

## **ADMINISTRATIVE PANEL DECISION**

Elkem ASA v. Jungyunkook  
Case No. D2023-4737

### **1. The Parties**

The Complainant is Elkem ASA, Norway, represented by Zacco Norway AS, Norway.

The Respondent is Jungyunkook, Republic of Korea.

### **2. The Domain Name and Registrar**

The disputed domain name <elkeem.com> is registered with ConnectWave co.,Ltd (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 14, 2023. On November 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 23, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On December 1, 2024, the Center informed the parties in Korean and English, that the language of the registration agreement for the disputed domain name is Korean. On December 4, 2024, the Complainant confirmed its request that English be the language of the proceeding. On November 23, 2023, the Respondent requested that Korean be the language of the proceeding.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2024. The Respondent did not submit any response. On January 17, 2024, the Center notified the Parties that it would proceed to panel appointment.



The Center appointed Andrew J. Park as the sole panelist in this matter on January 25, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant, Elkem ASA, is a Norwegian company group founded in 1904. According to the Complainant, it is a provider of advanced silicon-based materials used in connection with electric mobility, digital communications, health and personal care, as well as smarter and more sustainable cities. The Complainant has offices and facilities located across five continents, and more than 7,300 employees worldwide. The Complainant is included in the OBX ESG index, a selection of 40 blue-chip companies in Norway that demonstrate the best Environmental, Social and Governance (ESG) practices.

The Complainant has a registered trademark ELKEM in the United States and has been granted trademark protection in a large number of jurisdictions, including China, the European Union, and the Republic of Korea, among others. The Complainant has had a business presence in the Republic of Korea for three decades, and currently operates two offices and one facility in that country. The Complainant has its official website with the domain name <elkem.com>.

The Complainant has obtained the following trademark registrations:

Jurisdiction	Trademark	Registration No.	Registration Date
United States Trademark	ELKEM	5797376	July 9, 2019
United States Trademark	 Elkem	5639353	December 25, 2018
United States Trademark	ELKEM MICROSILICA	2411847	February 10, 2000
Republic of Korea Trademark	 Elkem	4002010820000	September 20, 1990
European Union Trademark	ELKEM	017901616	October 30, 2018
China Trademark	ELKEM	31606984	March 14, 2019

The Respondent registered the disputed domain name <elkeem.com> on April 1, 2022, and it currently resolves to a pay-per-click (“PPC”) website.

The Complainant sent a cease-and-desist letter to the Respondent. The Respondent did not respond.

#### 5. Parties’ Contentions

##### A. Complainant

1. The Complainant, following the filing of the Complaint with the Center, requested that the language of proceeding be in English, providing three main reasons.

(a) The Respondent targeted the Complainant and its business by using a confusingly similar variation of the Complainant’s coined trademark ELKEM in the disputed domain name;

(b) The Respondent created a website in English available on the disputed domain name;

(c) The Respondent advertised the disputed domain name for sale in USD on an international domain marketplace which is in English.

2. The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name because:

(a) the disputed domain name is almost identical or at least very similar to the Complainant's trademark ELKEM in which the Complainant has rights. The Complainant owns several domain names that incorporate its ELKEM trademark, such as <elkem.com>.

The disputed domain name consists of the term "elkeem" which features a minor intentional misspelling of the Complainant's trademark. However, the trademark ELKEM is still quite recognizable in the disputed domain name. The Respondent's intentional misspelling of the Complainant's trademark and the addition of the generic Top-Level Domain ("gTLD") ".com" would not have any impact on the overall impression of the dominant portion of the disputed domain name and therefore, is irrelevant when determining the confusing similarity between the Complainant's trademark and the disputed domain name. Consequently, the Respondent's use of the Complainant's trademark in the disputed domain name leads the public to perceive the disputed domain name either as a domain name owned by the Complainant or that there is some commercial relationship with the Complainant, given the Complainant's long-standing use and recognition of the ELKEM trademark in various countries, including in China, the European Union, the Republic of Korea, and the United States.

(b) the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant claims that the Respondent lacks any right or legitimate interest in the disputed domain name because the Complainant has not licensed or authorized the use of its registered trademark ELKEM or variations thereof to the Respondent, and there is no information that the Respondent is trading under a name corresponding to the disputed domain name. Furthermore, there is also no indication of the Respondent's use of the disputed domain name in connection with a bona fide offering of goods and services. The Respondent intentionally chose the disputed domain name to generate traffic and income through a website displaying PPC links. In addition, the Respondent sought to sell the disputed domain name for USD 5000, which is a further indicator that the Respondent used the disputed domain name for a commercial purpose which will risk diluting and damaging the ELKEM trademark.

(c) The disputed domain name was registered and is being used in bad faith. First, the Complainant claims that the Respondent registered the disputed domain name with the aim of taking advantage of the reputation and goodwill of its well-known trademark ELKEM and creating confusion between the disputed domain name and the Complainant's trademark, which can be clearly evidenced by the Respondent's infringing and counterfeit use of the ELKEM mark in the disputed domain name.

The Respondent's registration date of the disputed domain name is subsequent to when the Complainant obtained its trademark right for ELKEM by many decades, both in the Respondent's jurisdiction and elsewhere, and the incorporation of the Complainant's well-known trademark in the disputed domain name to attract Internet users to a commercial website offering the disputed domain name for sale, and thereby attempt to earn commercial gain, can demonstrate that the Respondent targeted the Complainant's highly distinctive trademark and was also fully aware of the Complainant and the ELKEM trademark at the time of registration, all of which clearly amount to bad faith use.

Second, the Complainant claims that the Respondent has engaged in prior cybersquatting activities by having registered numerous domain names that are confusingly similar to the principal domain names of other businesses, or that include third-party trademarks and cyberflight activities by transferring the disputed domain names it initially registered to other parties during the administrative proceedings after learning of complaints.

Further, the Complainant sent a cease-and-desist letter to the Respondent requesting that the disputed domain name be transferred to the Complainant. The Respondent chose not to respond, further indicating its disregard for the rights of the Complainant.

Thus, the Complainant argues that the Respondent is using the disputed domain name in order to intentionally attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion between the Complainant's trademark and the disputed domain name as to the source, sponsorship, affiliation, or endorsement of the Respondent, and thereby unfairly capitalizing on the reputation and goodwill of the Complainant and its ELKEM trademark.

## **B. Respondent**

The Respondent did not submit a formal response to the Complainant's contentions. However, in the Respondent's email of November 23, 2023, the Respondent requested that the language of the administrative proceedings be Korean on the grounds that he could not understand the Complainant's claims against the disputed domain name.

The Respondent claimed that it registered the disputed domain name in 2022 because it believed the disputed domain name had international character and therefore value. The Respondent further claimed that per its search on a Korean search portal, there were only results for the Complainant's trademark ELKEM, and that there were no findings for "elkeem," which is part of the disputed domain name. Thus, the Respondent challenged the Complainant's complaint since the Complainant lacks trademark rights to the term "elkeem" and the fact that he did not find the term "elkeem" in his online search using a Korean search portal.

## **6. Discussion and Findings**

### **A. Language of the Proceeding**

The Registration Agreement for the disputed domain name is in Korean. Pursuant to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the Registration Agreement, i.e., Korean, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Having considered the circumstances of the case, the Panel decides that English be adopted as the language of the proceeding under paragraphs 10 and 11(a) of the Rules. In coming to this decision, the Panel has taken the following into account:

- 1) The Complaint has been submitted in English and it would cause undue delay and expense if the Complainant were required to translate the Complaint and other documents into Korean;
- 2) The Panel is proficient in both English and Korean, capable of reviewing all the documents and materials in both languages and giving full consideration to the Parties' respective arguments;
- 3) Apart from the brief email communication, the Respondent chose not to participate in the proceeding even though the Complaint was notified in English and Korean, and he was informed that he could file a response in Korean; and
- 4) The Complainant and the Respondent use different languages; and the Complainant is located in Norway while the Respondent is from the Republic of Korea. Therefore, also noting the Panel's substantive findings in this matter, the Panel finds that English is the appropriate language here.

In light of these circumstances, the Panel concludes that it will (1) accept the Complaint in English and the Respondent's communications in Korean; (2) consider any relevant materials in English and in Korean; and (3) issue a decision in English.

## **B. Identical or Confusingly Similar**

This element consists of two parts: first, whether the Complainant has rights in a relevant trademark and, second, whether the disputed domain name is identical or confusingly similar to that trademark.

The Panel finds that the Complainant has established registered rights in the trademark ELKEM and that the disputed domain name is nearly identical to the Complainant's trademark. The Complainant has created its trademark ELKEM to refer to its company and its products since the 1990s. The term "elkem" is not a common word and it is neither descriptive for the Complainant's products nor for any other products, companies or places. The Complainant argues that the Complainant's trademark ELKEM is nearly identical with the main element in the disputed domain name and the only difference between the disputed domain name and the Complainant's trademark is that the disputed domain name has one additional letter "e," when compared with the Complainant's ELKEM mark.

By misspelling the trademarks, the Respondent is clearly trying to take advantage of typographical errors to benefit from the likelihood of confusion between the disputed domain name and the Complainant's trademark. There is nothing in the record to prevent a finding of confusing similarity to the Complainant's trademark. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Further, the addition of the gTLD ".com" is a standard registration requirement and as such may be disregarded when assessing confusing similarity under the first element of the Policy. [WIPO Overview 3.0](#), section 1.11.1 and *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#).

For these reasons, pursuant to the Policy, paragraph 4(a)(i), the Panel finds that the Complainant has shown rights in respect of the trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Panel also finds that the disputed domain name is confusingly similar to the Complainant's trademark.

## **C. Rights or Legitimate Interests**

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Once such a prima facie case is made, the Respondent carries the burden of demonstrating its rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. [WIPO Overview 3.0](#), section 2.1.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish its rights or legitimate interests in the disputed domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, the Panel finds that the Complainant has made out a prima facie case.

The Complainant has asserted that the Respondent has no relationship with or authorization from the Complainant to use its trademark. There is nothing in the record to suggest that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or has been commonly known by the disputed domain name. The Respondent registered the disputed domain name and created a website using the disputed domain name redirecting Internet users who visit the Respondent's website by clicking the PPC links leading to third party websites, all in an effort to confuse Internet users or consumers about the relationship between the Respondent and the Complainant and all without the Complainant's permission or authorization. These facts demonstrate that the Respondent never had an intention to use the disputed domain name in connection with a bona fide offering of goods and or services.

The Panel also finds that these facts may be taken as true in the circumstances of this case in view of the use of the disputed domain name. Further, the Panel is unable to find any reasonable basis upon which the Respondent could be said to have any rights or legitimate interests in respect of the disputed domain name even after duly considering the Respondent's claims as set forth in his email of November 23, 2023.

Accordingly, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

#### **D. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or 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 the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant claims that the Respondent registered and is using the disputed domain name in bad faith in violation of the Policy, paragraph 4(a)(iii). Specifically, the Complainant claims that the Respondent violated the Policy, paragraph 4(b)(i), (ii) and (iv) by registering the disputed domain name with the intention of selling the disputed domain name for valuable consideration and that it prevented the Complainant from reflecting the mark in a corresponding domain name, given that the Respondent has engaged in a pattern of such conduct and attempts to attract, for commercial gain, Internet users to the Respondent's website to which the disputed domain name resolves by creating a likelihood of confusion with the Complainant's trademark.

As stated previously, the Respondent did not file any formal response to the Complaint, failing thereby to formally rebut the Complainant's allegations of the Respondent's bad faith registration and use of the disputed domain name. The Panel has duly considered the Respondent's assertions in the informal email submission of November 23, 2023.

In the circumstances, the Panel has the responsibility of determining which of the Complainant's assertions are established as facts and whether the conclusions asserted by the Complainant can be drawn from the established facts (*Harvey Norman Retailing Pty Ltd v. Oxford-University*, WIPO Case No. [D2000-0944](#)).

First, the Panel finds the Respondent intentionally registered the disputed domain name in bad faith. The Respondent registered the disputed domain name, which is confusingly similar to the Complainant's trademark, ELKEM, while aware of the Complainant's business and its trademark. The Complainant holds numerous registrations of the trademark ELKEM in various jurisdictions worldwide including in the Republic of Korea where the Complainant has had a business presence since the 1990s and where the Respondent is located. The Respondent registered the disputed domain name in 2022, which is almost three decades after the Complainant's earliest registrations of the trademark ELKEM. Thus, the Respondent must have targeted the Complainant's distinctive and well-known trademark in an effort to show a business relationship between the Respondent and the Complainant or to otherwise benefit from the likelihood of confusion with the Complainant's trademark.

Secondly, the Panel finds that the Respondent has been using the disputed domain name in bad faith. The Respondent intentionally engaged in activities intended to mislead Internet users and cause confusion between the disputed domain name and the Complainant by associating the disputed domain name with a website that contains PPC links leading to third party websites, all for commercial gain.

Further, the Complainant submitted evidence of the Respondent having registered numerous additional domain names that are either confusingly similar or identical to the principal domain name of other companies to prevent the owner of the trademark from reflecting variations of its mark in a corresponding domain name. In addition, the Panel recognizes the Complainant's claim that the Respondent has a history of being a respondent in multiple prior UDRP complaints where the Respondent purportedly transferred the disputed domain name in an effort to avoid a WIPO UDRP decision for the transfer of its domain names. This conduct by the Respondent is considered cybersquatting and cyberflight, respectively, and are indicative of bad faith use of the disputed domain name. Such a record of the abuse of domain name registrations is probative of the Respondent's conduct in this case.

Lastly, the Complainant sent a cease-and-desist letter to the Respondent and the Respondent did not respond. This is further indicia of the Respondent's bad faith use of the disputed domain name.

As the conduct described above falls squarely within paragraph 4(b)(i), (ii) and (iv) of the Policy, the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith pursuant to the Policy, paragraph 4(a)(iii).

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <elkeem.com> be transferred to the Complainant.

*/Andrew J. Park/*

**Andrew J. Park**

Sole Panelist

Date: February 13, 2024