

## UDRP: personal names generally evidence respondents' rights

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### INTERNATIONAL

Legal updates: case law analysis and intelligence

- Hale Law, the owner of the mark GO TO HALE, sought the transfer of 'gotohale.com' under the UDRP
- The panel found that the respondent held the legitimate right of priority, as he registered the domain name 20 years before the registration of the complainant's mark
- Use of one's own surname in a domain name is generally sufficient evidence of a right or legitimate interest in that domain name

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a three-member panel has denied a complaint for the disputed domain name 'gotohale.com'. The decision was on the basis that the complainant had failed to show that the respondent had no rights or legitimate interests in respect of the domain name as it included the respondent's personal name.

## Background

The complainant was Hale Law, located in Florida, United States. It owned a trademark registration for GO TO HALE, registered in December 2021. The respondent was Roger Hale, an individual based in the United States. He registered the disputed domain name in May 2000.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements under Paragraph 4(a):

1. the domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
2. the respondent has no rights or legitimate interests in respect of the domain name; and

3. the domain name has been registered and is being used in bad faith.

## Decision

### **First limb**

The panel was satisfied that the complainant had rights in the trademark GO TO HALE and that the domain name incorporated the complainant's trademark in its entirety. The majority of the panel therefore found that the domain name was confusingly similar to the complainant's trademark. Thus, the complainant satisfied the first limb of Paragraph 4(a) of the UDRP.

### **Second limb**

According to Section 2.1 of the [WIPO Overview 3.0](#), a complainant must demonstrate that a respondent has no rights or legitimate interests in respect of the domain name in question. In this regard, a complainant is normally required to make out a *prima facie* case, and it is then for the respondent to demonstrate otherwise. If the respondent fails to do so, then the complainant is deemed to satisfy Paragraph 4(a)(ii) of the UDRP.

In the present case, the complainant claimed that the respondent had not used the domain name for over two decades and that the domain name was resolving to a parking page with pay-per-click links at the time of filing.

The respondent argued that he registered the domain name at least 20 years before the complainant's registration of its GO TO HALE trademark and that he had made legitimate use of the domain name for the past 23 years. He also added that he had used the domain name for an IT consultancy business incorporating his surname, Hale Solutions, since 2001, and evidenced that he had used the domain name for his email address to conduct his personal and professional business for more than 20 years before the complainant had begun using GO TO HALE as a trademark for legal services.

The panel stated that the evidence showed that the respondent was holding the legitimate right of priority, as he had registered the domain name 20 years before the registration of the complainant's trademark. It also found that the use of one's own surname in a domain name is generally sufficient evidence of a right or legitimate interest in a disputed domain name. The panel further underlined that, typically, the first person in time to register a domain name would normally be entitled to use the domain name for any legitimate purpose it wished. The panel thus concluded that the respondent had rights and legitimate interests in respect of the domain name.

### **Third limb**

The panel did not need to consider the issue of bad-faith registration and use under the third limb in light of its analysis of the second limb. Nevertheless, the panel noted that it was clear that, since neither the trademark nor the complainant existed at the time when the respondent acquired the domain name, it was not possible to find that the domain name had been registered in bad faith.

### **Reverse domain name hijacking**

The panel thus denied the complaint and entered a finding that the complainant had engaged in reverse domain name hijacking as the complainant's counsel must have known that, without supporting evidence, the complaint was doomed to failure, at least from the time that it became aware of the respondent's personal name.

## Comment

This decision highlights that trademark owners should think very carefully about filing a UDRP complaint when the domain name at issue was registered before their trademark registration. The resolution of a disputed domain name to a parking page at the time of filing is not necessarily decisive when it comes to a respondent's lack of rights or legitimate interests, especially when the domain name matches the respondent's personal name. In addition, the fact that the registrant details are often hidden at the time of filing is frequently problematic, but complainants are given the opportunity to amend their complaints further to the registrar's disclosure of the registrant details. They should thus give careful consideration to the implications of the disclosure and whether it means that their complaint can no longer succeed and should thus be withdrawn before it is officially served on the respondent.

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