



Asian Domain Name Dispute Resolution Centre

(Seoul Office)

ADMINISTRATIVE PANEL DECISION

Case No.	KR-1400101
Complainant:	Samyoung Machinery Co., Ltd.
Authorized Representative:	Yoon Kun Cha, Jae-Hee Lee, Seo Hyong Koh
Respondent:	Gary Lee
Disputed Domain Name(s):	samyoungmachinery.com

1. The Parties and Contested Domain Name

The Complainant is Samyoung Machinery Co., Ltd., Chungcheongnam-do, Korea.

The Respondent is Gary Lee, Chungcheongnam-do, Korea.

The domain name at issue is<**samyoungmachinery.com**>, registered by Respondent with PDR Ltd. d/b/a PublicDomainRegistry.com, USA.

2. Procedural History

The Complaint was filed with the Seoul Office of the Asian Domain Name Dispute Resolution Center ("Center") on December 4, 2014.

On December 10, 2014, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 10, 2014, PDR Ltd. d/b/a PublicDomainRegistry.com confirmed by e-mail to the Center that the <**samyoungmachinery.com**> domain name is registered with PDR Ltd. d/b/a PublicDomainRegistry.com and that Respondent is the current registrant of the name. PDR Ltd. d/b/a PublicDomainRegistry.com has verified that Respondent is bound by the PDR Ltd. d/b/a PublicDomainRegistry.com registration agreement and has thereby agreed to

resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

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 ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

On December 11, 2014, the Center served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of December 31, 2014 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts. Also on December 11, 2014, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via registered mail. Respondent did not submit a Response by the deadline of December 31, 2014.

The Center appointed **Ho-Hyun Nahm, Esq.** as the sole panelist in this matter on January 7, 2015. With the consent for the appointment, impartiality and independence declared and confirmed by the panelist, the Center, in accordance with paragraph 7 of the Rules, organized the Panel of this case in a legitimate way.

On January 15, 2015, the Panel issued a Procedural Order No.1 on the ground that the Complaint does not meet formal and substantive requirements set out in the "Policy" setting a deadline of January 23, 2015 by which the Complainant could submit an amended Complaint to the Center. Complainant submitted amended Complaint on January 23, 2015. The Center transmitted the amended Complaint to Respondent setting a deadline of January 30, 2015 by which Respondent could file any response to it. Respondent did not submit any response by January 30, 2015.

3. Factual background

Complainant is engaged in locomotive and marine diesel industry in the Republic of Korea ("Korea"). Complainant owns following trademark registrations registered in Korea.

Trademark: **SAMYOUNG**

Registration number: 787433

Registration date: April 30, 2009

Goods: Cylinders for machines, Gasoline engines (other than for vehicles), Diesel engines (other than for vehicles), parts and accessories for railway vehicles, etc.

The disputed domain name was registered on July 11, 2013.

4. Parties' Contentions

A. Complainant

The Complainant contends as follows:

- (i) The disputed domain name is confusingly similar to the Complainant's registered trademark "SAMYOUNG" in which the Complainant has rights:
 - (a) Complainant owns trademark registrations in Korea for the SAMYOUNG mark (*e.g.*, Reg. No. 787433, registered April 30, 2009). *See* Complainant's Annex 5.
 - (b) The incorporation of Complainant's trademark in entirety in the disputed domain name in itself establishes that the disputed domain name is confusingly similar to the SAMYOUNG trademark.
- (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name:
 - (a) Respondent copied the prominent part of company name "Samyoung Machinery Co., Ltd.", and thus Respondent has no rights or legitimate interest in respect of the disputed domain name.
- (iii) The disputed domain name was registered and is being used in bad faith by the Respondent:
 - (a) Respondent displays the Complainant's trademarks on the website at the disputed domain name, and it advertises the same line of products of Complainant. Respondent copied and pasted the pictures of Complainant's

products from the genuine website of Complainant. Respondent registered the disputed domain name to disrupt the business of Complainant and to capitalize on the name of Complainant. This is a case of paragraph 4 (b) (iii) of the Policy.

(b) Respondent has intentionally attempted to attract, for commercial gain, Internet users to the disputed web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the disputed website or location or of a product or service on the website resolved by the disputed domain name. This is a case of paragraph 4 (b) (iv) of the Policy.

(iv) The disputed domain name should be transferred to Complainant.

B. Respondent

Respondent did not submit a Response. The disputed domain name was registered on July 11, 2013.

5. Findings

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that Respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

Complainant asserts that it owns trademark registrations in Korea for the SAMYOUNG mark (*e.g.*, Reg. No. 787433, registered April 30, 2009). *See* Complainant's Annex 5. It also asserts that incorporation of Complainant's trademark in entirety in the disputed domain name in itself establishes that the disputed domain name is confusingly similar to the SAMYOUNG trademark.

The Panel finds that Complainant's Korean trademark registration of the SAMYOUNG logo mark sufficiently provides rights in the mark under Policy ¶ 4(a)(i). *See Paisley Park Enters. v. Lawson*, FA 384834 (Nat. Arb. Forum Feb. 1, 2005) (concluding that Complainant had established rights in the PAISLEY PARK mark under Policy ¶ 4(a)(i) through registration of the mark with the USPTO).

Complainant asserts that Respondent's <samyoungmachinery.com> domain name is confusingly similar to Complainant's SAMYOUNG logo mark. The Panel notes that Respondent adds the generic or descriptive term, a part of the Complainant's company name "machinery" to its disputed domain name. The Panel holds that Respondent's addition of a generic or descriptive term, a part of the Complainant's company name Samyoung Machinery Co., Ltd. to Complainant's SAMYOUNG mark does not distinguish the domain name from the mark under Policy ¶ 4(a)(i). *See Am. Express Co. v. MustNeed.com*, FA 257901 (Nat. Arb. Forum June 7, 2004) (finding Respondent's <amextravel.com> domain name confusingly similar to Complainant's AMEX mark because the "mere addition of a generic or descriptive word to a registered mark does not negate" a finding of confusing similarity under Policy ¶ 4(a)(i)).

The Panel also finds that the “.com” is a descriptive suffix commonly used as a generic Top-Level Domain (gTLD), and thus they do not constitute a prominent portion in the disputed domain name in determining confusing similarity between the disputed domain name and the Complainant’s mark. Therefore, the addition of the gTLD suffix “.com” in the disputed domain name does not have any impact on the avoidance of confusing similarity. See *Research in Motion Limited v. Input Inc, Domain Manager*, WIPO Case No. D2011-2197 finding “the use of the added descriptive word does not change the overall impression of the domain name.”

As such, the Panel concludes that the disputed domain name is confusingly similar to Complainant’s mark.

B) Rights and Legitimate Interests

Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455; see also *Hanna-Barbera Prods., Inc. v. Entm’t Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to Respondent to show that it does have rights or legitimate interests in a domain name); see also *AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) (“Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

Complainant argues that the disputed domain name’s website purports to be a Complainant’s own website, and appropriates Complainant’s own trademarks to promote Respondent’s business. See Compl., at Attached Ex. 11.

This Panel finds that Respondent’s attempt to pass itself off and run its own competing and unlicensed website for engine and locomotive products under the SAMYOUNG mark is suggestive of Respondent’s lack of rights under Policy ¶¶ 4(c)(i), or (iii). See *H-D U.S.A.*,

LLC v. Nguyen Duc Thuan, FA1588916 (Nat. Arb. Forum December 26, 2014)(The panel found Respondent's attempt to pass itself off and run its own competing and unlicensed motorcycle club under the HOG mark is suggestive of Respondent's lack of rights under Policy ¶¶ 4(c)(i), or (iii). *See also Kmart of Mich., Inc. v. Cone*, FA 655014 (Nat. Arb. Forum April 25, 2006) (The panel found the respondent's attempt to pass itself of as the complainant was not a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i), or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii) when the respondent used the disputed domain name to present users with a website that was nearly identical to the complainant's website).

The Panel also notes that Respondent fails to provide any evidence that it is known by the disputed domain name. Thus, the Panel concludes that Respondent is not commonly known by the disputed domain name pursuant to Policy ¶ 4(c)(ii). *See Coppertown Drive-Thru Sys., LLC v. Snowden*, FA 715089 (Nat. Arb. Forum July 17, 2006) (concluding that Respondent was not commonly known by the <coppertown.com> domain name where there was no evidence in the record, including the WHOIS information, suggesting that Respondent was commonly known by the disputed domain name).

Under the circumstance that Respondent did not reply, the Panel finds that Complainant has proven a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. *See De Agostini S.p.A. v. Marco Cialone*, WIPO Case No. DTV2002-0005; *see also Accor v. Eren Atesmen*, WIPO Case No. D2009-0701.

Given the above circumstances, the Panel concludes that Respondent has no rights or legitimate interests in the disputed domain name, and the second element of the Policy has been established.

C) Bad Faith

Complainant goes on to argue to the effect that the use of the disputed domain name to house a competing website is suggestive of Respondent's aim to disrupt Complainant's business. The Panel again notes that Respondent appears to operate its own website for engine and locomotive products, using the Complainant's SAMYOUNG and its other registered marks at the disputed domain name. *See Compl.*, at Attached Ex. 11. This Panel finds such a use to stand as evidence of a Policy ¶ 4(b)(iii) bad faith attempt to disrupt

Complainant's endeavors. *See Classic Metal Roofs, LLC v. Interlock Indus., Ltd.*, FA 724554 (Nat. Arb. Forum Aug. 1, 2006) (finding that the respondent registered and used the <classicmetalroofing.com> domain name in bad faith pursuant to Policy ¶ 4(b)(iii) by redirecting Internet users to the respondent's competing website).

Complainant contends that there is likelihood for Internet users to be confused as to Respondent's affiliation with the Complainant's legitimate and genuine website, and Respondent stands to profit from Internet users who might believe it is the Complainant's own website selling and displaying the Complainant's genuine products. Complainant thus suggests that Respondent is passing off as Complainant by misappropriating the Complainant's trademarks and its various copyrighted pictures. In examining Exhibit 11 provided by Complainant, the Panel agrees that the scope of this "passing off" is sufficient to illustrate Respondent's aim to profit through a likelihood of Internet user confusion and to disrupt the Complainant's business. *See H-D U.S.A., LLC v. Nguyen Duc Thuan*, FA1588916 (Nat. Arb. Forum December 26, 2014) ("the panel agrees that the scope of this "passing off" is sufficient to illustrate Respondent's aim to profit through a likelihood of Internet user confusion."). *See also Am. Online, Inc. v. Miles*, FA 105890 (Nat. Arb. Forum May 31, 2002) ("Respondent is using the domain name at issue to resolve to a website at which Complainant's trademarks and logos are prominently displayed. Respondent has done this with full knowledge of Complainant's business and trademarks. The Panel finds that this conduct is that which is prohibited by Paragraph 4(b)(iv) of the Policy.").

6. Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**samyoungmachinery.com**> domain name be **TRANSFERRED** from Respondent to Complainant.

Ho-Hyun Nahm, Esq.
Panelist

Dated: February 9, 2015