



26 Mar 2021 Bad-faith registration claim defeated by UDRP panel's research

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- SHL Medical AG, the owner of the SHL TECHNOLOGIES mark, sought the transfer of 'shl-technologies.com'
- The panel concluded that the respondent started controlling the domain name before the registration of the mark and had continuously controlled it since
- The fact that the respondent had re-registered the domain name did not, in itself, mean that he sought to take advantage of the complainant's mark

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to transfer the domain name 'shl-technologies.com', finding that the complainant had failed to prove that the domain name had been registered and used in bad faith.

Background

The complainant was SHL Medical AG, a Swiss provider of drug delivery devices and systems and a contract manufacturer of complex medical and industrial products. The complainant used the name SHL Technologies in connection with some of its services. In 2010 the complainant registered EU and Chinese trademarks for SHL TECHNOLOGIES. In addition, the complainant owned the domain names 'shl-tech.com', 'shltech.com' and 'shltechnologies.com', which redirect to its website at 'shl-medical.com'.

The respondent was an individual based in Hong Kong who registered the domain name 'shl-technologies.com', which, at the time of the UDRP proceedings, resolved to a parked page mentioning "this domain name is reserved for one of our clients". From WHOIS records, it appeared that the domain name was registered on 1 September 2017. However, in correspondence between the parties prior to the UDRP proceedings, the respondent declared that he had registered the domain name 15 years earlier for a company named SHL Technologies and that he would be willing to sell the domain name for €42,500. The complainant made a counter-offer of €1,000, which was rejected by the respondent.

On 28 September 2020 the complainant initiated proceedings under the UDRP for a transfer of ownership of the domain name. The respondent did not reply.

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

Paragraph 4(a)(i)

The complainant argued that the domain name was identical to its trademark SHL TECHNOLOGIES, as it fully and solely consisted of such trademark. The panel held that, due to the fact the domain name consisted of the SHL TECHNOLOGIES trademark, it was almost identical to the mark and, therefore, the complainant had satisfied the requirements of the first element.

Paragraph 4(a)(ii)

The complainant claimed that the respondent had no rights or legitimate interests in the domain name as, based on searches by the complainant, there was no proof that the respondent had an active company named SHL Technologies, used the trade name SHL Technologies or owned a trademark registration for SHL TECHNOLOGIES. The complainant considered that the respondent was passively holding the domain name, that he had not made use of it and had no basis for charging €42,500 for the transfer.

The panel did not judge it necessary to address the question of the respondent's rights and legitimate interests because it concluded that the complaint failed on the third element.

Paragraph 4(a)(iii)

The complainant contended that the respondent had registered and used the domain name in bad faith because:

- he had registered it after his bankrupt company was dissolved;
- he had not been using the domain name;
- he had no company named SHL Technologies; and
- he had renewed the registration of the domain name because he was aware of the complainant and he wished to sell it to the complainant for profit.

In order to rule on the third element, and in the absence of conclusive evidence, the panel sought to determine:

- the actual date of registration of the domain name; and
- whether the respondent had exercised continuous control over the domain name over the 15-year period preceding the complaint.

With respect to the registration date, the panel noted that the then current WHOIS record indicated that the domain name was registered on 1 September 2017. The panel also noted that, in the correspondence between the parties, the respondent claimed to have registered the domain name for the last 15 years and to have had registered it for his company SHL Technologies. The panel also noted that the respondent had sent an undated brochure to the complainant including information about the company, its history, products and services and entries that suggested the brochure was created after 2012. The brochure also made references to a website at the domain name and at 'shl-consultancy.com'. The company was apparently dissolved in December 2016. The panel concluded that the evidence tended to suggest that the respondent might have owned the domain name before the first registration of the SHL TECHNOLOGIES trademark.

With respect to the question of continuous control over the domain name, the panel considered that, although the complainant had not brought such evidence, the panel had general powers and discretion, pursuant to Paragraphs 10 and 12 of the UDRP Rules and for the benefit of the parties, to review the archival website page for the domain name through the Internet Archive and archival WHOIS records.

The search confirmed that the domain name was in use with an active website for a company named SHL Technologies Group that was related to SHL Consultancy, operated in China and that designed and supplied custom-made moulded products from, at least, as early as October 2009 to March 2016. The search also revealed that SHL Consultancy & Trading BV was the registrant organisation and that the registrant name was very similar to that of the respondent. It appeared to the panel that the domain name may have expired in August 2017 and that it had been re-registered under the respondent's name and SHL Technologies on 1 September 2017. The panel concluded that there was indeed a company named SHL Consultancy & Trading BV that operated a website at the domain name using the name SHL Technologies Group before the complainant acquired trademark rights in SHL TECHNOLOGIES. The panel concluded that the respondent started controlling the domain name before the registration of the complainant's trademark and that he had continuously controlled it since.

As regards the complainant's claim that the respondent had re-registered the domain name because he was aware of the complainant and in order to sell it to the complainant for profit, the panel held that the complainant had failed to provide evidence that the respondent had specifically targeted it, as opposed to merely registering a domain name that he had owned and used for many years and that had likely been re-registered after it had expired. The panel pointed out that the €42,500 request was made after the complainant had contacted the respondent for transfer of the domain name, and added that the fact that the respondent had re-registered a domain name that he was associated with for at least eight years, less than a month after expiry, did not, in itself, mean that the respondent had registered it to take advantage of the complainant's rights in its trademark.

As a consequence, the panel found that the claim had failed on the third element and the complaint was denied.

Comment

This case shows that, where evidence is publicly available, it is in the interests of the party seeking transfer of the domain name to thoroughly explore it to identify any elements that could substantiate or invalidate the party's assertions, as the panel is authorised to perform such searches and may do so to assist in deciding the case. As explained in the [WIPO Overview 3.0](#) at Section 4.8, a panel may undertake limited factual research into matters of public record if it would consider such information useful to assess the case merits and reach a decision.

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TAGS

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