

Clash of the cleaners
International - Hogan Lovells

Examination/opposition
Confusion
Domain names

July 06 2017

In a recent decision under the Uniform Domain Name Dispute Resolution Policy (UDRP) before the World Intellectual Property Organisation (WIPO), a panel not only denied the complaint, but also held that it had been brought in bad faith and constituted an abuse of the administrative proceeding – a practice known as ‘reverse domain name hijacking’.

The complainant, Anyclean Premium Limited of London, was a UK company which operated a cleaning business. It owned two trademarks – ANYCLEAN and ANY CLEAN. The earliest was registered in 2006, although the complainant alleged that it had used the term ‘anyclean’ in relation to its business since 2000.

The respondent, Jethro Denahy, owned a cleaning business called ‘Any-Clean’, also based in London.

The disputed domain name ‘any-clean.com’ was registered by the respondent on February 13 2010 and pointed to an active website relating to his cleaning business (although, somewhat unusually, this was disputed by the parties).

For a complaint to succeed under the UDRP, it must satisfy the following three requirements set out in Paragraph 4(a):

- “(i) The domain name registered by the respondent is identical or confusingly similar to a trade mark or service mark in which the complainant has rights; and
- (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.”

Regarding the first requirement and whether the complainant’s trademarks were identical or confusingly similar to the disputed domain name, the panel noted that each trademark consisted of the word or words in question in combination with a graphical representation of those words. The panel considered that similarity between a domain name and a device mark including words or letters is a readily accepted principle under the UDRP, as long as the words or letters comprise a prominent part of the trademark in question. The panel found that this was the case here and so the disputed domain name was held to be similar to the complainant’s trademarks.

Regarding the second requirement and whether the respondent had any rights or legitimate interests in the domain name, the complainant first noted that the respondent was not authorised to use its trademarks as he was not one of its distributors, licensors or authorised dealers. Furthermore, the complainant argued that the domain name pointed to a pay-per-click (PPC) website that offered links to competitors’ goods and services. The respondent denied these allegations, stating that he had used the term ‘any-clean’ since 2010 in connection with a *bona fide* cleaning business and supplied invoices other and documentary evidence to support this claim. He argued that there were no PPC links on his website – only links to other local websites which his customers may find useful and for which he received no payment.

The panel first tackled what it referred to as the “surprising disparity” between the complainant’s and the respondent’s contentions with regard to the nature of the respondent’s website. The panel concluded that it was a website operated by a small cleaning business on which no PPC links were detected. The panel was “unable to understand” how the complainant had concluded that this was a typical PPC website. In addition, the panel was confused by the complainant’s assertions that material exhibited was searched “through the homepage” of the respondent’s website. The panel concluded that the search results exhibited simply appeared to be the results of a Google search and were nothing to do with the respondent.

The panel was “equally bemused” by the complainant’s citation of a previous UDRP case and its assertion that it evidenced the respondent’s previous involvement in registering and using a domain name in bad faith. The panel found that the case had nothing to do with the respondent and had no idea why it had been cited in this regard. The panel concluded that the term ‘any-clean’ was composed of two ordinary English words and that these terms could be independently derived by a person establishing a cleaning business. The panel saw no reason to doubt the respondent’s assertion that this is what he did before he had any knowledge of the complainant.

Moving on to the question of the respondent’s bad faith, the complainant argued that the respondent knew,

or should have known, of its ANYCLEAN trademark. It claimed that the respondent had registered the domain name to confuse internet users and to attract them to his website for commercial gain. The respondent argued that he was using the domain name only in connection with his own business and was unaware of either the complainant's business or its trademarks when he registered the domain name. The respondent also noted that he had added a disclaimer to his website after the complainant had contacted him, stating that his business was not associated with any other business using the same or a similar name.

The panel pointed out that even though the complainant's earliest trademark pre-dated registration of the domain name, it had provided no evidence concerning the size or nature of its business or the number of customers. The panel therefore found that nothing suggested that the respondent knew about the complainant and its trademarks at the date of registration. The panel agreed with the respondent that the words 'any' and 'clean' were descriptive when applied to a cleaning business, and found that the complainant had not established that it had a significant reputation in these terms. As a result the panel was not prepared to find any wrong-doing by the respondent in this regard.

The panel also noted that there was no evidence that the respondent had registered the domain name in order to sell it to the complainant or to create a likelihood of confusion, and that such allegations were clearly inconsistent with the nature of the respondent's business and the way in which the domain name was being used. Finally, the panel considered that it was reasonable for the respondent to have added a disclaimer to his homepage after the complainant contacted him. The panel therefore found that neither registration nor use of the domain name was in bad faith and the complaint was therefore denied.

The panel then went on to consider Paragraph 15(e) of the UDRP covering reverse domain name hijacking:

"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...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 decided that this analysis was needed even though the respondent had not specifically requested it.

The panel considered that a finding of reverse domain name hijacking is appropriate where a complaint is presented in a misleading and inaccurate manner, and that panels should be able to rely on the certification given by complainants that all the information given is complete and accurate to the best of the complainant's knowledge.

In this case, the panel found that the certification was inaccurate for the following reasons:

- The respondent's website was not a PPC website;
- The search results provided by the complainant did not come from the respondent's website as claimed, but from Google;
- The allegation connecting the respondent with a previous UDRP decision was incorrect and misleading; and
- The complainant had ignored the fact that the respondent was operating a *bona fide* cleaning business.

In conclusion, not only was the complaint denied, but the panel found that it had been brought in bad faith and constituted an abuse of the administrative proceeding.

Findings of reverse domain name hijacking are relatively rare. This case demonstrates that it is unwise to file a complaint simply stating that conditions for transfer under the UDRP are fulfilled when the facts tell a different story, perhaps in the hope that the respondent will not reply and the panel will accept the assertions at face value and order transfer without further consideration. This never happens.

The decision is available [here](#).

David Taylor and Jane Seager, Hogan Lovells, Paris

World Trademark Review™

Daily

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.