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THE KOREA DATABASE: WIPO-ADMINISTERED UDRP
DECISIONS, THE FIRST FIFTEEN YEARS (2000–2014)

ILHYUNG LEE*

The Republic of Korea (“Korea”) may be the most wired country in the world.¹ In 2003, the *New York Times* described Korea as “an Internet powerhouse,” with “the world’s most comprehensive Internet network” and most of the country’s population online at high speeds.² The Internet has long played an active role in everyday life in Korean society, affecting politics,³ education,⁴ and marriage,⁵ among others. Internet use in Korea (and elsewhere) also entails the registration of domain names, and occasionally, disputes over domain names. In 1999, the Internet Corporation for Assigned Names and Numerals (“ICANN”) adopted the Uniform Domain Name Dispute Resolution Policy (“UDRP”) to provide an

* Edward W. Hinton Professor of Law & Senior Fellow, Center for the Study of Dispute Resolution, University of Missouri. The author wishes to thank Jacqueline Lipton, Chuck McManis, Gary Myers, and Peter Yu for their comments and suggestions on a previous draft of this article. Sierra S. Clark, Minchung Lee, and Allegra K. Waddell provided invaluable research assistance. As a matter of disclosure, the author has served as a WIPO-appointed panelist in a number of UDRP proceedings. The decisions included herein in which the author was a panelist, either as a sole panelist or as one of a three-member panel, are indicated. My analysis of the panel decisions is based on publicly available sources. This article is dedicated to the memory of Dr. Joong Ho Kim, 1923–2015.

1. Sang Jo Jong, *The World’s Most Wired Nation: A Real-Life Case Study on Digital Rights and the Internet* (Nov. 25, 2014) (copy on file with author); see Sang-Hun Choe, *South Koreans Connect Through Search Engine*, N.Y. TIMES (July 5, 2007), http://www.nytimes.com/2007/07/05/technology/05online.html?_r=0&pagewanted=print.

2. Ken Belson & Matt Richtel, *America’s Broadband Dream Is Alive in Korea*, N.Y. TIMES (May 5, 2003), <http://www.nytimes.com/2003/05/05/business/worldbusiness/05BROA.html>.

3. One Korea observer even identified the Internet specifically as one of the factors that explained Moo-Hyun Roh’s surprising victory in the presidential election of December 2002. Peter M. Beck, *Korea’s Next President*, KOREA INSIGHT (Jan. 2003) (copy on file with author).

4. See *Educ. Testing Serv. v. Hackers Language Inst./David Cho*, Ph.D., WIPO Case No. D2006-1089 (Nov. 27, 2006) (in dispute over <hackerstoefl.com> and <hackerstoec.com>, the Korean respondent asserted that the domain names were used for a bona fide offering of test preparation materials).

5. See *InBev SA, Anheuser-Busch, Inc. v. JS Wook*, WIPO Case No. D2008-1652 (Jan. 19, 2009) (in dispute over <abinbev.com>, the Korean respondent claimed that the domain name was used for a legitimate online dating service).

extrajudicial method of resolving disputes over domain names.⁶ Since then, Korea-based parties have been involved in a number of proceedings, as the complainant (the party alleging abusive registration and use of a domain name), and much more frequently, as the respondent (the registrant of the disputed domain name).⁷ For a country with a comparatively small population, Korea has been an active participant in UDRP proceedings.

This article offers a report and summary of the database of over 800 Korea-related proceedings administered by the World Intellectual Property Organization (WIPO), the first dispute resolution service provider accredited by ICANN, and the first to receive cases under the UDRP.⁸ At the author's request, WIPO provided a list of the UDRP proceedings in which either the complainant's address or the respondent's address was in Korea. Typically, the complainant provides its address in the complaint and the respondent's address is reflected in the registration agreement with the registrar. Whether either party, especially the respondent, is a Korean national or of Korean national origin has not been independently confirmed. Thus, the database of decisions herein may be overinclusive by including some proceedings in which a party claimed a Korean address but may not have any other connection to Korea.⁹ The database errs on the side of inclusion. The database may also be underinclusive, because the list provided might not

6. ICANN, UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (Oct. 24, 1999), <https://www.icann.org/resources/pages/policy-2012-02-25-en> [hereinafter UDRP]. For background, see ICANN, SECOND STAFF REPORT ON IMPLEMENTATION DOCUMENTS FOR THE UNIFORM DISPUTE RESOLUTION POLICY (Oct. 25, 1999), <https://archive.icann.org/en/udrp/udrp-second-staff-report-24oct99.htm> (last visited Jan. 17, 2016) [hereinafter ICANN, SECOND STAFF REPORT]. ICANN adopted the UDRP on the basis of *The Management of Internet Names and Addresses: Intellectual Property Issues*, WIPO, FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS (Apr. 30, 1999), <http://www.wipo.int/export/sites/www/amc/en/docs/report-final1.pdf> [hereinafter WIPO, FINAL REPORT], and the recommendations of others. ICANN, SECOND STAFF REPORT ¶ 4.1.a.

7. See WIPO, COMPLAINANT COUNTRY FILING (RANKING), <http://www.wipo.int/amc/en/domains/statistics/countries.jsp?party=C> (last visited Jan. 17, 2016); WIPO, RESPONDENT COUNTRY FILING (RANKING), <http://www.wipo.int/amc/en/domains/statistics/countries.jsp?party=R> (last visited Jan. 17, 2016).

8. WIPO, WIPO GUIDE TO THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP), <http://www.wipo.int/amc/en/domains/guide/#c> (last visited Dec. 23, 2015) (addressing the question, "To which dispute resolution service provider do I submit my Complaint?"); UDRP ¶ 4(d) (stating the complainant chooses the provider that will administer the proceeding, by submitting the complaint to that provider).

9. For example, there is a small number of decisions from the early years in which the same respondent had a reported address in Kwangju (also referred to as Gwangju), Korea, but the respondent's administrative contact was in Moscow, Russia. *NASDAQ Stock Market, Inc. v. Momm Amed Ia*, WIPO Case No. D2001-1496 (Mar. 15, 2002); *Microsoft Corp. v. Momm Amed Ia*, WIPO Case No. D2001-1454 (Mar. 13, 2002); *T. Rowe Price Assocs. Inc. v. Momm Amed Ia*, WIPO Case No. D2001-0930 (Sept. 27, 2001); *Gen. Elec. Co. v. Momm Amed Ia*, WIPO Case No. D2000-1727 (Mar. 21, 2001); *News Grp. Newspapers Ltd. and News Network Ltd. v. Momm Amed Ia*, WIPO Case No. D2000-1623 (Jan. 18, 2001); see *Expedia, Inc. v. Seocho*, WIPO Case No. D2002-0288 (June 11, 2002) (involving a Korean-named respondent with an administrative contact in Moscow, Russia).

include decisions with a Korean party whose address is outside Korea.¹⁰ With the list in hand, the author created the database of Korea decisions, making necessary adjustments.¹¹

By way of necessary background and introduction, Part I of this article describes the key provisions of the UDRP, the essential elements of the complainant's case, and illustrative decisions from the database. Part II addresses an issue that arises when a non-Korean complainant files a complaint in English against a Korean respondent who insists that the proceeding be conducted in Korean. The manner in which panels have determined the proper language of the proceeding is one of the areas in which the Korea decisions have contributed to the development of the UDRP. Part III discusses selected decisions of interest, including those involving frequent respondents, a frequent complainant, and individual Korean respondents who prevailed against prominent U.S. parties. Finally, Part IV offers a summary of selected statistics relating to the database, which contains over 800 decisions and 1,000 domain names.

I. THE UDRP

The UDRP provides a streamlined, efficient, and inexpensive method of resolving disputes between a trademark owner and a party who allegedly registers and uses a domain name abusively, in violation of the trademark holder's rights. The UDRP is incorporated by reference into every domain name registration agreement between a registrar and a registrant of a domain name. Under the UDRP, if a trademark holder challenges the registrant's domain name, the registrant agrees to submit the dispute to an administrative

10. Some of the decisions in the database that fit this description were captured because the *other* party's address was also in Korea. *E.g.*, Orion Corp. v. Jang, Dong, WIPO Case No. D2012-2184 (Feb. 7, 2013) (stating that the respondent "spent most of its life in the Republic of Korea"); NHN Corp. v. NHN Corp., WIPO Case No. D2003-0939 (Feb. 27, 2004) (stating that the president of the respondent is "of Korean origin, [and] understand[s] the Korean language"); Samsung Corp. v. Tristar Networks, WIPO Case No. D2003-0746 (Nov. 25, 2003) (stating that the U.S. respondent "is clearly of Korean origin"); Cho Yong Pil v. Kee Dooseok, WIPO Case No. D2000-0754 (Aug. 28, 2000) (stating that the U.S. complainant is "a Korean pop music artist"); Cho Yong Pil v. Sinwoo Yoon, WIPO Case No. D2000-0310 (June 19, 2000) (same); Cho Yong Pil v. ImageLand, Inc., WIPO Case No. D2000-0229 (May 10, 2000) (same). The respondent in some proceedings had a Korean name but an address outside of Korea. *E.g.*, Samsung Elecs. Co. v. Seung Kang, WIPO Case No. D2005-0557 (Sept. 5, 2005) (noting that the respondent's address was in Fullerton, California, U.S.); [*Kyobo Life Ins. Co.*] v. Yongku Cho, WIPO Case No. D2004-0553 (Oct. 1, 2004) (noting that the respondent's address was in Torrance, California, U.S.) [decision in Korean]; Kangwon Land, Inc. v. Bong Woo Chun (K.W.L. Inc.), WIPO Case No. D2003-0320 (July 4, 2003) (noting that the respondent's address was in Costa Rica).

11. Some decisions were inadvertently included or excluded in the list that WIPO provided. All WIPO-administered decisions are publicly available on its Internet site, which assists parties and panels in the research and review of decisions of interest. WIPO, SEARCH WIPO CASES AND WIPO PANEL DECISIONS, <http://www.wipo.int/amc/en/domains/search/> (last visited Jan. 17, 2016).

proceeding for resolution. The administrative panel that issues the decision may deny the complaint, allowing the registrant to keep the domain name, or order either cancellation of the domain name or a transfer of the domain name to the mark holder.¹² Importantly, even if the panel decides in favor of the trademark holder and orders cancellation or transfer of the domain name, the panel's decision will not be implemented if the registrant commences a timely action challenging the panel decision in a court of competent jurisdiction.¹³ In reality, however, many named respondents (i.e., domain name registrants) do not participate in UDRP proceedings, and even fewer challenge the administrative decisions in court. Therefore, the panel's decision tends to be the final outcome in a large majority of the cases. WIPO-administered panels have issued decisions in favor of the complainant, the objecting trademark holder, in over 87% of the proceedings.¹⁴

Under paragraph 4(a) of the UDRP, in order for the complainant to prevail, it must demonstrate that

- (i) [the] domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) [the registrant] ha[s] no rights or legitimate interests in respect of the domain name; and
- (iii) [the] domain name has been registered and is being used in bad faith.¹⁵

The complainant has the burden of proving, by a preponderance of the evidence, that all three elements are present.¹⁶ The absence of any one element will lead to a denial of the complaint, allowing the respondent to keep the domain name.

Regarding the first element under paragraph 4(a)(i), there are two components: the complainant must have rights in a mark, and the domain name must be identical or confusingly similar to the mark. Panel decisions have stated that the complainant may demonstrate rights in a mark by registration or common law rights through use.¹⁷ Once rights in a mark are

12. These are the exclusive remedies under the UDRP, which does not allow for damages or other relief. UDRP ¶ 4(i).

13. *Id.* ¶ 4(k).

14. As of June 30, 2015, WIPO panels have ordered the transfer of the domain name in 85.88% of the cases and cancellation in 1.64% of them. The panel denied the complaint in 12.48% of the cases. WIPO, CASE OUTCOME (CONSOLIDATED): ALL YEARS, http://www.wipo.int/amc/en/domains/statistics/decision_rate.jsp?year= (last visited Jan. 17, 2016).

15. UDRP ¶ 4(a).

16. *E.g.*, JGC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim, WIPO Case No. D2013-1838 (Dec. 20, 2013).

17. *E.g.*, SmarTours, Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0964 (Sept. 7, 2007).

established, the panel must determine identical or confusing similarity by engaging in an objective test of comparison between the mark and the domain name.¹⁸ The addition of the generic Top Level Domain (e.g., “.com,” “.net,”) is not generally considered in the comparison.¹⁹

With respect to the second element, paragraph 4(c) provides that for purposes of paragraph 4(a)(ii), “[a]ny of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate . . . rights or legitimate interests to the domain name”:²⁰

- (i) before any notice to [the respondent] of the dispute, [the respondent’s] use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trademark or service mark rights; or
- (iii) [the respondent is] making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.²¹

Regarding the third (i.e., bad faith) element, paragraph 4(b) provides,

For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the respondent] ha[s] registered or . . . ha[s] 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 trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the

18. *E.g.*, *IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim*, WIPO Case No. D2007-1513 (Mar. 4, 2008) (citing *Magnum Piering, Inc. v. Mudjackers & Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525 (Jan. 29, 2001)); *Nursefinders, Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2007-0417 (July 5, 2007).

19. *E.g.*, *Mobile’s Republic v. Kwangpyo Kim*, WIPO Case No. D2014-0089 (Apr. 23, 2014); *Deutsche Lufthansa AG v. [] Kwangpyo Kim*, WIPO Case No. D2013-1844 (Jan. 22, 2014); *Heimbs Kaffee GmbH & Co. KG v. Ho Kyoung Trading Co., Heui-il Kang*, WIPO Case No. D2011-1407 (Oct. 17, 2011); *Reckitt Benckiser Plc v. Eunsook Wi*, WIPO Case No. D2009-0239 (May 20, 2009); *IPGM Inst.*, WIPO Case No. D2007-1513; *STX LLC v. Yu nae ho, Jinsu Kim*, WIPO Case No. D2006-0567 (Aug. 14, 2006); *Jet Marques v. Vertical Axis, Inc.*, WIPO Case No. D2006-0250 (May 26, 2006); *Carfax, Inc. v. COMn.COM*, WIPO Case No. D2002-0513 (Sept. 18, 2002); *SGS Société Générale de Surveillance S.A. v. Inspectorate*, WIPO Case No. D2000-0025 (Mar. 17, 2000).

20. UDRP ¶ 4(c).

21. *Id.*

respondent's] documented out-of-pocket costs directly related to the domain name; or

- (ii) [the respondent] ha[s] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent] ha[s] engaged in a pattern of such conduct; or
- (iii) [the respondent] ha[s] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, [the respondent] ha[s] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] web site or location or of a product or service on [the respondent's] web site or location.²²

In *SGS Société Générale de Surveillance S.A. v. Inspectorate*, the very first WIPO-administered decision involving a Korean party, the panel applied paragraph 4 and ruled in favor of the complainant, ordering the transfer of the disputed domain names.²³ In that case, the complainant, a Swiss corporation, which registered the "SGS" mark in a number of countries, challenged the Korean respondent's registration and use of the domain names <sgs.net> and <sgsgroup.net>.²⁴ The parties acknowledged that they were "fierce" competitors "in the very specialized market of services of certification and inspection in a global environment."²⁵ Panelist Roberto A. Bianchi, of Argentina,²⁶ determined that the complainant met the requisite three elements of paragraph 4(a). Regarding the first element, the panel noted that "[the] Respondent has accepted straightforwardly that the 'SGS' trademarks or service marks are owned by Complainant,"²⁷ and determined that the domain names were confusingly similar to the complainant's marks.²⁸ In finding that the respondent lacked a right or legitimate interest in the domain names, the panel rejected the notion that the

22. *Id.* ¶ 4(b).

23. WIPO Case No. D2000-0025.

24. *Id.*

25. *Id.*

26. According to the panelist profile available on WIPO's Internet site, Panelist Bianchi has both Argentine and Italian nationality. WIPO, ROBERTO AMERICO BIANCHI, WIPO LIST OF NEUTRALS BIOGRAPHICAL DATA (June 4, 2012), <http://www.wipo.int/export/sites/www/amc/en/domains/panel/profiles/bianchi-roberto.pdf>.

27. *SGS Société Générale de Surveillance S.A.*, WIPO Case No. D2000-0025.

28. *Id.* (describing <sgs.net> as "identical or confusingly similar" and <sgsgroup.net> as "confusingly similar").

respondent registered them for its “networking business.”²⁹ The panel also discussed each of the examples of a permissible right or interest under paragraph 4(c) but found them to be absent.³⁰ Turning to the third element, the panel stated that bad faith was present under multiple provisions of paragraph 4(b) – (ii), (iii), and (iv).³¹

Where one or more of the elements of paragraph 4(a) is not established, the panel must deny the complaint. For example, in *SK Energy Sales Co., Ltd. v. Superkey Comdomain*, one of the very first UDRP decisions issued by a Korean panelist, the complainant commenced a UDRP proceeding to challenge the domain name <speedmate.com>.³² The panel found that the complainant was not the owner of the “SPEED MATE” mark, but was instead an exclusive licensee of the mark’s owner.³³ Reasoning that “[a]lthough the license may continue to be granted, it is limited in nature,” and that “[a] license can and may be revoked at any time,” the panel concluded that the complainant did not have rights in the subject mark for purposes of paragraph 4(a)(i), and denied the complaint.³⁴ It must be noted that *SK Energy Sales Co.* was an early decision, and WIPO has since noted, citing subsequent decisions, the consensus view of panelists that “[i]n most circumstances, a licensee of a trademark or a related company such as a subsidiary or parent to the registered holder of a trademark is considered to have rights in a trademark under the UDRP.”³⁵

In addition to the complainant’s rights in a mark, paragraph 4(a)(i) also requires identical or confusing similarity between the domain name and the mark. In *ISL Marketing AG v. J.Y. Chung*, one of the complainants was the Federation Internationale de Football Association (FIFA), which claimed rights in the mark “WORLD CUP”.³⁶ The panel denied the complaint with respect to the domain names <wc2002.com> and <wc02.com>, on the

29. *Id.*

30. *Id.*

31. *Id.* In this light, the panel repeatedly emphasized the respondent’s competing business operations. With respect to paragraph 4(b)(ii), the panel noted that in addition to <sgs.net> and <sgsgroup.net>, the respondent had previously registered <sgsgroup.com>. *Id.*

32. WIPO Case No. D2000-0380 (July 19, 2000). Panelist Young Kim was the author of the decision. *Id.*

33. *Id.*

34. *Id.*

35. WIPO, WIPO OVERVIEW OF WIPO PANEL VIEWS ON SELECTED UDRP QUESTIONS, SECOND EDITION ¶ 1.8 (2001), <http://www.wipo.int/amc/en/domains/search/overview2.0/> [hereinafter WIPO OVERVIEW 2.0].

36. WIPO Case No. D2000-0034 (Apr. 3, 2000).

ground that these domain names were not confusingly similar to FIFA's "WORLD CUP" mark.³⁷ The panel explained:

The fact that [the] domain names . . . both contain the letters <WC> is insufficient to satisfy the requirement of paragraph 4(a)(i) of the Uniform Policy. Whilst it can be argued that <WC> is an abbreviation of <WORLD CUP>, this Administrative Panel does not consider that this is the likely meaning which most people would give to these letters. These letters are open to being interpreted as meaning any number of things, as well as meaning nothing at all. There is nothing in the context of the use of these letters in the domain names that suggests they are an abbreviation of anything. Even if the context of their use did make clear that the letters <WC> were an abbreviation, it is quite likely many native speakers of the English language would consider they were an abbreviation either for "water closet" (and hence an allusion to "toilet") or "West Central" (see *Concise Oxford English Dictionary*, entry for "WC"), or for "without charge" (see *Merriam-Webster's Collegiate Dictionary*, entry for "WC") In short, the letters <WC>, even in conjunction with the year <2002> or the year abbreviation <02>, do not likely suggest <WORLD CUP>, and hence [the] domain names . . . are not confusingly similar to any of the trademarks³⁸

The second requisite element under paragraph 4(a) relates to the respondent's right or interest with respect to the disputed domain name. If the panel finds evidence that the respondent has such a right or interest, the complaint fails. An example is seen in *UTV Ltd. v. Unitedeuropa Consulting, Kwang Pyo Kim*, where the complainant, based in Belfast, Northern Ireland, had trademark rights in "UTV" (originally, Ulster Television) and challenged the Korean respondent's registration and use of <utv.com>.³⁹ The panel determined that the domain name was identical or confusingly similar to the mark in which the complainant had rights, but denied the complaint on the ground that respondent had a right or interest in respect of the domain name.⁴⁰ The respondent acknowledged that it registered a number of "common word domain names and combined letter domain names for investment and development."⁴¹ Noting the lack of evidence to support the complainant's argument that its mark had a "strong reputation" or that the respondent was aware of the complainant's mark, the panel was "of the

37. *Id.* The panel found the requisite elements to be present and ordered the transfer to FIFA thirteen of the fifteen disputed domain names: <worldcup2002.com>; <worldcup2002.net>; <worldcup2002.org>; <worldcup02.org>; <worldcup10.com>; <2002worldcup.org>; <worldcup02.net>; <2002worldcup.net>; <worldcup2006.org>; <worldcup2010.com>; <worldcup2010.org>; <worldcup2010.net>; and <2006worldcup.org>. *Id.*

38. *Id.*

39. WIPO Case No. D2011-2293 (Mar. 5, 2012).

40. *Id.*

41. *Id.*

opinion that the disputed domain name is merely a generic short acronym in which the Respondent has a legitimate interest to use.”⁴²

The bad faith element has provided the basis for the panel to deny the complaint in a majority of cases. Or, put another way, there is a number of decisions where the panel found that the first two elements of paragraph 4(a) were established, but denied the complaint due to the absence of bad faith.⁴³ Preliminarily, panels have held that bad faith on the part of the respondent generally presumes that the respondent, at the time it registered the domain name, was aware of the complainant and the complainant’s mark on which the respondent sought to capitalize.⁴⁴ Thus, bad faith requires evidence of knowledge of the complainant and its mark, or more frequently, “facts that might support an inference of knowledge,” such as a well-known or famous mark.⁴⁵ Of course, where the respondent’s registration of the domain name predates the complainant’s rights in a mark, the respondent could not have known about the complainant or its mark, and bad faith is difficult to prove.⁴⁶

A review of the decisions in the database indicates that bad faith is most commonly established by evidence supporting the circumstances described in paragraph 4(b)(i) (i.e., registering the domain name primarily for the purpose of selling it to the complainant or a competitor for a price in excess of the respondent’s out-of-pocket costs), or 4(b)(iv) (using the domain name in an attempt to attract Internet users to the website by creating a likelihood of confusion with the complainant’s mark). But there are decisions in which

42. *Id.*

43. *E.g.*, Segis SPA v. Kwon Tong Wan, WIPO Case No. D2013-0725 (June 20, 2013); China Care Found., Inc. v. Choi Yun Gul, WIPO Case No. D2010-1208 (Nov. 10, 2010); Manufacturas Muñoz S.A. Colombia v. Choi Sungyeon, WIPO Case No. D2010-0312 (Apr. 26, 2010); SDLC SAS v. H.S Kim, WIPO Case No. D2007-1003 (Sept. 10, 2007); Builder’s Best, Inc. v. Yoshiki Okada, WIPO Case No. D2004-0748 (Nov. 17, 2004); Mitsubishi Motors Corp. v. sDns.com, WIPO Case No. D2001-1031 (Oct. 22, 2001). In some cases, the panel, after determining that the first element was met, stated that it was not necessary to reach a conclusion on the second element relating to the respondent’s right or interest, due to the panel’s dispositive conclusion regarding the third element of bad faith. *E.g.*, Kyle Grant v. jeongyong cho, WIPO Case No. D2013-1697 (Dec. 16, 2013); Petrogas Grp. Ltd. v. Kim Sooyong - (Arisu Tech), WIPO Case No. D2013-0749 (June 12, 2013); Société DADIER v. info, WIPO Case No. D2011-1034 (Aug. 10, 2011); GRUPORPP S.A. v. RPP, WIPO Case No. D2011-0371 (Apr. 28, 2011); GetMore A/S v. Arisu Tech, WIPO Case No. D2008-1595 (Dec. 22, 2008), *re-filed, denied*, GetMore A/S v. Sooyong Kim, WIPO Case No. D2009-0357 (June 2, 2009); Lantek Commc’ns, Inc. v. Jae Wan, Lee, WIPO Case No. D2004-1020 (Mar. 17, 2005); Craig Media, Inc. v. Kim Hyungho, WIPO Case No. D2004-0091 (Mar. 22, 2004).

44. *E.g.*, Telefire Fire & Gas Detectors Ltd. v. Easy Prop. Mgmt. Grp., WIPO Case No. D2013-1003 (Sept. 6, 2013); *Builder’s Best, Inc.*, WIPO Case No. D2004-0748; *Craig Media, Inc.*, WIPO Case No. D2004-0091 (Mar. 22, 2004).

45. JJC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim, WIPO Case No. D2013-1838 (Dec. 20, 2013).

46. *E.g.*, *GRUPORPP*, WIPO Case No. D2011-0371; *Lantek Commc’ns, Inc.*, WIPO Case No. D2004-1020.

the panel rejected these grounds as a possible basis for bad faith, as discussed below.

Panel decisions have determined that the respondent's offer to sell the domain name to the complainant does not, by itself, satisfy bad faith under paragraph 4(b)(i). In this regard, the specific circumstances of the individual cases are important. In *FreedomCard, Inc. v. Mr. Taeho Kim*, the U.S.-based complainant that claimed rights to the "FREEDOM CARD" mark—which was registered for "Insurance and financial services, namely credit card services, banking services, financial management, investment brokerage services; and financial analysis and consulting services"—challenged the registration and use of the domain name <freedomcard.com>.⁴⁷ The respondent was a Korean web designer who conceded that he registered the domain name "with the purpose of either developing a website or selling the name."⁴⁸ Before the commencement of the proceeding, in response to a query from a representative of the complainant about whether the domain name was for sale, the respondent stated that the domain name "is on the negotiation with other buyer from us. The price range is \$20,000us If you can be affordable over \$20,000us, let me know immediately."⁴⁹ The panel declined to find bad faith under paragraph 4(b)(i), stating,

[H]aving regard principally to the generic nature of the domain name, to the absence of evidence that Respondent was aware of Complainant or its mark at the time of registration and to the fact that Respondent did not approach Complainant to solicit the sale of the domain name, the Panel is not satisfied that sale at a profit to Complainant or to a competitor of Complainant was the Respondent's primary purpose in registering the domain name.⁵⁰

Likewise, in *Manufacturas Muñoz S.A. Colombia v. Choi Sungyeon*, the respondent's asking price for the domain name ranged from US\$5,000 to \$25,000, which the panel described as "somewhat suspicious and disconcerting" and "somewhat high."⁵¹ Nevertheless, the panel determined that bad faith could not be found where the domain name was acquired six years before the complainant obtained rights in the corresponding mark.⁵² The panel also added that "there is no evidence to suggest that Respondent did not pay the same amount itself in originally acquiring the Disputed

47. WIPO Case No. D2001-1320 (Jan. 20, 2002).

48. *Id.*

49. *Id.* At the time, the representative did not disclose his association with the complainant. *Id.*

50. *Id.*

51. WIPO Case No. D2010-0312 (Apr. 26, 2010).

52. *Id.*

Domain Name.”⁵³ In another decision where the complainant sought to establish bad faith under paragraph 4(b)(i), the panel distinguished between the respondent’s offer to sell and the respondent’s reply to the complainant’s offer to purchase; the reply indicated that the respondent did “not object to selling the Domain Name.”⁵⁴ The panel also denied the complaint due to a lack of bad faith.⁵⁵

Panel decisions have also elaborated on a respondent’s alleged use of the domain name to attract Internet users to the respondent’s website by creating a likelihood of confusion with the complainant’s mark as a basis for finding bad faith under paragraph 4(b)(iv). The panel rejected the complainant’s efforts to establish bad faith on this ground in *SBC Communications, Inc. v. Boolgook Corp.*⁵⁶ In that case, the complainant, a co-owner of “BELL”, who also registered “SOUTHWESTERN BELL”, sought transfer of the domain names <mailbell.com> and <mailbell.net>.⁵⁷ The panel noted that whether the respondents’ use of the domain names amounted to bad faith under paragraph 4(b)(iv) was “the critical question to be determined here”:⁵⁸

Even assuming, in the Complainant’s favour, that an internet user would be attracted by the “mailbell” Domain Names to visit these sites in the belief that they may be sites that are those of, or endorsed by, the Complainant, it does not seem likely to the Panel that anybody viewing the web pages found at these Domain Names would be remotely likely to think they were anything to do with any of the BELL operating companies. The entire content of the pages . . . seems to this Panel inconsistent with

53. *Id.* Likewise, in *Lantek Commc’ns, Inc. v. Jae Wan, Lee*, WIPO Case No. D2004-1020 (Mar. 17, 2005), where the domain name was registered two years before the complainant’s mark was registered, the panel noted that the respondent’s offer of US\$3,000 to sell the domain name to the complainant was “not on its own in contravention of the Policy. As stated in numerous UDRP decisions, absent other indications of bad faith, a domain name registrant is free to sell, rent or otherwise deal with a domain name just like any piece of corporeal property.”

54. *Mitsubishi Motors Corp. v. sDns.com*, WIPO Case No. D2001-1031 (Oct. 22, 2001).

55. *Id.*

56. WIPO Case No. D2002-0474 (July 24, 2002).

57. *Id.* The respondent in the proceeding had applied to register the mark “M@ILBELL” in the U.S. Patent and Trademark Office, “but allowed this application to lapse.” *Id.* The <mailbell.com> domain name resolved to a site that described

“M@ailBell” as “the leading Internet destination for premium E-mailchecker” (see the “About M@ailBell” section of the website). It continues, “We present an independent editorial selection of the world’s best products, combined with in-depth information from sponsoring manufacturers. M@ilBell Shopping purchase e-mailchecker from your nearest retailers or directly online. Our editorial staff is . . . always looking for new products, manufacturers, and categories to serve your discriminating e-mailchecker”.

Id.

58. *Id.* Initially, the panel stated that its decision regarding the bad faith element was dispositive and that it was unnecessary to determine whether the complainant demonstrated the first two elements, though it expressed “severe reservations” that the complainant did so. *Id.*

such a finding. In the absence of any evidence of actual confusion of this nature the Panel is not able to infer that this is the case.⁵⁹

II. THE LANGUAGE OF THE UDRP PROCEEDING: KOREA CONTRIBUTION

Given “the international character of the Internet,”⁶⁰ and the possibility that parties in a dispute over a domain name may be from different countries, the matter of the language of the UDRP proceeding is a procedural question of some significance. Paragraph 11 of ICANN’s Rules for Uniform Domain Name Dispute Resolution Policy (“UDRP Rules”)⁶¹ addresses the language question squarely, stating in full:

11. Language of Proceedings

- (a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.
- (b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.⁶²

In brief, the parties may agree that a language other than the language of the registration agreement will be the language of the proceeding.⁶³ In the

59. *Id.*

60. IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim, WIPO Case No. D2007-1513 (Mar. 4, 2008) (citations omitted).

61. ICANN, RULES FOR UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY, <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en> (2015) [hereinafter UDRP RULES]. ICANN originally approved the rules on October 24, 1999, and later approved amendments, on October 30, 2009, and September 28, 2013. *See id.* The UDRP Rules address procedural matters of a UDRP proceeding. WIPO has also adopted supplemental procedural rules for proceedings that it administers. WIPO, WORLD INTELLECTUAL PROPERTY ORGANIZATION SUPPLEMENTAL RULES FOR UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY, <http://www.wipo.int/amc/en/domains/rules/supplemental/> (1999) [hereinafter WIPO SUPP. RULES].

62. UDRP RULES ¶ 11. The UDRP documents do not define “language of the administrative proceeding.” But paragraph 2 of the UDRP Rules, which is entitled “Communications” and refers to communications by the provider to the parties, and by the parties to the provider and the panel, states, “Communications shall be made in the language prescribed in Paragraph 11.” *Id.* ¶ 2(d).

63. *E.g.*, Samsung Networks, Inc. v. ABC Co., WIPO Case No. D2004-0727 (Dec. 28, 2004) (noting that even though English is the language of the registration agreement, since both parties are fluent in Korean and they submitted papers in Korean, the decision would be in Korean) [decision in Korean]; Samsung Networks, Inc. v. ss RC, WIPO Case No. D2004-0560 (Oct. 6, 2004) (same) [decision in Korean]; *see* Hertz Sys., Inc. v. Jeff Park, WIPO Case No. D2007-1120 (Nov. 9, 2007) (noting that the U.S. complainant provided evidence that the Korean respondent agreed to conduct the proceeding in English, despite a Korean registration agreement).

absence of such an agreement, the default is the language of the registration agreement, and panels have summarily selected that language as the language of the proceeding, whether it is Korean⁶⁴ or English.⁶⁵ But the panel has the authority to depart from the language of the registration agreement, and also to order translations.⁶⁶

Three themes emerge from the text of paragraph 11, which relate to: (i) characteristics of the arbitration method, especially in the international setting; (ii) concerns of procedural due process, principally with respect to the respondent's right to receive proper notice of the claim against it and an opportunity to present its own case; and (iii) the panel's discretion to address situations of potential party abuse, mindful of the streamlined procedure for which the UDRP is intended. These points are addressed in turn.

Paragraph 11 appears to adopt the approach seen in the rules of some international arbitration administering organizations regarding the language of the arbitration proceeding. One provision of the rules of the American Arbitration Association for international arbitrations is particularly illustrative: "If the parties have not agreed otherwise, the language(s) of the arbitration shall be the language(s) of the documents containing the arbitration agreement, subject to the power of the arbitral tribunal to determine otherwise."⁶⁷ Likewise, in the related UDRP procedural rule, party autonomy permits the parties to agree to conduct the proceeding in a language different from that of the registration agreement; failing agreement, the panel has the discretion to choose a language that it determines to be

64. *E.g.*, *Air Dolomiti S.p.A. v. Lee, Li-hwa*, WIPO Case No. D2008-1827 (Apr. 9, 2009) [decision in Korean]; *Conoco Inc. v. Conocophillips Inc.*, WIPO Case No. D2002-0346 (June 25, 2002) [decision in Korean].

65. *E.g.*, *G.M. Studio Design & Fashion S.N.C. v. Lee, Hyun Woong*, WIPO Case No. D2007-1770 (Jan. 31, 2008); *O2 Holdings Ltd. v. Guen-Tea Park*, WIPO Case No. D2005-0588 (Aug. 26, 2005); *Pfizer Inc. v. Mmyongjin Kim*, WIPO Case No. D2005-0083 (May 19, 2005).

66. UDRP RULES ¶ 11(a)–(b).

67. Am. Arbitration Assoc., INTERNATIONAL ARBITRATION RULES, art. 18 (2014), <https://www.adr.org/aaa/ShowProperty?nodeId=/UCM/ADRSTAGE2020868&revision=latestreleased>; *see* Int'l Chamber of Commerce, ICC RULES OF ARBITRATION, art. 20 (2012), <http://www.iccwbo.org/products-and-services/arbitration-and-adr/arbitration/icc-rules-of-arbitration/> ("In the absence of an agreement by the parties, the arbitral tribunal shall determine the language or languages of the arbitration, due regard being given to all relevant circumstances, including the language of the contract."); London Court of Int'l Arbitration, LCIA Arbitration Rules (2014), arts. 17.1, 17.4 (2014), http://www.lcia.org/Dispute_Resolution_Services/lcia-arbitration-rules-2014.aspx ("The initial language of the arbitration (until the formation of the Arbitral Tribunal) shall be the language or prevailing language of the Arbitration Agreement, unless the parties have agreed in writing otherwise."; "Following the formation of the Arbitral Tribunal, unless the parties have agreed upon the language or languages of the arbitration, the Arbitral Tribunal shall decide upon the language(s) of the arbitration after giving the parties a reasonable opportunity to make written comments and taking into account the initial language(s) of the arbitration and any other matter it may consider appropriate in the circumstances.").

appropriate.⁶⁸ Panels must exercise such discretion “judicially in the spirit of fairness and justice to both parties,” and with the procedural due process interests of the respondent in mind.⁶⁹ As noted above, the UDRP provides that the respondent may, in a court action, challenge the panel’s decision ordering the transfer of the domain name. The respondent may then argue that it was not given proper notice of the proceeding or the claim against it, because the submissions were not in a language that the respondent could understand, which deprived the respondent of the opportunity to present a defense.⁷⁰ As one panel noted, the language provision is “designed to provide the Respondent with a fair opportunity to present its case.”⁷¹

Finally, paragraph 11 allows the panel to address potential party abuse. For instance, there is the possibility of the respondent insisting on a Korean proceeding, even when the respondent is proficient in English, for the purpose of delay, cost, frustration, or obfuscation—the kind of activity to which an unscrupulous cybersquatter might subscribe. There are examples of the respondent changing the registrar in order to obtain a new registration agreement in Korean, and then requesting the UDRP proceeding to be in the Korean language.⁷² One panel found that this maneuver “served to complicate [the] administrative proceeding,”⁷³ which “was no doubt intended to make life much more difficult for the Complainant, requiring translation of the Complaint into another language.”⁷⁴ Another described the act as an effort “to disrupt [the] proceeding and to frustrate the Complainant to the greatest extent possible.”⁷⁵ In such cases, the panel rejected the respondent’s request for the Korean language and determined that the proceeding would be conducted in English.⁷⁶

In some of the earlier decisions in the database where the registration agreement was in Korean but the complainant filed the complaint in English,

68. UDRP RULES ¶ 11(a).

69. *Intesa Sanpaolo S.p.A. v. Linecom*, WIPO Case No. D2009-1492 (Dec. 28, 2009); *Toyota Motor Credit Corp. v. Kilsoo Jung*, WIPO Case No. D2008-0731 (July 22, 2008).

70. One decision, which does not address the language issue, stated, “One fundamental requirement of due process is that a respondent has notice of proceedings that may substantially affect its rights. The Policy, Rules, and Supplemental Rules establish procedures intended to assure that a respondent is given adequate notice of proceedings commenced against it and a reasonable opportunity to respond” *Google Inc. v. Dzone Inc.*, WIPO Case No. D2011-1033 (July 26, 2011).

71. *Playboy Enters. Int’l, Inc. v. Sookwan Park*, WIPO Case No. D2001-0778 (Oct. 1, 2001).

72. *E.g.*, *Banco Itau S.A. v. Webmedia*, WIPO Case No. D2008-0531 (July 18, 2008); *L’Oreal S.A. v. MUNHYUNJA*, WIPO Case No. D2003-0585 (Nov. 17, 2003); *Playboy Enters. Int’l, Inc.*, WIPO Case No. D2001-0778.

73. *Banco Itau S.A.*, WIPO Case No. D2008-0531.

74. *Id.*

75. *L’Oreal S.A.*, WIPO Case No. D2003-0585.

76. *Id.*

WIPO notified the complainant that the complaint was “administratively deficient” and directed the complainant to file the complaint in Korean.⁷⁷ This was presumably pursuant to a provision of the UDRP Rules⁷⁸ and WIPO’s own Supplemental Rules.⁷⁹ In some cases, WIPO gave the complainant the option of providing evidence of an agreement between the parties to depart from the language of the agreement, or filing the complaint in Korean.⁸⁰ In subsequent proceedings, WIPO, still characterizing the English complaint as “deficient” in light of the language of the registration agreement, directed the complainant to submit a request to proceed in English with an explanation for the request.⁸¹

Later decisions indicate that WIPO’s practice turned to issuing, in both Korean and English, a “Language of Proceedings” notice to the parties before notification of the proceeding’s commencement. The notice directed the complainant to submit: evidence of an agreement between the parties that the proceeding should be in English, the complaint translated into Korean, or a request for English to be the language of the proceeding.⁸² The same notice informed the respondent that it could object to the complainant’s request for English and comment on the complainant’s submission regarding the language issue.⁸³ After receiving the complainant’s request for English to be the language of the proceeding and reasons thereto, WIPO, in its notification to the parties of the commencement of the proceeding, informed the parties, again in both Korean and English, that it would accept the complaint in English and the response in either English or Korean.⁸⁴ WIPO also informed the parties that it would appoint a panel familiar with both

77. *E.g.*, *Chivas Bros. Ltd. v. Anyweb Co., Ltd.*, WIPO Case No. D2006-1446 (Feb. 2, 2007); *see Viterra Energy Servs. GmbH & Co. KG v. Com & Network*, WIPO Case No. D2004-0258 (June 1, 2004).

78. Paragraph 4(b) of the original UDRP Rules, stated in part, “If the Provider finds the complaint to be administratively deficient, it shall promptly notify the Complainant and the Respondent of the nature of the deficiencies identified. The Complainant shall have five (5) calendar days within which to correct any such deficiencies” ICANN, ARCHIVED RULES FOR UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY, <https://archive.icann.org/en/dndr/udrp/uniform-rules-24oct99-en.htm> (1999). This rule is still intact in the current version of the UDRP Rules. UDRP RULES ¶ 4(d).

79. WIPO SUPP. RULES ¶ 4(b) (“Complaint Transmittal Coversheet. The Complainant shall be required to send or transmit its complaint under cover of the Complaint Transmittal Coversheet Where available, the Complainant shall use the version that is in the same language(s) as the registration agreement(s) for the domain name(s) that is/are the subject of the complaint.”).

80. *E.g.*, *Viterra Energy Servs. GmbH & Co. KG v. Com & Network*, WIPO Case No. D2004-0258 (June 1, 2004).

81. *E.g.*, *TCN, Inc. v. 3v Networks*, WIPO Case No. D2008-0134 (June 4, 2008); *Laboratoire Nutergia v. Jeongyong Cho*, WIPO Case No. D2007-1582 (Jan. 14, 2008).

82. *E.g.*, *GetMore A/S v. Sooyong Kim*, WIPO Case No. D2009-0357 (June 2, 2009); *Fissler GmbH v. Chin Jang Ho*, WIPO Case No. D2008-1002 (Sept. 9, 2008).

83. *E.g.*, *GetMore A/S*, WIPO Case No. D2009-0357; *Fissler GmbH*, WIPO Case No. D2008-1002.

84. *E.g.*, *GetMore A/S*, WIPO Case No. D2009-0357; *Fissler GmbH*, WIPO Case No. D2008-1002.

English and Korean, if available, and that the panel has the ultimate authority to determine the language of the proceeding.⁸⁵ This evolved practice—of notification to the parties in both languages—appears to be WIPO’s current procedure when a complaint is filed in a language different from that of the registration agreement.⁸⁶

The matter of the language of the UDRP proceeding is addressed in WIPO’s Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”), which provides a summary of panel decisions on key procedural and substantive issues that commonly arise.⁸⁷ Decisions involving a Korean party are prominently mentioned in the portion of the overview that addresses the language of the proceeding, and specifically, panel discretion under paragraph 11.⁸⁸ This portion cites to ten relevant panel decisions, half of which involve a Korean respondent.⁸⁹ Among the many issues in which the Korea decisions contribute to the understanding of the UDRP text and procedural rules, the contribution is perhaps most significant regarding the language issue.

The vast majority of Korea-related UDRP decisions involve a non-Korean complainant and a Korean respondent. The language issue arises most vividly when the registration agreement is in Korean, but the complainant files the complaint in English, to which the respondent objects,⁹⁰

85. *E.g.*, *Boyd Flotation, Inc. v. Noori net*, WIPO Case No. D2010-1630 (Nov. 30, 2010); *L.M.X. holding v. admin, Han-Jin Ko*, WIPO Case No. D2009-1514 (Dec. 30, 2009); *GetMore A/S*, WIPO Case No. D2009-0357; *Minka Lighting, Inc. v. Lee Wongi*, WIPO Case No. D2004-0984 (Feb. 22, 2005) (author was a member of the three-member panel). An excerpted quotation of WIPO’s correspondence to the parties regarding the language of the proceeding is available in the author’s decision in *LEGO Juris A/S v. Linecom*, WIPO Case No. D2012-1800 (Nov. 16, 2012).

86. WIPO OVERVIEW 2.0, *supra* note 35, ¶ 4.3 (“What is the proper language of the proceeding and what are the relevant considerations in this regard?”).

87. *Id.* (prefatory paragraph). The overview indicates the consensus or clear majority views on some issues, as well other questions that have attracted “a diversity of views.” *Id.* WIPO notes that although neither the overview nor prior panel decisions are binding on the panels, “predictability remains a key element of dispute resolution systems.” *Id.*

88. *Id.*

89. *Id.* The five cited decisions involving a Korean party are discussed herein: *L’Oreal S.A. v. MUNHYUNJA*, WIPO Case No. D2003-0585 (Nov. 17, 2003) (see *supra* text accompanying notes 70, 75, 76; *infra* notes 90, 119); *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. D2003-0679 (Nov. 13, 2003) (see *infra* text accompanying notes 92–94); *MySpace Inc. v. Will Eom*, WIPO Case No. D2008-0448 (June 30, 2008) (author served as sole panelist) (see *infra* note 102); *Fissler GmbH v. Chin Jang Ho*, WIPO Case No. D2008-1002 (Sept. 9, 2008) (see *supra* text accompanying notes 82, 83, *infra* note 97); *Biotechnology & Biological Scis. Research Council v. Kim Jung Hak*, WIPO Case No. D2009-1583 (Feb. 9, 2010) (see *infra* text accompanying note 100).

90. The respondent sometimes explicitly states that it does not understand the English correspondence. *E.g.*, *L.M.X. holding v. admin, Han-Jin Ko*, WIPO Case No. D2009-1514 (Dec. 30, 2009); *TCN, Inc. v. 3v Networks*, WIPO Case No. D2008-0134 (June 4, 2008); *Viterra Energy Servs. GmbH & Co. KG v. Com & Network*, WIPO Case No. D2004-0258 (June 1, 2004); *Samsung Corp. v. Tristar Networks*, WIPO Case No. D2003-0746 (Nov. 25, 2003); *L’Oreal*, WIPO Case No. D2003-0585.

insisting that the proceeding occur in Korean.⁹¹ The several relevant panel decisions appear to reflect a cottage industry of litigating the language question. In *Deutsche Messe AG v. Kim Hyungho*, Panelist Boh Young Hwang wrote, “The spirit of paragraph 11 is to ensure fairness in the selection of language by giving full consideration to the parties’ level of comfort[] with each language, the expenses to be incurred[,] . . . possibility of delay in the proceeding in the event translations are required[,] and other relevant factors.”⁹² In that proceeding, although the registration agreement was in Korean, Panelist Hwang determined that English would be the language of the proceeding, due to the respondent’s ability to understand English (as indicated by the parties’ correspondence), the complainant’s inability to communicate in Korean,⁹³ and the delay that would occur and the additional expenses that the complainant would have to bear, if translation to Korean were required.⁹⁴ This approach taken by Panelist Hwang—beginning with the spirit of paragraph 11 and followed by the reasons and conditions for adopting English as the language of the proceeding despite a Korean registration agreement—has been seen in a number of subsequent decisions.⁹⁵

91. Objecting to English as the language of proceeding, the respondent has sometimes not participated further in the proceeding and defaulted. *E.g.*, *Xstrata v. KpOREA*, WIPO Case No. D2012-1073 (Aug. 7, 2012); *Airasia Berhad v. Park sung mo*, WIPO Case No. D2011-0933 (Aug. 22, 2011); *GRUPORPP S.A. v. RPP*, WIPO Case No. D2011-0371 (Apr. 28, 2011); *Turkiye Halk Bankasi A.S. v. y.g jo*, WIPO Case No. D2007-1628 (Jan. 25, 2008). Or continuing to insist on Korean, and as permitted by WIPO’s dual language approach, the respondent has filed its response in Korean. *E.g.*, *LEGO Juris A/S v. Lee Young Ju*, WIPO Case No. D2013-0812 (July 19, 2013); *GetMore A/S v. Sooyong Kim*, WIPO Case No. D2009-0357 (June 2, 2009); *Viator, Inc. v. iContents, Brian Yu*, WIPO Case No. D2008-0190 (June 19, 2008); *TCN, Inc. v. 3v Networks*, WIPO Case No. D2008-0134 (June 4, 2008); *Massive, Inc. v. Ricky Park*, WIPO Case No. D2008-1375 (Dec. 11, 2008); *Julbo v. Lee, Jong-Guk*, WIPO Case No. D2006-0870 (Sept. 11, 2006). In one proceeding, the respondent requested correspondence in Korean, noting the financial burden in obtaining translation from English to Korean. *Viterra Energy Servs. GmbH & Co. KG*, WIPO Case No. D2004-0258. The respondent then submitted its response in English, giving no explanation as to why. *Id.*

92. WIPO Case No. D2003-0679 (Nov. 13, 2003). Until her untimely passing in 2009, Panelist Hwang was the most prolific Korean author of UDRP panel decisions.

93. *Id.* In one proceeding, the “Complainants and their representative certified that they did not master the Korean language and that access to qualified translators would have been both difficult and costly.” *Raisio plc and Town of Raisio v. Lee Joohee, Yang Youngho*, WIPO Case No. D2005-1041 (Dec. 14, 2005).

94. *Deutsche Messe*, WIPO Case No. D2003-0679. Panelist Hwang emphasized that the determination of English as the language of the proceeding was on the condition that the respondent was permitted to submit any materials in Korean. *Id.*

95. *E.g.*, *Massive, Inc. v. Ricky Park*, WIPO Case No. D2008-1375 (Dec. 11, 2008); *Viator, Inc. v. iContents, Brian Yu*, WIPO Case No. D2008-0190 (June 19, 2008); *Mangels Indústria e Comércio Ltda., Mangels Industrial S/A v. Eweb*, WIPO Case No. D2005-0598 (July 28, 2005); *Amazon.com v. Kim Yoon-Jo*, WIPO Case No. Case No. D2003-0774 (Mar. 2, 2004); *Groupe Industriel Marcel Dassault, Dassault Aviation v. Mr. Minwoo Park*, WIPO Case No. D2003-0989 (Feb. 12, 2004).

Panels have further elaborated on the respondent's ability to proceed in English. In addition to the respondent's apparent command of the language as demonstrated by its correspondence with the complainant, sufficient ability may also be evidenced by a response in Korean that is responsive to points contained in the English-language complaint,⁹⁶ as well as by the English content of the resolving website.⁹⁷ Regarding the latter, one panel stated that where the respondent's website is

directed at English-speaking Internet users[, i]t would not be possible for Respondent to operate an English-language website unless Respondent or his staff had the ability to read and understand the website. Moreover, by operating an English-language website, Respondent is holding himself out to the public as having at least some ability to communicate in English.⁹⁸

Another panel declared, "If an entity conducts activities in English, it is difficult for that entity to object if someone complains about such activities in English."⁹⁹

Panels have also determined that a respondent's default in the proceeding may be a relevant factor in determining that English is the language of the proceeding.¹⁰⁰ As one panel indicated, in a case where the respondent did not respond to WIPO's Language of Proceeding notice and

96. In all of the following decisions, the response was in Korean, which, according to the panel, reflected an understanding of the contents of the complaint and the points therein: *LEGO Juris A/S v. Lee Young Ju*, WIPO Case No. D2013-0812 (July 19, 2013); *GetMore A/S v. Sooyong Kim*, WIPO Case No. D2009-0357 (June 2, 2009); *Viator, Inc.*, WIPO Case No. D2008-0190; *TCN, Inc. v. 3v Networks*, WIPO Case No. D2008-0134 (June 4, 2008); and *Julbo v. Lee, Jong-Guk*, WIPO Case No. D2006-0870 (Sept. 11, 2006).

97. *E.g.*, *Arcadia Grp. Brands Ltd. v. Richard Yaming*, WIPO Case No. D2012-1490 (Sept. 11, 2012); *Wal-Mart Stores, Inc. v. WalMart Careers, Inc.*, WIPO Case No. D2012-0285 (Apr. 11, 2012); *NH Hoteles, S.A. v. Will Eom*, WIPO Case No. D2010-0227 (Apr. 9, 2010); *L.M.X. Holding v. admin, Han-Jin, Ko*, WIPO Case No. D2009-1514 (Dec. 30, 2009); *Intesa Sanpaolo S.p.A. v. Linecom*, WIPO Case No. D2009-1492 (Dec. 28, 2009); *GetMore A/S v. Sooyong Kim*, WIPO Case No. D2009-0357 (June 2, 2009); *IVECO S.p.A. v. Linecom*, WIPO Case No. D2008-1726 (Jan. 31, 2009); *Fissler GmbH v. Chin Jang Ho*, WIPO Case No. D2008-1002 (Sept. 9, 2008); *Viator, Inc.*, WIPO Case No. D2008-0190; *TCN, Inc.*, WIPO Case No. D2008-0134; *Deutsche Telekom AG v. Unitedeuropa Consulting*, WIPO Case No. D2006-0930 (Dec. 27, 2006). The fact that the domain name is in English may also be relevant. *GetMore A/S*, WIPO Case No. D2009-0357; *NBC Universal, Inc. v. Junak Kwon*, WIPO Case No. D2004-0764 (Dec. 23, 2004) (opinion of Sir Ian Barker).

98. *Arcadia Grp. Brands Ltd.*, WIPO Case No. D2012-1490.

99. *NH Hoteles, S.A.*, WIPO Case No. D2010-0227 (citing *Burger King Corp. v. Burger King S.R.L.*, WIPO Case No. DRO2008-0012 (Sept. 15, 2008)). One panel stated, "[T]he Respondent does not use a Korean name when writing his name in English. The Panel notes that the use of a 'Western' name is not unusual in Korea if a person communicates in English or is in frequent contact with non-Korean speakers, but it would be very rare indeed to do so if the Korean person had no English ability." *Viator, Inc.*, WIPO Case No. D2008-0190

100. *E.g.*, *VKR Holding A/S v. Noorinet*, WIPO Case No. D2011-1360 (Oct. 13, 2011); *Airasia Berhad v. Park sung mo*, WIPO Case No. D2011-0933 (Aug. 22, 2011); *Biotechnology & Biological Scis. Research Council v. Kim Jung Hak*, WIPO Case No. D2009-1583 (Feb. 9, 2010); *Amazon.com, Inc. v. Kim Yoon-Jo*, WIPO Case No. D2003-0774 (Mar. 2004).

did not file a response, the respondent's failure to respond "should be a strong factor to allow the panel to decide to proceed in the language of the complaint."¹⁰¹ Perhaps in anticipation of the argument that a respondent could later raise in a court action, one panel noted that the respondent's failure to respond to the complainant's language request and the respondent's default in the proceeding amount to a waiver of any objection to the proceeding being conducted in English.¹⁰²

It should be noted that there are decisions in which panels, discussing the relevant factors identified above, nevertheless adhered to the language of the registration agreement for the language of the proceeding. In *NBC Universal, Inc. v. Junak Kwon*, the complainant filed a Korean translation of the complaint at WIPO's instruction, and the respondent defaulted.¹⁰³ The majority of the panel determined that the language of the proceeding would be Korean, following the language of the registration agreement and the respondent's refusal to agree to a proceeding in English.¹⁰⁴ The majority explained that under paragraph 11, the availability of the registration agreement in English (as well as in Korean) and the complainant's lack of fluency in Korean were not sufficient reasons to depart from the language of the registration agreement.¹⁰⁵ Further, the majority noted that the respondent used English only briefly for its website and that the procedures for the respondent to follow were in Korean.¹⁰⁶ Sir Ian Barker filed a separate opinion disagreeing with the majority's determination that the language of the proceeding should be Korean, emphasizing the respondent's facility in the English language, as indicated in its correspondence and website, and the respondent's default.¹⁰⁷ Panelist Barker relied on four prior UDRP decisions

101. *Intesa Sanpaolo S.p.A. v. Linecom*, WIPO Case No. D2009-1492 (Dec. 28, 2009). "Further, forcing Complainant to translate the Complaint into the language of the registration agreement in circumstances when Respondent has failed to show any active interest in the proceeding or respond to [WIPO's] invitation to comment on Complainant's request is unfair." *Id.*

102. *Laboratoire Nutergia v. Jeongyong Cho*, WIPO Case No. D2007-1582 (Jan. 14, 2008); see *MySpace Inc. v. Will Eom*, WIPO Case No. D2008-0448 (June 30, 2008) (author serving as sole panelist, wrote, "[T]he Respondent failed to submit a response to the translated Complaint. The Respondent may not now complain that it was not given full and fair notice of the action, or that it was denied an opportunity to review the Complainant's allegations in its preferred Korean language, or to respond to the Complaint. Indeed, the Respondent has been given every reasonable opportunity to defend its cause, but other than requesting a translated copy of the Complaint, has declined to do so.").

103. WIPO Case No. D2004-0764 (Dec. 23, 2004) [decision in Korean]. The proceeding involved the domain name <nbuniversal.com>; the panel unanimously determined that the complainants satisfied the elements of paragraph 4(a) and ordered the transfer of the domain name to the complainants. *Id.*

104. *Id.* Presiding Panelist Boh Young Hwang and Panelist Ik-Hyun Seo comprised the majority. *Id.*

105. *Id.*

106. *Id.*

107. *Id.* (opinion of Sir Ian Barker).

with similar circumstances in which the panel decided to depart from the language of the registration agreement and to proceed in English,¹⁰⁸ three of which involved a registration agreement in Korean.¹⁰⁹

As in *NBC Universal, Inc.*, the complainant in *JJGC Industria E Comercio de Materiais Dentarios S.A. v. Yun-Ki Kim* also requested that English be the language of the proceeding, despite the Korean registration agreement.¹¹⁰ The complainant referred to the registrar's publication of the standard registration agreement in both English and Korean; the respondent's alleged sufficient ability in English, as evidenced by the correspondences between the parties; the complainant's inability to communicate in Korean; and the "substantial delay and expense" in translating the complaint and annexes.¹¹¹ The panel—comprised of two non-Korean panelists and one Korean panelist—rejected the request to depart from the language of the registration agreement.¹¹² The panel's explanation should give pause to any party seeking English as the language of the proceeding:

The Complainant correctly argues that "[t]he spirit of paragraph 11 is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfort with each language, the expenses to be incurred and possibility of delay in the proceeding in the event translations are required and other relevant factors," but it cites only its own convenience without regard to the corresponding delay and expense that the Respondent would bear should the Panel depart from the default rule. The Complainant is here by choice; the Respondent is not. The Complainant is a large multinational corporation; the Respondent appears to operate a single dental clinic. Without a compelling reason to proceed otherwise, if one party or the other will be unfairly inconvenienced by requiring translations the language of the Registration Agreement should prevail. In these circumstances the Panel finds no unfairness in abiding by the plain language of the Rules.¹¹³

Nevertheless, the panel stated that it would "proceed both in English and Korean, accepting the Complain[t] as filed in English and the Response as filed in Korean."¹¹⁴ As to the language of the decision, "The Panel renders

108. *Id.* (citing *Int'l Data Grp. Inc. v. Lingjun*, WIPO Case No. D2004-0398 (Aug. 4, 2004); *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. D2003-0679 (Nov. 13, 2003); *Amazon.com v. Kim Yoon-Jo*, WIPO Case No. D2003-0774 (Mar. 2, 2004); *Groupe Industriel Marcel Dassault, Dassault Aviation v. Mr. Minwoo Park*, WIPO Case No. D2003-0989 (Feb. 12, 2004)).

109. *See supra* text accompanying notes 92–95, 100.

110. WIPO Case No. D2013-1838 (Dec. 20, 2013).

111. *Id.*

112. *Id.*

113. *Id.*

114. *Id.* The panel in another decision declared that "both English and Korean shall be the languages of this proceeding." *Massive, Inc. v. Ricky Park*, WIPO Case No. D2008-1375 (Dec. 11, 2008) (emphasis

its Decision in English, as the language in which all members are fluent.”¹¹⁵ This holding is a rather abrupt and unexpected twist in the panel’s decision, in light of its definitive rejection of the complainant’s request to depart from the default rule. One wonders if the common language of fluency among the panel members did not contribute to the determination for a decision in English, and whether a panelist’s language ability is a relevant factor or circumstance for the panel’s consideration under paragraph 11(a) of the UDRP Rules.

Two other decisions, also by three-member panels, appear to indicate that individual panelists’ (in)ability to conduct the proceeding in Korean may be a factor in determining the language of the proceeding to be English. In one case, the decision noted that “one of the panelists does not understand the Korean language”,¹¹⁶ another case observed that “the majority of the Panel has command over the English language only.”¹¹⁷ Of course, the matter of a panelist’s inability to proceed in a particular language can be alleviated beforehand if the provider is able to select a panelist with means to comprehend materials in Korean. But due to panelist availability, this will not always be an option. In proceedings where a three-member panel is selected and one or more members do not have proficiency in Korean, a Korean panelist (or one with Korean ability) may inform the non-Korean panelists of the submissions in *Han-geul*.¹¹⁸ The situation becomes more difficult in proceedings where the parties have selected a sole panelist to decide the dispute, and the appointed panelist does not have ability in Korean.¹¹⁹ Indeed, “The language issue is a tricky one.”¹²⁰

added). This approach, also seen in *JJGC Industria E Comercio de Materiais Dentarios S.A.*, WIPO Case No. D2013-1838, has a Solomonic quality. But the decisions in both cases were in English. *Id.*; *Massive, Inc.*, WIPO Case No. D2008-1375.

115. *JJGC Industria E Comercio de Materiais Dentarios S.A.*, WIPO Case No. D2013-1838.

116. *Playboy Enters. Int’l, Inc. v. Sookwan Park*, WIPO Case No. D2001-0778 (Oct. 1, 2001).

117. *Carfax, Inc. v. COMn.COM*, WIPO Case No. D2002-0513 (Sept. 18, 2002).

118. *E.g.*, *JJGC Industria E Comercio de Materiais Dentarios S.A.*, WIPO Case No. D2013-1838, n.1 (“The Korean-speaking member of the Panel has provided the other panelists with summaries of the Response and relevant evidence submitted in the Korean language, which the Panel has considered.”); *NBC Universal, Inc. v. Junak Kwon*, WIPO Case No. D2004-0764 (Dec. 23, 2004) (opinion of Sir Ian Barker) (“I agree with the majority that the complaint be allowed and transfer of the Disputed Domain Name ordered. I have been supplied with a translation of the operative part of the decision by the Presiding Panelist and I agree with it.”).

119. The sole panelist in one decision noted that were the proceeding conducted in Korean, “It would[,] . . . in all likelihood, require appointment of a new Panel as this Panelist cannot understand Korean. Alternatively it would involve translating any submissions of the Respondent into a language understood by the Panel.” *L’Oreal S.A. v. MUNHYUNJA*, WIPO Case No. D2003-0585 (Nov. 17, 2003).

120. Julia Hörnle, *The Uniform Domain Name Dispute Resolution Procedure: Is Too Much of a Good Thing a Bad Thing?*, 11 *SMU SCI. & TECH. L. REV.* 253, 274 (2008). In proceedings where English was not the native language of either country, some panels have stated that English is the “fairest neutral

Where the proceeding involves materials in multiple languages, the presence of at least one member on the panel with ability in each language will lead to party confidence in the process. Panels have emphasized that the ultimate determination of the language of the proceeding must not lead to prejudice to either party.¹²¹ Even where the panel departs from the language of the Korean registration agreement in favor of English, WIPO's practice—which permits the complainant to file its complaint in English and the respondent to submit in either Korean or English—allows for the respondent's Korean submissions to be considered, assuming a panelist with ability in *Han-geul*. Some panels make this assurance explicitly.¹²² Alas, there is the possibility in some instances of the cottage industry being much ado about not very much. As one panel noted, ordering translation of the complainant's English submissions into Korean was “unlikely to make any substantial difference in this proceeding.”¹²³

III. SELECTED DECISIONS

Many of the decisions in the database share some common characteristics: A non-Korean complainant brings a UDRP claim against a Korean respondent, who often defaults; the panel determines that the requisite elements of paragraph 4(a) of the UDRP are satisfied, and orders a

language.” *LEGO Juris A/S [Denmark] v. Lee Young Ju [Korea]*, WIPO Case No. D2013-0812 (July 19, 2013); *Nsense Group [Denmark] v. noorinet [Korea]*, WIPO Case No. D2011-1888 (Jan. 25, 2012); *VKR Holding A/S [Denmark] v. Noorinet [Korea]*, WIPO Case No. D2011-1360 (Oct. 13, 2011); *Airasia Berhad [Malaysia] v. Park sung mo [Korea]*, WIPO Case No. D2011-0933 (Aug. 22, 2011). Query as to whether this view reflects a tendency to favor the English language in UDRP proceedings. Moreover, panels in some proceedings in which the complaint is in English and the response is in Korean observed that the parties were able to submit their materials in their “preferred languages.” *LEGO Juris A/S*, WIPO Case No. D2012-2068; *Viator, Inc. [USA] v. iContents, Brian Yu [Korea]*, WIPO Case No. D2008-0190 (June 19, 2008); *Deutsche Telekom AG [Germany] v. Unitedeurope Consulting [Korea]*, WIPO Case No. D2006-0930 (Dec. 27, 2006); *SEMATECH, Inc. [France] v. Lee Hyunggyu [Korea]*, WIPO Case No. D2001-0870 (Nov. 26, 2001). It should be noted, however, that in most of these decisions, English was not the native language of the complainant. The complainant may well have preferred to submit the complaint in its native tongue. These decisions suggest the emergence of English as the de facto preferred language in UDRP proceedings. The complainant in one proceeding made this very argument. *Intesa Sanpaolo S.p.A. v. Linecom*, WIPO Case No. D2009-1492 (Dec. 28, 2009) (referring to complainant's view that English “is an international language ‘comprehensible to all parties’”).

121. See, e.g., *Wal-Mart Stores, Inc. v. WalMart Careers, Inc.*, WIPO Case No. D2012-0285 (Apr. 11, 2012); *Massive, Inc. v. Ricky Park*, WIPO Case No. D2008-1375 (Dec. 11, 2008); *Toyota Motor Credit Corp. v. Kilsoo Jung*, WIPO Case No. D2008-0731 (July 22, 2008); *SEMATECH, Inc.*, WIPO Case No. D2001-0870. In another decision, the panel noted that “there is no advantage in favor of the Complainant with the English language being the language of the proceeding as the Complainant is French.” *L.M.X. Holding v. admin, Han-Jin, Ko*, WIPO Case No. D2009-1514 (Dec. 30, 2009).

122. E.g., *GetMore A/S v. Sooyong Kim*, WIPO Case No. D2009-0357 (June 2, 2009); *Companhia Paulista de Papéis e Artes Gráficas - COPAG v. Lee Youngho*, WIPO Case No. D2006-0166 (Apr. 28, 2006); *O2 Holdings Ltd. v. Guen-Tea Park*, WIPO Case No. D2005-0588 (Aug. 26, 2005).

123. *Massive, Inc. v. Ricky Park*, WIPO Case No. D2008-1375 (Dec. 11, 2008).

transfer of the domain name to the complainant. There are departures from this pattern, some of which are discussed herein. The database also includes individual decisions that are of interest in their own right.

A. *The Frequent Respondent: The Domain Name Investor*

A review of the decisions reveals that some parties have appeared in multiple proceedings as the respondent.¹²⁴ As noted above, one respondent acknowledged that over a fourteen-year period, it registered a number of “commercially valuable” domain names for investment and development.¹²⁵ Another repeat respondent acknowledged that it acquired a number of expired or deleted domain names containing generic terms, and used some of them “‘to generate advertising revenue’ by displaying pay-per-click advertising directory websites hosted by a third party.”¹²⁶ In one decision, the panel observed that this respondent, “a company known for trying to make money by registering third parties’ trademarks as domain names, . . . has been a respondent in at least 27 UDRP proceedings.”¹²⁷ Five of the frequent respondents are discussed herein.

Linecom was the named respondent in eleven decisions in the database, from 2006 to 2014.¹²⁸ Reporting an address in Gyungjoo in six of the decisions, and Seoul in five, it was ordered to transfer the disputed domain name in all eleven decisions.¹²⁹ Noorinet (or noorinet, Nurinet, Noori net),

124. A frustrated complainant might refer to such a respondent as a “serial cybersquatter.” *Federal-Mogul Corp. v. noorinet*, WIPO Case No. D2015-0828 (July 31, 2015); *see* *Compart AG v. Compart.com/Vertical Axis, Inc.*, WIPO Case No. D2009-0462 (July 9, 2009) (“The Complainant further asserts that Vertical Axis, Inc. is a professional domainer and was the registered owner of thousands of domain names in the past.”). In one decision, a Korean company brought a UDRP claim against the respondent whom the panel noted “has been involved in over 200 UDRP proceedings since 2004, where it was ordered to transfer domain names in dispute to respective trademark owners.” *Hyundai Card Co. v. Domains By Proxy*, WIPO Case No. D2012-0858 (June 28, 2012).

125. *UTV Ltd. v. Uniteurope Consulting, Kwang Pyo Kim*, WIPO Case No. D2011-2293 (Mar. 5, 2012); *see supra* text accompanying notes 39–42.

126. *Nursefinders, Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2007-0417 (July 5, 2007).

127. *Compart AG v. Compart.com/Vertical Axis, Inc.*, WIPO Case No. D2009-0462 (July 9, 2009).

128. *Nat’l Grid Elec. Transmission Plc & NGrid Intell. Prop. Ltd. v. Linecom*, WIPO Case No. D2013-2074 (Feb. 23, 2014).

129. *Id.* (<nationalgridsaves.com>); *Colgate-Palmolive Co. v. Linecom*, WIPO Case No. D2013-0712 (June 28, 2013) (<colgatemaxwhite.com>) (author served as sole panelist); *LEGO Juris A/S v. Linecom*, WIPO Case No. D2012-2068 (Dec. 27, 2012) (<mindstormslego.com>); *LEGO Juris A/S v. Linecom*, WIPO Case No. D2012-1800 (Nov. 16, 2012) (<legotrains.com>) (author served as sole panelist); *Microsoft Corp. v. Linecom*, WIPO Case No. D2012-0538 (May 20, 2012) (<microsoftbank.com>) [decision in Korean]; *Camlog Biotechnologies AG v. Linecom*, WIPO Case No. D2011-2317 (Feb. 24, 2012) (<conelog.com>); *Intesa Sanpaolo S.p.A. v. Linecom*, WIPO Case No. D2009-1492 (Dec. 28, 2009) (<pravexbank.com>); *One Vision Direct Ltd v. Linecom*, WIPO Case No. D2009-1147 (Oct. 9, 2009) (<metsuki.com>); *EKKIA SAS v. LINECOM*, WIPO Case No. D2009-1124 (Oct. 31, 2009) (<equitheme.com>); *IVECO S.p.A. v. Linecom*, WIPO Case No. D2008-1726 (Jan. 31,

with an address most often listed in Daegu and once in Gyungjoo, was also the respondent in eleven proceedings herein. Noorinet was ordered to transfer the disputed domain name to the complainant in all but one decision.¹³⁰ Another party, Unitedeurope Consulting or Kwangpyo Kim, which was the respondent in ten decisions herein, fared somewhat better. The ten proceedings involved twenty domain names, and the respondent was ordered to transfer twelve of them to the respective complainants.¹³¹ The panel denied the complaint for eight of the domain names, allowing the respondent to keep them.¹³²

The two respondent parties with the highest success in retaining the challenged domain names are Arisu Tech/Sooyong Kim and Vertical Axis, Inc. Arisu Tech/Sooyong Kim prevailed in five decisions, allowing the respondent to keep the domain names <applegreen.com>,¹³³ <getmore.com>

2009) (<ivecoshop.com>); Iconcard S.p.A. v. Linecom, WIPO Case No. D2005-1115 (Mar. 28, 2006) (<iconcard.com>).

130. The panel ordered the transfer of the domain name in the following decisions: Philippe Astie Owner, isails, LLC v. noorinet, WIPO Case No. D2014-0381 (May 1, 2014) (<isails.com>); MSM Satellite Pte Ltd. & Multi Screen Media Private Ltd. v. Noorinet, WIPO Case No. D2014-0100 (Mar. 31, 2014) (<sonypix.com>); “Dr. Martens” Int’l Trading GmbH, “Dr. Maertens” Mktg. GmbH v. noorinet, WIPO Case No. D2014-0083 (Mar. 25, 2014) (<drmartensshop.com>); Neste Oil Oyj v. Noorinet, WIPO Case No. D2014-0019 (Mar. 20, 2014) (<nexbase.com>); End of the Road, Inc. v. Noorinet, WIPO Case No. D2013-1321 (Oct. 27, 2013) (<quickfist.com>); Date4sports UG v. Noorinet, WIPO Case No. D2012-1986 (Dec. 27, 2012) (<date4sport.com>); VKR Holding A/S v. Noorinet, WIPO Case No. D2011-1360 (Oct. 13, 2011) (<veluxmarket.com>); Suspa Holding GmbH v. Noorinet, WIPO Case No. D2011-0975 (Aug. 4, 2011) (<movotec.com>); Credit Industriel et Commercial S.A. v. Noori net, WIPO Case No. D2010-0729 (June 29, 2010) (<cices.com>); Kshocolat Ltd. v. Nurinet, WIPO Case No. D2010-0577 (June 10, 2010) (<kshocolat.com>). The respondent prevailed in the proceeding involving the domain name <nsense.com>, in which the panel determined that the complainant failed to establish rights in a mark and that the complainant could not satisfy the bad faith element. Nsense Grp. v. noorinet, WIPO Case No. D2011-1888 (Jan. 25, 2012).

131. Deutsche Lufthansa AG v. [] Mediablue Inc., Kwangpyo Kim, WIPO Case No. D2013-1844 (Jan. 22, 2014) (<flynet.com>); Caterham Cars Ltd. v. Unitedeurope Consulting, WIPO Case No. D2011-2135 (Feb. 1, 2012) (<caterham.com>); NATRA, S.A. v. Unitedeurope Consulting, WIPO Case No. D2011-1056 (Aug. 23, 2011) (<natra.com>); Mr. Ángel Custodio Dalmau Salmon & Blue Tower, S.L. v. Unitedeurope Consulting, WIPO Case No. D2011-0796 (July 4, 2011) (<custo.com>); Casa Bahia Comercial Ltda. v. Unitedeurope Consulting/Casas Bahia, WIPO Case No. D2010-1660 (Dec. 1, 2010) (<casasbahia.com>); MasterCard Int’l Inc. v. Unitedeurope Consulting, WIPO Case No. D2007-0830 (Aug. 27, 2007) (<master-card.com>); Deutsche Telekom AG v. Unitedeurope Consulting, WIPO Case No. D2006-0930 (Dec. 27, 2006) (involving eleven domain names; transfer ordered for <t-biz.com>, <t-box.com>, <t-city.com>, <t-home.com>, <t-jobs.com>, <t-network.com>).

132. Mobile’s Republic v. Kwangpyo Kim, WIPO Case No. D2014-0089 (Apr. 23, 2014) (<newsrepublic.com>); UTV Ltd. v. Unitedeurope Consulting, Kwang Pyo Kim, WIPO Case No. D2011-2293 (Mar. 5, 2012) (<utv.com>); Witmer Pub. Safety Grp., Inc. v. Kwang pyo Kim, WIPO Case No. D2011-0075 (Mar. 31, 2011) (<firestore.com>); Deutsche Telekom AG v. Unitedeurope Consulting, WIPO Case No. D2006-0930 (Dec. 27, 2006) (involving eleven domain names; complaint denied for <t-broadcast.com>, <t-health.com>, <t-portal.com>, <t-sales.com>, <t-show.com>).

133. Petrogas Grp. Ltd. v. Kim Sooyong - (Arisu Tech), WIPO Case No. D2013-0749 (June 12, 2013).

(in two proceedings),¹³⁴ <mornay.com>,¹³⁵ and <strongarm.com>.¹³⁶ The absence of the respondent's bad faith was dispositive in all of these decisions. Arisu Tech/Sooyong Kim's lone loss involved the domain name <volkswagen.net>, which the German automaker was successful in retrieving.¹³⁷

Vertical Axis, Inc. has appeared in a number of UDRP proceedings and is apparently well-known among some panelists.¹³⁸ Within the proceedings included in the database, Vertical Axis was the respondent in eight, all within a seventeen-month period in 2006–2007.¹³⁹ Korea has not been the exclusive location for Vertical Axis in the UDRP proceedings. In a 2003 WIPO-administered decision, the same named respondent indicated an address in Hong Kong.¹⁴⁰ In proceedings after the string of decisions indicating a Korean address, Vertical Axis's reported address was in Barbados.¹⁴¹ In one of these Barbados decisions, the panel observed that Vertical Axis "is now using a privacy shield for the vast majority of its domain names so there are now only a few WhoIs records actually referring to Respondent."¹⁴² It is not clear what connection this party has to Korea.

In all events, Vertical Axis has been the most successful respondent in the decisions in the database, prevailing in seven of the eight proceedings,

134. GetMore A/S v. Sooyong Kim, WIPO Case No. D2009-0357 (June 2, 2009) (re-filed complaint denied); GetMore A/S v. Arisu Tech, WIPO Case No. D2008-1595 (Dec. 22, 2008).

135. IPGM Inst. Mixte de Prévoyance du Groupe Mornay v. Sooyong Kim, WIPO Case No. D2007-1513 (Mar. 4, 2008).

136. Strongarm Designs, Inc. v. Arisu Tech, WIPO Case No. D2001-0776 (Sep. 17, 2001).

137. Volkswagen AG v. NovaNIC, WIPO Case No. D2005-0142 (Mar. 31, 2005) (<volkswagen.net>) ("The Respondent is Novanic and the administrative contact is Mr. Kim Sooyong. . . . The previous domain name holder was Arisu Tech and the administrative contact was also Mr. Kim Sooyong.").

138. See CEAT Ltd., CEAT Mahal[] v. Vertical Axis Inc., WIPO Case No. D2011-1981 (Feb. 20, 2012); Ustream.TV, Inc. v. Vertical Axis, Inc., WIPO Case No. D2008-0598 (July 29, 2008).

139. Bright Horizons Family Sols. Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0795 (Oct. 12, 2007); Esquire Innovations, Inc. v. [] Vertical Axis, Inc., WIPO Case No. D2007-0856 (Oct. 5, 2007) (2-1 decision); SmarTours, Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0964 (Sept. 7, 2007); Nursefinders, Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0417 (July 5, 2007); HSM Arg. S.A. v. Vertical Axis, Inc, WIPO Case No. D2007-0017 (May 1, 2007); Protosoftware, Inc. v. Vertical Axis, Inc., WIPO Case No. D2006-0905 (Oct. 10, 2006); Shoulderdock Ltd. v. Vertical Axis, Inc., WIPO Case No. D2006-0625 (Sept. 8, 2006); Jet Marques v. Vertical Axis, Inc., WIPO Case No. D2006-0250 (May 26, 2006).

140. Vernons Pools Ltd. v. Vertical Axis, Inc., WIPO Case No. D2003-0041 (Mar. 12, 2003).

141. Phoenix Contact GmbH & Co. KG v. [] Vertical Axis Inc., Domain Adm'r, WIPO Case No. D2012-2014 (Jan. 22, 2013); CEAT Ltd., WIPO Case No. D2011-1981; Compart AG v. Compart.com/Vertical Axis, Inc., WIPO Case No. D2009-0462 (July 9, 2009); Which? Ltd. v. [] Vertical Axis, Inc., WIPO Case No. D2008-1637 (Jan. 27, 2009); Metro Sportswear Ltd. v. Vertical Axis Inc. and Canadagoose.com, WIPO Case No. D2008-0754 (Aug. 4, 2008); Ustream.TV, Inc., WIPO Case No. D2008-0598; Liquid Nutrition Inc. v. liquidnutrition.com/Vertical Axis Inc., WIPO Case No. D2007-1598 (Jan. 28, 2008).

142. Compart AG, WIPO Case No. D2009-0462.

for a complaint denial rate of 87.5%. Although this figure is from a very small sample, it is nevertheless a drastic departure from the denial rate of 12.5% for all WIPO-administered decisions.¹⁴³ Vertical Axis's successful decisions involved the following domain names: <brighthorizon.com>;¹⁴⁴ <hsm.com>;¹⁴⁵ <jettour.com>;¹⁴⁶ <nursefinder.com>;¹⁴⁷ <proto.com>;¹⁴⁸ <shoulderdoc.com>;¹⁴⁹ <smartrtours.com>.¹⁵⁰ The common theme among all of these decisions is that the complainant's mark was neither particularly distinctive nor well-known, such that the respondent could not have been aware of it.¹⁵¹ In the lone decision where Vertical Axis was not successful, in a proceeding involving the domain name <iscrub.com>, the panel decision was divided.¹⁵² The dissenting panelist would have not only denied the complaint due to the complainant's failure to establish bad faith registration and use, but also found that "the Complaint was brought in bad faith . . . constitut[ing] an abuse of the administrative proceeding."¹⁵³

Of the eleven domain names on which the respondents Arisu Tech/Sooyong Kim and Vertical Axis prevailed and were permitted to keep, only one of them, <strongarm.com>, currently resolves to the opposing complainant's website.¹⁵⁴ According to publicly available records, Sooyong Kim is still the registrant of <applegreen.com>, <getmore.com>, and

143. See CASE OUTCOME (CONSOLIDATED): ALL YEARS *supra* note 14.

144. Bright Horizons Family Sols. Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0795 (Oct. 12, 2007).

145. HSM Argentina S.A. v. Vertical Axis, Inc., WIPO Case No. D2007-0017 (May 1, 2007).

146. Jet Marques v. Vertical Axis, Inc., WIPO Case No. D2006-0250 (May 26, 2006).

147. Nursefinders, Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0417 (July 5, 2007).

148. Protosoftware, Inc. v. Vertical Axis, Inc., WIPO Case No. D2006-0905 (Oct. 10, 2006).

149. Shoulderdoc Ltd. v. Vertical Axis, Inc., WIPO Case No. D2006-0625 (Sept. 8, 2006).

150. SmarTours, Inc. v. Vertical Axis, Inc., WIPO Case No. D2007-0964 (Sept. 7, 2007).

151. One panel, which ruled in favor of Vertical Axis, nevertheless noted other decisions administered by another provider, in which the panels found that Vertical Axis "more likely than not was aware that the[] domain names were confusingly similar to famous and distinctive marks" and ordered a transfer of the domain names to the complainants. *Nursefinders, Inc.*, WIPO Case No. D2007-0417 (citing *MBNA [America Bank], N.A. v. Vertical Axis, Inc.*, NAF Claim No. FA133632 (Jan. 6, 2003) (<mbnaaccess.net>); *Harveys Casino Resorts v. Vertical Axis, Inc.*, NAF Claim No. FA117320 (Oct. 10, 2002) (<harveys-tahoe.com>); *Pearl Jam v. Vertical Axis, Inc.*, NAF Claim No. FA593325 (Dec. 27, 2005) (<pearljams.com>)).

152. *Esquire Innovations, Inc. v. [] Vertical Axis, Inc.*, WIPO Case No. D2007-0856 (Oct. 5, 2007) (2-1 decision).

153. *Id.* (Sorkin, Pan., dissenting). A UDRP panel has the discretion to make a finding of "reserve domain name hijacking," defined as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name." UDRP RULES ¶ 1. Vertical Axis requested, and received a finding of reverse domain name hijacking, in *Protosoftware, Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2006-0905 (Oct. 10, 2006) (<proto.com>).

154. STRONGARM, <http://www.strongarm.com> (last visited Jan. 17, 2016).

<mornay.com>.¹⁵⁵ The seven domain names on which Vertical Axis prevailed—<brighthorizon.com>, <hsm.com>, <jettour.com>, <nursefinder.com>, <proto.com>, <shoulderdoc.com>, and <smarttours.com>—are currently registered to a privacy service with an address in Australia.¹⁵⁶ The websites to which these ten domain names resolve indicate that they are available for sale or rent.

B. The Frequent Complainant: Samsung (Mostly)

Of the 106 decisions in the database in which the complainant was listed as a Korean party, a Samsung entity was the complainant in over half of them, in fifty-four decisions. In these fifty-four proceedings, virtually all of the subject domain names began with “samsung,”¹⁵⁷ followed by a term that related to one of Samsung’s many products or services (e.g., <samsunganycall.com>;¹⁵⁸ <samsungtonercartridge.com>;¹⁵⁹ <samsungcallingcards.com>;¹⁶⁰ <samsunggalaxygear.com>;¹⁶¹ <samsunglcd.com>;¹⁶² <samsungprinterdrivers.com>;¹⁶³ <samsungtv.com>¹⁶⁴), or by a geographic location (e.g.,

155. See Applegreen.com, WHOIS, <http://www.whois.com/whois/applegreen.com> (<applegreen.com>) (last visited Jan. 17, 2016); Getmore.com, WHOIS, <http://www.whois.com/whois/getmore.com> (<getmore.com>) (last visited Jan. 17, 2016); Mornay.com, WHOIS, <http://www.whois.com/whois/mornay.com> (<mornay.com>) (last visited Jan. 17, 2016).

156. See Brighthorizon.com, WHOIS, <http://www.whois.com/whois/brighthorizon.com> (<brighthorizon.com>) (last visited Jan. 17, 2016); Hsm.com, WHOIS, <http://www.whois.com/whois/hsm.com> (<hsm.com>) (last visited Jan. 17, 2016); Jettour.com, WHOIS, <http://www.whois.com/whois/jettour.com> (<jettour.com>) (last visited Jan. 17, 2016); Nursefinder.com, WHOIS, <http://www.whois.com/whois/nursefinder.com> (<nursefinder.com>) (last visited Jan. 17, 2016); Proto.com, WHOIS, <http://www.whois.com/whois/proto.com> (<proto.com>) (last visited Jan. 17, 2016); Shoulderdoc.com, WHOIS, <http://www.whois.com/whois/shoulderdoc.com> (<shoulderdoc.com>) (last visited Jan. 17, 2016); Smarttours.com, WHOIS, <http://www.whois.com/whois/smarttours.com> (<smarttours.com>) (last visited Jan. 17, 2016).

157. Only two of the fifty-four decisions involved a domain name that did not begin with “samsung.” Samsung Elecs. Co. v. Grupoinova, WIPO Case No. D2012-0569 (May 10, 2012) (<centralitassamsung.com>); Samsung Elecs. Co. v. Shenzhneshe Luohuqusaigedianzicheng, WIPO Case No. D2006-0934 (Sept. 20, 2006) (<sssamsung.com>) [decision in Chinese].

158. [*Samsung Elecs. Co.*] v. Kidon Chang, WIPO Case No. D2005-1344 (Mar. 2, 2006) [decision in Korean].

159. Samsung Elecs. Co. v. Seung Kang, WIPO Case No. D2005-0557 (Sept. 5, 2005).

160. Samsung Elecs. Co. v. Samsungmexico, WIPO Case No. D2005-1245 (Mar. 15, 2006).

161. Samsung Elecs. Co. v. Harry Willems, WIPO Case No. D2014-1611 (Nov. 4, 2014); see Samsung Elecs. Co. v. Reactivation Period/Whoisguard, Inc., WIPO Case No. D2014-1615 (Nov. 14, 2014) (<samsunggalaxygear.org>).

162. Samsung Elecs. Co. v. Yangwooju, WIPO Case No. D2008-1159 (Sept. 29, 2008).

163. Samsung Elecs. Co. v. Customer # 400097311/Gustavo Winchester, WIPO Case No. D2014-1386 (Sept. 29, 2014); Samsung Elecs. Co. v. Anika Van Leeuwen (Jag Web Ventures), WIPO Case No. D2013-2162 (Feb. 28, 2014).

164. Samsung Elecs. Co. v. Kutchery Road, WIPO Case No. D2008-1436 (Nov. 4, 2008).

<samsungmexico.com>;¹⁶⁵ <samsungturkey.com>¹⁶⁶), or a generic term (e.g., <samsungad.com>;¹⁶⁷ <samsungbio.com>¹⁶⁸). Other domain names were comprised of “samsung” followed by the gTLD (<samsung.biz>¹⁶⁹), or the country code TLD (e.g., <samsung.as>¹⁷⁰ (American Samoa); <samsung.bz>¹⁷¹ (Belize); <samsung.ie>¹⁷² (Ireland); <samsung.ma>¹⁷³ (Morocco); <samsung.ro>¹⁷⁴ (Romania)¹⁷⁵).

Given the widely recognized nature of the “SAMSUNG” mark worldwide, it is not surprising to see that Samsung as the complainant prevailed and won transfer of all the domain names above, as well as others, succeeding in fifty of fifty-four decisions, for a total of fifty-two of fifty-six domain names. But the panel denied Samsung’s complaint and permitted the respondent to keep the domain name in four proceedings. These decisions are noteworthy, and the panel’s reasoning therein allows for further elaboration of the relevant provisions of the UDRP. The four decisions involved the domain names <samsungand.com>,¹⁷⁶ <samsungcentralitas.com>,¹⁷⁷ <centralitassamsung.com>,¹⁷⁸ and <samsunghub.com>.¹⁷⁹ In each case, the respondent highlighted circumstances that indicated activity apart from cybersquatting, and the panel’s decision turned on the respondent’s right or legitimate interest in the domain name.

165. Samsung Elecs. Co. v. Samsungmexico, WIPO Case No. D2005-1245 (Mar. 15, 2006).

166. Samsung Elecs. Co. v. Pimsar Elecs. Ltd. (Samsung Turkey), WIPO Case No. D2009-1630 (Feb. 16, 2010).

167. [*Samsung Elecs. Co.*] v. Richard Yaming, WIPO Case No. D2011-1097 (Sept. 6, 2011) [decision in Korean].

168. Samsung Elecs. Co. v. Lee, kee, Lee, Kwangjae, WIPO Case No. D2011-0748 (July 22, 2011).

169. [*Samsung Networks Inc.*] v. Kang Yang-heon, WIPO Case No. D2004-0904 (Dec. 23, 2004) [decision in Korean].

170. [*Samsung Networks Inc.*] v. Kim Jangwoo, WIPO Case No. DAS2010-0001 (Apr. 15, 2010) [decision in Korean].

171. Samsung Networks Inc. v. woo kyungwon, WIPO Case No. DBZ2010-0001 (Mar. 23, 2010).

172. Samsung Elecs. Co. v. Alan Donohoe, WIPO Case No. DIE2015-0002 (May 21, 2015); Samsung Elecs. Co. v. Brendan Furlong, WIPO Case No. DIE2013-0005 (Jan. 9, 2014).

173. Samsung Networks Inc. v. Conaho, WIPO Case No. DMA2010-0002 (June 30, 2010) [decision in French].

174. Samsung Electronics Co[.]. Ltd. v. Selim Civelek, WIPO Case No. DRO2008-0005 (May 19, 2008).

175. For the country code abbreviations, see WIPO, DOMAIN NAME DISPUTE RESOLUTION SERVICE FOR COUNTRY CODE TOP LEVEL DOMAINS (CCTLDS), <http://www.wipo.int/amc/en/domains/ccld> (last visited Jan. 17, 2016).

176. [*Samsung Elecs. Co.*] v. Lee Jun Ho, WIPO Case No. D2011-1515 (Nov. 1, 2011) [decision in Korean].

177. Samsung Elecs. Co. v. Gestion Integral Inovages, WIPO Case No. D2012-0570 (May 10, 2012).

178. Samsung Elecs. Co. v. Grupoinova, WIPO Case No. D2012-0569 (May 10, 2012).

179. Samsung Elecs. Co. v. Kunal Gangar, WIPO Case No. D2013-0578 (May 18, 2013).

1. The Other Samsung

The Korean conglomerate's SAMSUNG mark (삼성 in Korean characters) is based on the Chinese 三星¹⁸⁰ and literally means “three stars.”¹⁸¹ The respondent in *Samsung Electronics Co. v. Lee Jun Ho* averred that “samsung” in its domain name <samsungand.com> was based on the Chinese 三省, meaning “three reflections,” and that the “-and” suffix was an acronym for “advertising and development.”¹⁸² The decision noted that the respondent's grandfather began using the “Samsung” trade name, specifically “Samsung Printing” (삼성인쇄소 or Samsung *in-sweh-soh*) in 1946.¹⁸³ The business continued under the respondent's father as owner in 1982, then his mother in 1987, and then his older brother in 1998 with a revised name, “Samsung Print Planning” (삼성인쇄기획 or Samsung *in-sweh-gi-hwek*).¹⁸⁴

In 2003, the respondent resumed the business under a new name, “Samsung AnD,” and highlighted the advertising and software development areas of the company's operations.¹⁸⁵ On February 20, 2009, the respondent registered the <samsungand.com> domain name, reflecting the company's name.¹⁸⁶ Under these circumstances, the panel held that, under paragraph 4(a)(ii) of the UDRP, the respondent had a right or legitimate interest in respect of the domain name.¹⁸⁷ The panel did not explicitly cite to paragraph 4(c)(i) or (ii) of the UDRP, but emphasized the respondent's bona fide commercial activities under the “Samsung” name.¹⁸⁸

180. See *Samsung Elecs. Co. v. Shenzheshi Luohuqusaigedianzicheng*, WIPO Case No. D2006-0934 (Sept. 20, 2006) [decision in Chinese]; *Samsung*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Samsung> (last visited Jan. 17, 2017).

181. *Samsung Elecs. Co. v. Reactivation Period/Whoisguard, Inc.*, WIPO Case No. D2014-1615 (Nov. 14, 2014); *Samsung Elecs. Co. v. samsung-phone-sale.com*, WIPO Case No. D2013-0555 (May 8, 2013); *Samsung Elecs. Co. v. Maksim*, WIPO Case No. D2010-1274 (Sept. 22, 2010).

182. [*Samsung Elecs. Co.*] v. Lee Jun Ho, WIPO Case No. D2011-1515 (Nov. 1, 2011) [decision in Korean].

183. *Id.*

184. *Id.*

185. *Id.*

186. *Id.*

187. *Id.*

188. *Id.*

2. The Unauthorized Seller of Samsung

The decisions involving the domain names <samsungcentralitas.com>¹⁸⁹ and <centralitassamsung.com>¹⁹⁰ stem from the same facts and were issued by the same panelist on the same date.¹⁹¹ Samsung Electronics Co. brought separate UDRP proceedings against the two respondents based in Sevilla, Spain, whom Samsung averred were the same party, due to a merger between them five years before.¹⁹² The panel's discussion on the merits is virtually identical in the text of both decisions.¹⁹³ The panel found that there was a distribution agreement between the respondent and Samsung's authorized wholesaler in Spain, which set forth the terms and conditions under which the respondent could purchase Samsung products.¹⁹⁴ The expiration date for the agreement was December 31, 2009.¹⁹⁵ The panel noted that the "Complainant produced a letter dated January 19, 2010, whereby [Samsung's wholesaler] informed Respondent on the expiration of the Agreement, that there was no intention to renew it and asking Respondent to no longer show themselves as official distributors of Samsung."¹⁹⁶ From here, the facts diverge in the two decisions. The respondent in the proceeding involving <samsungcentralitas.com> registered the domain name on February 2, 2010, which the decision characterized as follows: "the disputed domain name was created on February 2, 2010, that is, less than 2 weeks from the date of the letter Complainant asserts [the wholesaler] sent to Respondent."¹⁹⁷ In the <centralitassamsung.com> decision, the panel in correcting the complainant stated, "Contrary to Complainant's assertion, the disputed domain name was created on November 23, 2009, that is, almost 2 months before the date of the letter Complainant asserts [the wholesaler] sent to Respondent."¹⁹⁸ Then,

189. Samsung Elecs. Co. v. Gestion Integral Inovages, WIPO Case No. D2012-0570 (May 10, 2012).

190. Samsung Elecs. Co. v. Grupoinova, WIPO Case No. D2012-0569 (May 10, 2012).

191. *Centralita* is Spanish for "switchboard." Google Translate, <https://translate.google.com/#es/en/centralita> (last visited Jan. 17, 2016).

192. *Gestion Integral Inovages*, WIPO Case No. D2012-0570 n.2; *Grupoinova*, WIPO Case No. D2012-0569 n.2.

193. See *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

194. *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

195. *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

196. *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

197. *Gestion Integral Inovages*, WIPO Case No. D2012-0570.

198. *Grupoinova*, WIPO Case No. D2012-0569.

the text in both decisions merges, stating, “In any event, almost 2 years lapsed after registration of the disputed domain name before Complainant itself had a cease and desist letter sent to Respondent on November 17, 2011.”¹⁹⁹

The central question for the panel in both decisions was whether the respondent’s use of the domain name was for a bona fide offering of goods or services under paragraph 4(c)(i) of the UDRP, thus establishing a proper right or interest in the domain name.²⁰⁰ The panel referred to the “relevant prior UDRP panel decisions dealing with the issue of whether a reseller of trademarked goods may have rights or legitimate interests in a domain name that contains such trademark.”²⁰¹ The panel noted that the standard set forth in *Oki Data Americas, Inc. v. ASD, Inc.*²⁰² called for:

- (i) the Respondent to actually be offering the goods or services at issue;
- (ii) the Respondent to use the website to sell only the trademarked goods;
- (iii) the website to accurately disclose Respondent’s relationship with the trademark owner, that is, not falsely suggesting that it is the trademark owner or that the website is the official site, if, in fact, it is only one of many sales agents; and (iv) the Respondent not trying to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.²⁰³

Although the oft-cited *Oki Data* standard was intended for an authorized seller,²⁰⁴ the panel in the Samsung decisions noted that the standard “has been applied in several UDRP panel decisions involving unofficial or unauthorized resellers.”²⁰⁵ The panel wrote, “[S]everal UDRP panel

199. *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

200. See *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

201. *Gestion Integral Inovages* WIPO Case No. D2012-0570 (citing WIPO OVERVIEW 2.0, *supra* note 35, ¶ 2.3); *Grupoinova* WIPO Case No. D2012-0569 (citing same).

202. *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903 (Nov. 6, 2001).

203. *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

204. Panelist David H. Bernstein wrote, “This case raises the difficult question of whether an authorized sales or service agent of trademarked goods can use the trademark at issue in its domain name.” *Oki Data Americas, Inc.*, WIPO Case No. D2001-0903 (emphasis added). “Here, there is no dispute concerning Respondent’s status: It is an authorized Oki Data repair facility, and has been offering OKIDATA goods and services since prior to the commencement of this case. The only issue before the Panel, then, is whether Respondent’s offerings may be characterized as ‘bona fide.’” *Id.* (emphasis added).

205. *Gestion Integral Inovages*, WIPO Case No. D2012-0570 (citing *Dr. Ing. h.c. F. Porsche AG v. Del Fabbro Laurent*, WIPO Case No. D2004-0481 (Aug. 20, 2004); *Le Creuset SA v. Vineyards Direct Ltd.*, WIPO Case No. D2004-0551 (Sept. 6, 2004); *Volvo Trademark Holding AB v. Auto Shivuk*, WIPO Case No. D2005-0447 (June 8, 2005); *National Ass’n for Stock Car Auto Racing, Inc. v. Racing Connection/The Racin’ Connection, Inc.*, WIPO Case No. D2007-1524 (Jan. 28, 2008)); *Grupoinova*, WIPO Case No. D2012-0569 (citing same).

decisions have considered that an unofficial or unauthorized reseller or distributor of trademarked goods may have a right or legitimate interest in using another's trademark in a domain name under paragraph 4(c)(i) of the Policy . . . provided certain criteria are met."²⁰⁶

Reviewing the case record, the panel ultimately concluded that Samsung failed to establish that the respondent lacked a right or legitimate interest in the domain name.²⁰⁷ Indeed, "the opposite may in fact be concluded" as "it seems to this Panel that Respondent is conducting a bona fide offering of products as per Paragraph 4(c)(i) of the Policy."²⁰⁸ Given the panel's decision regarding the second element, the panel stated that it was unnecessary to discuss the bad faith element.²⁰⁹

The <samsungcentralitas.com> and <centralitassamsung.com> decisions are part of a significant body of UDRP decisions that elaborate on whether the respondent's use of a domain name containing the complainant's trademark in connection with the respondent's sale of the complainant's products is a bona fide offering of goods or services. The initial decision was *Oki Data*, which detailed the requirements for an authorized seller. The standard has subsequently been applied to an *unauthorized* seller.²¹⁰ All of the prior UDRP decisions that the panelist cited in the two Samsung decisions involved a respondent who was not an authorized seller, had no relationship with the complainant (other than the respondent's desire to sell the complainant's products), and used the complainant's trademark in the domain name.²¹¹ In each of the cited decisions, the respective panel found that the complainant failed to establish that the respondent lacked a right or

206. *Gestion Integral Inovages*, WIPO Case No. D2012-0570 (citing Koninklijke Philips Elecs. N.V. v. Cun Siang Wang, WIPO Case No. D2000-1778 (Mar. 15, 2001); DaimlerChrysler A.G. v. Donald Drummonds, WIPO Case No. D2001-0160 (June 18, 2001)); *Grupoinova*, WIPO Case No. D2012-0569 (citing same).

207. *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

208. *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

209. *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

210. *National Ass'n for Stock Car Auto Racing*, WIPO Case No. D2007-1524 ("[T]he *Oki Data* criteria are appropriate even in cases where the respondent is not an authorized dealer, so long as the Respondent operates a business genuinely revolving around the trademark owner's goods or services.") (citing *Volvo Trademark Holding*, WIPO Case No. D2005-0447).

211. *Id.* (<nascars-tours.com>); *Volvo Trademark Holding AB*, WIPO Case No. D2005-0447 (<volvo-auto-body-parts-online.com>); *Le Creuset SA v. Vineyards Direct Ltd.*, WIPO Case No. D2004-0551 (Sept. 6, 2004) (<lecreusetdirect.com>); *Dr. Ing. h.c. F. Porsche AG v. Del Fabbro Laurent*, WIPO Case No. D2004-0481 (Aug. 20, 2004) (<porsche-buy.com>, <porschebuy.com>); *DaimlerChrysler*, WIPO Case No. D2001-0160 (<mercedeshop.com>) (2-1 decision); *Koninklijke Philips Elecs.*, WIPO Case No. D2000-1778 (<philips-indonesia.com>).

legitimate interest and denied the complaint, with some panels affirmatively stating that the respondent was engaged in a bona fide offering of goods and services.²¹² The respondent in the <samsungcentralitas.com> and <centralitassamsung.com> decisions was a former authorized seller who registered the domain name as the authorizing agreement was expiring or recently expired.²¹³ Thus, the respondent here occupied a place somewhat in between the complainant's authorized seller (by contract) and the unauthorized seller, with no contractual relationship with the complainant. In all events, the facts gave rise to a permissible right or interest in the domain name.²¹⁴

3. The Samsung Fan Site

The panel in *Samsung Electronics Co., Ltd. v. Kunal Gangar*, the final Samsung decision, elaborated on the respondent's right or interest in the domain name <samsunghub.com>.²¹⁵ At the time of the complaint, Internet users who resorted to the domain name were re-directed to the website for <sammyhub.com>, which described the complainant's activities, especially its new products.²¹⁶ Previously, the website for <samsunghub.com> was at that location.²¹⁷ The respondent explained that the change was made in 2011, due to one of the complainant's subsidiaries launching an "app named 'Samsung Hub'. As a pre-emptive measure, . . . the Respondent commenced using <sammyhub.com> as the domain name for the Respondent's Website and redirected users seeking the Respondent's Website from the [<samsunghub.com>] Domain Name to the new domain name <sammyhub.com>."²¹⁸ The respondent urged that its website was "a fan site," "one of the most widely read websites when it comes to Samsung

212. *National Ass'n for Stock Car Auto Racing*, WIPO Case No. D2007-1524; *Volvo Trademark Holding AB*, WIPO Case No. D2005-0447; *Le Creuset SA*, WIPO Case No. D2004-0551; *Del Fabbro Laurent*, WIPO Case No. D2004-0481; *DaimlerChrysler*, WIPO Case No. D2001-0160; *Koninklijke Philips Elecs.*, WIPO Case No. D2000-1778.

213. *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

214. The panel did note that "it would be highly advisable for Respondent to clearly include in the website linked to the disputed domain name an express notice disassociating Respondent from Complainant and indicating that the SAMSUNG trademark belongs to Complainant." *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569. But the lack of such a notice in the particular case was not, by itself, sufficient to defeat bona fide use. *Gestion Integral Inovages*, WIPO Case No. D2012-0570; *Grupoinova*, WIPO Case No. D2012-0569.

215. WIPO Case No. D2013-0578 (May 18, 2013).

216. *Id.*

217. *Id.*

218. *Id.* "The reason for this approach is that the Respondent retains its search engine rankings that it would otherwise lose if it did not re-direct the site." *Id.* The respondent stated that the redirection was made "for the purpose of search engine optimization." *Id.*

related news,” and that readers know that “it is a fan site and not officially endorsed by the Complainant.”²¹⁹

In its decision, the panel stated that the question of whether the respondent had a right or interest in a domain name used for a fan site “is relevant to and intertwined with a finding of bad faith.”²²⁰ The panel then discussed the examples provided in paragraph 4(b)(i)–(iv) and concluded that none were present in the case.²²¹ The panel noted that although advertisements appeared on the respondent’s website, for which the respondent received revenue, they were “of an ancillary or limited nature” and not evidence of registration and use of the domain name in bad faith.²²² Ultimately, the panel concluded, “The Respondent has provided a plausible reason for registering the Domain Name and considerable evidence in support of its factual claims.”²²³ Describing the respondent’s use as “an essentially noncommercial fan site without attempting to sell the Domain Name,” the panel found no bad faith and denied the complaint.²²⁴

In this regard, of note is the discussion of fan sites in WIPO Overview 2.0. WIPO places the issue of fan sites under the second element of paragraph 4(a), relating to the respondent’s right or interest, and not the third element, which addresses respondent’s bad faith.²²⁵ WIPO notes that for “fan sites that are clearly active and noncommercial,”²²⁶ there are two views: (i) the registrant may have a right or interest in the domain name that includes the complainant’s mark, if the site is “actually in use, clearly distinctive from any official site, and noncommercial in nature;”²²⁷ and

(ii) [a] respondent does not have rights or legitimate interests in expressing its view, even if positive, on an individual or entity by using an identical or confusingly similar domain name, if the respondent is intentionally misrepresenting itself as being (or as in some way associated with) that individual or entity, or seeks to derive commercial advantage from its registration and use. Also, where the domain name is identical to the trademark, panels have noted that such respondent action prevents the

219. *Id.*

220. *Id.*

221. *Id.*

222. *Id.*

223. *Id.*

224. *Id.*

225. WIPO OVERVIEW 2.0, *supra* note 35, ¶ 2.5 (“Can a fan site generate rights or legitimate interests in the disputed domain name?”).

226. *Id.* This is in contrast to the “many UDRP cases in which the respondent claims to have an active noncommercial fan site but the panel finds that it is primarily a pretext for commercial advantage.” *Id.*

227. *Id.*

trademark holder from exercising its rights to the trademark and managing its presence on the Internet.²²⁸

In addition to fan sites, WIPO has also addressed panels' views on whether a domain name containing the complainant's trademark for a website that offers "genuine, noncommercial criticism" of that complainant may give rise to a proper right or interest in the domain name.²²⁹ Again, WIPO notes two views:

View 1: The right to criticize does not necessarily extend to registering and using a domain name that is identical or confusingly similar to the complainant's trademark. That is especially the case if the respondent is using the trademark alone as the domain name (i.e., <trademark.tld>) as that may be understood by Internet users as impersonating the trademark owner. Where the domain name comprises the protected trademark plus an additional, typically derogatory term (e.g., <trademarksucks.tld>), some panels have applied View 2 below.

View 2: Irrespective of whether the domain name as such connotes criticism, the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if such use is fair and noncommercial.²³⁰

WIPO adds that panelists tend to adopt the second view "[i]n cases involving only US parties or the selection of a US mutual jurisdiction."²³¹

The possibility of a criticism site was discussed in the proceeding involving the domain names <chungmongku.com> and <chungmongku.net>, which incorporated the name of Mong Koo Chung, chairman and CEO of Hyundai Motor Company, a unit of another Korean conglomerate.²³² The panel determined that the individual complainant had

228. *Id.*

229. *Id.* ¶ 2.4 ("Can a criticism site generate rights and legitimate interests?").

230. *Id.*

231. *Id.*

232. Chung, Mong Koo and Hyundai Motor Co. v. Individual, WIPO Case No. D2005-1068 (Dec. 21, 2005). The panel described the website to which the domain names resolved thus:

In essence it is a website which purports to be the website of Hyundai and Mr. Chung Mong Koo, for it is reached by domain names consisting solely of his name, it includes a series of questions where the answers are by implication being given by Mr. Chung, it carries a photograph of Mr. Chung with greetings from the website and it gives his name in Chinese characters. It also underlines the connection between Mr. Chung and [Hyundai Motor Company] by prominently displaying the word HYUNDAI which is a registered Korean and international trademark and by inviting the reader to send an email to chungmongku@[email address]. The real vice in the website is that it poses questions, the answers to which are derogatory of Hyundai and which are falsely portrayed as coming by implication from Mr. Chung himself. Whilst this is being done, the website carries the exhortation 'don't buy Hyundai', an assertion that [Mr. Chung] illegally paid 9 billion won to a political party and another assertion that Hyundai is 'junk'. Clearly some consumers will find all of this ludicrous and will ignore it. But the Panel finds that in all probability at least some people will take notice of the false assertions on the website and many more will certainly be misle[d] and confused by them

common law trademark rights in his name and that each domain name was identical or confusingly similar to the mark.²³³ The panel also stated that the respondent had no right or interest in the domain name, specifically rejecting the notion of a criticism site:

Nor could the Respondent remotely succeed in arguing that he had the protection of free speech or that this was one of the so-called protest cases. That is so for the reason that the Respondent has not been open or transparent and has not publicly announced that his domain names will lead to a criticism or protest site.²³⁴

Instead, the resolving website purported to be that of Chung and Hyundai.²³⁵ The panel also found the respondent's conduct to be of bad faith under paragraph 4(b)(iii) and (iv), and ordered the transfer of the domain names.²³⁶ Although the facts of this case did not warrant a finding of a permissible criticism or fan site, celebrities and public figures are on notice of that possibility, given the current regime.²³⁷

C. Other Decisions of Interest

In addition to the decisions above, the facts of, and the panel's disposition in, other proceedings merit mention. One case in the database holds the record for the highest number of domain names challenged in one proceeding—forty.²³⁸ In that case, the panel ordered the Korean individual respondent to transfer all of the domain names containing “harrods” to the entity based in London by that name.²³⁹ Other proceedings invite further

Id.

233. *Id.*

234. *Id.*

235. *Id.*

236. *Id.*

237. In three early decisions, Yong Pil Cho, a Korean pop music artist, challenged domain names containing his name. Cho Yong Pil v. ImageLand, Inc., WIPO Case No. D2000-0229 (May 10, 2000) (<choyongpil.com>); Cho Yong Pil v. Sinwoo Yoon, WIPO Case No. D2000-0310 (June 19, 2000) (<choyongpil.net>); Cho Yong Pil v. Kee Dooseok, WIPO Case No. D2000-0754 (Aug. 28, 2000) (<choyongpill.com>). It should be noted that these decisions were issued within the first year after ICANN adopted the UDRP, and five years before WIPO posted its initial overview of decisions, with mention of fan sites. WIPO, WIPO OVERVIEW OF WIPO PANEL VIEWS ON SELECTED UDRP QUESTIONS, ORIGINAL EDITION ¶ 2.5, <http://www.wipo.int/amc/en/domains/search/oldoverview/#25>. While the disputed domain names might be candidates for a non-commercial fan site in the current setting, at the time, the respondent was not operating an active website. The panels ordered the transfer of the above domain names.

238. See Harrods Ltd. v. Yoo Jae Bong, WIPO Case No. D2005-0808 (Nov.15, 2005) [decision in Korean].

239. *Id.*. The domain names were: <antiharrods.com>; <antiharrods.net>; <harrodsacademy.com>; <harrodsair.com>; <harrodsbook.com>; <harrodscafe.com>; <harrodscanada.com>; <harrodscapital.com>; <harrodsdcard.com>; <harrods-china.com>; <harrodsdcity.com>; <harrodscom.com>; <harrodsdiet.com>; <harrodsfire.com>; <harrodsfood.com>; <harrodsfoods.com>;

elaboration. One decision involved two young Korean men who claimed that their nicknames were “Muscle” and “Fitness,” and registered the domain name <musclenfitness.com>.²⁴⁰ They prevailed over the U.S. company that published the magazine, *Muscle and Fitness*.²⁴¹ In another case, the complainant offered to pay the respondent’s predecessor \$50,000 for a domain name.²⁴² Rebuffed, the complainant later brought a UDRP proceeding in which the panel ordered the transfer of the domain name to the complainant.²⁴³ Finally, in two separate proceedings one year apart involving U.S. giant Nike, Inc. and a Korean respondent, which registered multiple domain names containing “nike,” Nike prevailed in the first proceeding²⁴⁴ but not in the second.²⁴⁵

1. Brothers Muscle and Fitness

In *Weider Publications, Inc. v. Don Ho Cha*,²⁴⁶ the portion of the decision devoted to the respondent party’s contentions appears to be a recitation from the response:

I was born strong, healthy, and muscular by nature - in good shape and fitness. So was my younger brother That’s why . . . one of my old friends, long ago called us by the nicknames “muscle” and “fitness”. Not only he but also everyone we know has called us by those names even at home, church and elsewhere. So when we decided to have a family homepage website in an attempt to apply the knowledge gained in our studies, we decided to make use of our nicknames – “muscle” and “fitness” as a domain name so that it would be easily recognizable to our friends.

. . . .

We had never heard of the trademark MUSCLE & FITNESS nor of the Complainant until this dispute arose.²⁴⁷

The panel acknowledged the complainant’s use of the “MUSCLE & FITNESS” mark for a “magazine concerning health and fitness” and its U.S.

<harrods-france.com>; <harrodsgame.com>; <harrodsgolf.com>; <harrodshospital.com>; <harrods-italy.com>; <harrods-korea.com>; <harrodsland.com>; <harrodsleisure.com>; <harrodsleports.com>; <harrodsmart.com>; <harrodsmember.com>; <harrodsmembers.com>; <harrodsnorway.com>; <harrodspark.com>; <harrodspfarm.com>; <harrodspiazza.com>; <harrodssauna.com>; <harrodsservice.com>; <harrodstour.com>; <harrodstown.com>; <harrodstrade.com>; <harrodswedding.com>; <harrodzone.com>; <hotelharrods.com>. *Id.*

240. *Weider Publ’ns, Inc. v. Don Ho Cha*, WIPO Case No. D2001-0105 (Mar. 14, 2001).

241. *Id.*

242. *NHN Corp. v. NHN Corp.*, WIPO Case No. D2003-0939 (Feb. 27, 2004).

243. *Id.*

244. *Nike, Inc. v. Crystal Int’l*, WIPO Case No. D2001-0102 (Mar. 19, 2001).

245. *Nike, Inc. v. Crystal Int’l*, WIPO Case No. D2002-0352 (July 4, 2002).

246. *Weider Publ’ns, Inc.*, WIPO Case No. D2001-0105.

247. *Id.*

registration of the mark, both predating the respondent's registration of the domain name <musclenfitness.com>.²⁴⁸ The complainant contended that its licensee was the owner of the same mark that was registered in Korea seventeen months before the registration of the domain name.²⁴⁹ Nevertheless, the panel accepted the respondent's assertion that he had no knowledge of the complainant or its mark before the dispute,

[h]aving regard to the descriptive nature of the words comprising the Complainant's mark; to the fact that the Respondent is in Korea and the Complainant is in the United States; to the absence of any evidence that the Complainant's printed magazine is published or circulates or is known in Korea and to the lack of evidence that the Complainant's online activities have led to the recognition of its mark in Korea.²⁵⁰

With respect to the registration of the mark by the complainant's licensee, the panel stated that there was no evidence of use of the mark in Korea by the licensee, and "no reason to reject the Respondent's assertion that he was unaware of the mark prior to this dispute."²⁵¹

The panel found that the respondent demonstrated that he had a right or legitimate interest in the domain name under paragraph 4(c)(i), relying in large part on a document provided by the respondent entitled "Website Project."²⁵² The document contained the following: the terms "Muscle" and "Fitness;" the names of the respondent, his brother, and other family members; a description of the contents of a proposed website; a "Project Plan"; and "Project Progress Schedule."²⁵³ In summary, the panel reasoned that the evidence showed that before notice of the dispute, the respondent "engaged in demonstrable preparations to use the disputed domain name in connection with a bona fide offering of services, namely information about his family and about heath [sic] and fitness in general."²⁵⁴

The decision in *Weider Publications* invites comment and questioning. On the respondent's side of the dispute, the decision indicates an Internet and UDRP savvy party. As the panel noted, the respondent's submissions "revealed a good knowledge of the cases on domain name disputes."²⁵⁵ One

248. *Id.*

249. *Id.*

250. *Id.*

251. *Id.*

252. *Id.*

253. *Id.*

254. *Id.* The panel also noted, without explicitly referring to paragraph 4(c)(ii), that the respondent demonstrated that he and his brother were "for some time commonly known by the names 'muscle' and 'fitness'." *Id.* Finally, the panel stated that the complainant did not show "either bad faith registration of bad faith use." *Id.*

255. *Id.*

example is the following statement by the respondent, which, according to the panel, was supported by the “Website Project” document: “[B]efore this dispute arose, my brother and I made *preparations* for a website using the domain name, for the *non-commercial*, family purpose of presenting useful information including tips about my family, golf, therapy and Korea ginseng.”²⁵⁶ The underscored text appears to be tailored to provisions of paragraph 4(c), although it combines both (c)(i) and (iii) into one.²⁵⁷

On the complainant’s side, the case highlights the predicament of the complainant whose mark does not have worldwide recognition and who must demonstrate that the respondent was aware of the complainant and its mark. Proving that the respondent had actual knowledge is difficult. In the ordinary course, the complainant hopes that the panel will find that the respondent *must* have known about the complainant. This can be problematic when the respondent is geographically separated from the complainant’s operations, as were the two brothers in Korea in the <musclenfitness.com> decision.²⁵⁸ In that case, the panel accepted the respondent’s assertion that he and his brother did not know about the complainant until the UDRP proceeding commenced.²⁵⁹ The panel also accepted the declaration by the respondent’s friend that the friend was the originator of the nicknames, and that the respondent and his brother were commonly and widely known by those names.²⁶⁰ The streamlined UDRP process does not allow for cross-examination of the parties.

For purposes of discussion only, were cross-examination of the type seen in a U.S. court action allowed here, the following considerations should be taken into account. In the author’s opinion, it is not inconceivable that a person in Korea could have “Muscle” or “Fitness” as a nickname, even if both are English words. There *is* a Korean term for muscle (근육 or *geun-yook*).²⁶¹ “Fitness” is one of several words for which Koreans use the Korean

256. *Id.* (emphasis added).

257. Paragraph 4(c)(i) refers to “before any notice . . . of the dispute,” “demonstrable preparations” to use the domain name in connection with “a bona fide offering of goods or services,” and 4(c)(iii) refers to “legitimate noncommercial or fair use of the domain name, without intent for commercial gain.” UDRP ¶¶ 4(c)(i), 4(c)(iii).

258. *See Weider Publ’ns, Inc.*, WIPO Case No. D2001-0105.

259. *Id.*

260. *Id.* The panel noted that it “sought confirmation that the declaration was in fact sworn on oath.” The panel explained,

The Respondent stated in reply that the document was in fact sworn on oath according to the Korean Civil Proceedings Act, Clause 292, Article 2 and Clause 329. He submitted a handwritten certificate from [the declarant] appearing to verify that the declaration (set out again in the certificate) was sworn on oath in accordance with that law.

Id.

261. DONG-A’S PRIME ENGLISH-KOREAN DICTIONARY 1492 (3d ed. 1994).

transliteration of the English term. But given that there is no “f” sound in the Korean phonetic alphabet, and that the “f” is normally replaced by an “h” or “p,” “fitness” in Korean is written and pronounced as *hwi-teu-ni-seu* (휘트니스) or *pi-teu-ni-seu* (피트니스).²⁶² In the present case, one supposes that the respondent was “Muscle” and his brother was “Fitness,” but this is not clear from the decision, either in the panel’s recitation of the respondent’s contentions or the description of the declaration of the respondent’s friend. The respondent asserted that not only his friend, “but also everyone we know . . . called us by those names even at home, church and elsewhere.”²⁶³

Korea is a deeply hierarchical society, and persons’ titles are normally used in most interpersonal interactions.²⁶⁴ One wonders if the respondent and his brother were addressed by their nicknames by their pastor or senior church personnel, or by their professors.

Finally, the panel decision identifies the respondent and his brother as “postgraduate University students in Korea.”²⁶⁵ This raises the question of whether either or both of them (or their friend who gave them the nicknames) studied in the U.S., or traveled there. Given their professed interest in health, a visit to any magazine or fitness store might have exposed them to the complainant’s magazine. In addition, while the declaration by the respondent’s friend specified that the friend was the originator of the Muscle and Fitness nicknames, it did not specify that *the friend* did not know about the complainant before notice of the proceeding.²⁶⁶

2. Domain Name Purchasers

The facts of *NHN Corporation v. NHN Corporation, National Health Network* involve multiple domain name purchasers and Korean principals.²⁶⁷

262. A common Korean use of “fitness” is seen in “fitness club”— 휘트니스 클럽 or 피트니스 클럽. An Internet search for these Korean phrases will confirm this. (The Korean term for “club” is also a transliteration, 클럽). MINJUNG ESSENCE KOREAN-ENGLISH DICTIONARY 2110 (2d ed. 1993).

263. *Weider Publ’ns, Inc.*, WIPO Case No. D2001-0105.

264. See generally Ilhyung Lee, *The Law and Culture of the Apology in Korean Dispute Settlement (with Japan and the United States in Mind)*, 27 MICH. J. INT’L L. 1, 24 (2005). First names are not generally used in interactions, except among family members and close friends and classmates, and to little children.

265. *Weider Publ’ns, Inc.*, WIPO Case No. D2001-0105.

266. Currently, the subject domain name resolves to a search portal site containing links for, among others, “Exercise Programs,” “ABS,” “A Fitness Plan.,” “Yoga Pilates Exercise Fitness.” <http://musclenfitness.com> (last visited Jan. 17, 2016). At the top of the website appears the text, “This domain is for sale.” *Id.* The domain name is registered to an organization in Oslo, Norway, and the registration date is in 2010. Musclenfitness.com, WHOIS, <http://www.whois.com/whois/musclenfitness.com> (last visited Jan. 17, 2016). Perhaps the domain name previously expired or was deleted after the respondent in *Weider Publications* held it, and was then acquired by another party.

267. WIPO Case No. D2003-0939 (Feb. 27, 2004).

In that case, the complainant, incorporated in Korea, was engaged in various Internet-related business operations.²⁶⁸ It registered a number of trademarks in Korea containing “NHN”, all predating the registration of the domain name <nhn.com>.²⁶⁹ In late August 2003, the complainant first contacted HBX, Inc., a U.S. company, about purchasing <nhn.com>, which HBX had bought from a domain name dealer for US\$20,000 almost three months before.²⁷⁰ The president of HBX, Mr. Nah, was of Korean origin, and understood the Korean language.²⁷¹ In the course of the negotiations in the ensuing nine days, the complainant offered to pay US\$50,000 for the domain name, which HBX declined, saying that it had received an offer for “over \$250,000.”²⁷² A month later, the complainant and HBX resumed correspondence, with HBX offering to sell the domain name for US\$150,000.²⁷³ This time, the complainant took a different approach, stating, “Your <nhn.com> domain coincides with our trade name ‘NHN Corp,’ which has been in use since September 2001. Your domain name also coincides with the trademarks and service marks registered in many countries including Korea.”²⁷⁴

The complainant stated that it was considering a proceeding under the UDRP, but that for a “mutually amicable and prompt settlement of this matter,” the complainant would purchase the domain name for \$5,000.²⁷⁵ Two days later, the complainant raised the amount to \$10,000 as a “final offer.”²⁷⁶ HBX’s response requested a “reasonable offer,” noting that the complainant, in the weeks before, had offered \$50,000 for the domain name.²⁷⁷ Nine days after this correspondence, on November 11, 2003, HBX transferred the domain name to the respondent, which was incorporated in New Jersey four days before.²⁷⁸ Mr. Nah, president of HBX, became a “substantial shareholder” of the respondent, and was “a close business associate” of the respondent’s president.²⁷⁹ After an exchange of emails

268. *Id.*

269. *Id.*

270. *Id.*

271. *Id.* The panel noted that the complainant’s correspondence was in Korean, while HBX’s was in English. *Id.*

272. *Id.*

273. *Id.*

274. *Id.*

275. *Id.*

276. *Id.*

277. *Id.*

278. *Id.*

279. *Id.*

between the parties on November 19, 2003, the complainant filed its complaint with WIPO on November 26, 2003.²⁸⁰

The respondent's story was that in June 2003, the respondent's president, Mr. Kim, who was the "prime mover," and his two partners—Mr. Nah, HBX's president and shareholder of the respondent, and Mr. Choi, a web designer—"formed plans to develop an online health related business under the name NHN, NHN being an acronym for National Health Network which was to be the trading name of the [respondent's] business."²⁸¹ Four months later, the respondent was incorporated and acquired the domain name.²⁸² According to the respondent, at all material times, the respondent's principals were unaware of the complainant and its mark.²⁸³ In fact, the respondent's response appended sworn statements from Mr. Kim and Mr. Nah denying that they were aware of the complainant's trademark when HBX acquired the domain name or when HBX transferred the domain name to the respondent.²⁸⁴ The panel described the statement to be "inherently unlikely," given that Mr. Nah and Mr. Kim were close business associates, and that Mr. Nah, as president of HBX, was "well aware of the Complainant and further . . . well aware that the Complainant was prepared to pay a substantial sum of money for the Domain Name."²⁸⁵

The panel issued a procedural order, which in part requested the respondent to provide "further information and contemporaneous documentation" relating to "its plans to use the name National Health Network prior to acquisition of the Domain Name,"²⁸⁶ which, if provided, might support the respondent's right or interest in the domain name under paragraph 4(c)(i) of the Policy. The panel noted that "no such documentation was produced; nor was there any explanation for the Respondent's failure to produce it."²⁸⁷

Under the circumstances, the panel stated that it had "no alternative but to conclude that . . . the Respondent and its predecessor HBX were targeting the Complainant all along and with no genuine intention of trading under the

280. *Id.*

281. *Id.*

282. *Id.*

283. *Id.*

284. *Id.*

285. *Id.*

286. *Id.* (quoting Procedural Or. Feb. 16, 2004).

287. *Id.* The panel also stated that given Mr. Kim's declaration that a web designer was working on the respondent's proposed website since June 2003, when HBX first acquired the domain name, "one would have thought that it would not be too difficult to produce something to demonstrate bona fide preparations to use the names National Health Network or its acronym, NHN. However, the Respondent has provided nothing of that kind." *Id.*

names NHN and National Health Network.”²⁸⁸ Thus, the panel found that the respondent had no right or legitimate interest in the domain name.²⁸⁹ By the same reasoning, the bad faith element was satisfied; “[t]he Panel believe[d] it probable that the Respondent’s purpose was to extract a much larger sum of money from the Complainant.”²⁹⁰

The *NHN Corp.* decision is the story of a domain name purchaser and investor who paid \$20,000 in the open market for the domain name, but was, under the UDRP, directed to surrender the domain name to a third party who was able to demonstrate a superior right in the domain name, by virtue of prior rights in a trademark.²⁹¹ The fact that the complainant was willing to pay \$50,000 for a domain name that it was able to retrieve under the UDRP framework for the cost of administrative and legal fees made the matter more intriguing. The complainant filed its complaint on November 26, 2003, and the panel was appointed on January 30, 2004.²⁹² The panel’s decision is dated February 27, 2004.²⁹³ The panel’s procedural order requesting information from the parties delayed the decision by a few weeks.²⁹⁴ The respondent had ten days to challenge the decision in a court of competent jurisdiction.²⁹⁵ Failing that, ICANN was to implement the panel’s decision.²⁹⁶

Regarding the work of the panel, whereas the panel in *Weider Publications* accepted the respondent’s assertions denying knowledge of the complainant, and was unwilling to question a sworn declaration by the respondent’s friend,²⁹⁷ the three panelists in *NHN Corporation* were less reluctant. Even acknowledging that “it is a serious matter to reject a sworn statement” when “the circumstances were, to say the least, suspicious,” the panel acted by rejecting the respondent’s statements.²⁹⁸ A UDRP panel has the authority to “determine the admissibility, relevance, materiality and

288. *Id.*

289. *Id.*

290. *Id.*

291. *Id.*

292. *Id.*

293. *Id.*

294. *Id.*

295. *Id.*

296. Currently, according to whois.com records, the <nhn.com> domain name, with a registration date of April 17, 2003, is registered to Naver Corp. in Korea. Nhn.com, WHOIS, <http://www.whois.com/whois/nhn.com> (last visited Jan. 17, 2016). The *NHN Corp.* panel decision notes that the complainant “was originally established as Navercom.” *NHN Corp.*, WIPO Case No. D2003-0939.

297. *Weider Publ’ns, Inc. v. Don Ho Cha*, WIPO Case No. D2001-0105 (Mar. 14, 2001).

298. *NHN Corp.*, WIPO Case No. D2003-0939.

weight of the evidence,”²⁹⁹ and in the *NHN Corp.* decision, the credibility of the declarant was at issue.

3. Panel Discretion in the Nike Proceedings

Nike, Inc. is a U.S. company “very well known throughout the world as a leading supplier of sports footwear, clothing and equipment under its name ‘Nike.’”³⁰⁰ In January 2001, in *Nike, Inc. v. Crystal International* (“*Nike I*”), the company commenced a proceeding against the Korean respondent that registered the domain names <nikewomen.com>, <nikeshop.net>, <nikeshop.org>, <nike-shop.com>, <nike-shop.net> and <inike.net>.³⁰¹ None of the domain names resolved to an active website.³⁰² The respondent did not file a timely response, but thirteen days after the deadline for the response, the respondent sent an email to WIPO stating that it intended to use some of the domain names for “a Nike shopping mall website and that it did not understand why this should be unlawful.”³⁰³ Initially, the panel stated that in its discretion under the UDRP Rules, it would not take into consideration the respondent’s email.³⁰⁴ Turning to the merits of the case, the panel determined that the three requisite elements of paragraph 4(a) were satisfied, and ordered the transfer of the domain names.³⁰⁵

Thirteen months after the panel’s decision in *Nike I*, Nike filed another complaint against the same Korean respondent in *Nike, Inc. v. Crystal International*³⁰⁶ (“*Nike II*”), this time objecting to the domain names <nikepark.com>, <nikepark.net>, <nikemen.com>, <nikegolf.net>, and <nikeshops.com>.³⁰⁷ Again, the Korean respondent did not file a response, nor did it submit anything by email.³⁰⁸ As in *Nike I*, the domain names did not lead to active websites.³⁰⁹ The panel issued a procedural order directing

299. UDRP RULES ¶10(d).

300. *Nike, Inc. v. Crystal Int’l*, WIPO Case No. D2001-0102 (Mar. 19, 2001) [hereinafter *Nike I*].

301. *Id.*

302. *Id.*

303. *Id.*

304. The panel stated that although paragraph 5(d) of the UDRP Rules provides that “at the request of the Respondent, the Provider may, in exceptional cases, extend the period of time for the filing of the response,” “this is not an exceptional case,” and also noted that the email did not comply with the certification requirement of the response in paragraph 5(b)(viii). *Id.*

305. *Id.*

306. WIPO Case No. D2002-0352 (July 4, 2002) [hereinafter *Nike II*].

307. The first four domain names were registered in 1999, and could have been included in Nike’s prior proceeding. Nike stated that it was unaware of these domain names at the time. *Id.*

308. *Id.*

309. *Id.*

Nike to respond to various items, to which Nike submitted a response.³¹⁰ On the merits, the panel in *Nike II* determined that the complainant failed to establish the bad faith element, and denied the complaint, allowing the respondent to keep the five domain names.³¹¹

The two panels' respective determinations regarding the bad faith element in the *Nike I* and *Nike II* decisions reflect a profoundly different approach to the issue, and are worthy of a side-by-side comparison. In *Nike I*, with respect to the third element, Panelist Jonathan Turner found evidence of bad faith under multiple provisions of paragraph 4(b):

As to the third requirement, the Panel considers that bad faith is indicated by the registration of a series of domain names which are confusingly similar to a famous brand name followed by the absence of any legitimate use of them for over two years since the first was registered. The Panel is satisfied that the Domain Names were in fact registered in order to prevent the Complainant from reflecting "Nike" and "Nike Shop" in corresponding domain names. The Panel considers that the registration of a series of six such names is sufficient to constitute a pattern of such conduct within the meaning of paragraph 4(b)(ii) of the Policy. The Panel is also satisfied that the Domain Names were registered by the Respondent primarily for the purpose of selling for valuable consideration in excess of its costs and that the case falls within paragraph 4(b)(i) of the Policy. Further, the retention of the Domain Names for these purposes constitutes use in bad faith.

Given the reputation of the "Nike" brand, the Panel considers that the use of the Domain Names by another person would be likely to cause confusion. . . .³¹²

In contrast, regarding the bad faith element in *Nike II*, Panelist Cecil O.D. Branson, QC began:

I will focus on bad faith use in dealing with this element and will assume that bad faith registration has been proved. Here, there is no evidence that Respondent has attempted to sell the Domain Names for profit, has engaged in a pattern of conduct depriving others of the ability to obtain Domain Names corresponding to their trademarks, is a competitor of Complainant seeking to disrupt its business, or is using the Domain Name to divert Internet users for commercial gain. Nor is there such conduct as cyberflying, failing to provide correct or any contact information, not responding to communications which might reasonably be thought to compel a Response, being disingenuous in his or her assertions, or failing to make any preparations to use the Domain Names over an extended

310. *Id.*

311. *Id.* The panel determined that the first element, relating to the domain name's identical or confusing similarity to a mark in which the complainant has rights was proven. *Id.* The panel declared that it was unnecessary to address the second element of the respondent's right or interest in the domain name, in light of the panel's disposition of the bad faith element. *Id.*

312. *Nike I*, WIPO Case No. D2001-0102.

period of time. Lack of *bona fide* use on its own is insufficient to establish bad faith, where there is no evidence that Respondent has participated in such conduct as mentioned above.³¹³

[The complainant] asserts that “Respondent’s use and registration of these domain names has prevented Complainant from using its own world-famous trademark in these domain names. This conduct constitutes bad faith registration and use of the domain names under controlling law and precedent.” But, what was this use? There must be something beyond mere registration and it should be a use at the time of the commencement of the UDRP proceedings. It is the opinion of this Panel that mere continuous ownership is not sufficient.³¹⁴

With respect to the prior panel’s finding regarding the bad faith element in *Nike I*, the panel in *Nike II* summarily observed, “The earlier decision between the parties to the instant case does not identify the evidence provided by the Complainant in support of bad faith use sufficiently to be of help here.”³¹⁵

Thus, in two proceedings involving the same parties with almost all of the domain names beginning with “nike” and followed by a generic term relating to the complainant’s goods or services, and under virtually identical facts (principally that the respondent took no separate action regarding the domain names), the panels reached opposite results. In *Nike I*, the panel inferred bad faith activity as described in paragraph 4(b)(i) and (ii), and also determined that mere retention of the domain name for purposes of such activity was sufficient to establish bad faith use.³¹⁶ In *Nike II*, even assuming

313. *Nike II*, WIPO Case No. D2002-0352 (citing *Societe des Produits Nestle S.A. v. Pro Fiducia Treuhand AG*, WIPO Case No. D2001-0916 (Oct. 12, 2001)). The focus of the panelist’s discussion here is bad faith use. *Id.* In the second sentence of the quoted text, the panel offers examples that presumably would be evidence of such use. *Id.* The four examples are a paraphrase of the four subdivisions of paragraph 4(b)(i)-(iv), the first three of which refer to *registration*. *Id.*

314. *Id.* There was quite a bit more to the panelist’s discussion, which incorporates matters contained in its procedural order and the complainant’s response thereto. The order, which is appended to the decision, is not the typical UDRP procedural order. It begins:

1. Upon reviewing the Complaint in this case the Panel’s initial view was that it ought to be disallowed as being deficient in its content. A good number of Panels, including this one, have said that an Administrative Panel must not deal with propositions not asserted. It is for the Complainant to plead the issues and to support them with some arguments and evidence. Simply stating reasons will not normally be sufficient to meet the Complainant’s burden of proof. More particularly, it has been held by a Panel that the mere assertion that any use of the Domain Name by another party would likely mislead or deceive the Complainant’s customers, without evidence, is not of much use. With these general admonitions in mind, this Panel is concerned about the failure of the Complaint to address a number of material facts which ought to be within its knowledge.

Id. (Addendum, Procedural Or. July 4, 2002). The order fairly posed questions seeking clarification of factual assertions made by the complainant, but also raised other “concerns” and included statements that border on the argumentative (e.g., “The name ‘Nike’ is not fanciful. She was the ancient Greek goddess of victory.”). *Id.*

315. *Id.*

316. *Nike I*, WIPO Case No. D2001-0102.

bad faith registration, in order to establish bad faith use, the panel required more than “mere continuous ownership.”³¹⁷ If the approach in *Nike II* were the rule, a cybersquatting respondent would be well advised to refrain from using the domain name for an active website for the time being in order to evade a finding of bad faith. It should be noted that the *Nike* decisions were handed down relatively early in the life of the UDRP. Currently, the consensus view that has emerged from WIPO-administered decisions is that “the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.”³¹⁸ Instead, “[e]xamples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant’s concealment of its identity.”³¹⁹ The panel decisions in *Nike I* and *Nike II* highlight the possibility of panels making divergent findings on essentially the same facts.³²⁰

IV. STATISTICS

This section offers selected statistics relating to the decisions contained in the database. Admittedly, there is a hodgepodge character to the collection of figures included here, reflecting the author’s curiosities. Interested observers may raise questions about other variables. The database includes

317. *Nike II*, WIPO Case No. D2002-0352. The panel in *Nike II* offered:

Evidence which proves bad faith use comes primarily from three sources. Communications between the parties, particularly statements made by a Respondent, demonstrate bad faith use. Cease and desist letters relating to the alleged offending use have been effective in drawing out the Respondent. What is posted on a web-site, often but not always the site to which the Domain Name resolves, performs the same function, e.g. where the web-site advertises a competing product, displays pornographic material, or links to such web-sites. . . . Another way of proving bad faith use through evidence is to obtain particulars about the Respondent and its enterprises, past history, reputation and ownership of other Domain Names, not the subject of the case at hand. There are other evidentiary indicia such as false contact information, making untruthful statements in a Response, and the like.

Id.

318. WIPO OVERVIEW 2.0, *supra* note 35, ¶ 3.2 (“Can there be use in bad faith when the domain name is not actively used and the domain name holder has taken no active steps to sell the domain name or contact the trademark holder (passive holding)?”).

319. *Id.*

320. Currently, all of the domain names in *Nike II*, WIPO Case No. D2002-0352, are registered to Nike, Inc. Nikepark.com, WHOIS, <http://www.whois.com/whois/nikepark.com> (last visited Jan. 17, 2016) (for <nikepark.com>); Nikepark.net, WHOIS, <http://www.whois.com/whois/nikepark.net> (last visited Jan. 17, 2016) (<nikepark.net>); Nikemen.com, WHOIS, <http://www.whois.com/whois/nikemen.com> (last visited Jan. 17, 2016) (<nikemen.com>); Nikegolf.net, WHOIS, <http://www.whois.com/whois/nikegolf.net> (last visited Jan. 17, 2016) (<nikegolf.net>); Nikeshops.com, WHOIS, <http://www.whois.com/whois/nikeshops.com> (last visited Jan. 17, 2016) (<nikeshops.com>). These domain names do not resolve to active websites.

a total of 818 panel decisions involving a party with a reported address in Korea; these decisions referred to 1,073 disputed domain names.³²¹ While the vast majority of the decisions referred to one domain name, some proceedings contained more—from two to forty domain names. Regarding the nationality of the parties, if the decision indicated that either party was of Korean national origin, even if its address was not reported as one in Korea, it is considered as a Korean party for purposes of the following figures. Of the 818 decisions in the database, approximately 87.0% of them (712 decisions) involved a non-Korean complainant and a Korean respondent; 7.6% (62) have both a Korean complainant and respondent; and the remaining 5.4% (44) involve a Korean complainant and a non-Korean respondent.³²² As noted above, for the latter two categories, of the 106 decisions in which the complainant identified itself as Korean, Samsung brought the proceeding in more than half of them.³²³ Thus, Korea appears far more frequently as the respondent than as the complainant in the UDRP proceedings.³²⁴ Put another way, it is more likely that a Korean party will emerge as the alleged cybersquatter than as the trademark holder who asserts another's abusive registration and use of a domain name.

A. Procedural

The language in which the decisions are published reflects the international nature of the UDRP proceedings involving Korean parties.³²⁵ The panel's decision was in English in nearly 70% of the proceedings in the

321. Ilhyung Lee, *Korea Database of WIPO-Administered Decisions, 2000–2014* (on file with author). Although these and other counts of the subject decisions and domain names were re-checked for accuracy, there is the possibility of human error in the tabulation.

322. These figures, resulting in a total of 106 decisions in which the complainant is Korean, and 774 decisions in which the respondent is Korean, do not coincide with the figures offered in WIPO's statistics, which lists 129 Korean complainants, and 929 Korean respondents. WIPO, GEOGRAPHICAL DISTRIBUTION OF PARTIES (Alphabetical), http://www.wipo.int/amc/en/domains/statistics/countries_a-z.jsp (last visited Jan. 17, 2016). See WIPO, COMPLAINANT COUNTRY FILING (RANKING), *supra* note 7; WIPO, RESPONDENT COUNTRY FILING (RANKING), *supra* note 7. The disparity could be due in part to the definition of a Korean party herein, and the inclusion in the WIPO statistics of terminated proceedings after the complaint was filed (with no published decision) and decisions issued in 2015, which the database does not include.

323. See *supra* text accompanying notes 157–167.

324. In WIPO's international "rankings" of the parties by country, Korea is twenty-fourth on the list for the complainant, between Ireland (twenty-third) and Luxembourg (twenty-fifth), WIPO, COMPLAINANT COUNTRY FILING (RANKING), *supra* note 7, but eighth on the list for the respondent, between France (seventh) and the Netherlands (ninth), WIPO, RESPONDENT COUNTRY FILING (RANKING), *supra* note 7.

325. For WIPO's list of the various case languages by year, see WIPO, ALL CASE LANGUAGES BY YEAR AND TOTAL, <http://www.wipo.int/amc/en/domains/statistics/languages.jsp> (last visited Jan. 17, 2016).

database (568 of 818 decisions), and in Korean in almost 29% of the proceedings (236 of 818).³²⁶ The remaining decisions were in Spanish (five),³²⁷ Chinese (four),³²⁸ French (three),³²⁹ and Turkish (one).³³⁰ There are two decisions in which the decision by the three-member panel was in Korean, but an individualist panelist's separate opinion is in English.³³¹ In one early decision, the panel issued separate decisions in both Korean *and* English.³³² This appears to be the only WIPO-administered proceeding involving a Korean party in which the same panel decision was released in both languages.

Many respondents in a UDRP proceeding decline to participate in the resolution of the claim, and default. One commentator observed, within a year after the first UDRP proceedings, "Default proceedings are commonplace; domain name registrants do not even file a response in one third to one half of all UDRP cases . . ." ³³³ The database indicates that in proceedings involving Korean parties, the respondent failed to submit a

326. The database counts 236 decisions in Korean. This figure differs from WIPO's statistics. *Id.* (reporting 272 cases in Korean). WIPO's statistics might include terminated cases and those decided in 2015, which the database does not include.

327. Samsung Elecs. Co., Samsung Elecs. Iberia, S.A.U. v. [J] Mega Componentes, S.L., WIPO Case No. DES2014-0031 (Dec. 31, 2014); Hyundai Motor Co. and Hyundai Motor España S.L.U. v. Mediakeys SL, WIPO Case No. DES2014-0012 (June 15, 2014); Samsung Networks Co. v. SuperVirtualOffice Corp., WIPO Case No. DVE2010-0001 (May 10, 2010); Samsung Elecs. Co., Ltd. v. Jung Hyun Shin Lee, WIPO Case No. DMX2006-0004 (July 11, 2006); José Carreras Coll v. Eladio García, WIPO Case No. D2002-0725 (Oct. 7, 2002).

328. Samsung Elecs. Co., Samsung Sec. Co. v. SmartNames, WIPO Case No. 2011-0166 (Apr. 3, 2011); Samsung Elecs. Co. v. Bei jing xin ke ji you xian gong si, WIPO Case No. D2009-0404 (May 27, 2009); Samsung Elecs. Co. v. Wu han bo shi tong dian zi you xian gong si, WIPO Case No. D2009-0251 (May 13, 2009); Samsung Elecs. Co. v. Shenzheshi Luohuquasaigedianzicheng, WIPO Case No. D2006-0934 (Sept. 20, 2006).

329. Vente-privee.com, Vente-privee.com IP S.à.r.l. v. [J] Dzone Inc., Yeonju Hong, WIPO Case No. D2013-0691 (June 12, 2013); Société Kyung Jin Corp. v. Michaël Massat, Innovacases Noreve, WIPO Case No. D2011-1543 (Oct. 24, 2011); Samsung Networks Inc. v. Conaho, WIPO Case No. DMA2010-0002 (June 30, 2010).

330. Hankook Tire Worldwide Col, Ltd. v. Kemal Tanca, Lastikturk, WIPO Case No. D2014-1281 (Sept. 22, 2014).

331. Wal-Mart Stores, Inc. v. iContents, WIPO Case No. D2006-0226 (June 20, 2006) (majority decision in Korean; author's dissent in English); NBC Universal, Inc. v. Junak Kwon, WIPO Case No. D2004-0764 (Dec. 23, 2004) (panel decision in Korean; opinion of Sir Ian Barker in English).

332. SEMATECH, Inc. v. Lee Hyunggyu, WIPO Case No. D2001-0870 (Nov. 26, 2001). The English version of the decision states: "In light of the correspondence between parties and taking into account the composition of this Administrative Panel, the Panel decides to proceed in Korean. Notwithstanding, as a matter of courtesy, the decision is also provided in English text." *Id.* [decision in English]. The corresponding portion of the decision in Korean text relates that the decision was issued in both English and Korean as a matter of procedural fairness. *Id.* [decision in Korean].

333. David E. Sorkin, *Judicial Review of ICANN Domain Name Dispute Decisions*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 35, 42 (2001).

response in over 70% of the decisions, 580 of 818.³³⁴ In addition, a sole panelist decides a UDRP proceeding, unless either party requests a panel of three members.³³⁵ A three-member panel decided only fifty-eight of the 818 decisions.³³⁶ Some of the fifty-eight panel decisions include separate opinions by individual panelists that are worthy of discussion in the further development of UDRP jurisprudence.³³⁷

B. The Disposition

Of the 1,073 domain names that were the subject of the 818 proceedings leading to panel decisions, nearly 90% of the domain names were transferred to the complainant or canceled, favoring the complainant. The complaint was denied, allowing the respondent to retain the domain name, for 10.1% of the domain names. These rates are comparable to the corresponding figures for all WIPO-administered UDRP decisions: 87.5% in favor of the complainant, and 12.5% for the respondent.³³⁸

I offer a few observations about the disposition of the 712 decisions involving a non-Korean complainant and a Korean respondent, which, as indicated above, comprise a significant majority of the database decisions.

334. In some decisions, the panel accepted late responses. *E.g.*, *Associazione Radio Maria v. Scot Weise*, WIPO Case No. D2011-2068 (Feb. 1, 2012); *Adimpo, S.A. v. Jinsoo, Yoon*, WIPO D2006-1613 (Mar. 12, 2007) [in Korean]; *Builder's Best, Inc. v. Yoshiki Okada*, WIPO Case No. D2004-0748 (Nov. 17, 2004); *Samsung Networks, Inc. v. ss RC*, WIPO Case No. D2004-0560 (Oct. 6, 2004) [in Korean]; *Groupe Industriel Marcel Dassault, Dassault Aviation v. Mr. Minwoo Park*, WIPO Case No. D2003-0989 (Feb. 12, 2004); *Lotte Shopping Co. v. [Lee In Gu]*, WIPO Case No. D2003-0966 (Feb. 16, 2004) [in Korean]. Some decisions note that although the respondent did not file an official response, it transmitted email messages to WIPO indicating argument on the merits. *E.g.*, *Kyle Grant v. jeongyong cho*, WIPO Case No. D2013-1697 (Dec. 16, 2013); *Wilier Triestina S.p.A. v. Park Young Min*, WIPO Case No. D2013-1098 (Aug. 13, 2013); *Samsung Elecs. Co. v. Brendan Furlong*, WIPO Case No. DIE2013-0005 (Jan. 9, 2014); *Samsung Elecs. Co. v. Grupoinova*, WIPO Case No. D2012-0569 (May 10, 2012); *Samsung Networks Inc. v. Systemprodukter AB*, WIPO Case No. DNU2010-0001 (May 5, 2010); *The Procter & Gamble Co. v. Names2000.com*, WIPO Case No. D2010-0357 (May 25, 2010); *Allstate Ins. Co. v. Seung Bum*, WIPO Case No. D2009-1760 (Mar. 22, 2010); *Samsung Elecs. Co. v. Yongbae Lee*, WIPO Case No. D2008-0852 (Aug. 25, 2008); *Archipel, Inc v. individual kim@yunsik.com/Kim Yunsik*, WIPO Case No. D2008-0553 (May 28, 2008); *Billabong Int'l Ltd. v. Mookie Lei*, WIPO Case No. D2008-0101 (Mar. 20, 2008); *GA Modefine S.A. v. Giorgio Armani S.p.A. v. Kim Hongtae*, WIPO Case No. D2007-08512 (Sept. 7, 2007); *Raisio plc and Town of Raisio v. Lee Joohee, Yang Youngho*, WIPO Case No. D2005-1041 (Dec. 14, 2005); *Benetton Grp. S.p.A. v. Wonil Park*, WIPO Case No. D2002-0577 (Aug. 12, 2002); *SBC Commc'ns Inc. v. Boolgook Corp.*, WIPO Case No. D2002-0474 (July 24, 2002); *Nike, Inc. v. Crystal Int'l*, WIPO Case No. D2001-0102 (Mar. 19, 2001). For purposes of calculation here, these decisions were not included in the cases of the respondent's default.

335. UDRP RULES ¶ 6(b)–(c).

336. These fifty-eight decisions are the focus of a separate article. Ilhyung Lee, *The Fifty-Eight Proceedings: Domain Name Disputes, Korean Parties, and WIPO Three-Member Panels*, 23 U. MIAMI INT'L & COMP. L. REV. ___ (2016) [forthcoming].

337. *Id.*

338. See WIPO, CASE OUTCOME (CONSOLIDATED): ALL YEARS, *supra* note 14.

Of these 712 decisions, the dispute was resolved by a sole panelist in 659 cases, and by a three-member panel in fifty-three of them. Of the 659 decisions by a sole panelist, the panel ordered the transfer of the domain name in 91.0% of decisions, denied the complaint in 8.6%, and issued a split decision in the remaining. Of the fifty-three decisions in which a three-member panel decided the case, the panel ordered transfer or cancellation of the domain name in 62.3% of the cases, denied the complaint in 34.0%, and issued a split decision in 3.8%.³³⁹ Although the group of the fifty-three decisions is a small sample, there is a noticeably higher rate of a denial of a complaint by a three-member panel than by a sole panelist.

Also, of the 659 decisions decided by a sole panelist, the panelist was a Korean national, of Korean national origin, or was based in Korea (“Korea panelist”), in 383 of the decisions. In the other 276 decisions, the sole panelist was a non-Korea panelist. If there is some question as to whether the nationality of the panelist might affect the disposition of a UDRP proceeding involving Korean parties, the statistics by themselves do not support such a correlation. When a Korea panelist decided the case, the domain name was transferred or cancelled in 90.6% of the 383 decisions,³⁴⁰ and the complaint was denied in 9.4% of the decisions. A non-Korea sole panelist ordered the transfer or cancellation of the domain name in 92.1% of the 276 cases,³⁴¹ and denial of the complaint in 7.6% of them.³⁴²

339. Due to rounding, the sum of the percentages does not add to 100.0%.

340. The panel ordered the transfer of the domain name to the complainant in the large majority of decisions. Cancellation was ordered in *Accor v. Kim hong tae*, WIPO Case No. D2014-0190 (Mar. 31, 2014); *Sanofi-aventis v. Yijinmok*, WIPO Case No. D2007-0972 (Oct. 8, 2007); *Abertis Infraestructuras S.A. v. pollack co., Ltd.*, WIPO Case No. D2006-1062 (Oct. 24, 2006); *Koninklijke Philips Elecs. N.V. v. [Seo, Kang-Cheul]*, WIPO Case No. D2002-0959 (Dec. 27, 2002) [decision in Korean]; *TCL Int’l Holdings Ltd. v. Daung Soo Ghim*, WIPO Case No. D2003-0993 (Apr. 27, 2004); *Koninklijke Philips Elecs. N.V. v. Jeon Tae Jin*, WIPO Case No. D2001-0078 (May 11, 2001). In another decision, the panel ordered the transfer of one domain name and the cancellation of another. *Compagnie Gervais Danone v. Geijin Kim*, WIPO Case No. D2009-0842 (Aug. 20, 2009) (author served as sole panelist).

341. The domain name was cancelled in the following decisions. *Compagnie Générale des Etablissements Michelin v. [] Frank Park*, WIPO Case No. D2014-1771 (Nov. 27, 2014); *Compagnie Générale des Etablissements Michelin v. HoangVu Luu*, WIPO Case No. D2014-1016 (Aug. 20, 2014); *Compagnie Générale des Etablissements Michelin v. [] Kim Bum LLC*, WIPO Case No. D2013-0181 (Mar. 31, 2013); *Compagnie Générale des Etablissements Michelin v. Kim Bum LLC*, WIPO Case No. D2012-2092 (Dec. 19, 2012); *AT&T Corp. v. Beomjoon Park*, WIPO Case No. D2001-0133 (Mar. 30, 2001). The panel ordered transfer of the domain name in the rest of the decisions.

342. In one decision, the panel ordered the transfer of thirteen domain names, and denied the complaint with respect to two domain names. *ISL Marketing AG, & The Federation Internationale de Football Ass’n v. J.Y. Chung, Worldcup2002.com, W Co., and Worldcup 2002*, WIPO Case No. D2000-0034 (Apr. 3, 2000).

V. CONCLUSION

The Internet Corporation for Assigned Names and Numerals adopted the Uniform Domain Name Dispute Resolution Policy in 1999 to provide for an efficient method of resolving disputes over domain names. Korea, perhaps the most wired country in the world, has had a significant presence in UDRP proceedings in the first fifteen years. This article brings to light a database of over 800 decisions administered by the World Intellectual Property Organization involving parties with a connection to Korea. Although many decisions sound of the cybersquatting for which the UDRP was designed to address, there are also notable exceptions, in which the registrant of the disputed domain name was permitted to retain it. The decisions elaborate on provisions of the UDRP, along with the procedural rules, thereby contributing to the development of the UDRP. Selected decisions, by their facts and panel dispositions, are worthy of examination and discussion. Statistically, the rate of transfer of the domain names to the complainant trademark holder for the Korea cases is generally consistent with that for all WIPO-administered UDRP proceedings, though slightly higher. With the database for the first fifteen years in hand, Korea and Internet observers may look for Korea's place in the UDRP for years to come.