



Asian Domain Name Dispute Resolution Centre

seoul

(Seoul Office)

ADMINISTRATIVE PANEL DECISION

Case No. KR-1900196

Complainants: Samsung Electronics Co., Ltd. (Authorized Representative : Bae, Kim & Lee LLC IP Group)

Respondent: Affordable Webhosting, Inc. (Authorized Representative : Zak Muscovitch)

Disputed Domain Name(s): galaxystore.com

1. The Parties and Contested Domain Name

The Complainant is Samsung Electronics Co., Ltd., Gyeonggi-do, Republic of Korea.

The Authorized Representative of Complainant is Bae, Kim & Lee LLC IP Group, Seoul, Republic of Korea

The Respondent is Affordable Webhosting, Inc., Manzanita, Oregon, USA.

The Authorized Representative of Respondent is Zak Muscovitch, Toronto, Ontario, Canada.

The domain name at issue is <galaxystore.com>, registered by Name.com.

2. Procedural History

The Complaint was filed with the Seoul Office of the Asian Domain Name Dispute Resolution Center (ADNDRC)[“Center”] on January 16, 2019, seeking for a transfer of the disputed domain name.

On January 17, 2019, the Center sent an email to the Registrar asking for the detailed data of the registrant. On January 18, 2019, Name.com transmitted by email to the Center its verification response, advising that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the Centre’s Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, the Centre formally notified the Respondent of the Complaint. The proceedings commenced on January 19, 2019 and the due date for the Response was February 15, 2019.

On February 15, 2019, a Response was submitted by the Respondent.

On March 6, 2019, the Center appointed Mr. Ho-Hyun Nam(Presiding-Panelist), Mr. Dae-Hee Lee and Mr. Alan Limbury as the Panelists in the administrative proceeding and 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.

3. Factual background

- i. Complainant has used its mark world widely since 2009. Complainant has established its rights for the mark 'GALAXY S' based on its trademark registration with the United States Patent and Trademark Office (“USPTO”) (*e.g.*, GALAXY S - Reg. No. 3,905,843, registered January 11, 2011) and for the mark 'GALAXY TAB' with the Korea Intellectual Property Office (“KIPO”) (*e.g.*, GALAXY TAB Reg. No. 40-0867368, registered June 3, 2011).
- ii. Respondent is a corporation incorporated in Oregon in 1999 and was incorporated for the express purpose of carrying on business in advertising.
- iii. The disputed domain name was registered on June 6, 2004.
- iv. Respondent used the disputed domain name for its “Galaxy Store” of various advertised goods and services.

4. Parties’ Contentions

A. Complainant

- i. Complainant uses its mark 'GALAXY' in connection with smart phone products which Complainant manufactures and sells. Complainant has used its mark world widely for long period of time since 2009. Complainant’s GALAXY smart phone was the number one smart phone for the second quarter of 2018 in worldwide smart phone sales, and in domestic markets. Complainant’s 'GALAXY' was selected as number one brand name which enhanced national prestige of Korea in 2018. Smart phones manufactured by Complainant occupied 26% of the northern America’s shipment in smart phones by the second quarter of 2018, and smart phones sold by Samsung reached 61.50 million units in the U.S. market by January 2018. As such, Complainant's mark 'GALAXY' is globally well known. Complainant has rights in the GALAXY mark based on its trademark registrations around the world, including with the United States Patent and Trademark Office (“USPTO”) (*e.g.*, GALAXY S - Reg. No. 3,905,843, registered January 11, 2011) and the Korea Intellectual Property Office (“KIPO”) (*e.g.*, GALAXY TAB Reg. No. 40-0867368,

registered June 3, 2011). The disputed domain name is confusingly similar to Complainant's GALAXY mark, as it fully incorporates the mark, adding only the generic term "store" and generic top-level domain ("gTLD") ".com."

ii. Respondent has no right or legitimate interest in the disputed domain name. Respondent is an entity completely unrelated to the Complainant. Complainant has never authorized Respondent to register and retain the disputed domain name. The disputed domain name has never been used for its owner's business purpose, but it is used merely for the purpose of diverting Internet users to another website 'mintsuff.com' where quit smoking gum named 'mintsuff' is sold.

iii. Given the fact that the Complainant's mark 'GALAXY' being famous; and the disputed domain name has been used solely for forwarding purpose without any lawful authorization, Respondent registered and used the disputed domain name in bad faith.

B. Respondent

i. Respondent denies the entire Complaint and requests dismissal with a finding of Reverse Domain Name Hijacking against Complainant.

ii. Respondent is a corporation incorporated in Oregon in 1999 and was incorporated for the express purpose of carrying on business in advertising as per the State of Oregon Corporate Report and (earliest readily available) Annual Filing.

iii. Respondent has rights or legitimate interests in the disputed domain name. Complainant has failed to explain, why or even how, Respondent should or could have obtained authorization to register the disputed domain name from Complainant in 2004, when Complainant had not even adopted GALAXY as a brand. Respondent registered the disputed domain name because it was comprised of two common English words and the combination thereof constituted an attractive phrase that Respondent coined and believed was apt for any number of

indeterminate and lawful future use, including advertising as part an online “store” offering a “galaxy” of diverse goods and services. From its registration to-date, Respondent consistently used the disputed domain name for its “Galaxy Store” of various advertised goods and services. As such, Respondent was the first and senior adopter of the Galaxy Store brand as between Complainant and Respondent.

iv. Complaint expressly acknowledges that the disputed domain name was registered on June 6, 2004 and also expressly concedes that Complainant only launched its GALAXY smart phone for the first time in 2010 or in 2009. This was obviously at least five years *after* Respondent registered the disputed domain name, making it impossible to have registered the disputed domain name in bad faith. To-date, Respondent has never used the disputed domain in any infringing manner. There is no factual basis whatsoever that Respondent registered the disputed domain name to target Complainant’s non-existent mark, nor is there any factual basis to conclude that Respondent used the disputed domain name to target Complainant’s smart phones. Lastly, registering un-trademarked domain names for speculation is a legitimate interest under the Policy.

v. The Complainant has engaged in Reverse Domain Name Hijacking by initiating this dispute despite the Complainant was even warned of the lack of merit to its case and it proceeded anyhow.

5. Discussion and Findings

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 claims rights in the 'GALAXY' mark based upon its trademark registrations around the world, including with the United States Patent and Trademark Office ("USPTO") (*e.g.*, GALAXY S - Reg. No. 3,905,843, registered January 11, 2011) and with the Korea Intellectual Property Office ("KIPO") (*e.g.*, GALAXY TAB Reg. No. 40-0867368, registered June 3, 2011).

Registration of a mark with several government authorities throughout the world is sufficient to establish rights in that mark. *See Google LLC v. Bhawana Chandel / Admission Virus*, FA 1799694 (FORUM Sep. 4, 2018) ("Complainant has rights in the GMAIL mark based upon its registration of the mark with numerous trademark agencies around the world."). The Panel therefore holds that Complainant's registration of the 'GALAXY S' and 'GALAXY TAB' marks with the USPTO and the KIPO is sufficient to establish rights in the marks under Policy ¶ 4(a)(i).

Complainant next argues disputed domain name is confusingly similar to Complainant's 'GALAXY' containing marks, as it fully incorporates the mark, adding only the generic term "store" and generic top-level domain ("gTLD") ".com." Addition of generic terms and/or a gTLD is not sufficient to overcome a confusingly similar analysis per Policy ¶ 4(a)(i). *See MTD Products Inc v J Randall Shank*, FA 1783050 (FORUM June 27, 2018) ("The disputed domain name is confusingly similar to Complainant's mark as it wholly incorporates the CUB CADET mark before appending the generic terms 'genuine' and 'parts' as well as the '.com' gTLD."). The Panel agrees that the disputed domain name is confusingly similar to Complainant's 'GALAXY S' and 'GALAXY tab' marks per Policy ¶ 4(a)(i).

B) Bad Faith

Complainant claims that given the fact that the Complainant's mark 'GALAXY' being famous; and the disputed domain name has been used solely for forwarding purpose without any lawful authorization, Respondent registered and used the disputed domain name in bad faith. Against the Complainant's contentions, respondent is rebutting that:

i) Complaint expressly acknowledges that the disputed domain name was registered on June 6, 2004 and also expressly concedes that Complainant only launched its GALAXY smart phone for the first time in 2010 or in 2009; ii) this was obviously at least five years after Respondent registered the disputed domain name, making it impossible to have registered the disputed domain name in bad faith; iii) to-date, Respondent has never used the disputed domain in any infringing manner; iv) there is no factual basis whatsoever that Respondent registered the disputed domain name to target Complainant's non-existent mark, nor is there any factual basis to conclude that Respondent used the disputed domain name to target Complainant's smart phones; and registering un-trademarked domain names for speculation is a legitimate interest under the Policy.

The Panel notes that the disputed domain name was registered on June 6, 2004 and it predates the earliest registration date of the Complainant's mark even the first-ever launching of the Complainant's GALAXY smart phone in 2009. The Panel agrees with Respondent that this was obviously at least five years after Respondent registered the disputed domain name, making it impossible to have registered the disputed domain name in bad faith. Therefore, the Panel concludes that Respondent registered the disputed domain name not in bad faith. See section 3.8.1 'WIPO Jurisprudential Overview 3.0' (where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent.). Given the conjunctive requirement of 'bad faith registration' and 'bad faith use,' needless to inquire into the requirement of bad

faith use, the Panel finds that Complainant has failed to satisfy Paragraph 4 (a)(iii) of the UDRP.

The Panel decides not to inquire into the respondent's rights or legitimate interests where the complainant could not satisfy the requirements of Policy ¶ 4(a)(iii). See *Creative Curb v. Edgetec Int'l Pty. Ltd.*, FA 116765 (FORUM Sept. 20, 2002) (finding that because the complainant must prove all three elements under the Policy, the complainant's failure to prove one of the elements makes further inquiry into the remaining element unnecessary); see also *Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, FA 836538 (FORUM Dec. 28, 2006) (deciding not to inquire into the respondent's rights or legitimate interests or its registration and use in bad faith where the complainant could not satisfy the requirements of Policy ¶ 4(a)(i)).

C) Reverse Domain Name Hijacking

Respondent claims that Complainant has engaged in Reverse Domain Name Hijacking against Respondent. Respondent contends that where a sophisticated complainant is represented by IP counsel and who even on a rudimentary examination of the Policy and its application in this area should have appreciated that the complaint could not succeed since Respondent's domain name had been registered prior to any trademark rights being acquired.

Paragraph 15(e) of the Rules provides that, if 'after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.'

The Rules define Reverse Domain Name Hijacking as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name."

The Panel also bears in mind that Complainant in this case is represented by counsel and, therefore, it should be held to a higher standard. *see* section 4.16 of the WIPO Overview 3.0.

The Panel concludes that the Complainant's actions constitute Reverse Domain Name Hijacking against Respondent for the following reasons:

i) the registration of the disputed domain name predates the earliest registration date of the Complainant's mark even the first- ever launching of the Complainant's GALAXY smart phone in 2009, which was obviously at least five years after Respondent registered the disputed domain name, making it impossible to have registered the disputed domain name in bad faith;

ii) given the conjunctive requirement of bad faith registration and bad faith use per paragraph 4(a) (iii) of the Policy, it was easily anticipated on the part of Complainant that it would fail to satisfy the requirement of bad faith registration and use, and thus this proceeding would be meritless;

iii) Respondent consistently used the disputed domain name for its "Galaxy Store" of various advertised goods and services in good faith; Respondent was the first and senior adopter of the Galaxy Store brand as between Complainant and Respondent; and

iv) in order to attempt to avoid a meritless proceeding, Respondent through counsel, sent a letter to Complainant's counsel, dated January 21, 2019, by both email and fax, receipt of which was acknowledged by counsel for Complainant; the Warning Letter invited Complainant to withdraw Complaint or face dismissal and a finding of Reverse Domain Name Hijacking.

See Darryl Davis Seminars, Inc. v. Privacydotlink Customer 656889 / Domain Admin, Abstract Holdings International Ltd., WIPO Case No. D2018-2238.

6. Decision

For the foregoing reasons, the Complaint is denied. The Panel further declares that the Complaint constitutes Reverse Domain Name Hijacking for the disputed domain name <galaxystore.com> against Respondent.

Ho-Hyun Nahm
Presiding Panelist

Dae-Hee Lee
Co-Panelist

Alan Limbury
Co-Panelist

Dated: March 14, 2019