

You are in preview mode

DISABLE PREVIEW MODE

21 Nov
2019

'Exact match' UDRP complaint denied as complainant fails to prove knowledge of its mark

International - [Hogan Lovells](#)

- **MiWay Insurance Limited sought the transfer of 'miway.online' under the UDRP**
- **The panel found that there was reason to believe that the domain name was selected as it suggests the phrase 'my way', rather than as a reference to the complainant's mark**
- **The case highlights the inherent risks associated with so-called 'passive holding' cases**

In [MiWay Insurance Limited v Domains By Proxy LLC/Sahi](#) (WIPO Case D2019-1987), a panel has refused to transfer the domain name 'miway.online' under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP), finding that the complainant had failed to establish bad faith under the third element of the UDRP.

Background

The complainant, MiWay Insurance Limited, was a South African public company controlled by the publicly-listed financial services group Sanlam. Since 2008, the complainant had built a business offering insurance coverage, including short-term insurance policies online via its website at www.miway.co.za. The complainant asserted trademark rights in its South African trademarks for MIWAY, registered since 2 November 2010.

The respondent, Jatinda Sahi, an individual based in the United Kingdom, had registered the disputed domain name 'miway.online' on 2 June 2018 using a privacy service. The disputed domain name had not been used in connection with any active website, but simply resolved to a registrar parking page indicating that the disputed domain name was parked for free.

UDRP requirements

To be successful under the UDRP, a complainant must satisfy the requirements of Paragraph 4(a) of the UDRP - namely, that:

- the disputed domain name is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
- the respondent has no rights or legitimate interests in the disputed domain name; and
- the disputed domain name was registered and is being used in bad faith.

Decision

Identity/similarity

The panel found that the complainant had satisfied the first element of the UDRP given that the disputed domain name reproduced the complainant's MIWAY trademark in its entirety. Disregarding the generic top-level domain '.online', the disputed domain name was identical to the complainant's trademark.

Rights/legitimate interests

The panel further accepted that the complainant had made a *prima facie* case that the respondent had no rights or legitimate interests in the disputed domain name, noting that the complainant had established:

- trademark rights;
- confusing similarity between the disputed domain name and the trademark;
- a lack of permission for the respondent to make use of the complainant's trademark; and
- the absence of a name corresponding to that of the respondent or any use of the disputed domain name in connection with a *bona fide* commercial offering or other fair use.

Despite the respondent's assertions that he had registered the disputed domain name for use in connection with an online life-coaching business, there was no evidence of any preparations to use the domain name for such purpose. The panel therefore found that the complainant had satisfied the requirements of the second element of the UDRP.

Bad faith

Under the third element, the panel considered the arguments put forward by the complainant. The complainant's case was built on the basis that:

mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. In this case, the respondent's domain name is identical to the complainant's MIWAY trademark, which is well known to a substantial number of people, particularly those within the insurance and financial services industry.

The panel did not hesitate to acknowledge that the complainant's trademark was well known in South Africa. At the same time, the respondent, who was based in the United Kingdom, had come forward to assert that he had never heard of the complainant prior to this dispute. In reaching its findings under the third element, the panel looked at the surrounding circumstances of the case beyond the disputed domain name vis à vis the complainant's identical trademark, namely that:

- the domain name corresponded to the English phrase 'my way';
- the respondent claimed to have plans to use the disputed domain name in connection with a life-coaching website;
- other third parties were making use of domain names containing the complainant's trademark, including 'miway.com', 'miway.net' and 'miway.eu'; and
- there was no evidence that the complainant had advertised its services to residents outside of South Africa, and certainly not in the United Kingdom.

The panel acknowledged that the identity between the disputed domain name and the complainant's trademark could lead to an inference of bad faith; however, the panel found that there was reason to believe that the disputed domain name was selected as it suggests the phrase 'my way', rather than as a reference to the complainant's trademark. The panel did not consider it to be likely that the respondent was aware of the complainant, or that it had any intent to disrupt the complainant's business in any way. Accordingly, the complaint failed under the third element of the UDRP.

Comment

This case highlights the inherent risks associated with so-called 'passive holding' cases. In instances where there is no apparent active use of a domain name, UDRP panels will consider factors outlined in [Telstra Corporation Limited v Nuclear Marshmallows](#) (WIPO Case No D2000-0003), namely:

- the degree of distinctiveness or reputation of the complainant's mark;
- the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;
- the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and
- the implausibility of any good-faith use to which the domain name may be put.

In the present case, it was plausible that the disputed domain name, which at least phonetically corresponded to the English phrase 'my way', could be put to another use other than in connection with the complainant's insurance business. Ultimately, the strength of a complainant's trademark will be paramount to risk analysis in cases of passive holding - even in cases of an exact match, prior UDRP decisions show that, where a domain name corresponds to a dictionary word or phrase, it will be far more challenging to prove registration of a passively-held domain name in bad faith.

Jane Seager

Hogan Lovells

Thomas Raudkivi

Hogan Lovells

TAGS

[Online](#), [Internet and Online](#), [International](#)