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No transfer and a finding of RDNH - a fitting end for Cro-Mag's "Age of Quarrel"?

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- The case involved hardcore punk music group Cro-Mags and the domain name 'cro-mags.com'
- The panel found that the complainant's failure to refer to a trademark registration and transfer was perplexing at best
- The complainant's theory according to which bad-faith intent could be imputed retroactively was far-fetched, unsubstantiated and unsuitable

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to transfer the domain name 'cro-mags.com', finding that the complainant had failed to prove that the respondent had no rights or legitimate interests and had registered and used the domain name in bad faith, and entering a finding of reverse domain name hijacking (RDNH).

Background

The complainant was Savoia NYC Incorporated, a company offering and selling goods in relation to a hardcore punk music group called Cro-Mags from New York City. The group was formed in the early 1980s and released a number of albums, including their now legendary debut, "Age of Quarrel", in 1986, and "Revenge" in 2000. Harley Flanagan, an individual associated with the complainant, was a founding member (vocals and bass), as was the respondent, Parris Mayhew (guitar). However, the band had a rather tumultuous history, undergoing various line-ups over the years, and the respondent eventually left to pursue other interests.

The complainant owned several trademarks for CRO-MAGS, including one which was registered in 2010 and subsequently assigned to the complainant by Harley Flanagan. Another CRO-MAGS trademark was also registered in 1993 by Harley Flanagan and was later assigned to a corporate entity jointly owned by Harley Flanagan and the respondent. This trademark registration, which lapsed due to lack of renewal, was not referenced by the complainant but was brought forward by the respondent in his response.

The respondent registered the domain name in February 1999. At the time of the proceedings, the domain name resolved to a website posting photographs of the Cro-Mags band, both before and after their falling out, with a description of their history, arguably not portraying Harley Flanagan in a favourable light.

The complainant initiated proceedings under the UDRP for a transfer of ownership of the domain name. The respondent submitted a response requesting the panel to enter a finding of RDNH.

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 panel found that the complainant had established rights in the CRO-MAGS trademark, and that the domain name incorporated the complainant's registered mark in its entirety.

Paragraph 4(a)(ii)

The complainant claimed that the respondent had no rights or legitimate interests in the domain name because:

- he had never been known by the domain name; and
- the domain name was identical to the complainant's trademark.

The panel held that the complainant had established a *prima facie* case against the respondent; however, it found the evidence brought forward by the respondent compelling enough to rebut this case.

The panel found that the respondent was an active member of Cro-Mags at the time of the domain name registration and that he had registered the domain name with the knowledge and consent of Harley Flanagan. Harley Flanagan's actual knowledge was demonstrated by his assignment of a CRO-MAGS trademark to a corporate entity partly-owned by the respondent approximately one year after the domain name registration and by the fact that the domain name prominently appeared on the cover of "Revenge" identifying it as their official website. As such, the complainant had not satisfied the second element of Paragraph 4(a) of the UDRP.

Paragraph 4(a)(iii)

The complainant claimed that the respondent had registered and used the domain name in bad faith because, among other things:

- he sought to profit from and exploit the complainant's CRO-MAGS trademark by misdirecting users to his website; and
- although the respondent might have had no bad-faith intention when registering the domain name, "bad-faith adoption" could be applied retroactively, especially where the respondent sought to trade on the goodwill of the complainant's trademark.

The panel rejected these arguments, finding there was no evidence showing the respondent acted intentionally to create a likelihood of confusion as to the source or sponsorship of the domain name. The panel emphasised once again that the domain name appeared on the cover of one of the band's albums and that Harley Flanagan ratified this course of conduct by transferring a CRO-MAGS trademark to a corporate entity jointly-owned by the respondent a year after the domain name registration. Regarding this trademark registration, the panel further underlined that the complainant's failure to make any reference to it was perplexing at best. Finally, the panel ruled that the complainant's theory according to which bad-faith intent could be imputed retroactively was far-fetched, unsubstantiated and unsuitable in these circumstances. As such, the complainant had not satisfied the third element of Paragraph 4(a) of the UDRP and the complaint was denied.

RDNH

The panel concluded by entering a finding of RDNH, citing both the complainant's failure to provide material evidence relevant to the complaint, as well as the fact that the complainant relied on a legal theory unsupported by UDRP precedent. According to the panel, the complainant and its counsel knew, or ought to have known, that the complaint could not have succeeded if the respondent filed a response.

Comment

This decision shows that complainants must disclose all known information about their trademark rights to the panel and conduct a thorough investigation in relation to prior dealings with a respondent. In this case, the panel seemed to interpret the failure of the complainant to make reference to a trademark identical to the domain name and once held by an entity linked to the respondent as a deliberate omission. This omission was instrumental in the panel entering a finding of RDNH. Moreover, this decision serves as a useful reminder that prior UDRP decisions cited in complaints must be relevant to the case at hand and that jurisprudentially far-fetched legal theories are best avoided.

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