sworn statement by Respondent David Oh annexed to the Response, Oh is the Chief Financial Officer of Respondent SK Market. Oh states further that a draft of the Trademark Agreement was sent to him by POA, and that he signed it on or about April 17, 2023 without proposing any changes. A copy of this alleged agreement, signed by Oh but not by Complainant, is annexed to the Response.

In its Complaint, Complainant made no mention of the Trademark Agreement, nor of its own counsel’s letter to and subsequent correspondence with Respondent. In its Complaint, Complainant alleges:

“Respondent’s use of the Disputed Domain Name is unauthorized. Respondent is not related to, affiliated with, endorsed by, or otherwise associated with Complainant. Respondent has not sought from Complainant, and Complainant has not granted to Respondent, any authorization, license, or permission to use the Marks.”

On May 30, 2023, Complainant’s counsel POA sent Respondent a cease-and-desist letter asserting Complainant’s rights in the OLÉ mark, demanding that Respondent abandon its USPTO applications for the OLÉ CITY MARKET word and design applications, and cancel its registration of the Domain Name.

According to Oh’s sworn statement, the first time he had ever heard of Complainant or its OLÉ marks is when he received the February 3, 2023 letter from POA. Oh states further that he had been seeking to rebrand SK Market for some time before then, and had decided to incorporate OLÉ into the brand because that Spanish term was regularly chanted at his son’s soccer game.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent asserts, among other things, that its business is different from Complainant's, that Respondent was unaware of Complainant's mark at the time the Domain Name was registered, and that there is widespread third-party use of the term OLÉ as a trademark or a domain name, including by businesses engaged in the food industry.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

A. Identical or Confusingly Similar

It is well accepted that the first element of the UDRP functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's trademark and the Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Panel finds that Complainant has rights in the mark OLÉ through registration and use demonstrated in the record. The Panel also finds that the Domain Name is confusingly similar to that mark. The mark OLÉ is entirely reproduced within the Domain Name, and the additional words "city market" does not prevent the OLÉ mark from being clearly recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are 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.

The Panel need not address this element, in view of its decision below regarding the "Bad Faith" element.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant

who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes, on the record provided, that Complainant has failed to carry its burden of proving that the Domain Name was registered and has been used in bad faith.

The Panel cannot conclude, on this record, that Respondent more likely than not had Complainant and its OLÉ mark in mind when registering the Domain Name. As noted above, Complainant's asserts that its mark enjoys fame, but does not support that assertion with evidence. Further, as Respondent noted (and supported with examples), there is considerable use of the term OLÉ – as part of a trademark or as part of a domain name – by third parties, including many within the food business. In addition, Respondent Oh provided an explanation of why he wanted to rebrand his retail store brand and adopted the term OLÉ as part of the brand, and that explanation does not appear to be far-fetched.

In addition, the Panel finds it curious that Complainant made no reference in this proceeding to the Parties' prior communications in early 2023 and the alleged Trademark Agreement. In the Panel's view, if the Trademark Agreement discussed by Respondent and produced as an annex to the Response (albeit a version signed only by Respondent) was not genuine, the Panel would have expected Complainant to object to this being put into evidence immediately. Complainant's silence about the Parties' prior discussions and the Trademark Agreement leaves the Panel with the impression that Complainant recognizes at some level that its UDRP case against Respondent is on shaky ground and in any event it does not bear the hallmarks of the type of cybersquatting case the Policy is intended to deal with.

Having said that, the Panel cannot and does not decide whether this matter presents a possible claim for trademark infringement or unfair competition. Such considerations lie well beyond the scope of the UDRP and the Panel's remit.

The Complaint fails.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: November 11, 2024