



Asian Domain Name Dispute Resolution Centre

seoul

(Seoul Office)

ADMINISTRATIVE PANEL DECISION

Case No. KR-1800172

Complainant: T-on Network

(Authorized Representative: Jaeyeon Ju)

Respondent: Domain Admin/This domain is For sale

Disputed Domain Name(s): celebspick.com

1. The Parties and Contested Domain Name

The Complainant is T-on Network, Seoul, Republic of Korea.

The Respondent is Domain Admin, Denver, the United States of America.

The domain name at issue is ‘celebspick.com’, registered by NameBright, Denver, the United States of America.

2. Procedural History

The Complaint was filed with the Seoul Office of the Asian Domain Name Dispute Resolution Center (ADNDRC)(“Center”) on January 14, 2018, seeking for a transfer of the domain name in dispute.

On January 30, 2018, the Center sent an email to the Registrar ‘NameBright’ asking for the detailed data of the registrant. On January 31, 2018, NameBright transmitted by

email to the Center its verification response, advising that the Respondent is listed as the registrant and providing the contact details and that the Respondent is bound by the NameBright registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

The Center verified that the Complaint satisfied the formal requirements of the "Policy", the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the Centre's Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, the Centre formally notified the Respondent of the Complaint. The proceeding commenced on February 5, 2018 and the due date for the Response was February 25, 2018.

On February 24, 2018, a Response was submitted by the Respondent, which was timely.

On March 16, 2018, the Center appointed Mr. Ho-Hyun Nahm (Presiding-Panelist), Mr. Doo-hyung Do and Ms. Gabriela Kennedy as the Panelists in the administrative proceeding and with the consents for the appointment, impartiality and independence declared and confirmed by the Panelists, the Center, in accordance with paragraph 7 of the Rules, organized the Panel of this case in a legitimate way.

On March 23, 2018, the Panel issued a Procedural Order requesting the Complainant to submit English translations of the Complainant's exhibits. In the same Order, the Panel allowed the Complainant to file an Additional Submission pursuant to the Complainant's request of March 16, 2018. In the Order, the Panel gave the Respondent the opportunity to file an Additional Submission in response to the Complainant's possible Additional Submission within seven (7) calendar days following its receipt of the Complainant's Additional Submission. The deadline for the Complainant's response to the Panel's Order was March 30, 2018.

On March 30, 2018, the Complainant filed an Additional Submission, which was timely. On April 7, 2018, the Respondent filed an Additional Submission, which was also timely.

3. Factual background

- i. The Complainant has registered the CELEB'SPICK mark with the Korean Intellectual Property Office (KIPO) (Reg. No. 401209083 and No. 401325102 covering class of goods 16; Reg. No. 410382938 covering class of service 45, Reg. No. 450076285 covering classes of goods and services 25, 35, 39, 42).
- ii. The disputed domain name was registered by the Respondent on January 18, 2018.

4. Parties' Contentions

A. Complainant

The Complainant's contentions in the Complaint:

- i. Complainant has registered the CELEB'SPICK mark with the Korean Intellectual Property Office (KIPO) (Reg. No. 401209083 and No. 401325102 covering class of goods 16; Reg. No. 410382938 covering class of service 45, Reg. No. 450076285 covering classes of goods and services 25, 35, 39, 42). *See* Complainant's exhibit 2 – copies of trademark registers). The distinctive part of the disputed domain name is <celebspick.com>, which is identical or confusingly similar to the Complainant's mark 'CELEB'SPICK' in stylization.
- ii. The disputed domain name was registered on January 18, 2018, which is later than the filing time of the Complainant's trademarks. The Respondent did not obtain any other rights; therefore, it does not have any rights or legitimate interests subsisting in the disputed domain name.

iii. The Respondent is actually selling the disputed domain <celebspick.com>, the website of which is directly connected to ‘hugedomains.com’, which enables users to purchase domain names at a high cost. It cannot be denied that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the said domain name registration to the Complainant who is the owner of the trademark and service mark, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name.

The Complainant’s contentions in the Additional Submission:

- i. The disputed domain name, <celebspick.com>, was first registered on November 3, 2015 by a company called “MM Ventures,” which had a trademark dispute with the Complainant. Since MM Ventures had filed an application for its trademark, copied from that of the Complainant, the Complainant submitted an opposition to the KIPO. The KIPO recognized the fact that MM Ventures imitated the Complainant’s well-known and famous trademark and eventually denied the trademark application of MM Ventures (Exhibit 4). The trademark in ANNEX A, submitted by the Respondent, is not the Complainant's trademark, but MM Ventures’ unsuccessful trademark application.

- ii. The translated document of the Complainant’s registered trademark was submitted by the Complainant (Exhibit 7). The term, “celebspick,” is a coined mark, which has never been defined, including in any dictionaries. The Complainant’s trademark was recognized as a well-known and famous trademark by the KIPO and has been broadly used and regarded as the trademark owned by the Complainant. The Complainant has widely used the trademark, “celebspick,” on Facebook, etc. (Exhibit 8), and therefore, it has become well known as it represents Complainant’s service (Exhibit 9: Google search results showing the Complainant’s services and related websites). It is an undeniable fact that the disputed domain name is identical or similar to the legally-registered trademark of the Complainant.

- iii. The distinctive part of the disputed domain name is not a generic but a coined term. The Complainant's trademark was recognized as a well-known and famous trademark by the KIPO and has been used globally on Facebook, for instance (Exhibit 8 and 9). The Respondent automatically renewed the disputed domain name, which was registered by the above-mentioned counterfeit trademark applicant, who had a trademark dispute with the Complainant. By doing so, the Respondent fundamentally deprived the Complainant, the legitimate rights holder of the disputed domain name, of the opportunity to apply for its transfer. As a result, the Respondent barred the Complainant from regaining the disputed domain name and deprived the Complainant of the disputed domain name.

- iv. Even in the U.S., the Respondent has been notorious for and provoked complaints about the way its does business, i.e. reselling domain names that it has registered (Exhibit 10). Since domain names are the business target, unlike the way ordinary people register them in good faith, the Respondent technically monitors and handles the renewal and pricing of domain names. The Respondent tries to defend its actions as being legal by relying on several previous UDRP decisions. The Complainant completed the registration of the trademark according to the results of its trademark opposition against MM Ventures and applied for the transfer of the disputed domain name, based on the Complainant's rights in the registered 'CELEB'SPICK' trademark. The Respondent, who automatically and as part of its business, was able to renew the disputed domain name. Therefore, the Respondent registered the disputed domain name with the intention of preventing the disputed domain name from being returned to its legitimate owner in order to sell it. Therefore, the Respondent registered the disputed domain name in bad faith.

B. Respondent

The Respondent's contentions in the Response:

- i. The Complainant failed to demonstrate its rights in the term "celebs pick". The Complainant failed to adhere to Rule 11(a) and submitted their annexes in the Korean language rather than English. Further, the Complainant's trademark is not

distinctive, and the Complainant does not have worldwide exclusive rights to the term “celebs pick”. “Celebs pick” is a generic and commonly used term, which was not originally coined or created by the Complainant. “Celebs pick” is a generic and commonly used term comprised of two dictionary-defined words. The Complainant does not have any exclusive notoriety with the generic term.

- ii. The Respondent has a legitimate interest in domain names that are generic in nature. The Respondent has a legitimate interest in <celebspick.com> as it is a common term that can be used for thousands of different entities in relation to the dictionary definitions of the two words “celebs” and “picks”.

The Complainant has made assumptions and speculative conclusions without providing evidence to back up its claims. The Complainant is a Korean company, with no English Internet presence, is located in Korea, and only caters to the Korean language. It therefore cannot claim global notoriety, especially against the Respondent, who is incorporated in the United States of America and who solely operates in the English language. The Respondent had never heard of nor registered the disputed domain name in bad faith.

The Respondent’s contentions in the Additional Submission:

- i. The Complainant has, for a second time, violated Rule 11(a) of the Policy and submitted exhibits in the Korean language, without providing English translations.
- ii. The Complainant’s assertions set forth in their Additional Submissions are illogical and full of false and unsupported statements. The Complainant’s submissions consist of irrelevant and fabricated arguments that are not based on fact nor are they supported by any evidence.
- iii. The Complainant’s averments that the Respondent does not have rights or a legitimate interest in <celebspick.com> are unintelligible. The Complainant continues to assert that the term “celebs pick” is not generic but fails to provide

evidence that they are the only entity using the term. Hundreds, if not thousands, of entities use the term “celebs pick” for the generic meaning. The Complainant claims that the Respondent, an Internet domain name re-seller, cannot have a legitimate interest to register <celebspick.com>, but does not give any supporting evidence or case law, which would support such a belief. This statement is incorrect and the Respondent’s business practices have been upheld as legitimate by many UDRP panels.

- iv. The Complainant is required to provide evidence of both registration and use in bad faith. The fact remains that the Complainant cannot provide any evidence that the Respondent has registered, nor is the Respondent using <celebspick.com> in bad faith. The Complainant could not provide a single source of case law that supports their erratic and un-researched arguments. Rather than provide the Panel with facts and evidence to support their claims and arguments, the Complainant has focused on providing irrelevant statements to create illusions in an attempt to divert the Panel from the facts in this matter. The Complainant could not prove that the Respondent lacked legitimate interests in <celebspick.com> under Policy ¶4 (a) (ii) nor could they prove the Respondent registered <celebspick.com> in violation of Policy ¶4 (a) (iii).

5. Findings

- i. Complainant has established its rights in the mark CELEB'SPICK through its registration with the Korean Intellectual Property Office (KIPO) (Reg. No. 401209083 and No. 401325102 covering class of goods 16; Reg. No. 410382938 covering class of service 45, Reg. No. 450076285 covering classes of goods and services 25, 35, 39, 42).
- ii. The disputed domain name was registered on January 18, 2018.

6. Discussion

Paragraph 15(a) of 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.”

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

i. Respondent’s domain name must be identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

ii. Respondent has no rights or legitimate interests in respect of the domain name; and

iii. Respondent’s domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

The Complainant has registered its CELEB'SPICK mark with the Korean Intellectual Property Office (KIPO) (Reg. No. 401209083 and No. 401325102 covering class of goods 16; Reg. No. 410382938 covering class of service 45, Reg. No. 450076285 covering classes of goods and services 25, 35, 39, 42). The consensus is that KIPO registrations are sufficient in conferring rights in a mark under Policy ¶ 4(a)(i). *See* ¶1.2.1 of *WIPO Jurisprudential Overview 3.0* stating (where the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.); *see also T-Mobile USA, Inc. dba MetroPCS v. Ryan G Foo / PPA Media Services*, FA 1627542 (NAF Aug. 9, 2015) (finding that Complainant has rights in the METROPCS mark through its registration with the United States Patent and Trademark Office). Therefore, the Panel deems the Complainant’s evidence of a KIPO registration for the CELEB'SPICK mark sufficient in establishing rights under Policy ¶ 4(a)(i).

Next, the Complainant argues that the Respondent's disputed domain name <celebspick.com> is confusingly similar to its CELEB'SPICK mark under Policy ¶ 4(a)(i). The Complainant contends that the only difference between the Respondent's disputed domain name and the CELEB'SPICK mark is the generic top-level domain name extension (<.com>), and thus it is confusingly similar to the Complainant's mark. Panels have agreed that the generic top-level domain extension by itself is insufficient to distinguish a domain name from the complainant's mark. *See Microsoft Corporation v. Thong Tran Thanh, FA 1653187* (NAF Jan. 21, 2016) (determining that confusing similarity exists where a disputed domain name contains a complainant's entire mark and differs only by the addition of a generic or descriptive phrase and top-level domain extension, the differences between the domain name and the incorporated trademark are insufficient to differentiate one from the other for the purposes of the Policy). Consequently, the Panel agrees that Respondent's disputed domain name <celebspick.com> is confusingly similar to the CELEB'SPICK mark pursuant to Policy ¶ 4(a)(i). Therefore, the Panel concludes that the Complainant has established the requirement under Policy ¶ 4(a)(i).

B) Bad Faith

The Complainant contends that the Complainant's trademark was recognized as a well-known and famous trademark by the KIPO and has been broadly used and regarded as the trademark owned by the Complainant. The Complainant further contends that it has widely used the trademark, "celebspick", on Facebook (Exhibit 8), and therefore, it has been well known as it represents Complainant's service (Exhibit 9: Google search results showing the Complainant's services and related websites). The Panel, however, finds that the Complainant has not provided sufficient evidence regarding its alleged fame and well-known status of its marks to recognize that the Respondent must have had knowledge of the Complainant and therefore registered the disputed domain name in bad faith to take advantage of the Complainant's mark. *See* ¶4.2 of *WIPO Jurisprudential Overview 3.0*, which states that the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence"; some

panels have also expressed this as an “on balance” standard. Under this standard, a party should demonstrate to a panel’s satisfaction that it is more likely than not that a claimed fact is true. Conclusory statements unsupported by evidence will normally be insufficient to prove a party’s case.

The Complainant contends that even in the U.S., the Respondent has been notorious for and provoked complaints about the way it does business (i.e. reselling after securing domain names), and that the Respondent, who also automatically renews expired domains as part of its business, was able to renew and register the disputed domain name with the intent of preventing the return of the domain name to its legitimate owner in order to resell it. However, the Panel is of the view that such accusations regarding the Respondent’s general conduct, without any reference or evidence related to the disputed domain name, does not constitute bad faith registration and use of the disputed domain name.

The Panel further notes that the Respondent appears to regularly register domain names that include generic words for reselling them. Such business activities can be legitimate and in good faith, and are not in themselves a breach of the Policy, so long as they do not encroach on a third party’s trade mark rights. The only evidence provided by the Complainant to the contrary is posts written by unknown individuals who allege that the Respondent registered expired domain names. There is no evidence or information regarding these domain names or such individuals, or whether they had any trademark rights that were encroached on by the Respondent, such that it would establish a pattern of bad faith behavior. Therefore, the Panel finds that not much weight can be lent to such evidence or allegations made by the Complainant.

The Complainant contends that the Respondent is actually selling the disputed domain <celebspick.com>, the website of which is directly connected to ‘hugedomains.com’, which provides the service of selling domain names at a high cost. However, the Panel notes that the Complainant has not provided evidence to back up its claims. The Panel found that when they visited the website of the disputed domain name, it displayed the

message 'Internet Explorer is not able to connect to www.celebspick.com'. The Panel also visited the website of 'hugedomains.com' to which allegedly the disputed domain name is directly connected. However, the Panel was not able to identify the disputed domain name on the list of domain names offered for sale.

Given all the circumstances above, the Panel finds that the Complainant has failed to establish the requirement under Policy ¶ 4(a) (iii).

7. Conclusion

Because the Complainant must prove all three elements under the Policy, the Complainant's failure to prove any one of the elements makes further inquiry into the remaining elements unnecessary. As such, the Panel has decided not to inquire into the Respondent's rights or legitimate interests or the parties' other allegations, based on the Complainant's failure to satisfy the requirements of Policy ¶ 4(a)(iii). *See* ¶4.2 of *WIPO Jurisprudential Overview 3.0* (a complainant must prevail on all three elements to succeed, and in appropriate cases where a panel finds that one of the elements is clearly not met, the panel may consider it unnecessary to address the other elements.); *see also Creative Curb v. Edgetec Int'l Pty. Ltd.*, FA 116765 (NAF Sept. 20, 2002) (finding that because the complainant must prove all three elements under the Policy, the complainant's failure to prove one of the elements makes further inquiry into the remaining element unnecessary); *see also Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, FA 836538 (NAF Dec. 28, 2006) (deciding not to inquire into the respondent's rights or legitimate interests or its registration and use in bad faith where the complainant could not satisfy the requirements of Policy ¶ 4(a)(i)).

8. Decision

Having not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

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

Ho-Hyun Nahm
Presiding Panelist

Doo-hyung Do
Co-Panelist

Gabriela Kennedy
Co-Panelist

Dated: April 25, 2018