



Asian Domain Name Dispute Resolution Centre

seoul

(Seoul Office)

ADMINISTRATIVE PANEL DECISION

Case No. KR-1500126

Complainant: SUNHAN ID Co., Ltd
(Authorized Representative: Heesob Nam)

Respondent: Whoisproxycy.com Ltd./Zineb Guessous
(Authorized Representative: Michael Gilmour)

Disputed Domain Name(s): filenor.com

1. The Parties and Contested Domain Name

The Complainant is SUNHAN ID Co., Ltd. of (Sampyong-dong Uspace), A-808, 660, Daewangpangyo-ro, Bundang-gu, Seongnam-si, Gyeonggi-do, Korea

The Respondent is Zineb Guessous of 152 Franklin St, New York, US

The Registrar of the domain name at issue is Key-Systems GmbH of Im Oberen Werk 1, 66386 St. Ingbert, Germany.

2. Procedural History

The Complaint was filed with the Seoul Office of the Asian Domain Name Dispute Resolution Center ("ADNDRC")["Center"] on June 25 2015, seeking for a transfer of the domain name in dispute.

On July 1 2015, the Center sent an email asking for the detailed data of the registrant or the Respondent to the Registrar. On the same day, the Registrar transmitted by email to the Centre its verification response, advising that Whoisproxycy.com Ltd. is not listed as the

registrant and providing the details of the underlying registrant, Zineb Guessous. The Complainant was notified and given until 13 July 2015 to file an amended Complaint. An amended Complaint was filed on 13 July 2015.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (“the Policy”), the Rules of Procedure under the Policy (“the Rules”), and the Centre’s Supplemental Rules. In accordance with the Rules, the Centre formally notified the Respondent of the Complaint. The proceedings commenced on 14 July 2015. In accordance with the Rules, the due date for the Response was 3 August 2015. On July 21 2015, the Respondent submitted the Response.

On July 27 2015, the Center appointed Mr. Jong-Yoon Kim as the Sole Panelist of this case, and with the consent for the appointment, impartiality and independence declared and confirmed by the panelist, the Center, in accordance with paragraph 7 of the Rules, organized the Panel of this case in a legitimate way.

On August 10 2015, the Panel issued procedural order to the parties to submit the further statements pursuant to Paragraph 12 of Rules. On August 17 2015, the Complainant submitted further statements. On August 20 2015, the Respondent submitted further statements to refute Complainant’s claims.

3. Factual background

3.1 The Complainant is a hosting service provider in South Korea, whose principal aim is permitting users to share, by using computers, third parties’ copyrighted works. The service provided by the Complainant is what is so called “web-hard service”. The Complainant launched its business in February 2007, and has provided service since at latest May 2007 through its webpage using its domain names “filenori.com” and “filenori.co.kr” both of which were registered on February 12, 2007. In the webpage of the Complainant, the letter “Filenori” and Logo has been used as a service mark to identify the source of the services.

3.2 The Complainant filed an application for registration of a service mark “Filenori” and Logo in class 42, which was registered on May 11, 2009. The Complainant filed another application for registration of a service mark “FILENORI” in class 38, which was registered

on December 29, 2008. The registration dates of the service marks were later than the registration date of the Disputed Domain Name (January 23, 2008).

3.3 According to the Internet Archive, a San Francisco-based non-profit digital library, at least 9,298 materials (contents) were posted by users on the Complainant's webpage on May 19, 2007. The number of such materials (contents) of the subsequent months were: 33,457 on June 16, 2007; 98,784 on July 12, 2007; 110,053 on July 16, 2007; 120,367 on July 18, 2007; 256,073 on August 15, 2007; 275,125 on August 19, 2007; and 724,377 on October 27, 2007.

3.4 In April 2015 when the Complainant became aware of the existence of the disputed domain name, the webpage of the disputed domain name was used only to show eight links entitled: "adult movie watching", "erotic video watching", "enjoying free movie", "free watching TV drama", "file", "Lg tv", "Television tv" and "32 inch lg tv price". By clicking "adult movie watching" in the webpage, visitors were directed to another webpage containing several advertising links. One of the links was directed to the webpage of www.ental.com operated by WithWeb Inc., one of the Complainant's competitors.

3.5 On April 9, 2015, the Complainant sent a cease and desist letter to WithWeb Inc. demanding to stop such unlawful activities as attracting users to its webpage using the disputed domain name. By the reply from WithWeb Inc. dated April 15, 2015, however, the Complainant was advised that WithWeb Inc. had nothing to do with the disputed domain name and the webpage thereof.

3.6 By the reply from WithWeb, the Complainant was further advised that the webpage of the disputed domain name had simply been used as a domain parking service of 'Sedo' which is a domain name and website marketplace and domain name parking provider. The disputed domain name was put in the webpage of Sedo 'for sale'.

3.7 According to the Complainant, the service mark of the Complainant "Filenori" was created by combining the English word "File" and "nori". "nori" is the English transliteration of Korean word "놀이" which has a meaning of "play" in English.

4. Parties' Contentions

A. Complainant

The Complainant asserts that the disputed domain name is confusingly similar to the service marks registered. According to the Complainant, the registration of the disputed domain name is a typical "typo-squatting".

The Complainant claims that the Respondent has no rights or legitimate interests in the disputed domain name because (a) the Complainant has never authorized the Respondent to use the disputed domain name, (b) the Respondent has not been commonly known by the disputed domain name and (c) the Respondent has not used the domain name for its own products or services.

The Complainant states that the Respondent has registered and used the disputed domain name in bad faith because (a) the Respondent has registered the disputed domain name for the purpose of disrupting the business of the Complainant as stated in Para 4(b)(iii) of the UDRP, or (b) intentionally attempt to attract, for commercial gain, Internet users to Respondent's website or other on-line location by creating a likelihood of confusion as stated in Para 4(b)(iv) of the UDRP.

The Complainant requests the Panel to direct the registrar to transfer the disputed domain name to the Complainant.

B. Respondent

The Respondent argues that the disputed domain name was not registered and used in bad faith because it was registered on January 23, 2008 which is well before the registration dates of the Complainant's service marks. The Respondent further argues that it has not infringed rights of the Complainant because the Complainant does not have any valid right in the USA where the Respondent operates its business.

The respondent states that the disputed domain name is not a typo of "Filenori", but a creation by combining the English words "File" and "nor" both of which are dictionary terms.

The Respondent argues that the advertising appeared for ‘ental’ (a competitor of the Complainant) after the Complainant clicked on a series of links in the webpage of the disputed domain name does not mean that the respondent was purposefully endeavoring to infringe on the Complainant’s Korean service mark rights.

The Respondent states that the disputed domain name has been up for sale and monetized since June 25, 2011 and the status of the domain name has not been changed, and that the service that the Respondent has provided by routing domain name to multiple monetization providers is widely recognized in the industry. The Respondent further states that it no longer has a relationship with “Sedo”.

The Respondent requests the Panel to reject the Complainant’s demand for transfer.

5. Findings

General

According to para. 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove that:

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

A. Identical or Confusingly Similar

There are two requirements that the Complainant must establish under this Paragraph; that it has rights in trademark or service mark, and that the domain name is identical or confusingly similar to the marks.

There is no dispute that the Complainant has a rights on the service mark “Filenori”. However, the Respondent argues that the disputed domain name was registered on January 23, 2008 well before the registration of the Complainant’s service marks.

The Panel refers to the passage in para. 1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions. The consensus view reads:

“1.4 Does the complainant have UDRP-relevant trademark rights in a mark that was registered, or in which the complainant acquired unregistered rights, after the disputed domain name was registered?

Consensus view: Registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity. The UDRP makes no specific reference to the date of which the owner of the trade or service mark acquired rights. However, it can be difficult to prove that the domain name was registered in bad faith as it is difficult to show that the domain name was registered with a future trademark in mind.”

The Panel adopts the consensus view, and thus the fact that the rights of the Complainant’s service mark postdated the disputed domain name registration does not prevent a finding of identity or confusing similarity.

The disputed domain name differs from the service mark “Filenori” only in that the disputed domain name does not have the final letter “i” of the service mark. Therefore, there is a risk that Internet users who want to visit the webpage of the Complainant to be diverted to the webpage of the disputed domain name by just omitting the last letter “i”. Under the reason, the Panel finds that the disputed domain name is confusingly similar to the service mark of the Complainant.

The Respondent states that dominant part of the disputed domain name (“filenor”) was created independently by combining the English words “File” and “nor”. However, such a statement is not persuasive.

The Respondent argues that it has not infringed the rights of the Complainant because the Complainant does not have any valid right in the USA where the Respondent operates its business. However, since the purpose of the UDRP is to prevent cybersquatting, not to prevent trademark infringement, the territory of the Complainant’s right does not affect in finding the identity or the confusing similarity.

Therefore, the Panel conclude that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purpose of paragraph 4(a)(ii):

- (i) before any notice to you of the disputes, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in accordance with a *bona-fide* offering of goods or service; or
- (ii) you (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 are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleading divert consumers or to tarnish the trademark or service mark at issue.”

The Respondent has not provided evidence that he has been commonly known by the disputed domain name, or that he has made or planned to make a *bona-fide* offer of goods or services using that name. The placement of the disputed domain name on a domain name parking website cannot be recognized as a *bona-fide* offering of goods or service within the meaning of paragraph 4(c)(i) of the Policy.

Therefore, the Panel conclude that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Because the rights of the Complainant's service mark postdated the disputed domain name registration, the Panel refers again to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, which reads:

“3.1 Can bad faith be found if the disputed domain name was registered before the trademark was registered or before unregistered trademark rights were acquired?”

Consensus view: Generally speaking, although a trademark can form a basis for a UDRP action under the first element irrespective of its date [see further paragraph 1.4 above], when a domain name is registered by the respondent before the complainant's relied-upon trademark right is shown to have been first established (whether on a registered or unregistered basis), the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the complainant's then non-existent right.

However: In certain situations, when the respondent is clearly aware of the complainant, and it is clear that the aim of the registration was to take advantage of the confusion between the domain name and any potential complainant rights, bad faith can be found. This has been found to occur: shortly before or after a publicized merger between companies, but before any new trademark rights in the combined entity have arisen; or when the respondent (e.g., as a former employee or business partner, or other informed source) seeks to take advantage of any rights that may arise from the complainant's enterprises; or where the potential mark in question is the subject of substantial media attention (e.g., in connection with a widely anticipated product or service launch) of which the respondent is aware, and before the complainant is able to obtain registration of an applied-for trademark, the respondent registers the domain name in order to take advantage of the complainant's likely rights in that mark. (In all such cases, in order to have a chance to succeed in any filed UDRP complaint, the complainant must actually demonstrate relevant trademark rights, as these are a precondition for satisfying the standing requirement under the first element of the UDRP for rights in a mark.)”

The Panel adopts the consensus view, and reviews the facts of the present case to find out whether or not the Respondent was clearly aware of the complainant at the time of registering

the disputed domain name, and whether or not the aim of the registration was to take advantage of the confusion between the domain name and the Complainant's rights.

The Complainant launched its business in March 2007, and has provided service since at latest May 2007 through its webpage using domain names "filenori.com" and "filenori.co.kr." According to the Internet Archive, materials posted on the Complainant's webpage in 2007 were as below.

| Date | Number of materials (contents) |
|------------------|--------------------------------|
| May 19, 2007 | 9,298 |
| June 16, 2007 | 33,459 |
| July 12, 2007 | 98,784 |
| July 16, 2007 | 110,053 |
| July 18, 2007 | 120,367 |
| August 15, 2007 | 256,073 |
| August 19, 2007 | 275,125 |
| October 27, 2007 | 724,377 |

The disputed domain name "filenor" was not such a word as could easily be created without referring to the Complainant's service mark. Despite that, the Respondent has offered no plausible good faith explanation for registering the disputed domain name. Namely, the explanation provided by the Respondent is not persuasive. The Respondent has offered to sell the disputed domain name to a third party. The disputed domain name has been used to be linked to other website for domain parking service, such as "Sedo."

Considering all these facts, the Panel finds that the Respondent was clearly aware of the Complainant, and has registered and used the disputed domain name with the bad faith intention within the meaning of Paragraph 4(b)(iv) of the Policy.

Therefore, the Panel conclude that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

6. Decision

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

Jong-Yoon Kim

Panelists

Dated: September 1, 2015