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'First come, first served' is key under the UDRP

International - [Hogan Lovells](#)

- The owner of several ROCHAS trademarks sought the transfer of 'gruporochas.com' under the UDRP
- The respondent provided evidence that its sole administrator bore the name Rochas
- However, this could not have been known by the complainant as it did not appear in the public WHOIS and the domain name had never been used

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

Background

The complainant was Interparfums SA France, a French company. It operated in the field of fashion and perfume, and owned several trademark registrations for ROCHAS, including the following:

- French trademark registration No 1436306 for ROCHAS, registered on 20 November 1987;
- US trademark registration No 75551139 for ROCHAS, registered on 29 August 2000; and
- international trademark registration No 697119 for ROCHAS, registered on 28 July 1998 and designating a number of countries including Spain.

The complainant also owned several domain names reflecting or including the trademark ROCHAS, including 'rochas.com'.

The respondent was Walking Styles, a Spanish corporation.

The disputed domain name, 'gruporochas.com', was registered in December 2006 and redirected to a website consisting of an index default page.

To be successful in a complaint under the UDRP, a complainant must satisfy the three elements set forth under 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 purpose of the first element is to determine whether the complainant has a *bona fide* basis for filing the complaint. In the present case, the panel found that the complainant had trademark rights in the name ROCHAS both by registration and acquired reputation, and that the disputed domain name was confusingly similar to it.

The panel noted that it is well established that the addition of descriptive terms or letters, such as '*grupo*' in this case (meaning 'group' in Spanish), to a domain name does not prevent a finding of confusing similarity between the trademark and the disputed domain name. Moreover, the generic top-level domain, here '.com', may be ignored for the purpose of assessing the question of confusing similarity.

Paragraph 4(a)(ii)

Under the second element, the panel noted that, while the complainant has the burden of proving the three elements of the UDRP, this burden can be quite difficult to meet when what must be proven is a lack of rights or legitimate interests in the disputed domain name, in other words a negative circumstance.

There are several ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, examples of which are set forth in Paragraph 4(c) of the UDRP:

- the respondent using, or making demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services before being put on notice of the dispute;
- the respondent having been commonly known by the domain name, even without having acquired any trademark rights; or
- the respondent making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In general, a complainant is required to make a *prima facie* case and the respondent must then demonstrate otherwise. In this case, however, while the complainant asserted that the respondent had no rights or legitimate interests in respect of the disputed domain name since it had not been authorised by the complainant to register the domain name nor to use its trademark within the domain name, the respondent provided evidence that its sole administrator bore the name Rochas. According to the panel, this sufficiently corresponded to the domain name and so it found that the complainant had failed to meet its burden under the second element of the UDRP.

Paragraph 4(a)(iii)

Given this, there was no need for the panel to go on to consider the third element of the UDRP as the three elements are cumulative. The panel nevertheless found that no bad faith could be established because the disputed domain name corresponded to the surname of the respondent's sole administrator, and the complaint was therefore denied.

Reverse domain name hijacking

Finally, the panel also denied the respondent's request to find that the complainant was guilty of reverse domain name hijacking (ie using the UDRP in bad faith to attempt to deprive a registrant of a domain name). The panel declined to find that the complainant had acted in bad faith in bringing the complaint since it did not know, or could not have known, that it would not succeed on the second and third elements of the UDRP. In this case, the surname of the respondent's sole administrator was identical to the complainant's trademark ROCHAS, but this could not have been known by the complainant as it did not appear in the public WHOIS and the domain name had never been used.

Comment

This decision illustrates that, if several different parties may have rights to a domain name, the principle of 'first come, first served' is paramount. It also underlines what can happen if such rights are not immediately apparent to those with competing rights - that is, the filing of unnecessary complaints under the UDRP. To try and avoid this, registrants can ask their registrar to ensure that their details are available in the public WHOIS (many registrars now mask almost everything by default, even company information, in the belief that this is needed to comply with data protection regulations). In addition, potential complainants should try and find out as much as possible about registrants before filing against them, for example by searching historic WHOIS details, examining the website history and sending cease-and-desist letters (using an anonymous address in the WHOIS or a registrar contact form, for example). It is possible to withdraw a complaint upon disclosure of the underlying WHOIS information, but it is best to try and avoid having to do this as it will result in wasted costs.

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