

## **ADMINISTRATIVE PANEL DECISION**

Palex Medical, S.A. v. Hanjin Ko (고한진)

Case No. D2022-1473

### **1. The Parties**

The Complainant is Palex Medical, S.A., Spain, represented by Ubilibet, S.L., Spain.

The Respondent is Hanjin Ko (고한진), Republic of Korea.

### **2. The Domain Name and Registrar**

The disputed domain name <palex.com> is registered with Gabia, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2022. On April 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 2, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On May 5, 2022, the Center notified the Parties in both English and Korean that the language of the registration agreement for the disputed domain name is Korean. On May 6, and May 9, 2022, the Complainant requested for English to be the language of the proceeding. On May 6, and May 11, 2022, the Respondent requested for Korean to be the language of the proceeding.

The Center verified that 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 the Respondent of the Complaint in Korean and English, and the proceedings commenced on May 13, 2022. In accordance with the Rules, paragraph 5, the due date for the Response was June 2, 2022. On June 1, 2022, the Respondent requested an extension of the due date, and the due date was subsequently extended through June 12, 2022. The Response was filed in Korean with the Center on June 12, 2022.

The Center appointed Kathryn Lee as the sole panelist in this matter on July 4, 2022. 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.

On August 2, 2022, the Center issued a procedural order (the "Procedural Order") to the Parties on the Panel's behalf. In the Procedural Order, the Panel requested from the Complainant evidence of its reputation in 1996 when the disputed domain name was registered, and extended the due date for the decision to August 17, 2022. The Complainant filed a response on August 3, 2022, and the Respondent filed a response on August 16, 2022.

#### **4. Factual Background**

The Complainant is a Spanish healthcare company founded in 1955. The Complainant is in the business of selling and distributing specialized equipment and supplies to hospitals throughout Spain and Portugal. The Complainant notably introduced the first "Shiley" pivoting disc heart valve in 1969 and installed the first da Vinci surgical robot in Spain in 2005. The Complainant invoiced EUR 325 million in 2020 and has around 600 employees in Spain and Portugal. The Complainant owns the trademark registrations to PALEX as follows:

Registration Number M1324390 filed in Spain on May 10, 1989 in class 35;  
Registration number M1324391 filed in Spain on May 10, 1989 in class 39;  
Registration Number M1736988 filed in Spain on December 23, 1992 in class 16;  
Registration Number 002693513 filed in the European Union on May 10, 2002 in classes 5 and 10; and  
Registration Number UK00902693513 filed in the United Kingdom on May 10, 2002 in classes 5 and 10.

The Respondent appears to be an individual with an address in the Republic of Korea.

The disputed domain name was registered on November 18, 1996 and resolves to a website with pay-per-click links.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is identical to the PALEX trademark in which the Complainant has rights.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name and confirms that it has not authorized or licensed rights to the Respondent in any respect.

Finally, the Complainant contends that the disputed domain name was registered and is used in bad faith. The Complainant asserts that its trademark has been registered since 1989 and is inherently distinctive, and that it is unlikely for the Respondent to have been unaware of the Complainant or its trademark when registering the disputed domain name. The Complainant points out that the Respondent's email address is associated with more than 17,000 domain names, some of which are identical or confusingly similar to third party registered trademarks, and argues that this shows that the Respondent is engaging in a pattern of bad faith registrations. Further, the Complainant asserts that the disputed domain name points to a parking page with pay-per-click links, and that this demonstrates the Respondent's intent to take unfair advantage of the reputation of the trademarks of the Complainant. Lastly, the Complainant states that the disputed domain name is offered for sale and that this shows that the Respondent intends to sell the disputed domain name to the Complainant for a profit which is further evidence of the Respondent's bad faith.

## **B. Respondent**

The Respondent argues that his registration of the disputed domain name was proper and lawful, and that the Complaint should be rejected given the significant amount of time that has passed since the disputed domain name was registered. Further, the Respondent argues that the Complaint constitutes reverse domain name hijacking.

## **6. Discussion and Findings**

### **A. Language**

Paragraph 11(a) of the Rules provides that the language of the proceeding shall be the language of the registration agreement, unless otherwise agreed to by the parties, subject to the authority of the panel to determine otherwise. In this case, the language of the Registration Agreement is Korean, and both Parties have had an opportunity to argue their positions on this point. The Center issued a notice in Korean and English stating that it would accept the Complaint filed in English, and that the Response would be accepted in either Korean or English. The Respondent thereafter submitted a Response in Korean.

The Panel finds it proper and fair to render this decision in English. First, as the Complainant is based in Spain and the Respondent is based in the Republic of Korea, English would appear to be the fairest neutral language for rendering this decision. Further, the disputed domain name is composed of Latin characters, and resolves to a website with advertising links and offer for sale of the disputed domain name in English. Besides, both parties were given the opportunity to and in fact did present their cases in the language of their preference, and the language in which to render the decision is reserved for the Panel. Accordingly, the Panel determines that proceeding in English is fair and procedurally efficient given the circumstances of this case.

### **B. Delay in bringing the Complaint**

The defense of laches is not generally recognized as such in UDRP proceedings as the purpose of a UDRP remedy is injunctive rather than compensatory. Panels have however noted that in specific cases, certain delays in filing a UDRP complaint may make it more difficult for a complainant to establish its case on the merits, particularly where the respondent can show detrimental reliance on the delay. See WIPO Overview section 4.17. There is no evidence that the Respondent has been prejudiced by delay, and the Panel makes no inferences from the Complainant's delay in filing this Complaint.

### **C. Identical or Confusingly Similar**

The Complainant has demonstrated with supporting evidence that it has rights to the trademark PALEX in a number of jurisdictions, a number of which were registered before the registration of the disputed domain name. The disputed domain name solely consists of the term "palex", and is therefore, identical to the Complainant's trademark.

For the reasons mentioned above, the Panel finds that the first element has been established.

### **D. Rights or Legitimate Interests**

On the basis of the present record, there is no evidence that the Respondent improperly registered or obtained the disputed domain name with knowledge of the Complainant. Further, the Respondent has parked the disputed domain name with a parking service but this is not *per se* illegitimate under the UDRP, absent evidence of trading on the trademark of the Complainant or its competitors. See section 2.9 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainant has not met its burden here with respect to the Respondent's lack of rights or legitimate interests in the disputed domain name.

#### **E. Registered and Used in Bad Faith**

Section 3.1 of the [WIPO Overview 3.0](#) provides that bad faith under the UDRP is “broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark”. Here, the record in this case – including the information provided in the Parties' responses to the Procedural Order – does not support a finding of bad faith.

First of all, there is no evidence to suggest that, on the balance of probabilities, the Respondent knew of the Complainant when registering the disputed domain name. Though the Complainant's registration and use of the PALEX mark precede the registration of the disputed domain name, the use of the mark seems to have been limited to Spain and Portugal, while the Respondent resides in the Republic of Korea. While the nature of the Internet and domain names is by definition global and globally-accessible, in the circumstances of this case and as based on the evidence provided by the Parties, this tends to suggest that it is unlikely for the Respondent to have known of the Complainant or its trademark at the time of registration of the disputed domain name barring evidence that PALEX would have been known (including by means of due diligence or search, which is on the one hand reasonable to consider in the context of the Respondent, a sophisticated actor apparently holding a portfolio of some 17,000 domain names, but also the Panel must weigh this obligation against the fact that the disputed domain name was registered some 26 years ago when such obligations and tools were relatively undeveloped) as a trademark of the Complainant in 1996 when the Respondent registered the disputed domain name. The Complainant was given the opportunity to address the issue by providing evidence on the fame of the PALEX mark in 1996, and although the Complainant submitted a response to the Procedural Order, it contained no such evidence and merely asserted the dates of several of its marks preceding the registration of the disputed domain name, and of its earlier corporate founding. The Complainant's response to the Procedural Order did allege that the Respondent only acquired the disputed domain name in 2009 because the Whois record was in pending delete status for a period and thereafter reflected the Respondent's name; the Panel does not find this shows a subsequent acquisition, but merely that the registration status was held by the registrar for a period – based on the case file (and in particular the Respondent's assertion to have registered the disputed domain name in 1996) likely due to renewal fee payments. Further, the Panel finds that although the disputed domain name corresponds exactly to the Complainant's trademark, it only consists of five letters and it is certainly possible for someone to have conceived of this combination of letters on his/her own even with no knowledge of the Complainant.

Next, there is no evidence that the Respondent used the disputed domain name in bad faith. The offer to sell the disputed domain name or the Respondent's use of the disputed domain name for domain name parking with pay-per-click links, without additional supporting factors, do not necessarily indicate bad faith. See Sections 3.1.1 and 3.5 of the [WIPO Overview 3.0](#). For instance, the pay-per-click links are to goods or services wholly unrelated to the business of the Complainant. And based on the available record, while an inference could be made that the Respondent targeted the Complainant in bad faith to sell the disputed domain name to the Complainant (e.g., based on his portfolio where other third-party marks appear), mindful of the burden being on the Complainant, the totality of the evidence ultimately does not point in this direction.

Therefore, the Panel does not find sufficient evidence of bad faith in this case.

On the other hand, the Panel finds no evidence that the Complaint was brought in bad faith, and finds that the Respondent's claim of reverse domain name hijacking is not warranted.

## 7. Decision

For the foregoing reasons, the Complaint is denied.

*/Kathryn Lee/*

**Kathryn Lee**

Sole Panelist

Date: August 17, 2022