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The wish is father to the thought

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- **Agfa-Gevaert NV sought the transfer of four domain names, including ‘agfachelseapartners.com’, under the UDRP**
- **The panel found that the respondent had offered a seemingly plausible explanation as to why he registered the domain names and his company name**
- **The complainant had offered no arguments or documentation as to the respondent’s explanation despite having been given the opportunity to do so**

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to order the transfer of four domain names because the complainant had failed to prove that the respondent had acted in bad faith.

Background

The complainant was **Agfa-Gevaert NV**, a Belgian multinational corporation that develops, manufactures and distributes analogue and digital imaging products, software and systems. The respondent was Fabrice Akakpo, an individual based in the United Kingdom.

The disputed domain names, ‘agfachelseapartners.com’, ‘agfachelseapartners.store’, ‘agfachelseapartners.tech’ and ‘agfachelseapartners.world’ were registered by the respondent on 16 April 2020. Three domain names resolved to error pages and the fourth, ‘agfachelseapartners.tech’, resolved to a website with limited content.

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

- the domain name registered by the respondent 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 respect of the domain name; and
- the domain name has been registered and is being used in bad faith.

Decision

Paragraph 4(a)(i)

The complainant contended that it owned many AGFA marks in registered between 2005 and 2013. The complainant argued that the disputed domain names contained the trademark AGFA in its entirety and, therefore, they were highly similar to such trademark. The respondent did not dispute that fact. The panel stated that the domain names indeed incorporated the complainant’s trademark with the addition of ‘chelseapartners’, but given its findings under the third limb of the policy, the panel did not decide under the first element.

Paragraph 4(a)(ii)

The complainant asserted that the disputed domain names had always been inactive or presented very little content and there was no evidence that the respondent had been preparing to use them to offer goods or services. The complainant added that the respondent was not commonly known by the domain names. The respondent refuted these arguments by stating that the domain names corresponded to the name of the company that he registered on the very same day that he acquired the domain names. Moreover, the respondent underlined that the first four letters of his company name represented his and his son’s initials.

Again, in light of its findings under the third limb of the UDRP, the panel did not make a definite statement on the eventual existence of the respondent’s rights or legitimate interests. The panel noted, however, that the respondent’s evidence of pre-complaint preparations seemed to be restricted to registration of the company name and the domain names, and the content of the active web page was limited. Even if the panel observed a slight inconsistency in the respondent’s explanation behind the choice of his company name, the panel decided that it was not possible to ascertain if such explanation was false. Therefore, the panel expressed some hesitation with regard to whether the respondent was making a legitimate non-commercial or fair use of the domain name.

Paragraph 4(a)(ii)

Turning to the third limb of the UDRP, the most significant in this case, the complainant asserted that the respondent had intentionally attempted to attract, for commercial gain, internet users to his website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation or endorsement of the respondent’s website or location or of a product or service on the

respondent's website or location. The respondent rebutted such allegation by stating that he was not trying to target the complainant's trademark.

The panel first noted that it was not convinced that the respondent was targeting the complainant given that the respondent had offered a seemingly plausible explanation as to why he registered the domain names and his company name, which was supported by passport copies showing his and his son's name and a copy of his company registration Agfachelseapartners Limited. Furthermore, the panel stated that the complainant had offered no arguments or documentation as to the respondent's explanation despite having been given the opportunity to do so by way of a panel order. The panel also stated that the UDRP was designed to address specific issues related to cybersquatting and, therefore, more complex disputes requiring eventual discovery and examination of the parties generally fell outside of its scope.

In light of the above, the panel made a finding that the complainant had failed to demonstrate the requirements prescribed by the third limb of the policy and so the panel refused the transfer of the domain names.

Comment

Although UDRP proceedings differ from conventional national courts offering discovery and examination of the parties, complainants should not refrain from conducting due diligence on the registrant's details before filing a complaint. If the underlying registrant details are publicly available, it is useful to consult companies' registries, check whether the registrant has participated in previous proceedings or verify the results associated with the registrant in commonly-known internet search engines. Such actions can help to assess the chances of success in UDRP proceedings and, if they are good, to prepare for an eventual response from the registrant. Moreover, it should be underlined that, if a complainant finds any information on the registrant which could be potentially harmful to the chances of success of the complaint, it is not advisable to ignore it.

However, such research may prove difficult for trademark holders if the registrant's details in the WHOIS are hidden or masked, either because the registrant has subscribed to a privacy protection service or because of the data protection regulations adopted by many countries worldwide. In such cases, it may be helpful to use specialised research services, allowing for the examination of the historical WHOIS records of the domain name, for example.

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TAGS

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