

Food for thought: UDRP d(ish)oomed to fail
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Cybersquatting
Internet issues

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- **A WIPO panel has denied the transfer of 'dishoom.co' to the owner of several DISHOOM marks**
- **There was no actual evidence that the respondent knew of the complainant's rights when registering the domain name**
- **Owners of marks with generic or descriptive meaning have heavier burden to establish bad-faith registration and use**

In a [recent decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the World Intellectual Property Organisation (WIPO), a panel has denied the transfer of a domain name identically reproducing a complainant's trademark as there was insufficient evidence that it was registered and used in bad faith to take advantage of the complainant's trademark.

The complainant was Dishoom Limited, a company based in London, United Kingdom, that operated a chain of restaurants. The complainant was the owner of a number of registered trademarks for DISHOOM in several jurisdictions, including United Kingdom trademark No 2468689, registered on March 7 2008. Since its launch in 2010, the complainant's restaurant business had acquired substantial goodwill and renown, having been listed in the *Good Food Guide* every year from 2012 to 2018, and the *Michelin Guide* in 2014, 2015 and 2017. Its main website was available at 'dishoom.com'.

The respondent was Ashish Parikh, an individual based in New Jersey, United States. The respondent submitted that he was associated with a consultancy business named Dishoom Pte Ltd, registered in Singapore in July 2017.

The disputed domain name, 'dishoom.co', was registered by the respondent using a privacy protection service on April 26 2017. At the time of the decision, it was resolving to a registrar parking page.

To be successful in a complaint under the UDRP, a complainant must prove each of the following cumulative requirements:

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.

The first requirement under the UDRP is two-fold and requires a panel to assess, first, whether the complainant has relevant trademark rights and, second, whether the disputed domain name is identical, or confusingly similar, to the complainant's trademark.

The panel found that the complainant had demonstrated that it had relevant trademark rights. The domain name reproduced the complainant's trademark without adornment and so the panel found that the domain name was identical to the complainant's trademark. Accordingly, the panel found that the complainant had satisfied Paragraph 4(a)(i) of the UDRP.

Turning to the second requirement under the UDRP, and whether the respondent had rights or legitimate interests in the domain name, Paragraph 4(c) of the UDRP provides a non-exhaustive list of circumstances that may indicate that a respondent has rights or legitimate interests in a domain name. In this regard, the complainant submitted that the respondent had no rights or legitimate interests in the domain name as the complainant had not authorised or otherwise allowed the respondent to make any use of its trademark, in a domain name or otherwise. The complainant also argued that there was no active website associated with the domain name, and that the respondent had not made any demonstrable preparations to use it in connection with a good-faith offering of goods or services. The complainant argued that the respondent had registered the domain name to trade off the complainant's goodwill and reputation. In turn, the respondent submitted that he had an active business providing strategy and technical consulting services and that he was engaging in a good-faith offering of services before he received any notice of the dispute, as he had two email addresses associated with the domain name which were actively being used.

The panel noted that the respondent had provided limited evidence to support his arguments, and that the limited evidence submitted contained gaps. For instance, the respondent had submitted as evidence a copy of his LinkedIn profile stating that he was CEO of Dishoom since August 2016. However, the only evidence he had provided which predated the notice of the dispute (ie, July 20 2017) was a statement of work in the name Dishoom Pte Ltd dated June 2017. Furthermore, a public records search carried out by the panel had revealed that the Singaporean entity Dishoom Pte Ltd was incorporated on July 27 2017. The panel noted that the respondent had not made any attempt to provide any explanation regarding these inconsistencies. As a result, the panel found that the respondent's rights or legitimate interests in the domain name were "not clear". However, given the panel's finding in relation to bad faith, the panel was not required to conclusively determine whether or not the respondent had rights to or a legitimate interest in the domain name.

Turning to the third requirement under the UDRP, and whether the respondent had registered and used the domain name in bad faith, Paragraph 4(b) of the UDRP also provides a non-exhaustive list of circumstances that may be considered evidence of registration and use of a domain name in bad faith. The complainant started operating its business in 2010 and since then had acquired substantial reputation. The complainant thus argued that the respondent knew or should have known of the complainant's trademark rights at the time of registration of the domain name seven years later. However, the complainant's restaurants were located in the United Kingdom (mainly in London) and the respondent appeared to be based in the United States and operated a business in Singapore that was not connected to the complainant's field of business. Given this, the panel noted that the complainant had not provided any actual evidence to support its claim that the respondent knew or should have known of the complainant's rights at the time of registration of the domain name.

Further, the panel noted that the respondent's assertion that the complainant did not have universal rights in the term 'dishoom' was correct as the term appeared to be a dictionary word and the onomatopoeic equivalent to 'pow' or 'bang' in Hindi. In addition, the panel noted that there was no evidence suggesting that the respondent was attempting to trade off the complainant's reputation and so the panel was not willing to accept the complainant's contention that the respondent had registered the domain name in bad faith.

Accordingly, the panel found that the complainant had not satisfied Paragraph 4(a)(iii) of the policy.

Given that a complainant must cumulatively fulfil the three requirements under the UDRP and that the complainant in this case had failed to satisfy the third requirement, the panel denied the transfer of the domain name to the complainant.

This decision highlights how having a trademark by itself does not necessarily mean that the trademark holder will succeed in obtaining the transfer of a domain name, even if it identically reproduces such trademark. A complainant must also demonstrate that the disputed domain name was registered and used to take advantage of the complainant's rights, which may prove difficult particularly where the name in question also has a generic or descriptive meaning and is not being actively used. This case therefore serves as a reminder that complainants owning trademarks that also have a generic or descriptive meaning have a heavier burden to establish bad-faith registration and use, and so complainants should support their case with as much evidence as possible in order to reduce the risk of denial.

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