



Asian Domain Name Dispute Resolution Centre

seoul

(Seoul Office)

## ADMINISTRATIVE PANEL DECISION

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**Case No.** KR-1900204

**Complainants:** Prinker Korea Inc. (Authorized Representative : SIHUN Attorneys at Law)

**Respondent:** Kwang pyo Kim (Mediablue)

**Disputed Domain Name(s):** prinker.com

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### 1. The Parties and Contested Domain Name

The Complainant is Prinker Korea Inc., Gyeonggi-do, Republic of Korea.

The Authorized Representative of Complainant is SIHUN Attorneys at Law, Seoul, Republic of Korea.

The Respondent is Kwang pyo Kim, Gwang-ju, Republic of Korea.

The domain name at issue is 'prinker.com', registered by Uniregistrar.com.

### 2. Procedural History

The Complaint was filed with the Seoul Office of the Asian Domain Name Dispute Resolution Center (ADNDRC)[“Center”] on September 30, 2019, seeking a transfer of the disputed domain name.

On October 1, 2019, the Center sent an email to the Registrar asking for the detailed data of the registrant. On October 2, 2019, Uniregistrar.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 October 2, 2019 and the due date for the Response was October 22, 2019.

On October 22, 2019, a Response was submitted by the Respondent.

On November 12, 2019, the Center appointed Mr. Ho-Hyun Nam (Presiding-Panelist), Mr. Douglas Clark and The Honourable Neil Anthony Brown QC as the Panelists in the administrative proceeding and with the consent for the appointment, impartiality and independence declared and confirmed by the Panelists, the Center, in accordance with paragraph 7 of the Rules, effected the appointment of the Panel in the usual manner.

Pursuant to the Complainant's request, on November 22, 2019 the Panel issued a procedural order allowing Complainant to file an additional submission by setting a deadline of November 29, 2019 and Respondent to file an additional submission in response to Complainant's additional submission by December 6, 2019.

The Complainant filed the additional submission with Exhibits 14 through 16 on November 29, 2019 which was timely, and the Respondent filed the additional submission with Exhibits 7 through 9 on December 6, 2019 which was also timely.

On November 29, 2019, the Complainant filed the 'Request for Correction of Name' from SketchOn Inc. to Prinker Korea Inc. due to its change of name as of November 7, 2019 along with documents proving the name change.

### **3. Factual background**

#### **A. Complainant**

Complainant was established on December 10, 2015 and developed 'the erasable mobile tattoo device.' Complainant has registered the mark 'PRINKER' (logo) in a few countries including Europe, Korea and China since 2016, and has conducted various global marketing activities under the product name of 'PRINKER.'

#### **B. Respondent**

Respondent is engaged in the business with domain names, e.g., hosting underdeveloped domain names with domain name parking services which pay a share of the advertising revenue they generate. Since 2001, Respondent has registered a good number of short and brandable domain names. Over the past decade Respondent has hosted many domain names for parking services that have displayed pay-per-click advertising links on hosted domain names.

Respondent purchased the disputed domain name on February 20, 2018, through namejet.com auction. The disputed domain name was updated on May 20, 2018 (at which times it appears to have been transferred to the Respondent). The disputed domain name was initially created on September 1, 2000 and became available when its prior owner allowed the disputed domain's registration to expire in 2018.

### **4. Parties' Contentions**

#### **A. Complainant**

i) The Complainant's mark 'PRINKER' (device) has been used in respect of printer device, printer cartridge, printer App, etc. The tattoo printing product is advertised in global markets such as Korea, China, Europe and the United States. The Complainant's mark was registered with EUIPO ( Reg. No. 015620404 registered on January 11, 2016 ); with the Korean Intellectual Property Office (Reg. No. 1239552 registered on February 1, 2017); in China (registration number: 20533810 on August 28, 2017); and in the U.S.A., Japan and Thailand. The disputed domain name is identical or confusingly similar to the Complainant's mark.

ii) Respondent has no rights or legitimate interests in respect of the disputed domain name. The disputed domain name does not appear to have been used by Respondent, nor does it conform to legitimate non-commercial or fair use of the disputed domain name. Also, Respondent (as an individual, business, or other organization) does not appear to have been commonly known by the disputed domain name.

iii) The disputed domain name has been registered and is being used in bad faith. After acquiring the disputed domain name on May 20, 2018, Respondent asked Complainant to buy the disputed domain name for USD 85,000, which shows that the disputed domain name was acquired primarily for the purpose of selling, renting, or otherwise transferring to the owner of the trademark or service mark for valuable consideration in excess of Respondent's out-of-pocket costs directly related to the domain name. Complainant was established on December 10, 2015 and successfully developed 'the world's first erasable mobile tattoo device.' Therefore, Respondent must have known the existence of the Complainant's mark prior to its acquiring the disputed domain name by conducting Internet searches.

## **B. Respondent**

i) Respondent has rights or legitimate interests in respect of the disputed domain name. Respondent acquired and is using the disputed domain name in good faith for his own business purpose.

ii) Respondent purchased the disputed domain on February 20, 2018, through a namejet.com auction because the disputed domain name is a short, brandable domain name to which it believed no party could claim exclusive rights and which is also a valuable short <.com> domain name. It did not register the disputed domain with Complainant's trademark in mind and had no knowledge of Complainant, its web site, its business name or trademark at the time of registration.

iii) Respondent did not register the disputed domain name with intent to sell it to Complainant, to disrupt Complainant's business, or to confuse consumers seeking to find Complainant's website. Since 2001, Respondent has registered hundreds of common word domain and combined letter domain names for investment and development. Respondent registers generic and descriptive common word and 3, and 4 letter, and first or surname domain names because they best fulfill the purpose of a domain name which is to be easy to remember. Common word domains therefore serve well as online identities and, as a result, are commercially valuable. Respondent has continued to register inherently valuable short and brandable dot com domains, in part, because of the decisions of impartial panels of legal experts have found in favor of such a business strategy of domain investing.

iv) Respondent hosts underdeveloped domain names with domain name parking services which pay a share of the advertising revenue they generate, an industry-wide accepted practice. Over the past decade Respondent has hosted many domain names for parking services that have displayed pay-per-click advertising links on hosted domain names powered by their software. The provider's automated technology generated links based on provider's search algorithm and also generic links. Respondent did not select these links with the intent to profit from Complainant's trademark and does not have any links related to Complainant or its business on the webpage.

### C. Additional Submissions

#### Complainant's Additional Submission

i) Complainant has made out a *prima facie* case that Respondent does not have rights or legitimate interests. However, Respondent failed to rebut the *prima facie* case against it. According to decisions of many other cases on domain name disputes, pay-per-click advertising does not constitute rights or legitimate interests. Respondent is clearly in the business of reselling domain names on a large scale and using them, at least in the interim, to point to websites with advertising links. The Response does not indicate what steps, if any, the Respondent took in good faith to avoid registering, using, and selling domain names that correspond to trademarks. The disputed domain name is a short string of letters, but it is not a dictionary word or descriptive phrase. Rather, it is suspiciously identical to the Complainant's arbitrary mark. Reselling domain names or using them for advertising links can in certain circumstances represent legitimate interests for purposes of paragraph 4(c) of the Policy, but not in all instances. The Panel must consider, as have several previous UDRP panels, whether the Respondent's apparent disregard for the likelihood that the disputed domain name corresponded to a distinctive trademark is itself evidence of bad faith in the registration and use of the disputed domain name.

ii) Respondent had knowledge of Complainant's mark when he purchased the disputed domain name in 2018 and used it in bad faith. Respondent's claim that "it did not register the disputed domain with Complainant's trademark in mind and had no knowledge of Complainant, its website, its business name or trademark" is totally unconvincing in determining Respondent's bad faith. Respondent who is professionally engaged in selling and buying domain names was able to easily find news articles, photos, and videos containing Complainant's website or related product promotions by searching "prinker" in search engines (e.g. google) around in May 2018 when he purchased the disputed domain name. [Annex 13-1 online presence (Media Articles), Annex 13-2 online presence (Videos), Annex 13-3 online presence (Social Media), and Annex 13-4 online presence (Government Agencies)]. Also refer to the Google Trend result: <https://trends.google.com/trends/explore?date=all&q=Prinker>].

iii) Respondent claims that PPC advertisement does not target Complainant, however, when looking at the websites that Respondent linked to (Annex 10, www.prinker.com page capture), they include Epson Printer Ink, Lexmark Printer Ink, Canon Printer, etc., which are all included in the designated goods of Complainant's register of trademark (Annex 3 to 8, Certificate of Trademark Registration). This may result in misidentification for consumers who have access to printer.com to be confused with Complainant's products (or the kinds) on sale (Annex 9 trademark used photo – Printer, cartridge & Ink) or with websites of Complainant's competitors. Therefore, Respondent's conduct falls under Policy 4(b)(iv).

iv) The use of privacy services for secretly transferring registration concealing registrant information, contact information and registration dates is against the purpose of UDRP.

#### Respondent's Additional Submission

i) It is generally noted that a respondent may have a right to register and use a domain name to attract Internet Traffic based on the appeal of a commonly used short or brandable or descriptive term, even when the domain name is confusingly similar or identical to a complainant's registered mark. Respondent registered the disputed domain solely based on its descriptive nature or inherent value of a short term – and not because of Complainant's trademark. Respondent registered many other non-trademark domain names most notably other registrations of short, memorable and brandable names. Respondent does not target trademarks. Such pattern of descriptive domain name registration supports an inference that the descriptive and memorable disputed domain was not registered with the intent to target trademark. On the balance of probabilities, considering the facts of this case and respondent's other domains, Respondent has established rights and a legitimate interest in the disputed domain name.

ii) Over the past decade Respondent has hosted parking services with many different domain names that have displayed pay-per-click advertising links on hosted domain names powered by their software which the provider's automated technology generated

links based on provider's search algorithm and also generic links. Respondent did not select these links with the intent to profit from Complainant's trademark and does not have any links related to Complainant or its business on the webpage. In addition there are many other cases in which respondent believes that posting a link to a PPC advertisements has legitimate interest.

iii) The fact that Respondent responded to Complainant's inquiry to purchase the disputed domain is not improper and it does not make its use of the disputed domain illegitimate. A business based on reselling domain names satisfies the legitimate interest prong of the Policy, provided there is no evidence a trademark was targeted by the registrant. Respondent registered the disputed domain simply because it incorporated a short, memorable domain name that became available when its prior owner allowed the disputed domain's registration to expire. Previous panels have held that the expiration of a domain name raises the presumption that any trademark rights in such domain have been abandoned, signaling to prospective registrants that it is available and can be registered in good faith absent specific proof of intent to profit from Complainant's mark.

iv) Complainant must produce specific evidence of bad faith registration because there is no proof that Complainant's mark was the reason Respondent registered the disputed domain name. Complainant has failed to provide such evidence because none exists. There is no logic to the allegation that Respondent targeted Complainant when it purchased the disputed domain as it was deleted after 18 years and offered for re-registration.

v) The former registrant of the disputed domain name had operated the disputed domain name's resolved website for a period from 2001 through 2018 related to black and color inks and refilled ink (Annex 4). Many companies use the name 'prinker' (Annex 9). The panels should not give them excessive rights.

vi) The registration date of the Complainant's U.S. trademark registration is April 30, 2019 (Annex 7)

## 5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of the following 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 rights in the PRINKER (logo) mark through its registration of the mark with the multiple trademark agencies, including EUIPO ( Reg. No. 015620404, registered January 11, 2016 ) and the Korean Intellectual Property Office (Reg. No. 1239552, registered February 1, 2017). *See* Compl. Annexes 3 through 8.

Registration of a mark with the multiple trademark agencies around the world, including the EUIPO, is sufficient to demonstrate rights in the mark per Policy ¶ 4(a)(i). *See Alibaba Group Holding Limited v. YINGFENG WANG*, FA 1568531 (FORUM Aug. 21, 2014) (“Complainant has rights in the ALIBABA mark under the Policy through registration with trademark authorities in numerous countries around the world.”); *see also Lilly A/S v. yiyi chen*, FA 1704586 (FORUM Jan 5, 2017) (“Until March 23, 2016, the EUIPO was known as the Office for Harmonization in the Internal Market. Registration of a mark with the EUIPO (or any other similar governmental authority) is sufficient to establish rights in the mark.”). Therefore, the Panel finds Complainant has demonstrated rights in the PRINKER (logo) mark per paragraph 4(a)(i) of the Policy.

Complainant next argues that the disputed domain name is identical or confusingly similar to the Complainant's mark as it contains the mark in its entirety and merely adds the <.com> gTLD. Similar changes in a registered mark have failed to sufficiently distinguish a domain name for the purposes of paragraph 4(a)(i) of the Policy. *See Tupelo Honey Hospitality Corporation v. King, Reggie*, FA 1732247 (FORUM July 19, 2017) ("Addition of a gTLD is irrelevant where a mark has been fully incorporated into a domain name and the gTLD is the sole difference."). The Panel therefore finds that the disputed domain name is identical or confusingly similar to the PRINKER (logo) mark under paragraph 4(a)(i) of the Policy.

### **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 paragraph 4(a)(ii) of the Policy, then the burden shifts to Respondent to show it does have rights or legitimate interests. *See Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its *prima facie* case and satisfy paragraph 4(a)(ii) of the Policy); *see also Neal & Massey Holdings Limited v. Gregory Ricks*, FA 1549327 (FORUM Apr. 12, 2014) ("Under Policy ¶ 4(a)(ii), Complainant must first make out a *prima facie* case showing that Respondent lacks rights and legitimate interests in respect of an at-issue domain name and then the burden, in effect, shifts to Respondent to come forward with evidence of its rights or legitimate interests").

Complainant asserts that the disputed domain name does not appear to have been used by Respondent, nor does it conform to legitimate non-commercial or fair use of the disputed domain name. Also, Respondent (as an individual, business, or other organization) does not appear to have been commonly known by the disputed domain name. Pay-per-click advertising does not always constitute rights or legitimate interests in the domain name but it may do so in some circumstances. Respondent is clearly in the business of reselling domain names on a large scale and using them, at least in the interim, to point to websites

with advertising links. The disputed domain name is a short string of letters, but it is not a dictionary word or descriptive phrase. Rather, it might be thought to be suspiciously identical to the Complainant's arbitrary mark. Reselling domain names or using them for advertising links can in certain circumstances represent legitimate interests for purposes of paragraph 4(c) of the Policy, but not in all instances.

Given the considerations above, the Panel finds that Complainant has made out a *prima facie* case. As the onus thus shifts to Respondent, the Panel must now see if Respondent has rebutted the *prima facie* case and shown that it has a right or legitimate interest in the disputed domain name.

Respondent contends that it has rights or legitimate interests in respect of the disputed domain name: i) Respondent acquired and is using the disputed domain name in good faith for his own business purpose. Respondent purchased the disputed domain on February 20, 2018, through namejet.com auction because the disputed domain name is a short, brandable domain name to which he believed no party could claim exclusive rights and which is also a valuable short <.com> domain name; ii) It did not acquire the disputed domain with Complainant's trademark in mind and had no knowledge of Complainant, its web site, its business name or trademark. Respondent did not acquire the disputed domain name with intent to sell it to Complainant, to disrupt Complainant's business, or to confuse consumers seeking to find Complainant's website; iii) Since 2001, Respondent has registered hundreds of common word domain and combined letter domain name for investment and development. Respondent registers generic and descriptive common word and 3, and 4 letter, and first or surname domain names because they best fulfill the purpose of a domain name which is to be easy to remember. Common word domains therefore serve well as online identities and, as a result, are commercially valuable. Respondent has continued to register inherently valuable short and brandable dot com domains, in part, because of the decisions of impartial panels of legal experts that have found in favor of such a business strategy of domain investing; iv) Respondent hosts underdeveloped domain names with domain name parking services which pay a share of the advertising revenue they generate, an industry-wide accepted practice; and v) It is generally noted that a respondent may have a right to register and use a domain name

to attract Internet Traffic based on the appeal of a commonly used short or brandable or descriptive term, even when the domain name is confusingly similar or identical to a complainant's registered mark.

The Panel notes that the pay-per-click advertising and reselling business with domain names comprising of a generic or a dictionary word is an industry-wide accepted practice unless such a pay-per-click advertising and reselling business with domain names targets another person's rights. As such, there are two questions: i) whether the disputed domain name is a generic or a dictionary word and ii) whether Respondent targets the Complainant's trademark.

As to the first question whether the disputed domain name is a generic or a dictionary word: The Panel finds that the former registrant of the disputed domain name owned the disputed domain name for 18 years from September 1, 2000 much earlier than January 11, 2016, the first registration date of the Complainant's mark. The former registrant of the disputed domain name had operated the disputed domain name's resolved website for a period of 2001 through 2018 related to black and color inks and refilled ink (*See* Respondent's Annex 4). Many companies use the name 'PRINKER' (*See* Respondent's Annex 9). The Panel agrees that 'PRINKER' is a dictionary word (*See* Respondent's Annex 8). A lot of domain names include the term 'prinker' (*See* Respondent's Annex 9).

Complainant argues that the distinctiveness of a trademark should be determined in term of goods, and the mark 'PRINKER' is not generic in relation to the goods of the Complainant's registered mark. However, the Panel finds that even such a distinctive trademark right does not extend to other's use of the name as a generic name and in a common way. The Panel finds that the use of the disputed domain name by Respondent constitutes the use as a generic name in a common way.

As to the second question whether Respondent targets the Complainant's trademark:

There is no evidence that Respondent specifically targeted the Complainant. The Complainant's trademark 'PRINKER' was not particularly well known prior to the acquisition date of May 20, 2018 of the disputed domain name. There is no evidence that

the Complainant's mark was prominent enough to put Respondent on any sort of notice that it existed. The Panel does not accept Respondent should have done a trade mark search. Even if it did, it would have found one or two trade marks in some countries, but not a worldwide portfolio. There is no reason the name 'PRINKER' cannot be used for other goods or services. Respondent bought a domain name on the open market that had been registered and used for years. It is entitled to do that.

The Panel finds that there is no specific proof of intent of Respondent to profit from Complainant's mark. The Panel finds that Respondent's response to Complainant's inquiry to purchase the disputed domain with the offer of US\$85,000 itself does not constitute targeting the Complainant's mark. Respondent put a price on the disputed domain name when Complainant asked him to do so. It is not appropriate for this Panel to say if it was a good, a low or a reasonable price. Respondent did not target Complainant or do anything to do it damage. Respondent used the disputed domain name in accordance with the normal meaning it had obviously acquired under the former owner, i.e. printing, and which the provider of the pay for click links has picked up and used for advertisements.

As the Panel agrees with Respondent's contentions, it finds that Respondent has successfully rebutted the *prima facie* case against it, and thus it finds that Respondent has rights or legitimate interests in the disputed domain name.

Therefore, the Panel concludes that Complainant failed to establish the second element of paragraph 4 (a) of the Policy.

### **C) Bad Faith**

As the Panel finds Complainant failed to satisfy the second element of paragraph 4(a) of the Policy (rights or legitimate interests), the Panel declines to analyze the third element of paragraph 4(a) of the Policy (bad faith registration and use). *See Creative Curb v. Edgetec Int'l Pty. Ltd.*, FA 116765 (Nat. Arb. 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).

## 6. Decision

Having not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the <**prinker.com**> domain name **REMAIN WITH** Respondent.

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Ho-Hyun Nahm  
Presiding Panelist

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Douglas Clark  
Co-Panelist

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The Honourable Neil  
Anthony Brown QC  
Co-Panelist

Dated: December 20, 2019