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A UDRP complaint out of the clear blue sky

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- SkyCell AG sought the transfer of the domain name 'skycell.com' under the UDRP
- The panel stated that it was impossible for the respondent to have acquired the domain name with knowledge of the complainant
- It also decided to make a finding of RDNH

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to order the transfer of the domain name 'skycell.com' because the complainant had failed to demonstrate that the respondent had registered and used the domain name in bad faith.

Background

The complainant was SkyCell AG, a Swiss company providing hybrid containers for the pharmaceutical industry and related services. The respondent was Joubin Safai, an individual based in the United States.

The disputed domain name, 'skycell.com', was registered in 1995 and purchased by the respondent in 2008.

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 submitted that it owned various trademark registrations for the mark SKYCELL, the earliest with a filing date of 2013. The respondent did not dispute this and the panel found that the disputed domain name was identical to the complainant's trademark. The panel also noted that the registration date of the complainant's trademark was not relevant to assess the existence of rights under the first limb of the UDRP. The panel therefore considered that the complainant had satisfied the first requirement.

Paragraph 4(a)(ii)

The complainant pointed out that its SKYCELL trademark was so well known in connection with its products and services that it was inconceivable that the respondent could now make either *bona fide* commercial use or legitimate non-commercial or fair use of the disputed domain name. Furthermore, the complainant argued that the respondent had no relevant trademark rights, had not commonly been known by the disputed domain name and had never used it.

The respondent strongly disagreed with the complainant by asserting that he was a domain name investor who had owned over 500 domain names and had never been accused of cybersquatting in 20 years. The respondent underlined that the disputed domain name was composed of two dictionary terms, 'sky' and 'cell', which he considered to fit well with potential communications and cellular uses. In addition, the respondent provided evidence of his purchase of the domain name in 2008 and also submitted proof of the acquisition of two similarly composed domain names in the same year, 'skyferry.com' and 'skygig.com'. Most importantly, the respondent contended that he was unaware of the complainant when he purchased the disputed domain name in 2008, given that the complainant commenced activity in 2013.

In view of the evidence presented by the respondent, the panel stated that it was indeed impossible for the respondent to have acquired the disputed domain name with knowledge of the complainant. The panel then underlined that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on a respondent. However, a registrant may obtain such rights if it uses or intends to use a domain name comprising dictionary terms in connection with those terms and not to target any third-

party trademark. The panel pointed out that, although the respondent had not been using the disputed domain name at all, he had provided evidence that he acquired it with the intention that it be used in connection with possible communications or cellular uses. Taking all these circumstances into consideration, the panel therefore considered that the complainant had not satisfied the second limb.

Paragraph 4(a)(iii)

The complainant asserted that the disputed domain name had been registered and was being used in bad faith. Moreover, the complainant contended that it was difficult to formulate a claim concerning bad faith given that the identity of the respondent was unclear. The complainant also speculated that it could not be excluded that the domain name had been registered to disrupt the complainant's business or for the purpose of selling it to the complainant or one of its competitors. According to the complainant, the passive holding of the domain name suggested the respondent's bad faith.

In his reply, the respondent reiterated his arguments relative to the second limb of the UDRP and added that he had never used the domain name in any manner that would target the complainant. Finally, the respondent also noted the complainant's admissions that its submissions as to bad faith were speculative.

The panel did not miss the opportunity to comment on the complainant's argument relative to the identity of the respondent. The panel highlighted that, although the complainant had an opportunity to amend its complaint after receipt of the registrar-disclosed respondent details, it merely added the respondent's name. Furthermore, the panel found that the respondent could not have registered the domain name in bad faith given the fact that the complainant did not exist when the domain name was acquired by the respondent. The panel also stated that the complainant had failed to provide evidence of the respondent's bad-faith use of the domain name. 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.

RDNH

Finally, the panel also considered whether a finding of reverse domain name hijacking (RDNH) was appropriate. RDNH is defined in Paragraph 1 of the UDRP Rules as "using the policy in bad faith to attempt to deprive a registered domain name holder of a domain name". In this case, the panel decided to make a finding of RDNH as the complainant had not provided any evidence to demonstrate or even infer that the respondent had registered the domain name with knowledge of the complainant's trademark and in order to target it, rather than owing to any inherent value.

Comment

This decision highlights once again how having a trademark by itself does not necessarily mean that a trademark holder will succeed in obtaining the transfer of a domain name, even if it is identical to such trademark. This is particularly the case when a disputed domain name was registered before a complainant's registration and use of a trademark. The decision also serves as a reminder of how important it is for complainants to avoid presenting speculative arguments.

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