



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2401930
Complainant:	GP CLUB
Respondent:	sebastian clemens
Disputed Domain Name(s):	<jmsolutionstore.com>

1. The Parties and Contested Domain Name

The Complainant is GP CLUB, of 152 Wonhyo-ro, Yongsan-gu, Seoul Special City, Korea (Wonhyo-ro 3rd Street).

The Respondent is sebastian clemens, of Am Weinberg 48, 99869 Drei Gleichen.

The domain name at issue is <jmsolutionstore.com> (the “Domain Name”), registered by Respondent with Dynadot Inc, of 210 S Ellsworth Ave #345 San Mateo, CA 94401 US.

2. Procedural History

The chronology of this proceeding is as follows:

23 September 2024 - the Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “Centre”) in the English language. The Complainant chose to have this case dealt with by a single-member panel.

24 September 2024 - the Centre transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name.

24 September 2024 - the Registrar transmitted by email to the Centre its verification response disclosing registrant contact information for the Domain Name and confirming that the language of the Registration Agreement is English.

8 October 2024 - the Centre sent an email communication to the Complainant providing the registrant contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint.

14 October 2024 - the Complainant filed an amendment to the Complaint.

15 October 2024 - The Centre 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 ADNDRC Supplemental Rules to the ICANN Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced. In accordance with the Rules, paragraph 5, the due date for Response was 4 November 2024. The Center did not receive any Response from the Respondent.

5 November 2024 - the Centre notified the parties of Respondent’s default.

5 November 2024 - the Centre appointed Claire Kowarsky as the sole panelist in this matter. 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 Centre to ensure compliance with the Rules, paragraph 7.

3. Factual background

The Complainant was established in Korea in 2003 and initially engaged in the game distribution business. In 2016, the Complainant developed and created the JMSOLUTION cosmetics brand. Since then, JMSOLUTION has sold more than 2.2 billion face masks, and its integrated cosmetic company has more than 500 product lines. The Complainant appointed Chofn Intellectual Property, of 1218 12th Floor, No 68 West Road of North Fourth Ring, Haidian, Beijing 100081, China, as its authorized representative in this matter.

The Complainant is registered owner of numerous JMSOLUTION wordmark trademarks, including: US trademark registration no. 5,467,157, which was registered on 15 May 2018 for goods and services in class 3; and European trademark registration no. 018387761 which was registered on 20 May 2021 for goods and services in class 3 (the “JMSOLUTION Marks”).

According to the Registrar verification, the Respondent is an individual named “sebastian clemens”[sic], located in Gliechen, Germany.

The Domain Name was registered on 8 July 2024 and has been used in connection with a website which refers directly to the Complainant’s JMSOLUTION Marks throughout and displays the Complainant’s logo.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The Complainant’s JMSOLUTION brand was formally established in Korea in 2016. Since then, the Complainant has achieved significant sales under its JMSOLUTION Marks, including more than 2.2 billion facemasks as of June 2021. Since 2018, Korean celebrities Lee Seung-heon, Han Hyo-joo, Kim Go-

eun, and Kim Tae-hee have been selected as JMSOLUTION brand endorsers. JMSOLUTION has launched online or offline sales in China, Korea the United States, Japan, Indonesia, Malaysia, Singapore, Vietnam and other countries.

- ii. The Domain Name is confusingly similar to Complainant's JMSOLUTION Marks because it completely contains the JMSOLUTION Marks and the term "store". The addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element. In a search of the term "JMSOLUTION" through the Google search engine, most of the results point to the Complainant, which shows that JMSOLUTION has a strong association with the Complainant's JMSOLUTION brand. Further, the generic top-level domain .com does not have the capacity to distinguish the Domain Name from the Complainant's prior rights.
- iii. The Respondent has no rights or legitimate interests in the Domain Name because the Domain Name misleads consumers for the purpose of commercial gain, causing them to believe that there is an affiliation between the Respondent and the Complainant, which does not constitute fair use. Further, the Respondent is not the Complainant's distributor or partner. The Complainant has never directly or indirectly authorized the Respondent to use the trademarks JMSOLUTION and corresponding domain names in any form. Additionally, the Complainant searched various national and regional trademark databases in the name of the Respondent and did not find that the Respondent had trademark rights in the name of JMSOLUTION. Lastly, the name of the Respondent is "sebastian clemens", and as such it is impossible for him to enjoy the name rights for JMSOLUTION.
- iv. The Domain Name was registered and is being used in bad faith because the JMSOLUTION mark has acquired a high level of popularity due to its extensive use and the JMSOLUTION mark itself does not correspond to any word in common use in French, English or any other language. The Complainant firmly believes that the JMSOLUTION Marks have acquired a high degree of distinctiveness through the Complainant's extensive use. Moreover, the content of the website to which the Domain Name points is identical to the content of the program operated by the Complainant including use of the JMSOLUTIONS trademarks. As such, this conclusively establishes that the Respondent was aware of the existence of the Complainant's prior trademark rights at the time of registration of the Domain Name. Prior panels have found that knowledge, actual or inferred, of a strong mark is evidence of registration in bad faith. Further, Respondent's use of the Domain Name to deliberately imitate the Complainant's JMSOLUTION brand for profit is consistent with bad faith under the Policy paragraph 4b(iv).
- v. The Complainant requests that the Domain Name should be transferred to the Complainant.

B. Respondent

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

5. Findings

The 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 is 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

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term JMSOLUTION in several territories around the world. Such trademark rights were created and registered prior to 8 July 2024, the creation date of the Domain Name. A nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Accordingly, the Panel finds that the Complainant possesses rights in its JMSOLUTION trademark such that it has standing under the Policy.

UDRP panels have held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., *LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com*, *WIPO Case No. D2011-1290 <legoninjagokai.com>* (“the mere addition of the words ‘Ninjago’ and ‘Kai’ is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant’s trademark.”).

In the present case, the Domain Name consists of the JMSOLUTION trademark reproduced in its entirety with the addition of the generic but related term “store”. In assessing confusing similarity, the Panel finds the Domain Name is confusingly similar to the Complainant’s trademark, because it incorporates the entirety of the JMSOLUTION trademark, and differs from such mark merely by adding the aforementioned generic but related term, “store”. This addition does not prevent a finding of confusing similarity considering the prominence of the distinctive JMSOLUTION mark within the Domain Name. See e.g. *HK-2401886 <accessboltinsurance.com>* (“The Disputed Domain Name is not identical to the Complainant’s mark “BOLT”, but has incorporated this mark in its entirety. Are the additional components “access” and “insurance” sufficient to differentiate the Disputed Domain Name from the Complainant’s mark for the purpose of the policy? The Panelist considers in the negative.”)

The TLD – in this case .com - may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant’s trademark as it is technical requirement of registration (see section 1.11.1 *WIPO Overview of Panel Views on Selected UDRP Questions, Third Edition* (“*WIPO Overview 3.0*”)).

Accordingly, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Domain Name is confusingly similar to the Complainant’s mark.

B) Rights and Legitimate Interests

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Domain Name. The generally adopted approach, when considering the second element, is that if a complainant makes out a *prima facie* case, the burden of proof shifts to the respondent to rebut it; see, for example, *WIPO Overview 3.0, section 2.1* (“While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”). However, the burden of proof still remains with the complainant to make out its *prima facie* case on a balance of probabilities. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

Paragraph 4(a)(ii) of the Policy contemplates an examination of the available facts to determine whether a respondent has rights or legitimate interest in the domain name. Paragraph 4(c) sets out a list of circumstances through which a respondent may demonstrate that it does have such rights or interests.

The first circumstance, under Paragraph 4(c)(i), is where “before any notice to you 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”. Here, according to screenshot evidence submitted by the Complainant, the Domain Name resolves to a copy-cat website displaying Complainant’s trademark and goods. Accordingly, the Panel finds no evidence of a bona fide offering of goods or services or demonstrable preparations to use per Policy 4(c)(i) and Respondent does not have rights or legitimate interests with respect to the Domain Name thereunder.

The second circumstance, under Paragraph 4(c)(ii), concerns cases where the respondent is commonly known by the domain name. Here, according to the registrar verification, the Respondent name is “sebastian clemens” and has no similarity or connection to the Domain Name. There is no evidence that the Respondent is commonly known by the Domain Name. As such, this second circumstance of legitimate rights or interests under the Policy is not applicable to the Respondent.

Regarding the third circumstance, under Paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent is making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s JMSOLUTION trademark. According to the evidence submitted, the Domain Name resolves to a website where the Complainant’s JMSOLUTIONS trademarks is displayed, and allegedly *prima facie* unauthorized branded products are being promoted. The Panel accepts, *prima facie*, that this use does not constitute legitimate

non-commercial or fair use because none of the accepted categories of fair use - such as news reporting, commentary, political speech, education etc. – are found to apply.

Even if the goods promoted via the website associated with the Domain Name are legitimate the present case fails the “Oki Data test” for establishing legitimate interest as set out in *Oki Data Americas, Inc. v. ASD, Inc* *WIPO Case No. D2001-0903 <okidataparts.com>* because the screenshots submitted as evidence do not appear to contain any information about the Respondent nor do they disclose the Respondent’s relationship with the Complainant. There is no clear and prominent disclaimer that could support a finding that the Respondent has taken reasonable steps to avoid confusing consumers about the provenance of the website. Further, cases applying the Oki Data test usually involve a domain name comprising the trademark plus a descriptive term such as “parts” or “repairs”. In the instant case there is no such descriptive term, and the Domain Name is identical to the Complainant’s trademark, save for the addition of the generic but related term “store”.

Lastly, the Complaint states that the Respondent is not licensed, nor has any relationship with or authority to represent the Complainant in any way. See, e.g. *HK-2401858 <paulsmithclearan.com>* (“Previous UDRP panels have found that in the absence of any license or permission from a complainant to use a complainant’s trademarks, generally no bona fide or legitimate use of the domain name could reasonably be claimed.”).

Accordingly, the Complainant has sufficiently made out its prima-facie case on the second element of the Policy. Thus, the burden of proof is shifted to the Respondent to rebut the Complainant’s case. Here, because the Respondent has not participated in these proceedings, there is no such rebuttal to consider, and the Complainant prevails.

The Panel therefore concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest in the Domain Name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C) Bad Faith

The third element requires the Complainant to show that the Domain Name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy.

Further, Paragraph 4(b) of the Policy sets out a non-exhaustive list of four circumstances, any one of which may be evidence of the registration and use of a domain name in bad faith. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or 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 the respondent’s documented out-of-pocket costs directly related to the domain name; or

(ii) the 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 the respondent has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website 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 the respondent's website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the Domain Name in bad faith under paragraph 4(a)(iii) of the Policy for the reasons set out below.

There is no evidence that the Respondent is commonly known by the Domain Name and the Complainant confirms that the Respondent has never been affiliated with nor authorized by the Complainant to use the Complainant's trademark(s) and/or register the Domain Name. Nor is there any business or other association between the Complainant and the Respondent.

The Complainant's JMSOLUTIONS trademark is distinctive and enjoys a considerable reputation in its industry as evidenced by its substantial sales of more than 2.2 billion face masks and its online presence as shown by the Google search results submitted as evidence. The Panel finds that because of the well-established status of the Complainant, it is more probable than not that the Respondent either knew, or should have known, that the Domain Name would be confusingly similar to the Complainant's trademarks and thus they registered the Domain Name with the Complainant in mind.

The Respondent's use of the Domain Name for a lookalike site demonstrates that Respondent almost certainly had actual notice of the Complainant's trademark when registering the Domain Name. It has regularly been held that to copy a trademark in a domain name, or use it with a slight variation, knowing that the disputed domain name is based on the trademark of another party, constitutes bad faith registration and use of the disputed domain name according to the Policy. The Panel makes that finding in the present case.

The evidence of targeting by the Respondent is compelling. The Domain Name comprises the Complainant's distinctive JMSOLUTION mark, with the addition of the generic but related term "store", apparently meant to represent an online store where the Complainant offers its goods and with which the Complainant can therefore be closely and relevantly associated.

According to the evidence submitted, the Domain Name resolves to active content purporting to promote goods bearing the Complainant's JMSOLUTION trademark. By using the Domain Name for lookalike websites as noted above, the Respondent is clearly intending to attract internet users for commercial gain, in a manner which would generate confusion as to the legitimacy of any site to which the disputed domain name resolves. This brings the instant proceeding within the provisions of paragraph 4(b) (iv) of the Policy. See, e.g. *HK-2401857 <pspaulsmithwear.com>* ("The "Home" page of the Respondent's website prominently displayed the Complainant's word and design PAUL SMITH trademark. As a result, Internet users may have been misled on the source, sponsorship, affiliation, or endorsement of the Respondent's website, which constitutes bad

faith use of the Domain Name.”). Further, this present case has similarities to Prada S.A. v. Chen Minjie, *WIPO Case No. D2015-1466 <prada-sa.com>* (“The Respondent’s registration of a domain name which incorporates the whole trade mark, PRADA, the use thereof for the purpose of selling what appears to be counterfeit PRADA products, and the creation of a web site which is intended to pass off as the authentic or official web site of the Complainant, are obvious signs of bad faith registration and use. This is the very kind of cybersquatting and illegitimate activity that the Policy is intended to address and deal with”.)

As a final point, the Panel may draw a negative inference from Respondent’s silence through these proceedings.

Considering the above analysis, the Panel concludes that the Complainant has made out its case that the Domain Name was registered and are being used in bad faith, and thus has satisfied the requirements under paragraph 4(a)(iii) of the Policy.

6. Decision

For the foregoing reasons, in accordance with the Policy, paragraph 4(i), and the Rules, paragraph 15, the Panel orders that the Domain Name <jmsolutionstore.com> be transferred to the Complainant.



Claire Kowarsky
Panelist

Dated: 13 November 2024