

# UDRP: solid evidence required to establish unregistered trademarks in descriptive terms

International - [Hogan Lovells](#)

- The Evergreen Review Inc, which claimed unregistered/common law trademark rights in EVERGREEN REVIEW, sought the transfer of 'evergreenreview.org'
- The panel found that the complainant had failed to demonstrate long-term, continuous use of a distinctive identifier associated with its goods or services
- The panel would likely find that the respondent prevailed on the third limb, even if the complainant had sufficient evidence of common law trademark rights

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied the transfer of a domain name due to the lack of solid evidence concerning the complainant's purported unregistered trademark rights.

## Background

The complainant was The Evergreen Review Inc, a New York non-profit corporation established in 1997 expressly to "revive and publish" the *Evergreen Review*, a literary magazine originally published from 1957 to 1972 and then re-launched by the complainant as an online review in 1998. The magazine ceased publication in 2013 and was revived under a new publisher and editorial board in March 2017. The complainant did not hold any registered trademarks in EVERGREEN REVIEW but claimed that it had unregistered/common law trademark rights. It also owned the domain name 'evergreenreview.com', which was being used in connection with the online magazine.

The respondent was Charles Mingus III, an individual based in the United States.

The domain name was 'evergreenreview.org', registered on 21 January 2019. It was being used to resolve to a landing page with pay-per-click advertising. The complainant stated that it previously owned the domain name when the online magazine was launched in 1998, but subsequently lost control of it "due to an internal oversight".

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

- 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

### First limb

The complainant contended that the domain name was identical to its unregistered trademark EVERGREEN REVIEW. In order to establish its unregistered trademark rights, the complainant provided the "About" page of its website with a brief history of the review, links to historical screenshots of its website and an article from March 2017 published online in *Daily Beast* under the title "Can the once *avant-garde* and erotic *Evergreen* magazine still excite modern readers?" It further submitted that its unregistered trademark had a long history (ie, the magazine was originally published 63 years ago) and had been known "both for its commitment to free expression as well as its devotion to an international array of authors and visual work". The respondent disputed that the complainant held any relevant trademark rights, since the domain name was comprised of two English dictionary words in common use that were not exclusively associated with the complainant.

In the absence of any registered trademark rights held by the complainant, it was important for the panel to assess whether the complainant could adequately establish that the string 'evergreen review' was protected as an unregistered, common law mark under the UDRP. The panel therefore referred to the [WIPO Overview 3.0](#), Section 1.3:

*To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services.*

Relevant evidence demonstrating such acquired distinctiveness may include factors reflecting:

- the duration and nature of use of the mark;
- the amount of sales under the mark;
- the nature and extent of advertising using the mark;
- the degree of actual public recognition; and
- consumer surveys.

On this basis, the panel pointed out that the reputation of the former *Evergreen Review* magazine, published between 1957 and 1972, was not material as it was simply a print magazine by a different publisher. Furthermore, this magazine did not exist for the next 25 years and was only launched online in 1998 by the complainant. The panel also noted that this online publication ceased in 2013 and was then relaunched under the same name in 2017 (ie, less than two years prior to the registration of the domain name.) Given the non-continuous use of the unregistered mark EVERGREEN REVIEW and, particularly, the complainant's failure to provide any concrete evidence on the circulation of this magazine (eg, its subscriber base) and its extent of recognition (apart from a single online article published in 2017), the panel found that the complainant had failed to demonstrate long-term, continuous use of a distinctive identifier associated with its goods or services. Unregistered trademark rights were therefore not established for the purpose of the first limb and so this meant that the complaint must fail.

For the benefit of the parties, the panel continued to briefly discuss the arguments under the second and third limbs.

### ***Second limb***

The respondent claimed that, as an inventor and artist, he intended non-commercial use of the domain name through a non-profit website reviewing developments in 'evergreen' or sustainable technologies. However, he was unable to put in place this plan due to the pandemic shut down this year. He also cited a US patent awarded to him in 2016 and other unpublished works to demonstrate his background in evergreen technologies.

Despite the respondent's assertions above, the panel considered that he had not yet made any such use of the website and allowed the domain name to be used in the interim for unrelated commercial advertising, which would not constitute legitimate non-commercial or fair use in this context. The second limb was therefore satisfied.

### ***Third limb***

Regarding the third limb, the complainant contended that the respondent must have prior knowledge of its unregistered mark since it was in fact the magazine's former publisher who urged the respondent to acquire the domain name so as to interfere with the complainant's business operations. The respondent denied that the former publisher or anyone else "urged" him to register the domain name and provided an email sent from the said publisher in October 2020, in which she seemingly stated that the domain name was previously owned by her late husband rather than by the complainant, and that she had responded to pressure by agreeing to inquire about the transfer of the domain name.

In the panel's opinion, although it was unclear whether the respondent had conspired with the former publisher, the respondent's denial of his prior knowledge of the complainant seemed plausible since the complainant only operated a non-profit literary review of unknown circulation and with limited public recognition, and it seemed unlikely that the respondent would be motivated to target the complainant to obtain financial gain by creating confusion. In any event, as the burden of proof under the third limb rested with the complainant, the panel stated that it would likely find that the respondent had prevailed, even if the complainant had sufficient evidence of common law trademark rights.

### **Comment**

Under the UDRP, holding a registered trademark is considered a prerequisite for satisfying the requirements of the first limb. For complainants who do not have a registered trademark, it is possible to rely on unregistered or common law trademark rights, as long as there is solid and specific evidence demonstrating that the term has given rise to distinctiveness/secondary meaning associated with the complainant. If the asserted unregistered trademark consists solely of descriptive terms which are not inherently distinctive, such as 'evergreen review' in the present case, there is a greater onus on complainants to present concrete and convincing evidence of acquired distinctiveness/secondary meaning rather than conclusory allegations.

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