

WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

Ho-Hyun NAHM
Barun IP & Law
Seoul
Republic of Korea



Nationality: Korean

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

LL.B., College of Law, Chung-ju University (1976);
M.PA., Graduate School of Public Administration, Seoul National University (1985).

Admitted to the 23rd Korean Patent Bar (1986).

Awards/Accolades:

Awarded 2015 Korea Invention Education Writing Award ' by Korean Academy of Invention Education
Recognized as the 'Man of the Year in Law 2010' by American Biographical Institute for Dedication
and Excellence;

Nominated as one of the leading, most highly-acclaimed legal experts, and highly recommended Asia-
Pacific-focused lawyers in areas of Intellectual Property Rights, for seven consecutive years
(2007~2013), by 'Asia Law';

Selected as one of 'The World's Leading Experts in Trademark Law' in 1996 by 'Euromoney
Publications PLC' based in London.

LANGUAGES

Korean, English and Japanese

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PRESENT POSITION

Partner, BARUN IP & LAW;
Chairman of KIDRC (Korea Internet Address Dispute Resolution Committee), semi-governmental organization;
Vice President of APAA (Asian Patent Attorneys' Association)-International;
Policy Advisor of the Ministry of Public Administration and Security.

PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Partner, Patent and Trademark Attorney at Central International Law Firm (1987-1996);
President of APAA (Asian Patent Attorneys' Association)-Korean Group (2012~ 2015);
Vice President of Korean Arbitrators' Association (2013~2015);
Visiting Professor of the National Police University (lecturing Intellectual Property Right Laws) (2012);
Visiting Professor of the Sookmyung Women's University (lecturing Intellectual Property Right Laws) (2001)
Director of the Korean Intellectual Property Forum, Korean Industrial Property Rights Institute (2006~present);
Director of the FICPI-Korea (2006~present);
Trademark policy advisor for the Korean Intellectual Property Office (KIPO);
President of Korea Trademark, Design and Copyright Chapter of the Korean Patent Attorneys' Association (2009~2010);
Councilor of the Presidential Council on State Science and Technology of the Republic of Korea (2005~ 2006);
Chairman of the Trademark Committee of the Asian Patent Attorneys' Association (2003~2009)
International Affairs Director of the Korean Patent Attorneys Association (2000~2002);
President of the Korean Trademarks Association (1999~2000);
Legal Affairs Department of Korean Air (1982~1987);
Overseas Information Service, Ministry of Culture and Information (1980~1982).

AREAS OF SPECIALIZATION

Intellectual Property: the acquisition and the filing of appeals of and for rights on patents and trademarks; legal proceedings for cancellation action against court rulings; legal proceedings for confirmation on a court decision; and international licensing work; resolution of domain name disputes.

MEMBERSHIP IN PROFESSIONAL BODIES

Korea Patent Attorneys' Association (KPAA);
International Trademark Association (INTA) ;
Association Internationale pour la Protection de la Propriété Intellectuelle (AIPPI) ;
Fédération Internationale des Conseils en Propriété Intellectuelle (FICPI);
European Communities Trade Mark Association (ECTA);
Asian Patent Attorneys' Association (APAA);
Pharmaceutical Trade Marks Group (PTMG);
The European Chamber of Commerce in Korea (ECCK);
Intellectual Property Forum (IPFORUM).

EXPERIENCE IN INTELLECTUAL PROPERTY

Practice of patent and trademark law by engaging in filings, prosecution and litigation internationally over the last 30 years

Written many articles in the field of Intellectual Property rights and have a knowledgeable background in the IP industry based on my experiences with conducting various presentations in international/domestic conferences including the INTA, AIPPI, ECTA, FICPI and PTMG.

Conducted lectures at Korea's Sookmyung Women's University in the field of Intellectual Property Rights in 2001 and at National Police University in 2012 as visiting professor.

EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Chairman and Panelist, Korean Internet Address Dispute Resolution Committee (KIDRC);

Panelist, National Arbitration Forum (NAF);

URS Examiner, National Arbitration Forum (NAF);

Panelist, Asian Domain Name Dispute Resolution Committee (ADNDRC);

Panelist, WIPO Arbitration and Mediation Center (Domain Name Dispute);

Issued more than 300 decisions in regards to arbitration and/or Domain Name Dispute Resolution in English, Korean and Japanese.

MAJOR PUBLICATIONS

Books

"Challenging the 21st Century with Intellectual Property Rights" published in Korean by the Chosun Daily Newspaper and selected as a best seller in the section of sociology and politics (2003)

published in English (2003);

published in Japanese (2008);

2nd Edition in English (2010);

"Change Your Life with Ideas" (2010);

"From Edison to iPod" (2010), an adapted version to Korean Intellectual Property Law and Practice.

Author of Korean chapter of "Domain Name Handbook 2nd Edition" published by Oxford University Press (2015);

Author of Korean chapter of "Opposition Guideline" of International Trademark Association (INTA).

Broadcasting

Host of the weekly program- 'Ho-Hyun Nahm's Fun Anecdotes of Patents' broadcasted by *Daily Economy TV* (MBN).

Articles

Trend of IP Education in Korea (2011, Japan, "Patent" Magazine);

Annotation on Judicial Precedents in Korea on Trademarks in Letter or Figure Type: STARBUCKS vs. STARPREYA (2005, Japan, International Association for the Protection of Intellectual Property);

Amendments for Korea Trademark Law and Korea Design (Protection) Law (2005, AIPPI Japan);

Domain Name Dispute Resolution Policy (2005, Korea Internet Security Agency);

The Protection of Telegraphic Design Registration in Korea (2003, Japan, Intellectual Property Information Center at Economic Industrial Investigating Committee);

Policy on Disclosing Design Application, Registration without Examination of Some Products, and Multiple Design Registration Application in Korea (2003, Journal of AIPPI Japan);

Use of a Mark 'As a Mark' as a Legal Requirement in Respect of Acquisition Maintenance Infringement of Rights in Korea (2002, AIPPI Year Book);

The Madrid Protocol and its Impact on Korean Trademark Laws (2002, Journal of AIPPI Japan Group);

Recent Trends in Judicial Precedents by the Korean Supreme Court with Regard to Domain Name Disputes and Judicial Judgments on Decision for Adjustment (2002, KRNIC International Seminar); Protection and Enforcement of Well-Known Trademarks, Service Marks and Domain Names in Korea (2001, Journal of the Japanese Group of AIPPI).

Presentations

“Ensuring Internet security, domain name and trademark protection” (October, 2014; ALB IP Conference, Seoul);
 “Protection of Non-traditional trademarks in Korea” (April, 2014; FICPI Kyoto Symposium, Kyoto);
 “How does UDRP affect the evolution of ccTLD dispute resolution policies - Perspectives from.Kr” (January, 2014; ADNDRC Conference, Kuala Lumpur);
 “Are Goods and Services Specifications Inflation Proof? Perspective of South Korea” (October, 2013; FICPI Open Forum, Sorrento);
 Lecture at Seoul National University (2013);
 Lectures at National Police University (semester of 2012);
 Handong International Law School (2011);
 Sookmyung University (2000);
 “Counterfeiting and Criminal Sanctions in Korea” (December, 2011; FICPI Korea Symposium);
 “Strategies for Efficient Protection - Maintenance of Intellectual Properties in Korea & Role of IP Lawyers” (April, 2011; Presentation at Handong International Law School);
 “New Marks - Old Laws” (September, 2010; FICPI 12th Open Forum, Munich);
 “Trademark Bullies” (October, 2010; APAA 58th Council Meeting in Jeju);
 “Recent Amendments in Korea-Design Protection Law and the Main Characteristics of Design Policy” (January, 2010; KPAA-JPAA Joint Seminar);
 “Trademark Protection of shapes & color” (December, 2009; FICPI India Symposium);
 “The Characteristics of Korean Design Protection Policy” (November, 2008; KPAA-JPAA Joint Seminar);
 “Prominent issues of Korean IP Attorneys' Profession” (October, 2008; FICPI Korea-FICPI France Joint Seminar);
 “Similarity in a Global Context” (May, 2008; International Trademark Association (INTA) the 130th Annual Meeting);
 “Boarder Seizures” (March, 2008; KPAA-AGPA(German Patent Attorneys' Association) Joint Seminar);
 “Strategies for Efficient Protection - Maintenance of Intellectual Properties in Korea” (March, 2008); International Seminar on Intellectual Properties hosted by British Embassy in Korea);
 “Strategies for Procuring and Maintaining Intellectual Properties to Boost Competitiveness of a Firm” (March, 2005; Guest Lecturer for Korea Invention Promotion Association);
 “Adaptation of Korean Law to Prevent Cyber-squatting” (March, 2004; Internet Address Dispute Resolution Committee);
 “Effective Trade Mark Rights Enforcement in Asia” (March, 2004; Pharmaceutical Trademark Group (PTMG) General Assembly);
 “Trademark Assignment & Licensing, Trade Remedies and An Advice to Exporting Companies” (March, 2003; Guangzhou, China);
 “The Madrid Protocol and its Impact on Korean Trademark Laws” (2002; the 3rd Joint Seminar of AIPPI Japan, China and Korea);
 “Protection and Enforcement of Well-Known Trademarks and Domain Names in Korea” (2001; the Joint Seminar of AIPPI Japan, China and Korea).

EXPERIENCE IN COURT LITIGATION

Has 30 years' experience extensively with litigation in trademark and patent matters and have produced leading cases, some of which have changed even well established legal principles in Supreme Court precedents.

The trademark 'Elegance' case

Though this mark had previously been judged to be of no distinctiveness as a trademark twice by the Supreme Court, the Patent Court later became acknowledged of its distinctiveness thanks to our logical argumentation and assertion that it contained an element of distinctiveness and uniqueness by successfully establishing a secondary meaning.

The domain names 'www.chungmongku.com,' 'www.chungmongku.net' case

The World Intellectual Property Office (WIPO) acknowledged Hyundai Motor Chairman Chung Mong Ku's name as a trademark in the context of common law.

The trademark 'JIMMY CHOO' case

The Supreme Court overturned the outcome announced by the Patent Court of Korea that the above mark and Sanrio's mark "PATTY & JIMMY" were similar. The Supreme Court ruled their dissimilarity, and as such we won the case. Furthermore, it resulted in amending the examination standard of the trademark similarity.

The trademark 'Hardy Amies' case

In the non-use cancellation action, whereby we submitted an advertisement published on a foreign magazine, the very piece of evidence was accepted and acknowledged. As such, we successfully defended the mark 'Hardy Amies'.

The trademark 'LOTS' case

The Supreme Court overturned the outcome announced by the Patent Court of Korea that the above mark and Lotus Group's mark the 'LOTUS' were similar. The Supreme Court ruled their dissimilarity, and as such we won the case.

PROFESSIONAL TRAINING IN ARBITRATION

Completion of CEO Academy course at Korean Commercial Arbitration Board (2007);
 National Arbitration Forum (NAF) panelist training at INTA meetings (2007~2013)
 WIPO Panelists Meetings and Domain Name Workshops
 KIDRC (Korean Internet Address Dispute Resolution Committee) workshop (2002~present) (twice each year)

EXPERIENCE IN ARBITRATION

Arbitrator, Korean Commercial Arbitration Board;
 Arbitrator, Hong Kong International Arbitration Centre (HKIAC);
 Chairman and Panelist, Korean Internet Address Dispute Resolution Committee (KIDRC);
 Panelist, WIPO Arbitration and Mediation Center (Domain Name Dispute);
 Arbitrator, National Arbitration Forum (NAF);
 Panelist, Asian Domain Name Dispute Resolution Committee (ADNDRC).

ARBITRATION EXPERIENCE
SUMMARY TABLE

Type	Administering Institution		Role			
	Name	Number of Arbitrations	Presiding Arbitrator	Sole Arbitrator	Co-arbitrator	Counsel
International Arbitrations	AAA					
	ICC					
	LCIA					
	Ad Hoc	282	2	273		
Number of cases: sub-total		282	2	273		
Domestic Arbitrations	AAA					
	Ad Hoc	57	12	25	20	
	Korean Commercial Arbitration Board	1			1	
Number of cases: sub-total		58	12	25	21	
TOTAL		340	14	298	21	