

ADMINISTRATIVE PANEL DECISION

World Family English Holdings Ltd. v. beats
Case No. D2023-0582

1. The Parties

The Complainant is World Family English Holdings Ltd., Bermuda, United Kingdom, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is beats, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <worldfamily.com> is registered with Megazone Corp., dba HOSTING.KR (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on February 8, 2023. On February 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 9, 2023, 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 February 20, 2023, 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 the same day, the Complainant requested for English to be the language of the proceeding. The Respondent did not comment on 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 both English and Korean, and the proceedings commenced on February 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 20, 2023.

The Center appointed Moonchul Chang as the sole panelist in this matter on March 27, 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

Since the predecessor of the Complainant was found in the United States of America in the 1970s, the Complainant World Family English Holdings Ltd has grown as a leading provider of English language courses in East Asia. Initially entering the Japanese market in the 1970s, the Complainant later expanded into Taiwanese Province of China in early 1990s, Hong Kong, China, in 1998, and the Republic of Korea in 2012. Now, the Complainant is the largest licensing partner for Disney Publishing Worldwide.

The Complainant is the owner of trademark "WORLD FAMILY" registrations through its wholly-owned subsidiaries throughout the world; for example, Korean Registration (KIPRIS) No. 4500163030000 (registered June 7, 2006), Japanese Registration (JPO) No.3000365 (registered July 29, 1994), Hong Kong Registration (HKIPO) No. 300145836 (registered January 20, 2004) and Taiwanese registration (TIPO) No.1135692 (registered January 1, 2005).

The Complainant and its affiliates are the owner of a number of domain name registrations which incorporate the WORLD FAMILY trademark. These include <worldfamilyenglish.com>, <worldfamily.com.tw>, <worldfamily.co.kr>, <worldfamilyenglish.co.kr>, and <worldfamily.com.hk>.

According to the publicly available Whois information, the disputed domain name was registered on November 11, 2008. The disputed domain name is currently redirected to the website featuring Pay-Per-Click links.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

- (a) The disputed domain name is identical or confusingly similar to its trademark. The disputed domain name incorporates the Complainant's trademark WORLD FAMILY in its entirety. The Complainant is the owner of WORLD FAMILY trademark registrations through its wholly-owned subsidiaries.
- (b) The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not given the Respondent permission to use the Complainant's trademarks including in domain names. The Respondent has no rights or legitimate interests in the WORLD FAMILY mark and the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. The Respondent is using the disputed domain name to redirect Internet users to a website featuring Pay-Per-Click links, some of which directly compete with the Complainant's business. Moreover, the Respondent has listed the disputed domain name for sale at the domain name sales platform SEDO. In addition, the Respondent has never been commonly known by the disputed domain name.
- (c) The disputed domain name was registered and is being used in bad faith. First, at the time of registration of the disputed domain name, the Respondent knew or at least should have known of the existence of the Complainant's trademarks and that registration of domain names containing well-known trademark WORLD FAMILY constitutes bad faith registration. Prior to the date at which the Respondent registered the disputed domain name, the Complainant has been a leading provider of English language products and services for children in East Asia.

Second, by creating the likelihood of confusion between the Complainant's trademarks and the disputed domain name, the Respondent intentionally attempted to attract Internet users for commercial gain to its website featuring Pay-Per-Click links.

Finally, the Respondent has been engaging in a pattern of cybersquatting, which is the evidence of bad faith registration and use of the disputed domain name. The Respondent has previously been involved in the numerous UDRP cases against him and currently holds registrations for several other domain names that misappropriate the trademarks of well-known brands and businesses. In addition, the Respondent is currently offering to sell the disputed domain name by listing the disputed domain name for sale at the domain name sales platform SEDO.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1. Preliminary Issue: Language of Proceedings

According to paragraph 11 of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement unless the Panel determines otherwise or otherwise agreed to by the Parties. In this present case, the Registrar confirmed that the language of the Registration Agreement for the disputed domain name is Korean. However, the Complaint was filed in English.

The Complainant requests that the language of proceeding be English for the following reasons. First, the Complainant representatives are unable to communicate in Korean and translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings. Such additionally delay, considering the abusive nature of the disputed domain name and its website, pose continuing risk to the Complainant. Second, the website resolved to the disputed domain name (not to mention the disputed domain name itself) features various phrases in English. Thirdly, the Respondent previously has been involved in numerous UDRP proceedings in English; for example, *Nike Innovate C.V. v. beats*, WIPO Case No. [D2021-3824](#).

Here, the Panel observes that the Center, for its part, has communicated with the Parties in a bilingual manner in both English and Korean concerning all of the various steps and requirements thus far in the administrative proceeding. However, the Respondent has not responded to the issue of the language of the proceeding. The spirit of paragraph 11 of the Rules is to ensure fairness in the selection of the language of the proceeding by giving full consideration, *inter alia*, to the Parties' level of comfort with each language, expenses to be incurred, and possibility of delay in the proceeding in the event translations are required and other relevant factors. The Panel would have accepted a Response in either English or Korean, but none was submitted. In consideration of the above circumstances and in the interest of fairness to both Parties, the Panel concludes, in view of all of the above, that it accepts the Complaint in English, and that it will render this Decision in English.

6.2. Substantive Issues

Under paragraph 4(a) of the Policy, the Complainant must demonstrate that the three elements enumerated in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to the Complainant's trademark or service mark; and
- (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. Identical or Confusingly Similar

The disputed domain name incorporates the Complainant's trademark WORLD FAMILY in its entirety. The Complainant is the owner of WORLD FAMILY trademark registrations through its wholly-owned subsidiaries. Noting in particular the global nature of the Internet and Domain Name System, the jurisdiction where the trademark is valid is not considered under the first element of the similarity test. (Section 1.1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Numerous UDRP panels have held that where a domain name incorporates a complainant's trademark in its entirety, or where at least a dominant feature of the relevant mark is recognizable in the domain name, it is sufficient to consider the domain name "confusingly similar" to that mark within the meaning of the Policy. (Section 1.7 of [WIPO Overview 3.0](#)). In addition, the generic Top-Level Domain ("gTLD") ".com" can be disregarded under the confusing similarity test. (Section 1.11.1, [WIPO Overview 3.0](#)).

Accordingly, the Panel finds that the first element under paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the overall burden of proof is on the Complainant. However, once the Complainant presents a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, the burden of production of evidence shifts to the Respondent. (Section 2.1 of [WIPO Overview 3.0](#)).

First, the Complainant contends that it has not permitted the Respondent to use the Complainant's trademark WORLD FAMILY in any manner including in domain name and that the Respondent has used the Complainant's trademark without permission of the Complainant. The Respondent is not sponsored by or affiliated with the Complainant. On the other hand, the Respondent did not reply to the Complaint.

Second, the Complainant contends that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. Here, the Respondent failed to come forward with any appropriate allegations or evidence that might demonstrate its rights or legitimate interests in the disputed domain name to rebut the Complainant's *prima facie* case. Rather, the Respondent is using the disputed domain name to redirect Internet users to a website featuring Pay-Per-Click links, some of which directly compete with the Complainant's business.

Third, there is no evidence to suggest that the Respondent has been commonly known by the disputed domain name.

In the consideration of the above circumstances the Panel finds that the Complainant has made out a *prima facie* case and the Respondent failed to come forward with any appropriate evidence that might rebut the Complainant's *prima facie* case.

Accordingly, the Panel concludes that the Complainant has satisfied the second element under paragraph 4(a) of the Policy in the present case.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the disputed domain name "has been registered and is being used in bad faith". Hence, the Complainant must establish both bad faith registration and bad faith use of the disputed domain name. In addition, the circumstances listed in paragraph 4(b) of the Policy are not exclusive, and other circumstances may likewise lead to a finding of bad faith registration and use.

Firstly, the Complainant obtained the registration of the Korean trademark WORLD FAMILY in 2006 earlier than the disputed domain name originally registered in 2008 or transitioned to the Respondent in 2017 as the Complainant contends. Having considered that the Complainant's trademark WORLD FAMILY is well-known it is highly likely that the Respondent has been aware of the reputation of the WORLD FAMILY mark when registering a confusingly similar domain name that incorporates the Complainant's mark in its entirety. Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. (Section 3.1 of the [WIPO Overview 3.0](#)). Thus, it is considered bad faith that the Respondent deliberately chose the disputed domain name to create a likelihood of confusion with the Complainant's trademark so as to create a false association or affiliation with the Complainant.

Secondly, the Panel notes that the disputed domain name is currently to the Respondent's website featuring Pay-Per-Click links, some of which directly compete with the Complainant's business. Having considered the reputation of the Complainant's mark WORLD FAMILY and the failure of the Respondent to submit a response or to provide any evidence of *bona fide* use, the Panel finds the Respondent's bad faith use of the disputed domain name.

Finally, the Complainant also submitted evidence that the Respondent has registered numerous domain names featuring famous third parties' trademarks and that the Respondent has previously been involved in the numerous UDRP cases against him. It supports that these registrations could lead to a pattern of cybersquatting and the Respondent intended to take unfair advantage of the WORLD FAMILY trademark in addition to various other third party trademarks.

Accordingly, the Panel concludes that the Complainant has satisfied the third element under paragraph 4(a) of the Policy in the present case.

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 <worldfamily.com> be transferred to the Complainant.

/Moonchul Chang/

Moonchul Chang

Sole Panelist

Date: April 10, 2023