



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Seoul Office)

ADMINISTRATIVE PANEL DECISION

Case No. KR-0600008

Complainant: Samsung Electronics Co., Ltd

Respondent : Joon Jeon

1. The Parties & The Domain Name in dispute

The Complainant:

Samsung Electronics Co., Ltd, 416 Maetan-Dong, Yeongtong-Gu, Suwon City,
Gyeonggi-dong, Republic of Korea

Authorized Representative: David Hunjoon Kim, YOU ME Patent & Law Firm,
Seolim Bldg., 649-10, Yoksam-Dong, Kangnam-Ku, Seoul, Republic of Korea

The Respondent:

Joon Jeon, 1758 Berkshire Dr., Fullerton, California 92833, United States

The disputed domain name <samsungtonershop.com> is registered with “Go Daddy Software, Inc.(Scottsdale, Arizona, USA,).” (the “Registrar”)

2. Procedural History

Complainant filed a complaint, dated 31 August 2006, (hereinafter, as amended by its Further statement, as referred to below, the “Complaint”) with the Seoul office of Asian Domain Name Dispute Resolution Centre (“ADNDRC”), through its counsel, YOU ME Patent & Law Firm, seeking transfer to Complainant of captioned domain name. According to the Complaint, the Respondent was identified by the Complainant on the “Whois” database on 18 August, 2006. In its Complaint, the Complainant opted for a sole panelist but did not nominate one, thereby leaving the selection to ADNDRC.

On 7 September, 2006, ADNDRC forwarded the Complaint to the Respondent, with a copy to the Registrar, and requested that it file its Response within twenty (20) days therefrom. No response was filed by Respondent within such time limit nor, to the knowledge of this Panel, has any such response been filed to date.

On 16 October, 2006, ADNDRC requested by email the undersigned, Karen Mills, to indicate ability to act independently and impartially, as sole panelist.

On the same date the undersigned responded, by email, in the affirmative on all points.

On 24 October, 2006, ADNDRC advised the parties of the appointment of the undersigned as sole Panelist, and copied the undersigned. The undersigned acknowledged her willingness to act as Panelist and requested the file to be sent to her by courier. ADNDRC sent the file by courier in two installments and the final initial documents, being a hard copy of the initial Complaint with annexures, was received by the undersigned (hereinafter referred to as this “Panel”) on 14 November, 2006. This panel rendered its award on 16 November, 2006, and sent the same to ADNDRC by email on the same day.

On 21 November, ADNDRC advised this Panel that the parties were meeting in an attempt to settle the matter and thus requested that the award be suspended. However, on 23 November, ADNDRC advised this Panel that the negotiation had failed but that the Complainant wished to submit an amended, or supplemented, Complaint. This Panel responded on 24 November agreeing to keep the award in suspension and accept a further submission from Complainant, provided that such further submission be sent to Respondent and that Respondent be afforded an opportunity to respond. On 7 December, this Panel received, by email, and later in hard copy by courier, Complainant’s “Further statement” to its Complaint, which is dated 7 December, but is stamped received by ADNDRC on 6 December, 2006. A

copy of Complainant's Further statement was sent by email to Respondent on 8 December, advising the Respondent that it had ten days, that is until 18 December, to submit a Response. This Panel was sent a copy of the email cover. On 19 December, ADNDRC advised this Panel, by email, that no response had been received from Respondent within the time limitation given. This Panel therefore deemed the submissions to be complete as of 19 December, 2006.

In drafting the revised award, this Panel sought to view Respondent's website, under the disputed domain name, once again, only to discover that it has, at least at this time, been removed from the internet. This Panel is nonetheless under the obligation to fulfill its mandate and rule upon the matter as requested.

ADNDRC requires a panel to render its award within 14 days of final submission, which has been interpreted by this Panel to be the date of receipt of the full file, as amended, and therefore, if "days" are to be considered as calendar days, irrespective of the intervening holidays, the deadline for delivery of this award is 2 January, 2007.

In its Complaint, the Complainant confirmed that no legal proceedings have been commenced by the parties in conjunction with or relating to the domain name which is the subject of this dispute

3. Factual Background

Complainant is the holding company of the Samsung Group, an internationally well known organization which, among other things, produces and sells a wide variety of goods and supplies therefor, including toner used in various items of equipment. Complainant has registered and is the owner of its trademark and trade name, as registered in a number of classes, in more than 100 countries around the world, including in the United States, the jurisdiction in which the Respondent has registered the domain name in question.

The disputed domain name was registered by the Respondent with the Registrar on 30 July, 2004.

This Panel has inspected the website maintained by Respondent under the disputed domain name. The site is used to sell what are described in the website as “*. . . remanufactured toner cartridges for Samsung printers*”. At the bottom of the site is the disclaimer: “*All brand names and trademarks are the property of their respective holders, while we make references to brand name merchandises (sic), we are in no way endorsed or associated by these companies.*”

4. Discussion and Findings

In determining the dispute, the Panel is instructed, under Article 15 (a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), to decide a complaint on the basis of the statements and documents submitted and in accordance with the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules and such rules and principles of law that it deems applicable.

Article 4(a) of the Policy sets out the criteria upon which the findings of the Panel shall be based. In order to establish its rightful ownership of a domain name in dispute, a complainant must satisfy the panel that:

- (i) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights nor legitimate interests in respect of the domain name; and
- (iii) that the domain name has been registered and is being used in bad faith.

Based upon the submissions by the Claimant and the website of Respondent, this Panel finds as follows:

(i) Is the domain name registered by the Respondents identical or confusingly similar to the trademark or service mark in which the Complainant has rights?

It would seem quite evident that the domain name: “*samsungtonershop.com*” is, if not identical at least confusingly similar to “*Samsung*”. The addition of one or more words to a tradename protected by trademark has often been held to be identical, or at the very least confusingly similar, to the registered trademark name. An exception is often made where the additional word or words indicate opposition to the views or position of the trademark owner, but such is not a relevant consideration in this case. As for the addition of “*.com*”, it is well recognized that the suffix after a domain name, be it regional or institutional in nature, does not affect the intellectual property rights in the name itself. This has been confirmed in most cases in which the question arose, and need not be debated at any length. The name “*samsung*” has been registered as a trademark or servicemark by the Complainant and has been used as its primary business name for many years. Consumers may assume that anything bearing the Samsung name is in some manner related to Samsung.

Therefore this Panel finds that the use of the word “*samsung*” in the domain name in question is identical or confusingly similar to the name Samsung, in which the Complainant has intellectual property rights pursuant to its trademarks.

(ii) Does the Respondent have any interest or legitimate right in the domain name in dispute?

Generally a legitimate interest or right in a domain name might be established where the name is the same as the first or family name of the respondent, where the respondent has registered a trade or service mark under such name, does business under that name, holds a license or franchise from the owner of the trademark of such name, or distributes or sells products under such name.

Clearly the disputed domain name is not the name of Respondent, nor has any indication been provided that Respondent has registered any trademark of such name. Complainant asserts that Complainant has not authorised, licensed, franchised, consented nor otherwise permitted the Respondent to register or use its trademark protected name, Samsung, nor is the Respondent affiliated with the Complainant in any way. Respondent has not submitted any response and thus has not contested this assertion and this Panel must therefore accept it.

Respondent does, however, appear actively to use the domain name in its business, maintaining a website on which it offers for sale products which it states to be “remanufactured” toner cartridges for use in Samsung printers. It does not appear that it is selling actual products under Complainant’s trademark or name, nor does it appear that such sales are made with reference to or consent of Complainant. Thus it is certainly more than questionable whether such business should be deemed to constitute a legitimate right in the domain name when considering the criteria normally applied. This panel does not see that the mere sale of a refill for use in Complainant’s produce gives Respondent a legitimate right to the use of Complainant’s trademark registered name.

This Panel therefore finds that the Respondent does not have any interest or legitimate right in the domain name in dispute.

(iii) Was the domain name in question registered and used in bad faith?

The Policy provides guidance for determining whether there is bad faith, listing four circumstances that could constitute evidence that the registration and use of a domain name is done in bad faith. These are:

- (a) circumstances indicating that registrant did so primarily for the purpose of selling, renting or otherwise transferring the domain name to the complainant who is the owner of the relevant trademark/service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name involved;
- (b) the registrant did so to prevent the owner of the relevant trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct;
- (c) the registrant did so for the purpose of disrupting the business of a competitor; or
- (d) by using the domain name in question, the registrant intentionally attempted to attract, for commercial gain, internet users to the registrants website, by creating confusion with the complainant's mark as the source, sponsorship, affiliation, or endorsement of the registrant's website or of a product or service on the registrant's website.

Let us examine which, if any, of these elements appear to be present in the instant situation.

(a) There is no indication that any attempt was made by Respondent to offer to sell the disputed domain name to the Complainant, nor is there any indication on the website or anywhere else that the site or the name is for sale.

(b) In most cases where a domain name is registered in bad faith, it is done for the purpose of “*cybersquatting*” or preventing the rightful owner from using its name. Normally such cybersquatters register many names and then try to sell them for profit. There is no indication that this Respondent is in the habit or business or cybersquatting, as we have no indication that it has registered any other domain names improperly. Furthermore, the addition of “...*tonershop*” to the tradename: “*samsung...*” would indicate that the product sold on the website is only toner, as is also clear from the website itself. Nor would registration of the combination “*samsungtonershop*” operate to prevent the Complainant from registering the domain name “*samsung*” by itself or in combination with any other words, with any suffix, including “*.com*.”

(c) There is no indication that the purpose, or the result, of the registration by Respondent of the domain name in question is disruptive to the business of Complainant. Indeed Complainant produces and sells toner for its products; but not all sales are direct by Complainant. Other parties also market and sell Samsung products. Nor does Respondent claim that they are selling authentic Samsung

products. It is very clear from the language on the website that what they are selling is “*remanufactured*” products, which we assume means that they collect spent and empty Samsung cartridges and refill them with other toner to sell, which they do at prices clearly below that of new original Samsung cartridges. There seems no intention to confuse customers into believing that they are purchasing original Samsung products. Thus the use of the name, as registered, does not seem to be intended to disrupt the business of Complainant. Complainant has confirmed that other third-parties do sell *refills* for Samsung toner cartridges, but points out that no other such third-party uses the name “*samsung*” in their website. It may very well be that Respondent’s reuse or remanufacture of Samsung cartridges is improper and may constitute a violation of Complainant’s intellectual property rights. However, any claim for trademark violation would be beyond the jurisdiction of this Panel, which has the mandate only to rule on the domain name itself. Complainant is free to bring infringement action against Respondent for any such violation in any court of appropriate jurisdiction, but unfortunately such is not within the jurisdiction of this Panel to rule. The registration of the domain name in question, and the inclusion of the word “*samsung*” in its website has not, under these facts, been shown to indicate the intention of Respondent to disrupt the business of Complainant, nor has Complainant provided any evidence that its business has been so interrupted.

(d) There seems little question that the purpose of Respondent in setting up a website under the disputed domain name, and registering such name, is to attract business, that is to encourage sales of remanufactured Samsung toner products. But is not every website, under any domain name, which offers anything for sale posted for the purpose of attracting business? Use of a trademark-registered name incorporated into a domain name does not necessarily indicate bad faith. If it did, there would be no need to have administrative panels to determine whether bad faith exists. In order to constitute *bad faith* pursuant to this category of the ICANN Policy, the Respondent would also have to be shown to create confusion with Complainant's mark as the source, sponsorship, affiliation or endorsement of Respondent's site or product offered thereon. This panel finds no indication that the purpose of registering, or using, such name was or is to create such confusion nor to appear that the Complainant has specifically authorized such use. Normally there is a different market for reconstituted products from that for original products, and people who intentionally purchase third-party discounted refills are not normally the same users that will purchase original products. Not only does Respondent's website make it clear at the top of the website, where the product is described as "*remanufactured toner cartridges for Samsung printers*" , indicating that it is not original Samsung products which are being offered, but Respondent has also inserted a disclaimer at the bottom of the website, of easily legible size, making it

clear that Respondent is not affiliated with Samsung. This disclaimer says: “*All brand names and trademarks are the property of their respective holders, while we make references to brand name merchandises, we are in no way endorsed or associated by these companies.*” Thus this Panel cannot find, as Complainant alleges, that Respondent is “.. *intentionally misleading Internet users to believe that the products on his website are affiliated with the Complainant. . .*”.

Complainant further claims that the inclusion of the disclaimer itself can be seen as an indication of Respondent’s admission of bad faith, which Respondent has tried to alleviate by the inclusion of such disclaimer. However, it is equally, or more, likely that, taking the wording of the disclaimer at face value, its purpose is specifically to ensure that Respondent’s customers be aware that its products are not authorized by, nor original products of, Complainant.

Complainant has cited, and provided a copy of, a WIPO case, No. D2003-0157, relating to the domain name: *ggbridge.com*. In that case the WIPO panel did find bad faith despite a disclaimer. However, in that case the disclaimer was added only after the complainant in such case demanded that such disclaimer be made. It was not inserted in the website from the outset, of Respondent’s own accord, as is the case here. Furthermore in that case there were many other indications of the bad faith of the respondent, whereas in this case this Respondent has taken no evasive

steps. Also in that case the domain name registered bore no relation to the services being provided by the respondent. This panel does not find the facts of the WIPO case to apply to this one. It may be that the Respondent was not acting entirely in good faith, in the normal parlance sense of the phrase, in using the Samsung name as part of its domain name. It certainly could have used a different name indicating only that it was offering toner for sale, even if such toner could be used only for Samsung printers. However, “*bad faith*” is strictly defined for purposes of the ICANN Policy and Rules for domain name disputes, and none of the criteria which would indicate bad faith under such rules are present in this situation. This Panel therefore is unable to find that the domain name in question was either registered or is being used in bad faith, as defined in the ICANN Rules and Policy.

6. CURRENT SITUATION/SUBSEQUENT WITHDRAWAL OF WEBSITE:

It should also be noted that, while revising the initial award, on 24 and 28 December, 2006, this Panel sought to open Respondent’s website at the disputed Domain Name address to seek to confirm the recollection of the size and accessibility of the disclaimer. However, it appears that the site has been removed from the internet, and in searching under “*Google*” for “*Samsung*” and “*toner*” there

is no longer any mention of “*samsungtonershop.com*” that appears, at least not in the first listings. It thus appears probable that the Respondent, after having discussed the matter with the Claimant, has decided, in good faith, to remove the offending site and avoid further contentious action. This Panel hopes that that is the case. Although this Panel is unable to find the bad faith element which would allow it to order transfer of the domain name in question, the Complainant is certainly justified in viewing this use of its trademark-protected name as a lack of good faith, and it is very likely that the Complainant might take other action against the Respondent for violation of its intellectual property rights in its registered trademark. Thus by ceasing to use the name of its own volition, the Respondent, it is hoped, is showing its good faith and also avoiding further litigation. This panel can only express its hope that, despite its finding here, the Respondent will cease use of the disputed domain name and show respect for Complainant’s intellectual property rights in its internationally known trade name.

7. Decision

Based upon the Policy, the Complaint and the above analysis, this Panel finds that the domain name registered by the Respondent is identical or confusingly similar to trademarks in which the Complainant has rights and that Respondent does

not have any legitimate right or interest in respect of the domain name; but that there is no concrete indication that the domain name was registered and is being used in bad faith.

In order to direct the transfer of a domain name, a panel must find that all three criteria of the Policy, as outlined above, are met. In this case only two are met. Therefore, this Panel is unable to direct that the disputed domain name: *www.samsungtonershop.com*, be transferred from Respondent to Claimant.

Application for transfer of registration is therefore declined, without prejudice, and with the hope that Respondent will nonetheless cease use of the disputed domain name.

Karen Mills

Sole Panelist

Date: 29 December, 2006