

Comparative Review on Domain Name Disputes Resolutions between the WIPO and the IDRC (Korea) Decisions*

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Abstract

The purpose of this study is to compare and contrast the approaches taken by the Uniform Domain Dispute Resolution Policy (UDRP) and the Act on Internet Address Resources (AIAR) of Korea in dealing with domain name disputes arising from cybersquatting. By examining the WIPO and the Internet Address Dispute Resolution Committee (IDRC) Panel decisions applying the relevant provisions of the UDRP and the AIAR, respectively, this study aims to shed light on how the UDRP and the AIAR are each designed to handle the myriad of complex issues which occur in connection with cybersquatting.

KEY WORDS: Cybersquatting, World Intellectual Property Organization, Uniform Domain Dispute Resolution Policy, Korea, Act on Internet Address Resources, Internet Address Dispute Resolution Committee, trademark, domain name, passive holding, initial interest confusion

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I. Introduction

The World Intellectual Property Organization (WIPO) adopted the Uniform Domain Dispute Resolution Policy (UDRP) for dispute resolutions regarding generic top-level domains. However, for Korean .kr domains, the Internet Address Dispute Resolution Committee (IDRC)¹⁾ applies the Act on

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1) Internet Address Dispute Resolution Committee (<http://www.idrc.or.kr>) operates and manages the Seoul Office of The Asian Domain Name Dispute Resolution Centre (ADNDRC). The ADNDRC is a provider (one of only four (4) providers in the world and the only one located in Asia) of dispute resolution services in regards to generic top level domain names

Internet Address Resources (AIAR) in settling disputes. Although there are similarities between these two regulations, there are also significant differences that may result in contrasting outcomes. This article will compare and contrast these regulations for differences and similarities, making references to specific decisions in order to examine how the varying sections of each regulation have been applied and interpreted.

II. Decision Standards of the WIPO and the IDRC (Korea)

1. The WIPO's Decision Standards: UDRP

The WIPO has adopted the UDRP to settle disputes on generic top-level domains (.com, .net, .org, etc.: gTLDs).²⁾ The UDRP § 4(a) requires a complainant to prove that each of the following elements is satisfied:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) The respondent has 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.

2. The IDRC's Decision Standards: AIAR

The IDRC of Korea applies the AIAR to resolve disputes on internet

(gTLD's), which are the top level domains approved by the Internet Corporation for Assigned Names and Numbers (ICANN). Because of the IDRC's regional ties to the other Asian branch offices of the ADNDRC, understanding of the IDRC decisions yields broader insight into the broader trends of domain name dispute resolution in Asia.

2) ICANN, *Uniform Domain Name Dispute Resolution Policy*, available at <http://www.icann.org/en/help/dndr/udrp/policy> (last visited Jun. 5, 2013); WIPO, *UDRP Procedures for Generic Top Level Domains* (gTLDs) (Korean translation), <http://www.wipo.int/amc/ko/domains/gtld/udrp/index.html>; WIPO, *Uniform Domain Name Dispute Resolution Policy* (Korean translation), <http://www.wipo.int/export/sites/www/amc/ko/docs/icannpolicy.pdf>.

addresses including .kr (Korean country code domain) domains. The AIAR § 18-2 requires a complainant to prove one of the following elements:³⁾

- (i) The respondent's use of the internet address infringes a complainant's right on a trademark or service mark registered in Korea under the Trademark Act of Korea;⁴⁾
- (ii) The respondent's use of the internet address causes a likelihood of confusion with the complainant's products or business widely known in Korea;⁵⁾
- (iii) The respondent's use of the internet address blurs the distinctiveness of or tarnishes the reputation of complainant's name, designation, mark or trade name, etc. which are well known in Korea;⁶⁾ or
- (iv) The respondent's internet address registration, ownership or use is conducted for the purpose to interfere with the registration or use of the internet address by the party who has the proper basis for claim (or legitimate ground of claim) or to obtain unfair profit by selling or renting the internet address to the party who has the proper basis for claim on a name, trade name, or other marks.⁷⁾

This study will focus mainly on the comparative review of the WIPO decisions under the UDRP and the IDRC decisions under the AIAR § 18-2②.”

3) Internetjusojawone Gwanhan Beomnyul [Act on Internet Address Resources (AIAR)], Act No. 11690, Mar. 23, 2013, *available at* <http://www.law.go.kr/lsSc.do?menuId=0&subMenu=1&p=&query=%EC%9D%B8%ED%84%B0%EB%84%B7%EC%A3%BC%EC%86%8C%EC%9E%90%EC%9B%90#liBgcolor0>

4) AIAR § 18-2① 1 (Similar to trademark infringement under the Trademark Act § 65).

5) AIAR § 18-2① 2 (Similar to likelihood of confusion under the Act on Unfair Competition Prevention and Trade Secret Protection (UCPA) § 2① a-b).

6) AIAR § 18-2① 3 (Similar to dilution under UCPA § 2① c).

7) AIAR § 18-2② (Similar to cybersquatting under UDRP § 4 (a). The main difference depends on whether bad faith is required for both registration **and** use of the domain name (UDRP), or for either registration **or** use (AIAR)).

Table 1. Requirements: UDRP vs. AIAR

	UDRP	AIAR
Registered Trademark Infringement	-	§ 18-2① 1.
Likelihood of Confusion	-	§ 18-2① 2.
Dilution	-	§ 18-2① 3.
Cybersquatting	§ 4 a	§ 18-2②
Justification	§ 4 c	§ 18-2③

3. Comparison of the UDRP and the AIAR

The UDRP and the AIAR show a significant difference in the scope of application. While the scope of the UDRP's application is limited to cybersquatting, the AIAR applies not only to cybersquatting but also to registered trademark infringement, likelihood of confusion, and dilution. With respect to cybersquatting, the UDRP and the AIAR show the following differences.

1) Scope of Protection

In principle, the UDRP only applies to trademark (service mark). However, because the UDRP does not provide a definition of 'trademark,' a few WIPO decisions have expansively interpreted the definition of 'trademark' in accordance with the purpose of the UDRP.⁸⁾

On the other hand, the AIAR § 18-2② protects "proper basis for claim" in addition to registered trademark and well-known mark. It should be noted that, because the AIAR does not define term "proper basis for claim," its definition and scope of application remain subject to the interpretation of courts.

8) Although the application of the UDRP does not extend to geographical designations and personal names in general, the marks may be protected in the event that they are registered or are being used as trademarks (WIPO Overview of WIPO Panel Views on Selected UDRP Questions [hereinafter WIPO Overview] Discussions 1.5 and 1.6, available at <http://www.wipo.int/amc/en/domains/search/overview>).

2) Requirements of Registration and/or Use

The UDRP requires the complainant to prove that the domain name has been registered *and* is being used in bad faith,⁹⁾ whereas the AIAR only requires “registration, ownership *or* use” of the internet address in bad faith.

3) Justification

(1) Under the UDRP § 4(a), the complainant must show ‘(i) a domain name is identical or confusingly similar to a trademark;’ ‘(iii) the domain name has been registered and is being used in bad faith;’ and ‘(ii) [the respondent has] no right or legitimate interests in respect of the domain name.’ Therefore, the burden of proving that the respondent has no right or legitimate interests in the domain name initially lies with the complainant. However, the UDRP § 4(c) provides detailed examples of how the respondent may demonstrate its rights and legitimate interests in the domain name in order to rebut the complainant’s contention.

(2) Under the AIAR, the requirements for transfer or cancellation of an internet address registration are provided under § 18-2① and ②. However, § 18-2③ states that “[n]otwithstanding paragraphs ① and ②, the Panel may dismiss the application if ... the respondent has the proper basis for claim, or the respondent has the legitimate rights or interest to register or use the internet address.” Therefore, the AIAR § 18-2③ places on the respondent the burden of proving that it has “the proper basis for claim, or the respondent has the legitimate rights or interest to register or use the internet address.”¹⁰⁾ It should be noted that the AIAR does not provide any example of how the respondent may satisfy this burden of proof.

(3) The AIAR requires the complainant to show that the internet address (domain name) is registered, owned or used for the purpose of interfering

9) *Teradyne, Inc. v. 4Tel Technology*, WIPO Case No. D2000-026 (May. 10, 2000); *Outils Rubis Ltd. v. NETPLUS Communication*, Case No. D2005-0645 (Aug. 2, 2005).

10) In the *koreacasio.co.kr* decision (Casio Computer Co., Ltd. v. Image Collection, Korean Domain Name Dispute Resolution Committee, KR 2003-0011, (2003), the Panel noted that “[R]espondent did not respond to the complaint to show that Respondent did not have the purpose to interfere with the business of Complainant and registered the domain name with legitimate interests,” and held for the Complainant.

Table 2. Comparison of Cybersquatting Requirements under the UDRP and the AIAR

	UDRP § 4(a), (c)	AIAR § 18-2②
Scope of Protection	Trademark or service mark	Legitimate grounds of claims (including name, designation, mark or trade name)
Requirements	(i) Identical or similar to trademark; (ii) No right and legitimate interest; and (iii) Registration and use in bad faith	Registration, ownership or use for the purpose of frustrating the registration and use by the right holder, or obtaining profits
Justification	§ 4(c) (examples) proved by the complainant	§ 18-2③ (general provision) proved by the respondent
Relief	Cancellation or transfer of domain name	Cancellation or transfer of internet address (domain name)
Scope of Applicability	Generic top-level domains (gTLDs), worldwide	.kr domains, Domain names registered, used, or held in Korea (revised in 2009)

with the registration or use of the internet address by a party who has the proper basis for claim. As long as the complainant satisfies this burden of proof, the complainant is not required to prove that there is no justification for the respondent's registration and use of the domain name.

This implies that, in the event that the respondent fails to respond to the complaint, the Panel may decide to transfer or cancel the internet address registration without determining whether there is any justification for the respondent's registration and use of the domain name.¹¹⁾

On the other hand, if the complainant fails to argue or prove under the UDRP that there is no justification for the respondent's registration and use of the domain name, the Panel, in theory, is precluded from rendering a decision in favor of the complainant even in the absence of any response to

11) Casio Korea.co.kr decision (Casio Computer Co., Ltd. v. Rak-Kyun Choi, Korean Domain Name Dispute Resolution Committee, KR 2003-0021(2003)): "[B]ecause there is no evidence of Respondent's intended use of the domain name, the Panel decides that the purpose of the domain name registration is to interfere with the domain name registration by Complainant."

the complaint by the respondent.¹²⁾ However, a number of WIPO decisions have held that the respondent's failure to respond to the complaint is sufficient for establishing a *prima facie* case that "no justifications exist."

(4) With respect to the WIPO and the IDRC decisions, the application of UDRP and AIAR shows the following differences.

III. Whether Domain Name is Identical or Confusingly Similar to Trademark

1. Whether Website Content Influences Panel's Decision on Similarity

1) The WIPO Decisions

Many WIPO decisions follow the trend that a complainant is "merely to demonstrate that the disputed domain name is identical or similar to the complainant's trademark, without reference to the way in which the domain name is being used."¹³⁾ ¹⁴⁾

The UDRP § 4(a)(i) test for confusing similarity only focuses on the disputed domain name and the trademark,¹⁵⁾ which differs from trademark

12) If there is "justification" in a UDRP case, it would be difficult to find the "bad faith" even though there were attempts to sell the domain name for profit. *Allocation Network GmbH v. Steve Gregory*, WIPO Case No. D2000-0016 (allocation.com); *International Raelian Religion and Raelian Religion of France v. Mailbank.com Inc.*, WIPO Case No. D2000-1210 (Apr. 6, 2001) (rael.com).

13) For example, *kool.com* decision (*BWT Brands, Inc and British American Tobacco (Brands), Inc v. NABR*, WIPO Case No. D2001-1480 (Mar. 26, 2002)): The Respondent claims that although the trademark KOOL is identical to the Complainants' registered trademarks, the concept of "confusingly similar to a trademark" can only be understood in the context of specific products or services. The Respondent states that the Complainants have failed to demonstrate that the Respondent used or planned to use the mark in a "confusingly similar" manner. With respect, the Panel does not accept this part of the Respondent's analysis. The burden on the Complainant under this head is merely to demonstrate that the disputed domain name is similar or identical to the Complainants' trademark, without reference to the way in which the domain name is being used. Plainly enough, the disputed domain name <kool.com> is identical to the Complainant's registered trademark.

14) WIPO Overview Discussion 1.2.

15) *Casio Keisanki Kabushiki Kaisha (Casio Computer Co., Ltd.) v. Jongchan Kim*, WIPO Case No. D2003-0400 (July 15, 2003) (casioshop.net) ("Many cases have established that the test of confusing similarity under the Policy is confined to a comparison of the disputed domain

infringement or unfair competition cases under the Act on Unfair Competition Prevention and Trade Secret Protection (AUCP) of Korea where other factors (such as use or marketing) are also considered. The UDRP's such focus appears to be based on the WIPO Panel's view that trademark right holders are victims of "initial interest confusion," which occurs when potential visitors are taken to an internet destination unrelated to their initial interest due to the existence of identical or similar domain names. Accordingly, because the content of the website is not relevant to the analysis by the Panel, a disclaimer on the respondent's website alone cannot remove confusing similarity.¹⁶⁾

2) *The IDRC Decisions*

(1) Unlike the UDRP which requires a review of whether the domain name is identical or confusingly similar to the trademark, the AIAR § 18-2② only requires a review of whether the internet address has been registered, owned, or used for the purpose of interfering with the internet address registration or use by a party who has the proper basis for claim or for the purpose of obtaining unfair profit. Here, the legitimate grounds of claim encompass all surrounding circumstances including similarity between the internet address and the trademark. In light of the above difference, direct comparison of UDRP § 4(a)(i) and AIAR § 18-2② may not be appropriate.

(2) Korean courts and IDRC have seldom expressly recognized the "initial interest confusion" theory in trademark infringement or unfair competition cases.

name and the trademark alone, independent of the other marketing and use factors usually considered in trademark infringement or unfair competition cases."); see also *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662 (Sept. 21, 2000) (wal-martsucks.com), *Koninklijke Philips Electronics N.V. v. In Seo Kim*, WIPO Case No. D2001-1195 (Nov. 12, 2001) (philipssucks.com), *Britannia Building Society v. Britannia Fraud Prevention*, WIPO Case No. D2001-0505 (July 12, 2001) (britanniabuildingsociety.org).

16) *PG&E Corporation v. Samuel Anderson and PGE in the year 2000*, Case No. WIPO D2000-1264 (Nov. 28, 2000) (PGE2000.com).

<Case 1> **jeilbank.co.kr** decision (Korean IDRC Case No.D2007-A020 (Sept. 18, 2007))¹⁷⁾

The Panel declined Complainant's domain name transfer request, holding that there would be no likelihood of confusion between the businesses of Complainant and Respondent when the customers visit the website and see its content.

However, it should be noted that the **jeilbank.co.kr** decision was based on AIAR § 18-2①2, similar to AUCP § 2①b (likelihood of confusion in business), which does not correspond UDRP § 4(a).

2. Whether Domain Name with Negative Terms Can Be Regarded As Being Confusingly Similar to Trademark

1) The WIPO Decisions

(1) The majority view in the WIPO decisions is that "a domain name consisting of a trademark and a negative term is confusingly similar to the trademark." Under the UDRP test for confusing similarity which only considers the disputed domain name and trademark, the addition of a prefix or suffix does not affect the decision on similarity. For example, negative terms (such as anti, sucks, etc.) in a domain name may not be recognizable by a user whose first language is not English.¹⁸⁾

(2) However, several WIPO decisions have held that a domain name which combines negative terms with a trademark would not be confusingly similar to the trademark.

<Case 2> **fucknetscape.com** decision (*America Online, Inc. v. Johuathan Investments, Inc., and AOLLNEWS.COM*, WIPO Case No. D2001-0918 (Sept. 14, 2001))

The Panel regards it as inconceivable that anyone looking at "fucknetscape.com" will believe that it has anything to do with a company of such high reputation as Complainant (Netscape). It is manifestly, on its face, a name which can have nothing whatever to do with Complainant.

17) Korea Internet and Security Agency, 2009 Domain Name Dispute Paper 138 (2009) [hereinafter 2009 Domain Name Dispute Paper].

18) WIPO Overview Discussion 1.3.

<Case 3> *lockheedsucks.com* decision (*Lockheed Martin Corporation v. Dan Parisi*, WIPO Case No. D2000-1015 (Jan. 31, 2001))

Both common sense and a reading of the plain language of the Policy support the view that a domain name combining a trademark with the word “sucks” or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark.

(3) The UDRP § 4 a(i) requires that the disputed domain name be “confusingly similar” to the trademark. That is, mere similarity is not enough. Instead, the level of similarity in this context should be sufficiently high so as to confuse customers on the relation between the domain name and the trademark. Considering this high standard, when a domain name is combined with negative terms, it is difficult to determine whether the domain name is “confusingly similar” to the trademark.

(4) The standard of judgment of whether the domain name is confusingly similar to the trademark should be considered separately from that of whether the domain name holder has bad faith or legitimate interests.

2) IDRC Decisions

Similarly, merely adding a prefix or suffix to the internet address for the purpose of conveying criticism or parody does not necessarily remove the internet address from the application of the AIAR §18-2② or provide the requisite justification under the or the AIAR § 18-2③. Indeed, it has often been found that there are registrants who request unfair return for internet address with negative terms such as “anti,” “fuck,” “suck,” etc.

<Case 4> *antisecc.co.kr* decision (Korean IDRC Case No.IDRC D2005-A033 (Dec. 23, 2005))¹⁹⁾

The IDRC decision is summarized as follows:

Although Respondent contends that “antisecc” does not cause any confusion with Samsung Electronics’ product or business and that the website of the domain

19) Internet Address Dispute Resolution Committee, *antisecc.co.kr* case, available at http://www.idrc.or.kr/sub2/sub2_3_7_view.jsp?num=133.

name is an “anti-site” without any content damaging the reputation of Samsung’s trademark, the Panel rejected Respondent’s contentions where such actions constitute “registration, ownership or use conducted for the purpose to interfere with Complainant’s domain name registration.” Additionally, Respondent offered to sell the domain name to Complainant for an amount clearly and substantially exceeding registration costs.

IV. Whether Respondent has Rights or Legitimate Interests in the Domain Name

1. Domain Names consisting of Generic or Descriptive Words

1) The WIPO Decisions

(1) “If the complainant makes a prima facie case that the respondent has no rights or legitimate interests, and the respondent fails to show one of the three circumstances under [UDRP § 4(c)], then the respondent may lack a legitimate interest in the domain name, even if it is a domain name comprised of a generic word(s).”²⁰⁾

(2) “Factors a panel should look for when determining legitimate use would include the status and fame of the mark, whether the respondent has registered other generic names, and what the domain name is used for (a respondent is likely to have a right to a domain name “apple” if it uses it for a site for apples but not if the site is aimed at selling computers or pornography).”²¹⁾

(3) Especially, “if the respondent is using a generic word to describe his product/business or to profit from the generic value of the word without intending to take advantage of complainant’s rights in that word, then he

20) WIPO Overview Discussion 2.2.

21) *Id.*

has a legitimate interest.”²²⁾ ²³⁾

In a case where the respondent registered a surname as the domain name and used the website to provide customer e-mailing services, the Panel held that the respondent had a legitimate interest (**velazquez.com** decision).²⁴⁾

2) *The IDRC Decisions*

Generally, the IDRC decisions follow the majority view of WIPO decisions. However, because the geographic scope of the IDRC decisions is limited to Korea, the question of “whether a trademark is generic or descriptive” must be answered by considering trademark’s product/service situation related to in Korea. Accordingly, even if a trademark is registered in several foreign countries, if the trademark is found to be generic or descriptive in Korea, then the courts may decide the respondent’s use of the trademark to be “justified.”²⁵⁾

22) *Advanced Drivers Education Products and Training, Inc v. MDN, Inc. (Marchex)*, NAF Case No. FA0509000567039 (Nov. 10, 2005) (teensmart.com) (“[B]ecause there is some reasonable connection between Respondent’s use and the Domain Name and for the other reasons set out above, Complainant has not succeeded in proving that Respondent lacks any rights or legitimate interests in the Domain Name.”); see also *Snowboards-for-sale.com, Inc. v. Name Administration Inc.*, WIPO Case No. D2002-1167 (snowboardsforsale.com), D2003-0227 (selfpics.org); D2003-0009 (safemail.com).

23) **Terroni.com** decision (*Terroni Inc. v. Gioacchino Zerbo*, WIPO Case No. D2008-0666): The Panel acknowledged “*terrioni*” to be a common term referring to Southern Italians. However the domain name “*terrioni*” was being used with no relation to its common meaning, where Respondent was making a profit by a pay-per-click method using the reputation of Complainant’s trademark. The Panel finds Respondent has no legitimate interests in the domain name and concludes that registration and use was in bad faith.

24) *José de Jesús Velázquez Jiménez v. Mailbank.com Inc.*, WIPO Case No. D2001-0341; see also *International Raelian Religion and Raelian Religion of France v. Mailbank.com Inc.*, WIPO Case No. D2000-1210 (rael.com). But in the IDRC’s **morinaga.co.kr** decision (Korean Domain Name Dispute Resolution Committee Case, KR2003-0007) where Respondent forwarded the domain name, which is identical to Complainant’s trademark, to its internet shopping mall, Respondent argued that “*MORINAGA*” is the English spelling of a Japanese surname and therefore cannot be given a trademark. Additionally, there are many famous Japanese celebrities with this surname and website could be used as a fan-club website. However, the Panel dismissed the Respondent’s argument and found the disputed domain name was registered and used to interfere with the Complainant’s business in Korea.

25) Supreme Court[S. Ct.], 85Hu94, Feb. 2, 1987 (S. Kor.); Supreme Court[S. Ct.], 92Hu414, Nov. 20, 1992 (S. Kor.).

<Case 5> **decopanel.co.kr** decision (Korean IDRC Case No.D2002-0020 (July 4, 2002))²⁶⁾

The Panel has found the term decopanel to mean a “decorated panel” and used by many interior dealers as a generic or descriptive term. Although the trademark is registered in several foreign countries, the generic or descriptive nature of the term decopanel in Korea cannot be ignored.

3) Comparison of Specific Decisions

With respect to identical or similar domain names reviewed by both the WIPO and the IDRC Panels, the decisions show the following differences.

- (1) VISA Trademark
 - (a) WIPO Decision

<Case 6> **visagiftcard.com** decision (*Visa U.S.A. Inc., Visa International Service Association v. The Best Present Company, Inc.*, WIPO Case No. D2002-1106 (Jan. 27, 2003))

The Respondent was offering MasterCard Prepaid Gift Cards for sale at the Domain Name. MasterCard is VISA’s main competitor ... [The Panel found that] Respondent clearly had no rights or legitimate interests in the Domain Name. Respondent did not sell any product related to Complainant. In fact, Respondent sold a competitor product at the Domain Name, clearly trafficking in the confusion created, and evidencing bad faith.

The domain name, which included the trademark “VISA,” was used to sell a competitor’s product. The Panel took into account all surrounding circumstances including the purpose of the respondent’s website.

26) Internet Address Dispute Resolution Committee, decopanel.co.kr case, available at http://www.idrc.or.kr/sub4/sub4_3_2_view.jsp?dbname=ddrc_jj&rownum=12&pageIndex=1.

[reference] **verified-by-visa.com** decision (*Visa International Service Association v. Visa Corp*, NAF¹ Case No. FA0603000660977 (May 15, 2006))

Complainant contends ... that Respondent is using the <**verified-by-visa.com**> domain name to entrap Internet users in a “phishing” scheme aimed at fraudulently obtaining their credit card numbers and other personal information. The Panel finds that Respondent’s use of the disputed domain name in this fashion is evidence of bad faith registration.

(b) IDRC Decisions

<Case 7> **visa.co.kr** decision (IDRC Case No.D2002-0027 (Nov. 9, 2002))²⁷⁾

The Complainant holds the rights and legitimate interests for the trademark and service mark ‘VISA,’ which is a well-known credit card and credit-card related service provider in Korea and worldwide. This complaint contends the Respondent’s use of the domain name for providing travel information and reservation services as violating the Korean Domain Name Dispute Resolution Policy (KDRP). The Panel dismisses the claim and agrees with the Respondent that the trademark “VISA” is generally understood to mean “visa issuance agency services” within the traveling industry and general consumers in Korea.

(2) CASIO Trademark

(a) WIPO Decisions

<Case 8> **casio.biz** decision (*Casio Keisanki Kabushiki Kaisha v. Netfuture*, WIPO Case No. DBIZ2002-00198 (Aug. 5, 2002))

The Panel decided that the Respondent knew of the Complainant, a world-renowned company in the field of electrical appliances and digital image products with the trademark CASIO registered in countries all around the world, and registered the domain name with the purpose of disrupting the Complainant’s business. The Respondent never used the domain name for any legitimate interest.

27) Internet Address Dispute Resolution Committee, **visa.co.kr** case, available at http://www.idrc.or.kr/sub4/sub4_3_2_view.jsp?dbname=ddrc_jj&rownum=27&pageIndex=1.

<Case 9> **casioshop.net** decision (*Casio Keisanki Kabushiki Kaisha (Casio Computer Co., Ltd.) v. Jongchan Kim*, WIPO Case No. D2003-0400 (July 15, 2003))

The Respondent registered the disputed domain name on August 6, 2002, and has operated under that domain name a website selling CASIO electronic watches and watches under other trademarks such as SEIKO and NIKE, which are not manufactured or distributed by the Complainant. The Panel finds the disputed domain name <casioshop.net> to be confusingly similar to the Complainant's strong and immediately recognizable trademark CASIO and the addition of the generic and/or descriptive term "shop" to do little to alter that conclusion.

<Case 10> **casio.ro** decision (*Casio Keisanki Kabushiki Kaisha, dba Casio Computer Co., Ltd. v. Fulviu Mihai Fodoreanu*, WIPO Case No. DRO2003-0002 (July 22, 2003))

The Respondent contends that ... the acronym "C.A.S.I.O." can easily be an acronym for the words in Romanian, Colegi, Amici, Singuri, Intalniri, Online which translated into English mean "Colleagues, Friends, Alone, Online Dates." [However,] [t]he Panelists find that the domain name is confusingly similar to a trademark or service mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name and that the domain name has been registered and is being used in bad faith.

(b) IDRC Decisions

<Case 11> **casio pia.co.kr** decision (IDRC Case No.D2003-0018 (June 26, 2003))²⁸

Respondent contends that the domain name "casio pia" was its mistaken attempt to spell the word "Cassiopeia," which is completely different from Complainant's trademark, and that as a seller of Complainant's genuine products, Respondent may justifiably display Complainant's trademark on its internet website for the limited purpose of notifying its customers and dealers of the products' origins and qualities. The Panel agreed with the Respondent and dismissed the complaint.

Respondent's argument that the domain name "casio pia" was merely a

28) Internet Address Dispute Resolution Committee, *casio pia.co.kr* case, available at http://www.idrc.or.kr/sub4/sub4_3_2_view.jsp?dbname=ddrc_jj&rownum=72&pageIndex=1 (Oct. 9, 2009).

misspelling of the word “Cassiopeia” has little merit considering that these words are spelled very differently. Furthermore, the Supreme Court of Korea has pronounced that the extent to which a dealer of genuine goods may use trademarks must be kept to a minimum.²⁹⁾ Here, the Panel appears to have reached this particular decision due to the insufficient evidence that Respondent used the domain name in bad faith and that it lacked rights and legitimate interests in the domain name.

The following decisions were decided differently from the <casio**pi**a.co.kr> decision.

<Case 12> koreacas**io**.co.kr decision (IDRC Case No.D2003-0011 (June 3, 2003))³⁰⁾

Complainant, a subsidiary of a foreign-based company manufacturing and distributing electronic watches, electronic calculators, electronic schedulers, and digital cameras etc., contends the domain name falls under KDRP § 8③1. or 4. The Respondent did not file a response to the complaint. The Panel, considering the website’s format and the introduction to Respondent’s business operations, confirmed the domain name to be a well-renowned trademark in Korea and decided there is a high possibility of visitors mistaking the website as the Complainant’s Korean distributor or someone with special ties with the Complainant. Additionally, Respondent did not file a response explaining the lack of any intent to disrupt the business of the Complainant or the registration was with legitimate interests. The Panel taking all factors into consideration, decided that the Respondent registered the domain name to disrupt the business of Complainant.

<Case 13> casio**w**atch.co.kr decision (IDRC Case No.D2003-0017 (June 21, 2003))³¹⁾

Respondent argued the domain name was within the boundaries of justification as a dealer in genuine goods. Respondent also argued that the Complainant’s contentions of trademark infringement and likelihood of confusion with Complainant’s business is difficult to conceive. The Panel noted there were no relations between the parties and the lack of any notification on the website exceeded the boundaries allowed for justified

29) Supreme Court [S. Ct.], 99Da42322, Sept. 24, 2002(S. Kor)

30) Internet Address Dispute Resolution Committee, koreacas**io**.co.kr case, *available at* http://www.idrc.or.kr/sub4/sub4_3_2_view.jsp?dbname=ddrc_jj&rownum=65&pageIndex=1(Oct. 9, 2009).

31) Internet Address Dispute Resolution Committee, casio**w**atch.co.kr case, *available at* http://www.idrc.or.kr/sub4/sub4_3_2_view.jsp?dbname=ddrc_jj&rownum=71&pageIndex=1(Oct. 9, 2009).

trademark use. The Panel also found the website indistinguishable from Complainant's websites causing likelihood of confusion and damage to Complainant's trademark. Additionally, the Panel acknowledged that the Respondent maintained the registration to disrupt Complainant's business.

2. Non-commercial Purposes of Domain Names

1) The WIPO Decisions

There are two main views on the use of domain names which are confusingly similar to a trademark as a genuine non-commercial free speech website. There is a division between proceedings involving US parties and those involving non-US parties, with several non-US panelists adopting the reasoning in View 2.³²⁾

[View 1] The right to criticize does not extend to registering a domain name that is identical or confusingly similar to the owner's registered trademark or conveys an association with the mark³³⁾

[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 the use is fair and non-commercial.³⁴⁾

2) The IDRC Decisions

Similar to the WIPO Overview, there has not been a formal opinion on

³²⁾ WIPO Overview Discussion 2.4.

³³⁾ *Skattedirektoratet v. Eivind, Nag*, WIPO Case No. D2000-1314(skatteetaten.com); *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. D2001-0763(myeronline.com); *Triodos Bank NV v. Ashley Dobbs*, Case No. D2002-0776(triodes-bank.com); *The Royal Bank of Scotland Group plc, National Westminster Bank plc A/K/A NatWest Bank v. Personal and Pedro Lopez*, WIPO Case No. D2003-0166(natwestbanksucks.com); *Kirkland & Ellis LLP v. DefaultData.com, American Distribution Systems, Inc.*, WIPO Case No. D2004-0136(kirklandandellis.com).

³⁴⁾ *Bridgestone Firestone, Inc., Bridgestone/Firestone Research, Inc., and Bridgestone Corporation v. Jack Myers*, WIPO Case No. D2000-0190(bridgestone-firestone.net); *TMP Worldwide Inc. v. Jennifer L. Potter*, WIPO Case No. D2000-0536. *Howard Jarvis Taxpayers Association v. Paul McCauley*, WIPO Case No. D2000-0536(tmpworldwide.net etc.); D2004-0014(hjta.com).

this issue. However, for genuine non-commercial purpose websites, “if the registered or used domain name is identical to or is similar to the trademark to bring about a great likelihood of confusion” the prevailing view is that the respondent does not have any legitimate interests in the domain name. (However, in the “oakley.co.kr decision,” the Panel dismissed the complaint because the website was used for genuine non-commercial purposes.)

All registrations of a domain name, whether or not for non-commercial purposes, will interfere with a third party’s right to register or use such domain name in some way. Therefore, the decision to cancel or transfer a domain name due to “[interference] with the registration of a domain name” will be subjective, depending on the factual circumstances of each case.

<Case 14> **samsungeverland.co.kr** decision (IDRC Case No.D2002-0011 (May 9, 2002))³⁵⁾

Respondent forwarded the disputed domain name to a pornography website and later to an anti-website after this complaint was filed. The Panel found no legitimate purpose to use the domain name as a genuine non-commercial website for criticism under the circumstances. Additionally, even in the case of a genuine non-commercial use for criticism, the Panel found it difficult to allow domain names identical to a third party’s trademark or service mark.²

3) Comparison of Specific Decisions

- OAKLEY Trademark
 - (a) WIPO Decision

<Case 15> **oakleykorea.com** decision (*Oakley, Inc. v. KH aka Ahn Kang-Hyun*, WIPO Case No. D2002-0814 (May 12, 2002))

Respondent worked as an employee of a company importing and selling the Complainant’s products in Korea. The Respondent proposed to sell the domain name and eight additional domain names for 500,000 dollars and threatened to import and compete with Complainant’s products in Korea if refused. The panel found registration and use in bad faith.

35) Jung Chan Mo, *Justification in IDRC Decisions*, KISDI Issue Report(04-01), Korea Information Society Development Institute, Jan. 7, 2004, at 39.

<Case 16> **oakleyshoes.com, oakleyfootwear, oakleywatches** decision (*Oakley, Inc. v. Kenneth Watson*, WIPO Case No. D2000-1658 (May 1, 2001))

Respondent argued ... [that Respondent's] Oakley Watson happens to share the exact spelling as the Complainant and has as much of a legal right to purchase as many domain names with any variation to his name in it as anyone else that shares the same name. [The Panel] concluded that the Respondent registered and has continued to act in bad faith ... considering ... Uncle Oakley Watson is not the registrant and there is no evidence or allegation that Respondent has obtained any legal rights from Uncle Oakley Watson. More importantly there is no indication in the record that Oakley Watson's name was ever used in connection with the sale of any of Registrant's goods. The Registrant also acquired multiple domain names, which are confusingly similar to Complainant. This is evidence of bad faith, especially the domain name <oakleywatches.com> because there is no allegation that Respondent even sells watches.

(b) IDRC Decisions

<Case 17> **oakley.co.kr** decision (IDRC Case No.2002-0045 (Nov. 20, 2002))³⁶⁾

Respondent contends that the website is an online club used for genuine non-commercial purposes and the registration and use of the domain name OAKLEY was legal where OAKLEY is a generic or descriptive term used as a name for trees and athletes. The Panel concluded that the Complainant's assertions satisfied § 8③1. but failed to satisfy § 8③2. and 4. Additionally, Respondent's registration and use of the domain name as a genuine non-commercial online club is confirmed as a justifiable registration and use under KDRP § 8③4.

However, this decision cannot be generalized, as the Panel's decision will differ on a case-by-case basis.³⁷⁾

36) Internet Address Dispute Resolution Committee, oakley.co.kr case, available at http://www.idrc.or.kr/sub4/sub4_3_2_view.jsp?dbname=ddrc_jj&rownum=45&pageIndex=1.

37) After consideration of all surrounding circumstances, there have been decisions dismissing the complaint where "[R]espondent, with the purpose to develop a marketing campaign for consumers, registered the disputed domain name with 40 other domain names." (*Matthew Strebe, Strebe Corp. and Connetic v. 3Sixty Market View*, NAF Case No. FA0007000095240 (Aug. 10, 2000) (connetic.com)).

V. Registration and/or Use of a Domain Name in Bad Faith

1. *Passive Holding*

The UDRP § 4(a)(iii) requires that the “domain name has been registered and is being used in bad faith.” The UDRP is applicable to generic top-level domains (.com, .net, .org etc.) worldwide with relatively simple complaint filing procedures on the registration and use of a preoccupied domain name. To prevent any abuse of the Policy, the UDRP was enacted with strict requirements. For example, the scope of protection extends only to trademarks and service marks, the burden of proof is on the complainant to show lack of legitimate interests, and the complainant must show evidence of both registration and use in bad faith.

Under the UDRP, evidence of registration in bad faith without evidence of use in bad faith, or vice-versa, is not sufficient and the request for cancellation or transfer must, in theory, be dismissed in such case.³⁸⁾

However, in cases of “passive holding” where the domain names are held but kept inactive, it is difficult to prove whether the disputed domain name was registered and “used” in bad faith.

1) *The WIPO Decisions*

(1) Inactiveness of domain names does not preclude finding of bad faith. The Panel must consider all factual circumstances in determining whether the respondent’s registration and use was in bad faith. Examples of circumstances indicating bad faith include possession of a well-known mark by the complainant, lack of response to the complaint, concealment of respondent’s identity and the impossibility of conceiving a good faith use

38) In the **sexplanets.com** decision (*Global Media Resources SA v. Sexplanets aka SexPlanets Free Hosting*, WIPO Case No. D2001-1391 (Jan. 24, 2002)), the Panel found that the use of the disputed domain name was in bad faith after where the use was after the knowledge of Complainant’s trademark and website. However, the registration of the disputed domain name was in good faith and therefore the complaint was dismissed. The Panel in the *animerica.com* decision reached a similar decision (*Viz Communications, Inc., v. Redsun dba www.animerica.com and David Penava*, WIPO Case No. D2000-0905 (Dec. 22, 2000)).

of the domain name.³⁹⁾

(2) With respect to passive holding, the Panel may draw inferences that the use of the domain name was in bad faith from the circumstances surrounding the registration of the domain name.⁴⁰⁾ Such inference stems from an interpretation of the UDRP's "use" requirement which is completely different from the "use" definitions of trademark infringement or unfair competition prevention acts.

(3) The following methods are used to solve the "use in bad faith" problem encountered in passive holding cases.

- 1) On the question of whether passive holding suffices as "use of domain name in bad faith," the Panel must take into consideration all surrounding circumstances (Respondent's actions, factual surroundings etc.).⁴¹⁾
- 2) Several decisions found passive holding of domain names infringing on a trademark as evidence of use in bad faith.⁴²⁾
- 3) In certain situations, inferences are drawn from passive holding that
 - ① there is no legitimate interest with regard to the disputed domain name, and
 - ② the disputed domain name is being used in bad faith.⁴³⁾

<Case 18> **morinaga.com** decision (*Morinaga & Co., Ltd. v. Jin Tong*, WIPO Case No. D2001-0622 (June 28, 2001))

The absence of use of a domain name after a long lapse of time not only provides an inference of no legitimate interest (see above) but also an inference that there has been use (or more accurately, non-use) of the domain name in bad faith.

39) WIPO Overview Discussion 3.2.

40) *Id.*

41) *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 (Feb. 18, 2000) (telstra.org). There has been decisions concluding passive holding to be "use" within the definition under UDRP § 4a(iii). *Jupiters Limited v. Aaron Hall*, WIPO Case No. D2000-0574 (Aug. 3, 2000) (jupiterscasino.com); *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. D2002-0131 (Apr. 10, 2002) (ladbrokepoker.net).

42) *Clerical Medical Investment Group Limited v. Clericalmedical.com* (Clerical & Medical Services Agency), WIPO Case No. D2000-1228 (Dec. 4, 2000) (clericalmedical.com); *DCI S.A. v. Link Commercial Corporation*, WIPO Case No. D2000-1232 (Dec. 12, 2000) (5asec.com); *PepsiCo, Inc. v Datasphere Ltd.*, NAF Case No. FA0102000096695 (Apr. 9, 2001) (pepsicola.com).

43) *Morinaga & Co., Ltd. v. Jin Tong*, WIPO Case No. D2001-0622 (June 28, 2001) (morinaga.com); *PepsiCo, Inc. v Datasphere Ltd.*, NAF Case No. FA0102000096695 (Apr. 9, 2001) (pepsicola.com).

(4) Although this is the majority view in the WIPO Overview, there is still ground for dispute. Debates have arisen over the reasonableness of inferring “use” from domain names which have been kept dormant for long lapses of time, when the UDRP policy clearly requires “use in bad faith.” Additionally, it is questionable whether such interpretation will receive support from the courts. If there is indeed a pressing need for making such inference, it would be more proper to revise the UDRP to include a provision which expressly deals with the issue of “passive holding.”⁴⁴⁾

(5) The Start-up Trademark Opposition Policy [hereinafter STOP] for .biz domains does not require both registration and use in bad faith. The complainant need only show either registration or use of the domain name in bad faith by the respondent.⁴⁵⁾ Therefore, passive holding issues arise less frequently.

The STOP has a different method of determining “bad faith.” When a respondent registers a domain name associated with an IP (intellectual property) Claim submitted under the IP Claim service,⁴⁶⁾ the respondent is given notice of the possibility of trademark infringement before the registration process is allowed. This notice acts as constructive notice to the respondent where knowledge of the trademark infringement can be inferred. Under such circumstances, the respondent’s registration of the domain name is deemed to be in bad faith. This is the main difference from the UDRP.⁴⁷⁾

2) *The IDRC Decisions*

The AIAR § 18-2② cancels or transfers the domain name if “registration, ownership or use is conducted for the purpose to interfere with the registration or use of the domain name by the party who has legitimate

44) *Teradyne, Inc. v. 4Tel Technology*, WIPO Case No. D2000-0026 (May 10, 2000) (4tel.com). In the decision, the Panel faced with the question whether a domain name can be transferred where there is “registration in good faith, but use in bad faith,” the Panel decided that this is for the ICANN to revise the UDRP.

45) *Marcus R. Schatte d/b/a Sex v. Personal*, NAF Case No. FA0209000124756 (Nov. 4, 2002) (sex.biz decision).

46) <http://www.wipo.int/amc/en/domains/reports/biz-stop/report/index.html>.

47) *Gene Logic Inc v. Cho Kyu Bock*, NAF Case No. FA103042 (Mar. 4, 2002) (genelogic.biz decision).

grounds of claim or to obtain unjustifiable profit.” Therefore, the problems of passive holding in .kr domain disputes are rare. This is another important difference between the AIAR and the UDRP.

<Case 19> **sens.co.kr** decision (IDRC Case No.D2007-A019 (Aug. 29, 2007))⁴⁸⁾

The domain sens.co.kr has been inactive for the past nine years. Respondent contends that “because sens.com is registered to Sensimetrics Corporation and sens.kr to the Seobu District Office of Education in Seoul, the Complainant has no right and legitimate interests in the domain name.” However, the Panel found the registration was for the purpose of interfering with the business of Complainant and falls under KDRP § 9②, rejecting the Respondent’s argument and transferring the domain name to Complainant.

2. Change in Circumstances, Change in Legal Standing

The WIPO and the IDRC have different requirements under each policy for situations where “the respondent had rights and legitimate interests in the initial registration and use of the domain name, but respondent later loses its right and legitimate interest due to a change in legal standing and uses the domain name in bad faith.”

1) The WIPO Decisions

(1) Where the respondent initially had rights and legitimate interests when the domain name was registered but later uses it in bad faith, the Panel will dismiss the claim for failure to satisfy the “registration in bad faith” requirement.⁴⁹⁾⁵⁰⁾ The Panel also noted that “the current use of the

48) 2009 Domain Name Dispute Paper at 124-29.

49) *Teradyne, Inc. v. 4Tel Technology*, WIPO Case No. D2000-0026 (May 10, 2000) (4tel.com). “[A] conscious decision was made that UDRP proceedings be limited to abusive registrations. The question whether domain names registered in good faith become infringing is outside the scope of this inquiry. Further support for this interpretation is contained in the example of “bad faith” contained in § 4(b)(i) of the Policy, which contemplates that the domain name must have been registered or acquired “primarily for the purpose of selling, renting or otherwise transferring” the domain name. In this case, it is clear that the domain name was not registered or acquired for this purpose. This Panel is not ready to extend the Policy to cover cases clearly intended to be outside its scope. That is a task for ICANN, or for the courts.”

50) *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270 (June 8, 2000) (htmlase.com). Even if the ‘(ii) Right or legitimate interest’

domain in bad faith” does not render an initial good faith registration into a bad faith registration.⁵¹⁾

(2) The WIPO Panel did not find the “registration in bad faith” requirement satisfied in a distributorship contract case where the domain name was registered and used without objection by the complainant but was not returned after termination of the contract, and respondent asked for unjustifiable profits.

<Case 20> **miele.net** decision (*Miele, Inc. v. Absolute Air Cleaners and Purifiers*, WIPO Case No. D2000-0756 (Sept. 20, 2000))⁵²⁾

The Respondent apparently registered the domain name MIELE.NET while he was an authorized dealer of Miele products. The Respondent used the domain name for a website that promoted his dealership and sold Miele products. At some point, ... the Respondent lost its status as an authorized dealer of Miele products. Since this time, the Complainant has allegedly made repeated requests to the Respondent to transfer the domain name to it ... The Panel finds that, as an authorized dealer of Miele vacuum cleaners, the Respondent initially had a legitimate interest in the domain name ... The Panel finds that the Respondent did not initially register the domain name in bad faith, because he registered it to promote his business and attract customers as authorized by the trademark owner whose products he was selling with full authority of the trademark registrant ... The Panel decides that the Respondent’s MIELE.NET domain name has been used but was not initially registered in bad faith ... Accordingly, the ICANN Policy reading “registered and ... used in bad faith” requires that the Complaint be denied and transfer of the MIELE.NET domain name be refused.

(3) However, there are decisions in favor of the complainant where the complainant contended that the registration and use of the domain name was not part of the distributor contract and the Respondent failed to

requirement is met, this does not automatically prove the ‘(iii) registration and use in bad faith’ requirement.

51) *Outils Rubis Ltd. v. NETPLUS Communication*, WIPO Case No. D2005-0645 (Aug. 2, 2005) (rubis.com); *Telaxis Communications Corp. v. William E. Minkle*, WIPO Case No. D2000-0005 (Mar. 7, 2000) (telaxis.com and telaxis.net).

52) See also *Outils Rubis Ltd. v. NETPLUS Communication*, WIPO Case No. D2005-0645 (Aug. 2, 2005) (rubis.com), *Eddy’s (Nottingham) Limited, trading as Superfi v. Mr. Kingsley Smith*, WIPO Case No. D2000-0789 (Sept. 19, 2000) (superfi.com).

respond to the complaint.⁵³⁾

2) IDRC Decisions

Unlike the UDRP, the AIAR does not require either “registration in bad faith” or “use in bad faith” and therefore an IDRC decision is rarely affected by a change in legal standing. This is another key difference between the WIPO and the IDRC decisions.

VI. Conclusion

The UDRP and the AIAR differ in the scope of protection, requirements, justification and scope of applicability, resulting in the possibility of differing outcomes under similar factual circumstances. This difference is attributable to the fact that the UDRP is the result of continuous efforts to reach a consensus among countries worldwide, whereas the AIAR is the result of Korean lawmakers’ efforts to solve domain name disputes within or related to Korea.

In particular, the difference between “registration and use in bad faith” and “registration or use for unjustifiable purpose” in these regulations is the major reason why different outcomes have been produced in factually similar cases.

Despite these differences, however, many cases have shown the possibility that courts or dispute resolution authorities can arrive at similar decisions for similar types of issues to achieve the most reasonable and desirable resolution. This shows the potential for a unified body of law for domain name dispute resolution.

53) *Omyacolor S.A. v. Recep Tanisman - Emko Emaye A.S.*, WIPO D2005-0520 (Aug. 3, 2005) (robercolor.com).

[Exhibit 1] Uniform Domain Name Dispute Resolution Policy (UDRP) § 4
a, b, c⁵⁴)

4. Mandatory Administrative Proceeding.

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at www.icann.org/udrp/approved-providers.htm (each, a “Provider”).

a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure, that

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

In the administrative proceeding, the complainant must prove that each of these three elements are present.

b. Evidence of Registration and Use in Bad Faith. 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 you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

54) WIPO, Uniform Domain Name Dispute Resolution Policy (Korean translation), available at <http://www.wipo.int/export/sites/www/amc/ko/docs/icannpolicy.pdf>.

- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.

c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint. When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure in determining how your response should be prepared. Any 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 your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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.

[Exhibit 2] Act on Internet Address Resources (AIAR) § 18-2⁵⁵⁾

Article 18-2 (Standards for Decision) ① If the Respondent's use of a domain name falls under any of the followings, the Panel may decide that the Respondent's domain name registration should be transferred to the Applicant or cancelled:

1. The Respondent's use of the domain name infringes the Applicant's right on a mark protected under the Trademark Act of Korea [hereinafter mark], including but not limited to trademarks and service marks
2. The Respondent's use of the domain name causes confusion with the Applicant's products or business operations widely known in Korea.
3. The Respondent's use of the domain name damages the power of discernment or reputation of the Applicant's name, designation, mark or trade name, etc. well known in Korea.

② The Panel may make the same decision specified in Paragraph 1 if the Respondent's domain name registration, ownership or use is conducted for the purpose to interfere the registration or use of the domain name by the party who has legitimate grounds of claim or to obtain unjustifiable profit including but not limited to for selling or renting the domain name to a party who has legitimate ground of claim on a name, designation, mark or trade name etc.

③ Notwithstanding Paragraphs 1 and 2, the Panel may dismiss the application if the Respondent's domain name is identical with the name, designation, mark or trade name for which the Respondent has legitimate grounds of claim, or the Respondent has the legitimate rights or interest to register or use the domain name.

55) Internet Address Dispute Resolution Committee, Domain Name Dispute Resolution Policy, available at http://www.idrc.or.kr/english/sub05_view.jsp?kinds=ddrc_ere&rownum=3&pageIndex=1.