Decision for dispute CAC-UDRP-102562

Case number	CAC-UDRP-102562
Time of filing	2019-07-17 09:12:18
Domain names	kinoptik.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Name	Vitaliy Kostenko

Complainant representative

Name	JUDr. Andrea Kůs Považanová

Respondent

Organization	hong wen pu

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings, pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has evidenced to be the owner of the following trademark registrations:

- European Union TM (word) “KINOPTIK” No. 17953530, registration date: February 16, 2019, registered for goods in class 9 of the international classification;

- National Japanese TM (word) “KINOPTIK” No. 6129001, registration date: March 8, 2019, registered for goods in class 9 of the international classification;

- National Chinese TM (word) “KINOPTIK” No. 30930406, registration date: April 14, 2019, registered for goods in class 9 of the international classification.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is the owner of word TMs “KINOPTIK” valid in the USA, EU, China and Japan. The Complainant uses its

TMs in relation to its company PHOTO VISION, s.r.o.

The Complainant's TMs include:

A national US TM "KINOPTIK" No. 87769850 with priority as of January 25, 2018. The TM is registered for "cases especially made for photographic apparatus and instruments; Lens hoods; Lenses for photographic apparatus; Lenses for cameras; Optical glasses; Optical lenses; Photographic filters; Photographic cameras; Wide-angle lenses for cameras".

A word EU TM "KINOPTIK" No. 17953530 with the priority as of June 7, 2018, registered for goods in class 9 of the international classification.

A word national Japanese "KINOPTIK" TM No. 6129001 with priority as of June 7, 2018, registered for goods in class 9 of the international classification.

A word Chinese TM "KINOPTIK" No. 30930406, registered for goods in class 9 of the international classification, with priority as of May 15, 2018.

Regarding the addresses of the Complainant stated in the respective TM registers the Complainant states that the address Navratilova 9/19, 110 00 stated in the Japan, EU and US TM registers is the office of the Complainant's company PHOTO VISION, s.r.o. The address U Pujcovny 8, 11000 registered in the Chinese TM register is the Complainant's home address. The Complainant documents these facts by a copy of his domiciliary permit and an extract from the business register of his company PHOTO VISION, s.r.o.

Evidence:

- Extract from the US TM register for US TM "KINOPTIK" No. 87769850;
- Extract from the EUIPO TM register for EU TM "KINOPTIK" No. 17953530;
- Registration certificate for Japanese "KINOPTIK" TM No. 6129001;
- Registration certificate for Chinese TM "KINOPTIK" No. 30930406;
- Extract from Chinese TM Register for TM "KINOPTIK" No. 30930406;
- A copy of the Complainant's domiciliary permit;
- An extract from the Companies Register for the Complainant's company PHOTO VISION, s.r.o.;
- English translation of the extract from the Companies Register for the Complainant's company PHOTO VISION, s.r.o.

As the TM owner the Complainant has the exclusive right to use the sign "KINOPTIK" in the course of business within the EU as well as in the US, Japan and China. Use of the TM includes use of the TM as a domain.

Respondent and his rights

The Respondent is a Chinese company that, according to the Complainant's knowledge, has no formal rights to the sign "KINOPTIK". The Respondent thus has no rights or legitimate interests in the disputed domain name.

The disputed domain name is not being used to host any legitimate site. On the website www.kinoptik.com is merely placed an offer to sell the domain.

Evidence:

- Extract of the domain name from the Whois database at <whois.web.com> for the domain <kinoptik.com>;
- Copy of the Respondent's website at www.kinoptik.com.

Bad faith of the Respondent

Before filing the complaint the Complainant has contacted the Respondent, informed him about his TM rights and asked the Respondent to assign him the domain.

To the Complainant's request the Respondent replied that it is happy to assign the domain name for 13 238 EUR. The Complainant below quotes the Respondent's reply "Considering that we spent 640.739 million yuan ($93610) (82615 euros) for our domain name portfolio, I think you need to give us appropriate compensation, such as $20,000 (17,650 euros). Of course, $15,000 (13,238 euros) is fine."

From the Respondent's reply it follows that the Respondent is the owner of many domains acquired entirely for speculative purposes, which the Respondent confessed by stating that it spent 82 615 euros for a domain name portfolio.

The speculative activities of the Respondent can be also documented by the fact that from a Google search it follows that the contact e-mail 731562@qq.com, which is used as a contact e-mail on the Respondent's website at the domain name in question for the purpose of purchasing the domain, is used as a contact e-mail for offering dozens of domains probably owned by the Respondent for sale. The Complainant notes that it submits as evidence only first two pages of the Google search.

Also the fact that the Respondent replied immediately to the Complainant's e-mail and offered him to sell him the domain clearly proves that the domain is owned by the Respondent merely for speculative purposes, otherwise the Respondent would not be this eager to sell the domain because if an entrepreneur uses a domain in the course of a legitimate business it is generally difficult for him to assign such domain as the assignment brings confusion of the consumers, from which follows decrease of business.

The speculative intentions of the Respondent further follow from the fact that on the domain name in question is placed merely a website offering the domain for sale.

The Complainant notes that in the reply to his e-mail the Respondent claims to have earlier rights to the domain, which the Respondent claims was registered on March 8, 2000. The Respondent supposedly documents this fact by a copy of lines from the WHOIS database.

However, the Complainant notes that from the WHOIS database it follows that the disputed domain name in question was registered on May 2, 2019. It is therefore untrue that it would be registered on March 8, 2000. In addition from the image provided by the Respondent it follows that the domain that was supposedly owned by the Respondent had ID: 21855537, while the ID of the disputed domain name is 2386799498.

From the above-stated fact it follows that it is untrue that the Respondent has priority rights to the disputed domain name <kinoptik.com> as this disputed domain name was registered on May 2, 2019, while the priority date of all the Complainant's "KINOPTIK" TMs precede this date.

The Complainant has therefore priority rights in relation to the "KINOPTIK" sign.

For all of the above reasons the Complainant requests that the Panel decides that the disputed domain name shall be transferred to Mr. Vitaliy Kostenko (the Complainant).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown that the Respondent has no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and that there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain name is identical to the Complainant's KINOPTIK trademark in which the Complainant has shown to have rights, including in China where the Respondent apparently is located. The disputed domain name incorporates the KINOPTIK trademark in its entirety with the top level domain .com being a standard registration requirement and as such being disregarded under the first element test. The fact that the Respondent alleges in its pre-procedural correspondence with the Complainant of July 1, 2019, to have acquired the disputed domain name already on March 8, 2000, thus a couple of years before the registration of the Complainant's KINOPTIK trademarks took place in 2019, does not by itself preclude the Complainant's standing to file this UDRP Case, but needs to be evaluated in connection with the finding below whether or not the Respondent acted in bad faith.

Moreover, the Panel is convinced on the basis of the Complainant's undisputed contentions that the Respondent has neither made use of the disputed domain name in connection with a bona fide offering of goods or services, nor has the Respondent been commonly known by the disputed domain name, nor can it be found that the Respondent has made a legitimate noncommercial or fair use thereof without intent for commercial gain. The Respondent has not been authorized to use the Complainant's KINOPTIK trademark, either as a domain name or in any other way. Also, there is no reason to believe that the Respondent's name somehow corresponds with the disputed domain name and the Respondent does not appear to have any trademark rights associated with the term "Kinoptik" on its own. Rather, the Respondent offers the disputed domain name for sale on the Internet; also, it follows from the pre-procedural correspondence between the Parties of July 1, 2019, that the disputed domain name is part of a larger domain name portfolio owned by the Respondent and that the latter offered to sell the disputed domain name to the Complainant for an amount of US $ 15.000 immediately upon being contacted by the Complainant with a transfer request. Accordingly, it may be concluded that the Respondent did not create the disputed domain name individually, but acquired it as part of a bulk registration in a speculative manner for purposes of future sales, however, the case file lacks any indication as to why such speculation might be legitimate, e.g. because the portfolio domain names including the disputed domain name had a dictionary meaning and did not target specific brand owners. The Respondent's behavior, therefore, neither qualifies as a bona fide offering of goods or services (because it obviously aims at e.g. profiting from the Complainant's KINOPTIK trademark rights) nor as a legitimate noncommercial or fair use without intent for commercial gain. Accordingly, there is no other way but to find that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Finally, the Panel holds that the disputed domain name was registered and is being used by the Respondent in bad faith. Offering the disputed domain name which is identical to the Complainant's KINOPTIK trademark on the Internet for online sale and requesting a sales price in the range of US $ 15.000 is a clear indication that the Respondent acquired the disputed domain name for the purpose of selling it to the Complainant as the trademark owner for valuable consideration in excess of the Respondent's out-of-pocket costs; such circumstances shall be evidence of registration and making use of the disputed

domain name in bad faith within the meaning of paragraph 4(b)(i) of the Policy. In this context, the Panel has well noted that the Respondent in its email of July 1, 2019, claims to have acquired the disputed domain name already back in March 2000, thus a considerable period of time before the Complainant registered its KINOPTIK trademark in 2019. The short cutout from an alleged WhoIs for the disputed domain name which the Respondent provided to support such claim, however, does not show any registrant's name pointing to the Respondent and is, therefore, not suitable to invalidate the complete WhoIs for the disputed domain name provided by the Complainant according to which the Respondent acquired the disputed domain name only on May 2, 2019, and, thus, after the accrual of Complainant's registered rights in the KINOPTIK trademark, including in China where Respondent obviously resides.

The Complainant, therefore, has fulfilled all three elements provided for by paragraph 4(a) of the Policy, the result being that the disputed domain name be transferred upon the Complainant as requested.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **KINOPTIK.COM**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2019-08-15

Publish the Decision