

## **ADMINISTRATIVE PANEL DECISION**

ALKALOID AD Skopje v. Admin  
Case No. D2024-4059

### **1. The Parties**

The Complainant is ALKALOID AD Skopje, North Macedonia, represented by Zivko Mijatović & Partners d.o.o. Beograd, Serbia.

The Respondent is Admin, Republic of Korea.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 3, 2024. On October 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 4, 2024, 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 October 8, 2024, the Center informed the parties in Korean and English, that the language of the registration agreement for the disputed domain name is Korean. On October 10, 2024, the Complainant submitted the amended Complaint and requested English to be the language of the proceeding. The Respondent objected to the Complainant’s request.

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 October 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 5, 2024. The Response was filed with the Center on November 4, 2024.

The Center appointed Kathryn Lee as the sole panelist in this matter on November 18, 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 is a North Macedonian company which has been operating in the field of manufacturing drugs, cosmetic, and chemical products, and processing of botanical raw materials for over 85 years. The Complainant has offices in more than 20 countries, including in Serbia, Slovenia, Turkey, Ukraine, Russian Federation, United States of America, and United Kingdom, with approximately 3,000 employees worldwide. Since 1977, the Complainant has produced and sold caffeine and paracetamol-based tablets, which are sold under a family of CAFFETIN-based marks including CAFFETIN, CAFFETIN COLD, CAFFETIN COLDMAX, CAFFETIN COUGH&COLD, CAFFETIN LADY, CAFFETIN SC, and CAFFETIN MENSTRUAL. These products are sold worldwide including in the United States of America, Canada, the United Kingdom, and Australia.

The Complainant owns a number of trademark registrations for CAFFETIN including Trademark Registration Number PZ-349/93 registered in North Macedonia on March 3, 1977, Trademark Registration Number 254679 registered in Greece on April 8, 2019, and Trademark Registration Number 20080026 registered in Armenia on January 16, 2008 for CAFFETIN COLD.

The Respondent appears to be an individual or entity in the Republic of Korea.

The disputed domain name was registered on January 26, 2024, and resolves to a landing page advertising 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.

Notably, the Complainant contends that the disputed domain name is identical to the Complainant's CAFFETIN mark in which the Complainant has right.

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 used in bad faith. The Complainant contends that the disputed domain name has not been used since its registration, and that there was registration and use in bad faith given the distinctiveness and reputation of the Complainant's mark, the Respondent's use of a privacy service to conceal its identity, the Respondent's offer of the disputed domain name for sale, and the fact that the disputed domain name corresponds exactly to the Complainant's trademark.

##### **B. Respondent**

The Respondent contends that the Complainant has not satisfied the second and third elements required under the Policy for a transfer of the disputed domain name. The Respondent contends that it has legitimate rights to the disputed domain name since it registered lawfully under the ICANN Policy. The Respondent also contends that the disputed domain name was not registered with the intent to sell it to the Complainant

or its competitor for a profit, to prevent the Complainant from reflecting its trademark on a domain name, to interfere in the Complainant's business, or to use it to attract for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark.

## **6. Discussion and Findings**

### **Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Korean. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English based on an email that the Respondent sent to the Complainant in response to the subject Complainant in English: "I didn't know there was a trademark. I am just an individual living in South Korea [.] I hope you to withdraw the complaint. Without wasting legal expenses (money) and our time. I wish USD \$1,000 would be good to be solved." The Complainant contends that this shows that the Respondent has English ability for English to be the language of the proceeding.

The Respondent requested that the language of the proceeding be Korean claiming that he does not understand English and is not able to respond to the contentions raised in the Complaint.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1). Here, the Panel notes that the Complainant is based in North Macedonia and the Respondent is based in the Republic of Korea, so English would appear to be a neutral language for rendering this decision. Further, the Respondent did submit a Response to the Complaint in the language of his choice which was taken into consideration by the Panel. And lastly, based on the Respondent's email to the Complainant, it appears that the Respondent has knowledge of English to be able to understand the Complaint and decision in English.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

### **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.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, the disputed domain name corresponds exactly to the Complainant’s trademark, thus carrying a high risk of implied affiliation to the Complainant, so in the circumstances – and noting the proposal to “settle” the case for USD 1,000 – the use of the disputed domain name by the Respondent who does not have any affiliation at all with the Complainant cannot be considered “fair.” [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, 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.

Here, the disputed domain name corresponds exactly to the Complainant’s mark, which is a coined term and has substantial online presence as the name of a line of pharmaceutical products produced by the Complainant. As such, it is unlikely that the registration was purely by chance. Rather, it is more likely that the Respondent was aware of the Complainant and its mark when registering the disputed domain name and registered it with the intent to benefit financially in some way, for example, to sell it to the Complainant for valuable consideration in excess of the Respondent’s costs related to the disputed domain name, or to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s mark.

Further, Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant’s trademark, the failure of the Respondent to provide any evidence of actual or contemplated good-faith use, the Respondent’s concealing its identity or use of false contact details, and the implausibility of any good faith use to which the domain name may be put given that the disputed domain name solely consists of the Complainant’s trademark, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <caffetin.com> be transferred to the Complainant.

*/Kathryn Lee/*

**Kathryn Lee**

Sole Panelist

Date: November 28, 2024