

ADMINISTRATIVE PANEL DECISION

Katepal Oy v. taeho kim, Dzone Inc
Case No. D2023-5188

1. The Parties

The Complainant is Katepal Oy, Finland, internally represented.

The Respondent is taeho kim, Dzone Inc, Republic of Korea, represented by Archer Softech, India.

2. The Domain Name and Registrar

The disputed domain name <katepal.com> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 13, 2023. On December 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 13, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Sav.com, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 13, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on December 14, 2023.

The Center verified that the Complaint together with the amended 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 7, 2024.

The Respondent and its representative both sent email communications to the Center on December 26, 2023. On January 4, 2024, the Respondent’s representative filed a response.

The Center appointed Steven A. Maier as the sole panelist in this matter on January 17, 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. Further Procedural Steps

As observed in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)):

“Paragraph 10 of the UDRP Rules vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition.

Paragraph 12 of the UDRP Rules expressly provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case.”

Based on its preliminary review of the Parties submissions and with the above criteria in mind, on January 29, 2024, the Panel issued Procedural Order No. 1, requesting the Complainant to provide further submissions and evidence relating to the reputation of its trademark at the relevant time, and affording the Respondent an opportunity to reply. The Complainant filed its submission accordingly on February 2, 2024, and the Respondent on February 8, 2024.

5. Factual Background

The Complainant is a company registered in Finland. It is a provider of roofing and other building materials.

The Complainant is or has been the owner of trademark registrations including the following:

- Finland trademark registration number 39508 for a combined mark comprising the text KATEPAL and a device, registered on November 14, 1962, in International Classes 17 and 19. The trademark expired on November 14, 2002;

- International trademark registration number 788849 for the word mark KATEPAL, registered on September 4, 2002 in International Classes 17 and 19. The trademark designates a total of 25 countries, including the Democratic People’s Republic of Korea; and

- Finland trademark registration number 226792 for the word mark KATEPAL, registered on March 31, 2003 with an application date of May 22, 2002, in International Classes 17 and 19.

The Complainant also refers to Republic of Korea trademark registration number 4003840000000 for the mark KATEPAL, including a device, registered on November 27, 1997, in international Class 33. The trademark was registered by Young Lee Co. Ltd, which the Complainant identifies as its importer in that country. The trademark expired on November 27, 2017.

The disputed domain name was created on December 14, 2000.

The Complainant submits evidence obtained from “[www.archive.org](#)” that, as of November 23, 2002, the disputed domain name resolved to a website at “[www.000sex.com](#)”. Based on the Panel’s independent review of “[www.archive.org](#)”, the disputed domain name appears to have resolved to web pages including sponsored links, or to have been inactive, at various times between 2006 and 2012, and from November 3, 2012 onwards to have resolved to web pages indicating that the disputed domain name is for sale.

6. Parties' Contentions

A. The Complaint

The Complainant submits that the disputed domain name is confusingly similar to its KATEPAL trademark.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It contends that the Respondent has never been known by the disputed domain name, and that the disputed domain name has never hosted any "decent" content. The Complainant refers to the website at "www.000sex.com" and to the advertising links to which the disputed domain name has redirected.

The Complainant submits that the disputed domain name has been registered and is being used in bad faith. The Complainant repeats that there has never been any "decent" content on the disputed domain name, and contends that the Respondent registered the disputed domain name only for the purpose of selling it to the relevant trademark owner. The Complainant asserts that the Respondent has demanded USD 29,000 for the disputed domain name, and states that the Complainant wishes to use the disputed domain name to publish its global websites.

The Complainant requests the transfer of the disputed domain name.

B. The Response

The Respondent acknowledges that the Complaint satisfies the technical requirement under the first element of the Policy, based on the Complainant's registered trademarks dated 2002 and 2003. The Respondent notes, however, that the first element is only a "standing" requirement, and submits that the Complainant has demonstrated no pre-existing trademark rights as at the date of registration of the disputed domain name, namely in 2000.

The Respondent submits that it has rights or legitimate interests in respect of the disputed domain name. Its case is as follows:

- (1) That in 2000, it operated a domain registration and website development company in the Republic of Korea.
- (2) That it registered the disputed domain name on behalf of "an English Teacher cum a friend" who was associated with the Korea Association of Teachers of English ("KATE"). The disputed domain name was intended for the purpose of a networking site for members of that association, hence the addition of the term "pal", meaning "friend".
- (3) That the Respondent arranged for a prototype of the proposed website to be developed offline.
- (4) That the Respondent's friend was ultimately unable to obtain the expected cooperation of the KATE association with the venture in question, and did not therefore proceed with the proposed website. In these circumstances, the disputed domain name was left with the Respondent to enable it to recover its costs incurred.

The Panel notes at this point that the Respondent neither identifies the "friend" to which it refers, nor exhibits any evidence in connection with the stated purpose for which the disputed domain name was registered, or the offline prototype website referred to. The Respondent states that evidence of this nature is "kind of impossible to retrieve" after a period of 23 years.

The Respondent states that it did not know that the disputed domain name redirected to "www.000sex.com" and does not recall whether or how any affiliate links were subsequently provided. It states that no affiliate content was provided after 2005 in any event.

The Respondent accepts that it invited enquiries for the sale of the disputed domain name from 2004 onwards, and that the disputed domain name was offered for sale on Afternic from 2021 for a “buy now” price of USD 29,000. However, the Respondent submits that it never heard from the Complainant in this regard. It provides evidence of an anonymous offer received in January 2023, and refers to “many [of] such offers”, which it believes were made by people having the name “Kate Pal” or similar names. It exhibits a Facebook page which appears to show numerous individuals with that name.

The Respondent submits that speculation in the disputed domain name is lawful in circumstances where the disputed domain name was not registered in bad faith. It contends that the sale of the disputed domain name gives rise of itself to rights or legitimate interests, since it forms part of the Respondent’s stock-in-trade.

The Respondent provides evidence of other domain names which it has registered and claims to be similar in nature to the disputed domain name. These include, for example, <teacher4you.com> registered in 2003, <kimsenglish.com> registered in 2006 and <homes4teachers.com> registered in 2020.

The Respondent submits that the disputed domain name was registered in good faith without any knowledge of the Complainant. It states that it has never solicited a sale to the Complainant and there is no evidence that the primary purpose of its registration of the disputed domain name in 2000 was to sell it to the Complainant in 2023. It submits that there was nothing wrong in it responding to an anonymous enquiry for the disputed domain name and that there are numerous individuals who could make legitimate use of the disputed domain name without infringing any rights of the Complainant. The Respondent cites examples of individuals named “Kate Pal”, “Kate Palmer” or “Kate Paley” who might want to use the disputed domain name for the purpose of a personal website.

The Respondent submits that the Complainant should be barred from succeeding in the proceeding by the doctrine of laches. It contends that a period of 23 years before bringing any Complaint is a substantial and unreasonable delay, and that the Respondent is not now able to locate every item of evidence in support of its case.

The Respondent further submits that this case relates to competing rights in the disputed domain name, and is not a case of “cybersquatting” which is suitable for determination under the UDRP.

C. The Complainant’s Reply to the Procedural Order

The Complainant submits that it began operations in Finland in 1949 and has exported products since the 1960s. It states that it exported roofing shingles to “Korea”, reaching approximately 900 shipping containers per annum between 1998 and 2004.

The Complainant refers to its Finland figurative trademark dated 1962, and the Republic of Korea trademark registered by its Republic of Korea importer in 1997. It points out that both these trademarks were in existence on the date the Respondent registered the disputed domain name, and submits that the Complainant therefore had valid trademarks, both in its own and in the Respondent’s location countries, on that date.

D. The Respondent’s Reply to the Procedural Order

The Respondent takes issue with Procedural Order No. 1, and objects in particular to the Complainant being given a second opportunity to state its case. It points out that the disputed domain name was registered in 2000 and submits that the Complainant should have pursued any case more promptly. The Respondent submits that the UDRP is a summary procedure and that the Complainant should not be given the opportunity of adding a further layer to the proceedings at this stage.

The Respondent also disputes the content of the Complainant's further submissions, stating that they are unsubstantiated and conclusory. It cites numerous previous decisions under the UDRP in which panels have denied complaints which were based on conclusory submissions unsupported by evidence. The Respondent contends, in particular, that the Complainant has produced no evidence to establish that the Republic of Korea trademark registrant, Young Lee Co. Ltd., was in any way connected with the Complainant. The Respondent denies that this was the case, and avers that the Complainant was not itself the owner of this trademark.

The Respondent further contends that the Complainant has sought to mislead the Panel by failing to make a distinction between the Democratic People's Republic of Korea and the Republic of Korea. It points out that the Complainant's International trademark registration dated 2002 relates to the Democratic People's Republic of Korea and not the Republic of Korea, and speculates that the Complainant's container deliveries in that period were in fact to the Democratic People's Republic of Korea.

The Respondent submits that the Complainant has provided no evidence to establish that the Respondent could have known of the Complainant or its trademark rights. It contends that, were the Panel to find in the Complainant's favour in these circumstances, this would effectively establish a *per se* rule of bad faith, where a domain name similar to any registered trademark would be found to have been registered in bad faith on the basis of "constructive notice".

The Respondent contends that the Complainant in this case constitutes a "Plan B" attempt to acquire the disputed domain name, the Complainant having remained silent for 23 years and then having attempted unsuccessfully to purchase the disputed domain name. The Respondent submits that the Complainant is therefore guilty of attempted "reverse domain name hijacking."

7. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established that it is the owner of current trademark registrations for the word mark KATEPAL. The disputed domain name is identical to that trademark, and the Panel therefore finds that the disputed domain name is identical to a trademark in which the Complainant has rights. While the Complainant's current trademarks were registered after the date of disputed domain name, that is immaterial to the analysis under the first element of the Policy, which (as the Respondent correctly observes) is understood as a "standing" requirement.

B. Rights or Legitimate Interests, and C. Registered and Used in Bad Faith

In this case, the Panel considers it appropriate to discuss the second and third elements under the Policy together, since similar factors inform the Panel's conclusions under each such element.

Having considered the parties' respective submissions, it appears to the Panel that broadly two possible scenarios exist.

Under the first such scenario, the Respondent registered the disputed domain name, as it claims, without knowledge of the Complainant, and for the purpose of an intended networking site related to the Korean Association of Teachers of English. When that project did not proceed, the Respondent continued to hold the disputed domain name in its capacity as a “domainer”, offering affiliate links for a period of time and subsequently offering the disputed domain name for sale. When it received an anonymous enquiry for the disputed domain name in 2023 (which it did not know to be from the Complainant) it quoted a price of USD 29,000, believing that the applicant was likely to be an individual with the name “Kate Pal” or a similar name who might wish to use the disputed domain name for the purpose of a personal website.

Under the second scenario, the Respondent registered the disputed domain name having become aware of the name of the Complainant’s business name and/or trademark, and hoping that the Complainant would seek to purchase the disputed domain name from it at some time in the future.

While the Respondent does not produce evidence in support of its version of events, the Panel accepts that it may be difficult for it now to do so, given the period of 23 years that has passed between its registration of the disputed domain name and the filing of the Complainant. While Panels under the UDRP do not generally recognize a doctrine of laches or acquiescence as such, it is generally accepted that where a complainant delays significantly in bringing a complaint, then it may be more difficult for that complainant to establish the second and third elements under the policy (see e.g., section 4.17 of [WIPO Overview 3.0](#)”).

The Panel also has regard to the paucity of the Complainant’s evidence (despite the opportunity presented by Procedural Order No. 1) of its commercial activities in the Republic of Korea prior to the date of registration of the disputed domain name. The Panel agrees that the Complainant’s reference to 900 container deliveries to “Korea” is ambiguous, in view particularly of the fact that the Complainant had an International trademark registration covering the Democratic People’s Republic of Korea, but no registration of its own for the Republic of Korea, at the material time. Nor has the Complainant produced evidence to support its statement that the Republic of Korea trademark registrant was its affiliated party.

The Respondent is correct in any event to observe that the mere existence of a trademark in a particular region is generally insufficient to establish bad faith on the part of a corresponding domain name registrant *per se*. In particular, the concept of “constructive notice” of trademark is not generally applied by panels under the UDRP. However, since panels are required to determine the respondent’s state of mind upon the registration of a disputed domain name, this commonly requires the application of inference based on the information available to the panel.

The disputed domain name is identical to the Complainant’s trademark, and there are circumstances in this case which raise serious concerns with the Panel as to the veracity of the Respondent’s version of events. In particular, while the Respondent has provided an explanation for its registration of the disputed domain name, and the Panel has established (by way of limited private research) that the Korean Association of Teachers of English did exist at the material time, the Panel nevertheless finds the Respondent’s explanation to be somewhat improbable.

The Panel also finds the initial use of the disputed domain name, to resolve to what appears on its face to be an adult entertainment website, to raise suspicions. The Respondent does not appear to be in the adult entertainment business, and it would be reasonable to infer in the circumstances that the use of the website for this purpose was intended to cause embarrassment to the Complainant and to increase the likelihood of it seeking to purchase the disputed domain name.

The Panel also notes that the Respondent Taeho Kim appears to have been the respondent in at least seven previous proceedings under the UDRP, in six of which the relevant registration was found to have been made in bad faith. The Panel finds the most significant of these case to be *The Commissioners for HM Revenue and Customs v. Privacy Protection / taeho kim, Dzone Inc*, WIPO Case No. [D2022-1662](#), which involved the domain name <govhmrc.com>. The Panel is unable to conceive of any use that could be made of that domain name other than to impersonate the official UK tax authority. The Respondent Dzone Inc. (excluding the name Taeho Kim) has also been the respondent in a significant number of other proceedings

in which bad faith has been found. The Panel does note, however, that the Respondent is the owner of other seemingly legitimate domain names, including those relating to education, albeit registered after the date of the disputed domain name.

While every case under the UDRP must turn on its own individual merits, the fact that a respondent has engaged in a pattern of registering domain names corresponding to marks held by third parties may be a relevant factor in the Panel's overall assessment.

All of these observations having been made, the Complainant nevertheless faces an uphill task in establishing the second and third elements under the Policy after a period of over 20 years since the registration of the disputed domain name. In this regard, the Complainant has done itself no favours by failing, despite two opportunities, to exhibit evidence of its business in the Republic of Korea at the material time, or otherwise to demonstrate why the Respondent was more likely than not to have been aware of its trademark at the time it registered the disputed domain name.

Furthermore, while the Panel finds the Respondent's explanation for its registration of the disputed domain name to be somewhat improbable, it cannot be definitively excluded. While the Respondent, too, has failed to exhibit relevant evidence in this regard, it is the Respondent who must receive the benefit of the doubt in circumstances where the Complainant has not been able to produce requisite historical evidence (in part no doubt due to the lapse of time).

In the circumstances, the Panel finds that the Complainant has failed to establish that the Respondent knew or ought to have known of its trademark at the time it registered the disputed domain name, or that it did so with a view to targeting the Complainant's trademark. Bearing the Respondent's explanation in mind, the Complainant is therefore unable to establish, at this distance in time, that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Panel also notes that, if the Respondent had rights or legitimate interests in respect of the disputed domain name at the date of its registration, then the subsequent use of the disputed domain name by the same registrant is immaterial under the UDRP. The Respondent's asking price of USD 29,000 could not therefore be a determinative factor, whether or not the Respondent knew or suspected that the Complainant was the applicant.

C. Reverse Domain name Hijacking

Under paragraph 15(e) of the Rules: "If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding."

The Panel makes no finding of Reverse Domain Name Hijacking ("RDNH") in this case. The Complainant has been unsuccessful in the proceeding primarily because of its failure to produce evidence relevant to the reputation of its trademark. The Panel does not find the circumstances to indicate bad faith on the part of the Complainant in this case.

8. Decision

For the foregoing reasons, the Complaint is denied.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: February 26, 2024