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Reboxed 'plan-B' UDRP complaint fails to deliver

International - [Hogan Lovells](#)

- Reboxed Limited, the owner of UK and EU trademarks for REBOXED, sought the transfer of 'reboxed.com' under the UDRP
- The panel found that it was impossible for the respondent to have been aware of the complainant's trademark at the date of registration of the domain name
- The panel concluded that the case constituted a 'plan B' complaint and entered a finding of RDNH

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a three-member UDRP panel has denied a complaint for the domain name 'reboxed.com', entering a finding of reverse domain name hijacking (RDNH).

Background

The complainant, Reboxed Limited, was a company incorporated in England and Wales in 2019, engaged in the purchase and sale of used mobile phones. The complainant had registered trademarks for REBOXED in the United Kingdom and the European Union, the earliest of which was applied for on 31 July 2019, and registered on 22 May 2020.

The disputed domain name was first registered on 9 November 2010. The respondent claimed that his wife had acquired the domain name in December 2012, and that the Whois information for the domain name was updated on 7 November 2014 to reflect the respondent's name. Between May and November 2019, individuals who would go on to form the complainant company attempted to negotiate the purchase of the domain name. Those negotiations ultimately proved unsuccessful. In August 2020 the domain name resolved to a website including the wording "Reboxed is a consumer marketplace to Sell, Swap and Shop Used, Refurbished and PreOwned Consumer Items".

The complainant asserted that the domain name was identical to its REBOXED trademark. It submitted that the respondent had no rights or legitimate interests in the disputed domain name. The complainant argued that the respondent had sought to create confusion between the domain name and the complainant's trademark for its own commercial purposes. It asserted that the domain name was registered and was being used in bad faith. In this regard, it argued that the respondent had registered the domain name for the purpose of selling it to the owner of a trademark associated with the domain name, at a profit, as evidenced by the respondent's asking price of £29,150 during the parties' negotiations in 2019. The complainant further asserted that the respondent's inclusion of the statement "Reboxed is a consumer marketplace to Sell, Swap and Shop Used, Refurbished and PreOwned Consumer Items" on the website to which the domain name resolved served as further evidence of the respondent's intention to attract internet users to its website by causing confusion with the complainant's trademark.

The respondent accepted that the domain name was identical to the complainant's trademark. It submitted that he had rights or legitimate interests in the domain name by virtue of the fact that the domain name corresponded to a dictionary term. The respondent denied having registered the domain name in bad faith, noting that it was acquired by the respondent's wife in 2012, several years before the formation of the complainant. The respondent submitted that the complainant had relied on a misguided interpretation of Paragraph 4(b)(i) of the UDRP, noting that bad-faith registration involves an intention to sell a domain name specifically to the complainant, or a competitor of the complainant. The respondent referred to the failed negotiations for the sale and purchase of the domain name, and asserted that the complaint was brought in bad faith as a so-called 'plan B' complaint.

To be successful under the UDRP, a complainant must satisfy the requirements of Paragraph 4(a):

- 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 domain name was identical to the complainant's REBOXED trademark.

Paragraph 4(a)(ii)

Given that the complaint would go on to fail under the third element, the panel did not consider it necessary to enter a finding on the question of rights or legitimate interests.

Paragraph 4(a)(iii)

The panel noted that the domain name was acquired personally by the respondent no later than November 2014, whereas the complainant company was not formed until July 2019. The panel accepted the respondent's submission that it was impossible for the respondent to have been aware of the complainant's trademark at the date of registration of the domain name. The panel went on to expressly reject the complainant's interpretation of Paragraph 4(b)(i) of the UDRP, which required an intention to sell the domain name to a current trademark owner, and not to an unknown and as yet non-existent party who may in the future have acquired an interest in a relevant trademark. The panel found that the complainant had failed to establish that the disputed domain name was registered in bad faith.

RDNH

In entering a finding of RDNH, the panel found that the complainant, who was legally represented, knew or ought to have known that the complaint had no reasonable prospect of success. While the panel accepted that the inclusion of the statement "Reboxed is a consumer marketplace to Sell, Swap and Shop Used, Refurbished and PreOwned Consumer Items" on the website at the domain name may have been interpreted as provocative, it ought to have nevertheless been clear to the complainant that it could not prove bad-faith registration under a plain reading of the UDRP. The panel agreed that the case constituted what is known as a 'plan B' complaint, where the complainant had misused the UDRP in an attempt to wrest the domain name from the respondent, after it had failed in negotiations to purchase it.

Comment

The case highlights the importance of a plain reading of the UDRP. It is a well-established principle from prior UDRP cases and in jurisprudential summaries that the mere registration of a domain name and offering it for sale does not in itself amount to bad faith. Complainants seeking to rely on Paragraph 4(b)(i) of the UDRP are required to assess whether the trademark relied upon to establish bad faith was in existence at the time that the disputed domain name was registered. Failure to do so risks consciously or unconsciously reading "retroactive bad faith" into the UDRP - an interpretation of the UDRP that has been categorically rejected in decisions over the last 10 years. In addition, where a complainant's case is weak from the outset, resort to the UDRP subsequent to a failed attempt to purchase a domain name may well result in a finding of RDNH.

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TAGS

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