



27 Sep 2021 UDRP: legitimate interests in a domain name consisting of an acronym

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- The owner of the mark TM (standing for 'transcendental meditation'), which operates a website at www.tm.org, sought the transfer of the domain name 'wwtm.org'
- The panel found that the domain name was genuinely used in connection with the respondent's business under the name of Working With The Mind
- It did not accept that the domain name was registered and used for typosquatting purposes

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied the transfer of a domain name that could potentially have been a typosquat of the complainant's long-standing trademark, but was in fact an acronym of the respondent's company name.

Background

The complainant was Maharishi Foundation USA Inc, based in the United States, which had been engaged in providing and promoting courses and seminars on personal development since 1966. It had continuously used its US trademark in the term 'TM', standing for 'transcendental meditation', registered in 1975 in connection with its educational services, and operated a website at www.tm.org for the purpose of its business.

The respondent was Matthew Ward, an individual based in the United Kingdom, who was the founder and director of a social enterprise entitled Working With The Mind, abbreviated to 'WWTM', which was aimed at providing mindfulness practices and approaches to support local communities.

The domain name 'wwtm.org' was registered by the respondent in May 2020. It pointed to the respondent's website promoting his social enterprise and soliciting donations.

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 'wwtm.org' was nothing but a typosquatted version of its web address 'www.tm.org' (the final 'w' and the full stop were omitted). The respondent countered that the domain name was merely an acronym of 'Working With The Mind' without incorporating the complainant's TM trademark, and that the proper comparison in this case should be between 'www.tm.org' and 'www.wwtm.org'.

According to the panel, since the complainant had established its trademark rights in the term 'TM', the fact that the domain name incorporated this term made it confusingly similar to the complainant's trademark under the UDRP. This finding was not surprising to the extent that the first requirement functions primarily as a standing requirement and the threshold is therefore relatively low.

Paragraph 4(a)(ii)

The complainant claimed that its TM trademark had acquired reputation and goodwill worldwide as a result of more than 50 years of using, advertising and promoting courses and seminars on personal development. Therefore, the respondent's use of the domain name to promote competing educational services related to "mindfulness" meditation could not constitute *bona fide* use as the respondent was clearly attempting to attract consumers to his website by trading on the fame of the complainant's TM trademark. The respondent insisted that he had a legitimate interest in using the domain name as it was merely an acronym for 'Working With The Mind', and underlined that he had no intent to use the complainant's trademark as he was not providing similar services.

The panel considered that the complainant's contentions could establish a *prima facie* case against the respondent, without taking into account the arguments and evidence put forward by him. However, after having assessed the evidence provided by the respondent, notably with regard to the actual operations of his social enterprise, the panel found that the domain name was genuinely used in connection with the respondent's business under the name of Working With The Mind, and that there was nothing to indicate that the respondent registered or used the domain name with the complainant in mind or to take unfair advantage of the reputation attached to its TM trademark. The panel therefore held that the respondent had a *bona fide* offering of services. The second limb was therefore not satisfied and the complaint was denied.

Paragraph 4(a)(iii)

For the sake of completeness, the panel continued to examine the third requirement under the UDRP. As far as the third limb was concerned, the complainant argued that the respondent's registration and use of the domain name was simply a case of typosquatting and was intended to derive revenue from internet users who inadvertently omitted the final 'w' and the full stop when typing the complainant's own web address 'www.tm.org'. The respondent claimed that he was unaware of the complainant and its TM trademark at the time of registration of the domain name since there was no trademark for WWTM registered in the United Kingdom, where he was based. He therefore did not select the domain name to target the complainant.

The panel agreed that no evidence suggested that the respondent registered the domain name with prior knowledge of the complainant or its TM trademark. The complainant was based in the United States and did not provide any evidence relating to its reputation in the United Kingdom. Furthermore, the complainant's TM trademark only consisted of two letters and it was highly unlikely that the respondent incorporated these two letters in the domain name with reference to "transcendental meditation". Finally, the legal name of the respondent's social enterprise, Working With The Mind, based on which the domain name was composed, appeared to be a believable and appropriate name given the nature of the respondent's activities (ie, using UK-accredited mindfulness practices and approaches to help local people find a way to work with their minds) and was not asserted by the complainant to be a ruse or sham. In this context, the panel did not accept that the domain name was registered and used for typosquatting purposes. Therefore, the third requirement was not satisfied.

RDNH

At the respondent's request, the panel also assessed whether the complaint was brought in an attempt at reverse domain name hijacking (RDNH), defined under the [Rules for Uniform Domain Name Dispute Resolution Policy](#) as "using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name". In this sense, the respondent argued that the complaint only focused on the complainant's rights and did not consider his actual conduct to the extent that the allegations in the complaint were made without proof. Based on the evidence presented in the complaint, the panel could not conclude that the respondent chose the domain name to target the complainant. The complainant had no reasonable basis to assert in the complaint that nothing on the respondent's website suggested a reason to adopt the WWTM name. The panel therefore found that the complainant was guilty of RDNH.

Comment

This decision constitutes a good example of how a respondent can establish its rights or legitimate interests in a domain name consisting of an acronym. As highlighted in Section 2.10.2 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions \(WIPO Overview 3.0\)](#), in this scenario, a respondent's evidence supporting its explanation for its registration or any use of the domain name should indicate "a credible and legitimate intent which does not capitalise on the reputation and goodwill inherent in the complainant's mark". In the event that such evidence is sufficiently and credibly submitted, mere assertions that the disputed domain name looks confusingly similar to the trademark in question and that the complainant is somehow well known are not sufficient to support a finding of targeting, which constitutes the basis of a respondent's bad faith under the UDRP.

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