



NATIONAL ARBITRATION FORUM

DECISION

PanaVise Products, Inc. v. Hae-joon Kang
Claim Number: FA0608000775107

PARTIES

Complainant is **PanaVise Products, Inc.** ("Complainant"), represented by **Jason Matthew Lamb**, of **The Walker Law Firm, A Professional Corporation**, 1301 Dove Street, Suite 450, Newport Beach, CA 92660. Respondent is **Hae-joon Kang** ("Respondent"), moonlight Villge 2 APT, Hwajung-1dong Duckyang-gu, Koyang city Gyeonggi-do, Koyang city Kyungki do 412735, KR.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**panavisekorea.com**>, registered with **Yesnic Co. Ltd.**

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on August 11, 2006; the National Arbitration Forum received a hard copy of the Complaint on August 31, 2006. The Complaint was submitted in both Korean and English.

On September 12, 2006, Yesnic Co. Ltd. confirmed by e-mail to the National Arbitration Forum that the <**panavisekorea.com**> domain name is registered with Yesnic Co. Ltd. and that Respondent is the current registrant of the name. Yesnic Co. Ltd. has verified that Respondent is bound by the Yesnic Co. Ltd. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On September 13, 2006, a Korean language Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of October 3, 2006 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@panavisekorea.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On October 9, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

Pursuant to Rule 11(a) the Panel determines that the language requirement has been satisfied through the Korean language Complaint and Commencement Notification and, absent a Response, determines that the remainder of the proceedings may be conducted in English.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

[a.] The domain name *PANAVISEKOREA.COM* is confusingly similar to the mark *PANAVISE* in which the Complainant has rights.

Complainant was founded in 1956 by Otto Colbert. Mr. Colbert needed to tilt, turn and rotate die casting dies for repair, and, as such, Complainant's famous "split ball" base was developed and patented. Since 1963, Complainant has been exporting its patented products throughout the world, including the Republic of Korea. In 1968, Complainant received its registration for the mark *PANAVISE*. Complainant has developed substantial goodwill and brand equity in its company name and marks for goods manufactured, marketed, distributed, and sold throughout the United States of America and internationally.

It recently came to Complainant's attention that Respondent was currently intending to manufacture, market, distribute, and/or sell goods similar to Complainant's goods sold under the mark *PANAVISE*. It also came to Complainant's attention that Respondent registered the domain name *PANAVISEKOREA.COM* with YesNIC Co. Ltd. on 31 March 2006 (31.03.2006).

Complainant contends that the domain name is confusingly similar to its marks as the only difference between them is the addition of the word KOREA to the domain name by Respondent. The mere addition of the word KOREA does not make the domain dissimilar to that of Complainant's marks. First, the domain name uses Complainant's protected marks. Second, the addition of the word KOREA makes the domain name appear to be associated with Complainant as an affiliate or subsidiary, or an authorized dealer or representative of Complainant. Complainant, moreover, has a registered the domain name *PANAVISE.COM*. For the same reasons stated-above, the domain name is confusingly similar to Complainant's registered domain name. Accordingly, the domain name is confusingly similar Complainant's marks, and, as such, the domain name should be transferred from Respondent to Complainant.

Therefore, Complainant respectfully requests that the domain name *PANAVISEKOREA.COM* be transferred to it as it is confusingly similar to its protected marks.

- [b.] Respondent should be considered as having no rights or legitimate interests in respect to the domain name that is subject of this Complaint.

Complainant is informed and believes, and upon such information and belief alleges that: (1) Respondent has made demonstrable preparations to use the domain name in connection with a bona fide intent of offering goods similar to Complainant's goods; (2) Respondent is an individual has not been commonly known by the domain name or acquired any trademark or service mark rights in the domain name; and/or (3) Respondent is making or intending to make an illegitimate commercial and non-fair use of the domain name with intent for commercial gain to misleadingly divert Complainant's consumers and/or tarnish Complainant's marks.

- [c.] The domain name should be considered as having been registered and being used, or intended to be used, in bad faith.

Complainant is informed and believes, and upon such information and belief alleges that: (1) Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the marks for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name; (2) Respondent has registered the domain name primarily for the purpose of disrupting the business of Complainant; and/or (3) Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site or other on-line location, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship,

affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Since 1956, Complainant, PanaVise Products, Inc. f/k/a Colbert Die Casting Company, has continuously used the PANAVISE mark in connection with a "split ball" base for tilting, turning and rotating die casting dies for repair.

Complainant holds trademark registrations for the PANAVISE mark with the United States Patent and Trademark Office ("USPTO") (Reg. No. 860,485 issued November 19, 1968) and the Office for Harmonization in the Internal Market (Reg. No. 618,462 issued April 16, 1999).

Respondent registered the <**panavisekorea.com**> domain name on March 31, 2006. Respondent has not made use of the disputed domain name but upon Complainant's information and belief, Respondent is planning on setting up a website offering products and services similar to those Complainant offers under its PANAVISE mark.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

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 the 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.").

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

Complainant's valid trademark registrations for the PANAVISE mark demonstrate its rights in the mark for purposes of Policy ¶4(a)(i). *See Google, Inc. v. DktBot.org*, FA 286993 (Nat. Arb. Forum Aug. 4, 2004) (finding that the complainant had established rights in the GOOGLE mark through its holding of numerous trademark registrations around the world); *see also Thermo Electron Corp et al. v. Xu*, FA 713851 (Nat. Arb. Forum July 12, 2006) (holding that the complainants established rights in marks because the marks were registered with a trademark authority).

Respondent has failed to sufficiently differentiate the <panavisekorea.com> domain name from Complainant's PANAVISE mark by merely adding the term "korea" and generic top-level domain ("gTLD") ".com." In *VeriSign, Inc. v. Tandon*, D2000-1216 (WIPO Nov. 16, 2000), the panel held that the <verisignindia.com> and <verisignindia.net> domain names were confusingly similar to the complainant's VERISIGN mark because the addition of the word "India" and a gTLD was not enough to distinguish the disputed domain names from the complainant's mark. Similar results have been reached in *Hewlett-Packard Company v. Alvaro Collazo*, FA0302000144628 (3/5/2003) and *Schouten Industries B.V. and Schouten Products B.V. v. Canadian SoyLife Health Co. Ltd.*, FA0303000149188 (7/19/2003). Because this case presents similar if not identical circumstances, the Panel finds the <panavisekorea.com> domain name to be confusingly similar to Complainant's PANAVISE mark under Policy ¶4(a)(i). *See Wal-Mart Stores, Inc. v. Walmart Canada*, D2000-0150 (WIPO May 2, 2000) (finding that the domain name, <walmartcanada.com> is confusingly similar to the complainant's famous mark).

The Panel concludes Complainant satisfied Policy ¶4(a)(i).

Rights or Legitimate Interests

Complainant has alleged Respondent lacks rights and legitimate interests in the disputed domain name. Complainant has the initial burden of proof in establishing Respondent lacks rights or legitimate interests in the domain name. Once Complainant makes a *prima facie* case in support of its allegations, the burden then shifts to Respondent to show it does have rights or legitimate interests pursuant to Policy ¶4(a)(ii). *See Hanna-Barbera Productions, Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶4(a)(ii) before the burden shifts to the 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.”).

Respondent’s failure to answer the Complaint raises a presumption Respondent has no rights to or legitimate interests in the disputed domain name. *See Geocities v. Geocities.com*, D2000-0326 (WIPO June 19, 2000) (finding that the respondent has no rights or legitimate interests in the domain name because the respondent never submitted a response or provided the panel with evidence to suggest otherwise); *see also Bank of Am. Corp. v. McCall*, FA 135012 (Nat. Arb. Forum Dec. 31, 2002) (“Respondent’s failure to respond not only results in its failure to meet its burden, but also will be viewed as evidence itself that Respondent lacks rights and legitimate interests in the disputed domain name.”). However, the Panel will now examine the record to determine if Respondent has rights or legitimate interests under Policy ¶4(c).

Respondent has registered the <**panavisekorea.com**> domain name as “Hae-joon Kang,” and there is no other evidence in the record suggesting that Respondent is commonly known by the disputed domain name. Consequently, Respondent has not established rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(c)(ii). *See Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); *see also M. Shanken Commc’ns v. WORLDTRAVELERSONLINE.COM*, FA 740335 (Nat. Arb. Forum Aug. 3, 2006) (finding that the respondent was not commonly known by the <cigaraficionada.com> domain name under Policy ¶4(c)(ii) based on the WHOIS information and other evidence in the record).

Respondent has neither used nor made demonstrable preparations to use the <**panavisekorea.com**> domain name since registering it over six months ago. In *Am. Online, Inc. v. Kloszewski*, FA 204148 (Nat. Arb. Forum Dec. 4, 2003), the panel stated that a respondent’s non-use of a domain name for over six months provided evidence that a respondent lacked rights and legitimate interests in the domain name. In this case as well, the Panel finds Respondent’s non-use of the disputed domain name since March 2006 demonstrates *prima facie* Respondent is not using the <**panavisekorea.com**> domain name in connection with 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). *See Vestel Elektronik Sanayi ve Ticaret AS v. Kahveci*, D2000-1244 (WIPO Nov. 11, 2000) (“Merely registering the domain name is not sufficient to establish rights or legitimate interests for purposes of paragraph 4(a)(ii) of the Policy); *see also Nike, Inc. v. Crystal Int’l*, D2001-0102 (WIPO Mar. 19, 2001) (finding no rights or legitimate interests where the respondent made no use of the infringing domain names).

The Panel concludes Complainant satisfied Policy ¶4(a)(ii).

Registration and Use in Bad Faith

Respondent's failure to use the <panavisekorea.com> domain name since registering it on March 31, 2006 provides evidence of bad faith registration and use. Respondent has constructive knowledge of Complainant's mark since its registration with the United States Patent and Trademark Office on November 19, 1968. In *Caravan Club v. Mrgsale*, FA 95314 (Nat. Arb. Forum Aug. 30, 2000), the respondent registered the <thecaravanclub.com> domain name, which the panel found was identical to the complainant's THE CARAVAN CLUB mark, and made no use of the domain name. The panel held that the respondent's non-use permitted an inference of registration and use in bad faith. Because Respondent here has registered a domain name confusingly similar to a registered mark and not made any use of the domain name for six months, the Panel concludes Respondent has demonstrated bad faith registration and use pursuant to Policy ¶4(a)(iii). See *DCI S.A. v. Link Commercial Corp.*, D2000-1232 (WIPO Dec. 7, 2000) (concluding that the respondent's passive holding of the domain name satisfies the requirement of ¶4(a)(iii) of the Policy).

Complainant asserts without opposition Respondent acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who is the owner of the marks for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name.

Complainant also asserts without opposition Respondent registered the domain name primarily for the purpose of disrupting Complainant's business. Finally, Complainant asserts without opposition Respondent intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site or other on-line location, by creating a likelihood of confusion with Complainant's marks as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location.

The Panel concludes Complainant satisfied Policy ¶4(a)(iii).

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 <panavisekorea.com> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: Monday, October 23, 2006