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Trademark owner is no superhero under the UDRP

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- The owner of numerous SHAKTIMAN marks around the world sought the transfer of 'shaktiman.com' under the UDRP
- The panel found it unlikely that the respondent registered the domain name because of the existence of the complainant's trademark
- The complaint should never have been brought because, even in the absence of a response, it would likely have failed

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, the panel has refused to order the transfer of a domain name: it found that the complainant had failed to show any evidence of bad faith and had therefore engaged in reverse domain name hijacking (RDNH).

Background

The complainant was Tirth Agro Technology Private Limited, an India-based company operating a business related to agricultural machines. It held numerous trademarks for SHAKTIMAN around the world, including in India, Israel, the United States and the European Union. According to the complainant, the trademarks were internationally used since 1961 and had therefore acquired trans-border reputation, goodwill and fame.

The respondent was Anuj Bhargava from Anroh Global Services Pvt Ltd, an individual based in India. No further information was provided.

The disputed domain name, 'shaktiman.com', was registered on 13 January 2000 and was not resolving.

The complainant initiated proceedings under the UDRP for a transfer of ownership of the domain name. 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)

Under the first requirement, the panel recognised that the disputed domain name was identical to the complainant's SHAKTIMAN trademarks. Therefore, without having to consider the timeline of the trademark applications, the panel found that the complainant satisfied Paragraph 4(a)(i) of the UDRP.

Paragraphs 4(a)(ii) and (iii)

The panel held that the second requirement of the UDRP did not need to be addressed in light of the third requirement, whereby the panel concluded that the respondent had not registered and used the disputed domain name in bad faith.

First, for bad faith to be established, the complainant needed to demonstrate that the respondent should have been aware of the complainant's trademarks at the time the disputed domain name was registered. Therefore, timing was key: evidence of the fame of the trademarks must predate the registration of the domain name. In this regard, the panel held that the evidence put forward by the complainant was insufficient.

The complainant evidenced proof of use of its trademarks only after the registration of the disputed domain name, not before. In addition, the only trademark dated before the registration date was in the name of another company, without any explanation as to how this company was related to the complainant. Similarly, the complainant did not explain why the alleged date of first use of 30 June 1999 on the complainant's trademark certificates was nearly one year before its incorporation on 26 July 2000. Taking into account all the evidence submitted by both parties, the panel found that it did not support a finding that the respondent ought to have known of the complainant's trademark when the domain name was registered. It was therefore reasonable to infer that it was unlikely that the respondent registered the disputed domain name because of the existence of the complainant's trademark.

The panel noted that the term '*Shaktiman*' was a generic word in the Hindi language, used in numerous fields, in particular in a popular Hindi television show featuring a superhero under the name of Shaktiman. When it comes to dictionary words, widely used as trademarks, it is important for complainants to show, by direct evidence, that their trademarks are being targeted. In this case, the complainant had not done this.

Finally, the panel noted that the complaint was brought 21 years after the disputed domain name was registered, without any explanation about the substantial delay in filing. While such delay was not sufficient, *per se*, to deny the complaint, the panel found that it did not help the complainant's case when combined with the additional factors discussed above. In the panel's opinion, this appeared to be a case where the respondent had registered the domain name in the early phase of the Internet and the trademark owner filed the complaint many years after. The complaint was therefore denied.

RDNH

Given the above, the panel also made a finding of RDNH, which is defined in the UDRP Rules as "using the policy in bad faith to attempt to deprive a registered domain name holder of a domain name". The panel held that the absence of evidence of any targeting precluded a finding of bad-faith registration under any reasonable interpretation of the UDRP. Hence, the panel concluded that the complaint should never have been brought because, even in the absence of a response, it would likely have failed.

Comment

This decision shows that trademark owners have no superpowers when it comes to the UDRP. The policy was intended to protect trademark owners in clear-cut cases of cybersquatting - in other words, domain name registrations made with the intention of profiting from the goodwill and reputation of a brand owner. The UDRP does not give each and every trademark owner carte blanche to ask for the transfer of a domain name incorporating its trademark.

Complainants should therefore think seriously about filing a complaint under the UDRP without strong evidence of bad faith. They should also be very thorough when compiling their evidence to make sure that their narrative fits the requirements of the policy.

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