

ADMINISTRATIVE PANEL DECISION

1inch Limited v. Kwang Lee
Case No. D2024-2132

1. The Parties

The Complainant is 1inch Limited, British Virgin Islands, United Kingdom, represented internally.

The Respondent is Kwang Lee, United States of America.

2. The Domain Name and Registrar

The disputed domain name <1inch.com> the (“Disputed Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 17, 2024. On May 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 4, 2024, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 5, 2024 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 June 9, 2024.

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 June 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 1, 2024. The Response was filed with the Center on June 30, 2024.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on July 16, 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

The Complainant, 1inch Limited, is a company based in the British Virgin Islands. The Complainant is the owner of several trademarks including the following:

- 1INCH, European Union word mark registered under No. 018373968 on May 21, 2021, in classes 41 and 42; and
- 1INCH, United Kingdom word mark registered under No. UK00003656236 on December 3, 2021, in classes 9, 36, 41, 42, and 45.

The Disputed Domain Name was created on October 25, 1999. According to the Respondent, the Disputed Domain Name directed to "Under Construction" and/or "Coming Soon" web pages. The Disputed Domain Name currently resolves to a standard webpage of the Registrar, offering the Disputed Domain Name for sale.

5. Parties' Contentions

A. Complainant

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

First, the Complainant contends that the Disputed Domain Name is identical to a trademark in which it claims to have rights.

Second, the Complainant claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, as, according to the Complainant:

- the Respondent has no right in the "1inch" trademark; and
- there is evidence that the Respondent is about to use the Disputed Domain Name in bad faith, trying to harm the Complainant's new business segment by misleading the Complainant's customers.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant:

- the Disputed Domain Name was registered in order to prevent the Complainant from using the Disputed Domain Name, to mislead the Complainant's counterparties, including clients, and to disrupt the Complainant's new business;
- the Respondents attempted to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademark; and
- the Disputed Domain Name was registered with the purpose of selling to the Complainant.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. However, in an email addressed to the Center, the Respondent submits the following arguments and contentions:

- the Respondent has owned the Disputed Domain Name continuously for 25 years, without rent, lease, or sale. It initially created the Disputed Domain for a potential LCD flat-screen monitor business in 1999. After giving up the LCD monitor business, the Respondent decided to keep the Disputed Domain Name for possible future business;
- from the time the Respondent first registered the Disputed Domain Name, it continuously directed to "Under Construction" and/or "Coming Soon" web pages. The Registrar's free parking page now appears on the initial screen of the website linked to the Disputed Domain Name without having ever requested it from

GoDaddy nor having received any compensation from it;

- the Complainant tried to cover up their weakest point by failing to point out their trademark registration dates, as these registrations occurred years after the registration of the Disputed Domain Name; and
- the Complaint is filed improperly and amounts to Reverse Domain Name Hijacking (“RDNH”).

6. Discussion and Findings

A. Identical or Confusingly Similar

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

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel observes that the entirety of the 1INCH mark is reproduced within the Disputed Domain Name. In such cases, the domain name will normally be considered identical to the incorporated mark for purposes of UDRP standing. [WIPO Overview 3.0](#), section 1.7.

The Panel observes that the Disputed Domain Name was registered on October 25, 1999, predating the Complainant’s trademark. However, the fact that a domain name may have been registered before a complainant has acquired trademark rights does not by itself preclude a complainant’s standing to file a UDRP case, nor a panel’s finding of identity or confusing similarity under the first element. For purposes of the first element under paragraph 4(a) of the Policy, the Complainant’s rights must be in existence at the time the Complaint is filed, which is the case here. [WIPO Overview 3.0](#), section 1.1.3.

It is well established that generic Top-Level-Domains (“gTLDs”), here “.com”, may be disregarded when considering whether the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

In this case the Panel does not need to consider or decide this issue, given its decision on the third element below and the fact that a successful complaint under the UDRP must establish all three elements under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel finds that the Respondent did not register the Disputed Domain Name in bad faith by targeting the Complainant or its trademark rights when the Complainant had no trademark rights at the time that the Respondent registered the Disputed Domain Name. [WIPO Overview 3.0](#), section 3.8.1.

The Panel observes that the Disputed Domain Name was registered in 1999, more than 20 years before the registration of some of the Complainant's 1INCH trademarks. The Complainant does not show any prior unregistered rights in the 1INCH sign. Moreover, the Complainant does not explain how the Respondent could have targeted the Complainant or its trademark at the time it appears to have acquired the Disputed Domain Name. Therefore, the Panel finds that the Complainant failed to prove that the Respondent registered the Disputed Domain Name in bad faith.

Finally, panels have found that the practice as such of registering a domain name for subsequent resale (including for a profit) would not by itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling it to a trademark owner (or its competitor). [WIPO Overview 3.0](#), section 3.1.1.

In view of the above, the Panel finds the third element of the Policy has not been established.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at RDNH or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

The Panel considers that, when filing the Complaint, the Complainant must have been aware that the Disputed Domain Name was registered more than 20 years before the Complainant registered its 1INCH trademarks. Yet, the Complainant failed to mention this pertinent fact in its Complaint and did not allege or seek to demonstrate that the Respondent acquired the Disputed Domain Name after the Complainant acquired rights in the 1INCH trademark.

The Panel considers that this was a case which should not have been brought, or at least not presented in the manner it was. Given the relevant facts, the nature of the Policy, and the fact that the Complainant was represented internally by a legally qualified counsel, the Panel finds that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

7. Decision

For the foregoing reasons, the Complaint is denied. Moreover, the Panel finds that the Complaint has been brought in bad faith and constitutes an attempt at Reverse Domain Name Hijacking.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: July 29, 2024