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## Not everyone on the Internet uses aliases

International - [Hogan Lovells](#)

- Borum A/S sought the transfer of 'borum.com' under the UDRP; the registrant was Thomas A Borum, DVM
- The panel found that it was perfectly feasible that the respondent registered the domain name for the purposes of a website in his own name relating to his business
- The complaint was entirely devoid of evidence supporting the complainant's assertion regarding use of the domain name in bad faith

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the World Intellectual Property Organisation (WIPO), a panel has refused to order the transfer of a domain name that exactly matched a complainant's trademark because the complainant failed to prove that the respondent had no rights or legitimate interests in the disputed domain name, and registered and used it in bad faith.

### Background

The complainant was Borum A/S, a Danish company that supplied machinery, tools, software, and vehicles for line markings and roads, as well as other related products. The respondent was Thomas A Borum, DVM, an individual based in the United States, who did not submit a response.

The disputed domain name 'borum.com' was originally created in 1998 and the underlying registrant information was updated in December 2017. The exact date when the respondent acquired the domain name was not certain. It was not resolving to an active website.

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)*

The complainant contended that the domain name was identical to the BORUM mark, in which it owned rights in the European Union since May 2019 and in the United States since August 2020. The panel stated that the complainant had established that it had rights in the term 'borum' by virtue of its trademark registrations and found that the domain name was indeed identical to complainant's mark. As a consequence, the panel concluded that the complainant had satisfied the first limb.

#### *Paragraph 4(a)(ii)*

The complainant pointed out that the respondent was not associated with the complainant or authorised to use the complainant's mark. The complainant also asserted that the domain name was inactive and so there was no evidence that the respondent used it in connection with a *bona fide* offering of goods and/or services. Moreover, the complainant also submitted that it was unable to find any registered rights in the term 'borum' or similar that were owned by the respondent. Finally, according to the complainant, the respondent's name in the WHOIS record may in fact have been an alias used to match the domain name.

The panel disagreed with the complainant and noted that it was perfectly feasible that the respondent, "Thomas Borum DVM" registered the domain name for the purposes of a website in his own name relating to his business as a veterinarian, as suggested by the abbreviation 'DMV' standing for 'doctor of veterinary medicine'. The panel underlined that the respondent had registered the domain name at least 17 months before the earliest of the registered trademark rights relied upon by the complainant, and possibly much earlier than that. In addition, the panel noted that the parties were based in different countries. As such, the panel concluded that there was no evidence that the respondent acted with a view to trading off any goodwill or reputation attaching to the complainant's rights. Therefore, the panel found that the complainant had failed to demonstrate that the respondent lacked rights or legitimate interests in the disputed domain name.

#### *Paragraph 4(a)(iii)*

Given its findings under the second requirement of the UDRP, it was not necessary for the panel to assess the complainant's arguments under the third limb of the policy, but the panel proceeded for the sake of completeness.

Turning to the third requirement, the complainant asserted that it was for the respondent to prove that he had owned the disputed domain name since its creation in 1998, as opposed to since 2017 when the WHOIS record was updated. The complainant also added that, in any case, the establishment of its company in 1996 predated the initial registration of the domain name in 1998. Moreover, the complainant argued that the respondent should have known about the complainant due to its international presence and number of international trademark registrations. Finally, the complainant submitted that the non-use of the domain name would not have prevented a finding of bad faith.

The panel considered that the complainant's arguments were not sufficient to demonstrate the respondent's bad faith. First of all, the panel found that the registration date of the domain name by the respondent was not clear. However, even if the respondent had acquired the domain name in 2017, as asserted by the complainant, this would still predate the complainant's earliest registered trademark rights. Furthermore, in the panel's view, the complainant had not offered any evidence that the respondent would necessarily have been aware of the complainant's business, whether in 1996 or 2017. In addition, the panel found that the complaint was entirely devoid of evidence supporting the complainant's assertion regarding use of the domain name in bad faith. The panel noted that passive holding was considered to be in bad faith only in certain limited circumstances, and these were absent in the present proceedings.

Finally, the panel observed that the most obvious and credible explanation for the respondent's registration of the domain name was for his own business purposes in connection with his professional occupation. Accordingly, the panel found that the respondent had not registered and used the disputed domain name in bad faith and so the complainant had not satisfied the third requirement under the UDRP. Therefore, the panel denied the transfer of the domain name to the complainant.

## Comment

This decision highlights once again how having a trademark does not necessarily mean that a rights holder will succeed in obtaining transfer of a domain name, even if it is identical to such trademark and even if the respondent does not reply to the complaint. In cases where a respondent also has a legitimate interest, the rule of 'first come, first served' generally applies. Such legitimate interest may be constituted by the proximity between the respondent's name and the disputed domain name (see Paragraph 4(c)(ii) of the UDRP). It is therefore recommended that potential complainants conduct at least basic due diligence before deciding to file a complaint under the UDRP, if the name of the registrant may be ascertained (in many cases the underlying details are now redacted in the WHOIS as a result of data protection regulations).

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## TAGS

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