

ADMINISTRATIVE PANEL DECISION

Supermercados Econo, Inc. v. Kim Seo Jun
Case No. D2022-4464

1. The Parties

The Complainant is Supermercados Econo, Inc., Puerto Rico, represented by Ferraiuoli LLC, United States of America (“United States”).

The Respondent is Kim Seo Jun, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <supermercadoecono.com> is registered with April Sea Information Technology Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 22, 2022. On November 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 28, 2022, 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 (John Doe) and contact information in the Complaint.¹ The Center sent an email communication to the Complainant on November 28, 2022, 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 November 28, 2022.

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 December 1, 2022. In accordance with the Rules,

¹ The Panel notes that the Complainant provided WHOIS search results from a search of the GoDaddy WHOIS portal, but that the Registrar (as is also identified as such in the Complaint) is April Sea Information Technology Corporation, in which case the relevant publicly-available details would have reflected “REDACTED FOR PRIVACY” instead of “John Doe”.

paragraph 5, the due date for Response was December 21, 2022. The Response was filed with the Center on December 20, 2022. The Complainant submitted a supplemental filing on December 21, 2022. The Respondent submitted a supplemental filing on December 22, 2022.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on January 19, 2023. 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 is a corporation with its principal office in Carolina, Puerto Rico, and is an operator of supermarkets. The Complainant is the owner of Puerto Rico Registered Trademark No. 214129 for the word mark SUPERMERCADOS ECONO, registered on October 22, 2015, in Class 35 (retail services of products such as food, detergents and beverages through supermarkets).

The disputed domain name was registered on January 11, 2007. The Respondent is a private individual with an address in the Republic of Korea, and states that it is an investor (both buyer and seller) in “dictionary domain names”. According to a screenshot provided by the Complainant, the website associated with the disputed domain name features three advertising links in a typical pay-per-click (“PPC”) format. These are “Supermercado Compras Online” (“Supermarket Shopping Online”), “Business”, and “Job Vacansis” [sic].

At some point prior to October 27, 2022, it appears that the Complainant’s representative made contact with a domain name broker to inquire about the availability for sale of the disputed domain name and another domain name described as “the plural version”. On October 27, 2022, said broker responded by email to the Complainant’s representative noting that “the plural version” was “not for sale at any price” but that the “singular version owner” (*i.e.*, the Respondent) had requested USD 14,500 for the disputed domain name. Said broker noted that the Respondent was overseas but that it had contacted “the broker that manages their portfolio and asked for this domain name”. It appears that the Complainant did not proceed with a purchase of the disputed domain name and correspondence with the broker appears to have ceased on October 27, 2022.

5. Parties’ Contentions

A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

The disputed domain name is written in an almost identical manner to the Complainant’s trademark and is infringing on the Complainant’s rights. Where marks are practically identical, a likelihood of confusion is presumed. In making the inquiry, the domain name extension “.com” should be disregarded.

The Complainant is the owner of the domain name <supermercadoecono.com> being the plural form, such that the disputed domain name, in the singular form, is a way to usurp the Complainant’s goodwill and image. Where the mark differs from the domain name by a single letter, panels under the Policy have concluded that confusing similarity exists. A domain name that consists of a common, obvious or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark. This is a typical case of typosquatting, condemned by panels under the Policy, whereby the Respondent has omitted the letter “s” from the Complainant’s mark and domain name. Typosquatting is a kind of cybersquatting in which a respondent registers a domain name in order to take advantage of typing errors eventually made by Internet users seeking a complainant’s website.

Rights or legitimate interests

The Complainant's trademark establishes its *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. No licensing agreement evidencing permitted use has ever been granted to the Respondent regarding the Complainant's trademark. There is no evidence of the Respondent's legitimate interests or business regarding the disputed domain name. The Respondent is not using the disputed domain name for a *bona fide* offering of goods or services but merely to force legitimate trademark owners into buying it at unreasonable prices. The Respondent's scheme is that it acquires various domain names, almost identical to a valid trademark, so that it has the bargaining power to negotiate a sale. The practice is done in bad faith and is completely unrelated to the Complainant's supermarket and food industry business.

Registered and used in bad faith

The Complainant's trademark certificate establishes that the rights in the mark belong to it and that it was first used in commerce on August 19, 1971. The Respondent intentionally registered and used the disputed domain name to create confusion regarding the source of sponsorship, affiliation, or endorsement of the website and uses the goodwill and reputation generated by the Complainant to increase the traffic to the disputed domain name. The disputed domain name is exclusively used as a domain parking services website from which the Respondent derives profit. This can only be considered a bad faith appropriation of the Complainant's trademark as the unlawful use of another's mark cannot be considered *bona fide* with respect to the offering of goods.

The Respondent's scheme of acquiring multiple domain names for the purpose of selling them is a practice done in bad faith. Where a respondent's purpose in registering a domain name is capitalizing on a complainant's trademark and then selling it, this has been deemed to be a bad faith use under the Policy.

When the Complainant attempted to purchase the disputed domain name from the Respondent, the price was USD 14,500.

B. Respondent

In summary, the Respondent's contentions are as follows:

General

The words "supermercado" and "econo" are Spanish words, believed to mean "discount supermarket". The disputed domain name was registered because the words were available and make a good general dictionary word in ".com". The Respondent has never heard of the Complainant before this Complaint. The Complainant is a Puerto Rican company and the Respondent is in South Korea. The Complainant says that it only operates in Puerto Rico, and the Respondent has since confirmed this by a Google search, so there is no reason why the Respondent would have known of it.

The Complainant's trademark is registered in Puerto Rico. The Respondent guesses that the Complainant would have registered its mark in the United States had it been able to but that the term is too generic. There are many countries that use the Spanish language and the Respondent did not search all of such countries before registering the disputed domain name. The Complainant should prove that it is known in South Korea but fails to do so.

Identical or confusingly similar

The Respondent accepts that the disputed domain name and the trademark are identical.

Rights or legitimate interests

The Respondent did not register the disputed domain name to target the Complainant and had never heard of it. The Respondent considered that the disputed domain name would be a good name for a supermarket in a Spanish language country and registered it for its dictionary meaning.

The Respondent is engaged in the legitimate business of buying, parking, and selling dictionary word domain names. This is not to target trademarks or to sell to trademark owners. The links on the website parking page associated with the disputed domain name all describe the meaning of the disputed domain name and do not target the Complainant.

Registered and used in bad faith

The Respondent purchased the disputed domain name in good faith and did not register it to sell it to the Complainant. The Respondent was unaware of the Complainant at that time. The Respondent does not compete with the Complainant. The Complainant uses a different domain name for its supermarket and does not own <supermarcadosecono.com>. Before the Complainant filed the Complaint, it invited the Respondent to sell the disputed domain name to it. The Respondent fixed a price and the Complaint was filed because the Complainant did not like that price. That is a bad faith activity on its part. If the Respondent was acting in bad faith, the Complainant should not have attempted to buy the disputed domain name from the Respondent in the first instance.

C. Complainant's supplemental filing

In the Complainant's supplemental filing, its contentions are as follows:

Puerto Rico falls within the United States federal system and is subject to federal law, including trademark law, and local law. What happens in the United States greatly influences what happens locally. The Puerto Rico Trademark Act is subject to the Federal Trademark Act of 1946 and all its applicable provisions. Trademark rights in Puerto Rico can be acquired through both the federal system of the United States and/or through local registration in the Puerto Rico Trademark Office. Trademark rights are territorial and each jurisdiction may recognize and protect these in a manner that fulfils its policy goals. The existence and enforceability of these rights are unique to each jurisdiction and, generally, not interdependent. The Complainant's trademark is legitimate and valid.

The Respondent's buying and selling of domain names is cybersquatting. The Respondent is using the disputed domain name as a domain parking services website, which can only be considered as a bad faith appropriation of the Complainant's mark, and its scheme of acquiring multiple domains for the purpose of sale is a bad faith practice. Registering a domain name that is capitalizing on a complainant's trademark and then selling it is bad faith conduct.

C. Respondent's supplemental filing

In the Respondent's supplemental filing, its contentions are as follows:

The Respondent agrees fully with the Complainant's discussion of the territorial nature of trademarks, noting that the Respondent is in South Korea and had never heard of the Complainant before this proceeding. The Complainant does not have a trademark for a generic word but only a state trademark.

The Respondent has the right to sell a domain name and the secondary market in domain names is a large industry. For example, large registrars engage in the secondary market and are acting legitimately in so doing.

The Complainant has not provided sufficient evidence to demonstrate the renown of its mark more broadly, including that it is sufficiently famous, such that the Respondent would likely have known of and registered it for its trademark value, as opposed to its desirability as a dictionary word. While the disputed domain name resolves to a website displaying generic sponsored links to the Complainant's field of services, those services correspond with the dictionary meaning of the term. This favors a finding that the Respondent did not register the disputed domain name to target the Complainant and/or its trademark, but bearing in mind its potential value as a dictionary term.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

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

A. Preliminary matter: Parties' supplemental filings

Paragraph 12 of the Rules provides that in addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties. Unsolicited supplemental filings are generally discouraged. Panels have repeatedly affirmed that the party submitting or requesting to submit a supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response.

In the present case, the Panel determines that it is appropriate to admit the Parties' unsolicited supplemental filings. The Complainant's filing is focused on the Respondent's challenge to the validity of its trademark, together with the fact that the Respondent has admitted to being a dealer in domain names, both matters that the Complainant may not reasonably have anticipated when it filed the Complaint. Bearing in mind the Panel's duties under paragraph 10(b) of the Rules to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, the Panel likewise admits the Respondent's supplemental filing, as this seeks to answer those points raised in the Complainant's supplemental filing.

B. Identical or Confusingly Similar

To make out its case on this element of the Policy, the Complainant must show that it has UDRP-relevant rights in a trademark, and that the disputed domain name is identical or confusingly similar to that trademark when they are compared. The comparison process typically takes place on a straightforward side-by-side basis, usually excluding the generic Top-Level Domain ("gTLD"), in this case ".com" (see section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Where the disputed domain name is alphanumerically identical to the trademark, identity will generally be found. Where the trademark is otherwise recognizable in the disputed domain name, confusing similarity will usually be found.

Accordingly, the first question for the Panel on this topic is whether the Complainant's trademark constitutes UDRP-relevant rights. Said mark is a Puerto Rico registered trademark. It is not, however, a United States federal registered mark, as both the Complainant and the Respondent note. The Complainant states that both the United States federal trademark regime and the local Puerto Rico trademark regime apply in its territory. This suggests to the Panel that the Puerto Rico trademark may be a right equivalent to a state registered trademark in the United States, a matter to which the Respondent alludes in its submissions. Section 1.2.2 of the [WIPO Overview 3.0](#) notes that, when considering UDRP standing, panels tend to carefully review certain types of automatic/unexamined registered trademarks such as U.S. state registrations (as opposed to U.S. federal registrations) adding that these are not accorded the same

deference and may not on their own satisfy the UDRP's "rights in a mark" standing test.

A further issue with the deference to be accorded to the Complainant's mark is raised by the Respondent, namely that the mark translates as "discount supermarket", being highly descriptive of the business of food retail, and potentially not registrable as a United States federal registered trademark. In its supplemental filing, the Complainant does not engage with section 1.2.2 of the [WIPO Overview 3.0](#), or the underlying principles expressed therein, but merely asserts that its trademark is in force and has territorial effect in Puerto Rico.

On the one hand, to the extent that the Complainant's mark could be considered equivalent to a state registered trademark in the United States, the Panel might have been inclined to reject it as sufficient on its own to confer standing on the Complainant for the purposes of the Policy. On the other hand, as far as the Panel can tell from a brief examination of the corresponding trademark regime, registered trademarks in Puerto Rico are issued after an examination procedure. That would suggest that the Complainant's mark should be entitled to the appropriate deference in a proceeding under the Policy. However, in light of its finding regarding registration and use in bad faith below, the Panel need not reach a conclusion on this point.

C. Rights or Legitimate Interests

The requirements of paragraph 4(a) of the Policy are conjunctive. A consequence of this is that failure on the part of a complainant to demonstrate one element of the Policy will result in failure of the complaint in its entirety. Accordingly, in light of the Panel's finding in connection with registration and use in bad faith below, no good purpose would be served by addressing the issue of the Respondent's rights or legitimate interests in the disputed domain name.

D. Registered and Used in Bad Faith

In general, to be successful in demonstrating registration and use in bad faith under the Policy, a complainant must show that the domain name concerned was registered in the knowledge of its rights and with intent to target these unfairly. Bad faith registration and use are conjunctive, and both must be found for a UDRP complaint to succeed.

In the first instance, the Complainant must establish that the Respondent had knowledge of the Complainant's SUPERMARCADOS ECONO trademark when it registered the disputed domain name. Neither the Complaint nor the Complainant's supplemental filing directly address this question of knowledge. The Complainant merely points out the existence of the Complainant's trademark and suggests that the use of the disputed domain name is an unfair appropriation thereof, constituting cybersquatting. For its part, the Respondent expressly denies having any such prior knowledge, asserting that the disputed domain name translates to the dictionary phrase "discount supermarket" and adding that it registered this term for its descriptive quality. On the Respondent's account, there was no reason for it to believe that the registration of such a domain name was, or was likely to be, abusive of any trademark.

In light of the Respondent's case, the Panel must examine the credibility of its assertion that the disputed domain name contains a dictionary phrase in Spanish, bearing in mind that previous panels under the Policy have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be *bona fide* and is not *per se* illegitimate under the UDRP (see sections 2.1 and 2.10 of the [WIPO Overview 3.0](#)).

It appears to the Panel that the phrase "supermercado econo" in the disputed domain name could stand for "discount supermarket" in Spanish, if one takes "econo" to be an abbreviation of a Spanish word such as "económico", which would have the appropriate meaning. The term "econo" does not appear to be a dictionary word in its own right. Neither of the Parties addressed the Panel on whether such term is or is not a recognized or typical abbreviation in the Spanish language, although it is possible to infer from the Respondent's submissions that it considers the abbreviation to be a valid use. Notably, in its supplemental filing, the Complainant chose not to address any of the Respondent's assertions as to the alleged dictionary

meaning of the phrase.

In the face of the Respondent's denial of knowledge, and its explanation for selecting the disputed domain name, the Complainant requires to demonstrate that it, and/or its rights, were sufficiently notorious, such as by the extent or reach of its trademark, that it is reasonable for the Panel to infer, on the balance of probabilities, that the Respondent did have the requisite knowledge when it registered the disputed domain name. The answer to the question of whether the abbreviation "econo" is typical in the Spanish language might have served to form part of that picture, had the Complainant chosen to address this in its supplemental filing. For example, if "econo" is only found in the Complainant's trademark and is not found in general Spanish usage (or if the singular of its mark was not in common usage), this might have been indicative of prior knowledge of the Complainant's mark on the Respondent's part. The fact that the Complainant did not address this, despite answering other aspects of the Response in its supplemental filing, suggests to the Panel that it cannot contradict the Respondent's assertions as to the meaning of the phrase in the Spanish language.

The Complaint provides no information that would assist the Panel in determining the extent or reach of the Complainant's mark, or the notoriety of the Complainant's business, at the date of registration of the disputed domain name. The Complainant's trademark was registered on October 22, 2015. The disputed domain name was registered over eight years earlier. It would not have been possible for the original registrant of the disputed domain name to have contemplated the Complainant's registered trademark at the point when the disputed domain name was registered. It is not known whether the Respondent is the original registrant of the disputed domain name, and it is possible that the Respondent acquired it at a later date, but neither of the Parties has raised that possibility or produced any evidence suggesting such later acquisition. It must be noted that the Complainant's trademark contains a "date of first use" of August 19, 1971, suggesting that it may be of a longstanding nature. Nevertheless, such a date, when claimed on a trademark application, is usually considered to be of limited evidentiary value on its own (*i.e.*, unless supported by some other indicia of use and reach) in administrative proceedings brought under the Policy (see *Dow Jones & Company, Inc. v. Idea Studios LLC dba Envent*, WIPO Case No. [D2009-1033](#)).

On the question of its prior knowledge of the Complainant's trademark, the Respondent claims to have investigated the Complainant's business only after receipt of the Complaint. The Respondent notes (and the Complainant does not deny) that such business is restricted to Puerto Rico, while the Respondent is based in the Republic of Korea. This fact on its own would not necessarily mean that the Respondent must have been unaware of the Complainant's business when it registered or acquired the disputed domain name. As the panel observed in *Fakir Elektrikli EV Aletleri Diş Ticaret Anonim Şirketi v. Development Services, Telepathy, Inc.*, WIPO Case No. [D2016-0535](#), "the fact that a respondent is in a different jurisdiction than a complainant is something that some people can consider to be of greater significance than it actually is, particularly if the complainant has a significant online presence". The Panel would also note however that the fact of an individual registering a domain name in a foreign language may to some extent cut against an assertion regarding a complete lack of prior knowledge given that some level of due diligence would be expected from individuals dealing in domain names.

In the present case, however, the Complainant has given no indication of having an online presence of any particular substance or significance, and has produced no evidence tending to show that this could or should have reasonably come to the Respondent's attention. For example, the Complainant might have shown that online searches (perhaps including a search engine accessible from the Respondent's location) would have disclosed the existence of the Complainant and its rights by way of repeated high rankings, thus allowing the Panel to make a reasonable inference as to the likely state of the Respondent's knowledge. On the other hand, to support its denial of knowledge, the Respondent points out that even if it had searched for a United States federal trademark before registering the disputed domain name this would not have identified the Complainant's rights.

Beyond a demonstration of prior knowledge of the Complainant's rights on the Respondent's part, the Complainant must also show that the Respondent intended to target its trademark, for example with a view to selling the disputed domain name to the Complainant for an amount exceeding the Respondent's out-of-

pocket costs. The question of whether the disputed domain name contains a pure dictionary term can also be relevant to this inquiry (see section 3.1.1 of the [WIPO Overview 3.0](#)). Where an alleged dictionary word domain name has been used in connection with PPC advertising, the fact that a complainant's mark has been targeted is sometimes demonstrated by showing that the links concerned are keyed to the line of business of that complainant as opposed to the dictionary meaning of the alleged word or phrase. The problem for the Complainant in this particular case is that its trademark has a descriptive quality, such that the line of business of the Complainant and the alleged dictionary meaning of the term are one and the same, provided that one accepts the abbreviation "econo" for "económico". As discussed above, this is something that the Complainant did not address in its supplemental filing. Accordingly, the use of this phrase in connection with advertising links denoting the Complainant's line of business would not necessarily suggest on its own that the Respondent was deliberately targeting the Complainant or its rights. Indeed, the specific examples of advertising links on the website associated with the disputed domain name, as shown on the Complainant's screenshot, suggest to the Panel that these have been keyed to the general nature of a dictionary phrase. For example, the first of these translates as "Supermarket Shopping Online". The other two links, "Business" and "Job Vacansis" [sic] similarly are of a general nature and do not have any apparent connection to the Complainant's mark. The Complainant's submissions suggested that the website also featured advertisements for credit cards scores and online applications for credit cards but no related supporting evidence was provided.

In all of these circumstances, the Panel finds that the Complainant has failed to demonstrate on the balance of probabilities that the Respondent had knowledge of the Complainant when it registered the disputed domain name, and/or that it did so with intent to target unfairly the Complainant's business or its rights. It follows that it has failed to prove to the Panel's satisfaction that the disputed domain name was registered and has been used in bad faith.

The Complainant has therefore failed to carry its burden with regard to the third element under the Policy and the Complaint fails.

E. Reverse Domain Name Hijacking

The Respondent asserts that the Complainant is engaged in bad faith activities by having entered into negotiations to purchase the disputed domain name and then bringing the present Complaint against the Respondent when it found that the price of the disputed domain name was not to its liking. This is effectively a request for a finding of Reverse Domain Name Hijacking ("RDNH"). The definition of RDNH in the Rules is "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name". It is generally accepted that mere lack of success of a complaint is not itself sufficient for such a finding. Further discussion as to the nature of RDNH and the typical circumstances in which it may be found are detailed in section 4.16 of the [WIPO Overview 3.0](#).

It is generally accepted that using the Policy to increase leverage in negotiations to purchase a domain name is "a highly improper purpose," that contradicts the Complainant's undertaking in paragraph 3(b)(xiii) of the Rules that "the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass" (*Patricks Universal Export Pty Ltd. v. David Greenblatt*, WIPO Case No. [D2016-0653](#)). In the present case, however, no negotiations of any real substance took place. The Complainant asked a broker for the price of the disputed domain name. It also inquired as to whether it might obtain the Respondent's details, allegedly on the basis that it wished to negotiate directly. Both of these requests strike the Panel as reasonable pre-complaint investigations in the context of the present case.

Turning to the merits as a whole, the Panel considers that while the Complainant has been unsuccessful in its Complaint, it was entitled to put the Respondent to the proof on the question of its prior knowledge of the Complainant, particularly where there is some ambiguity regarding the alleged dictionary word use within the disputed domain name. In short, the fact that the Complainant failed to bring forward sufficient evidence of its notoriety and of the extent of its online presence does not necessarily mean that it must have brought the present Complaint in bad faith.

Accordingly, the Panel does not consider that a finding of RDNH is merited in the particular circumstances of this case.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: February 2, 2023