



## Registrant of '.ru' and '.io' domain names denied transfer of identical '.com'

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### INTERNATIONAL

Legal updates: case law analysis and intelligence

- Appfollow.fi Oy sought the transfer of the domain name 'appfollow.com' under the UDRP
- The scale of the complainant's use of the term 'Appfollow' when the domain name was registered was insufficient to reject the respondent's denial of awareness of the complainant's unregistered trademark
- The panel decided not to make a finding of RDNH as the complaint was not necessarily bound to fail

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 at issue because the complainant failed to demonstrate that the respondent had registered and used it in bad faith.

### Background

The complainant was Appfollow.fi Oy, a Finnish company providing a software application review management, analytics and app store optimisation platform. The respondent was Pavel Gross, an individual based in the Russian Federation.

The disputed domain name, 'appfollow.com', was registered in February 2017 and used to point to various websites. Until 2020 it pointed to a registrar parking page or to a page indicating that the domain name was for sale. Starting from January 2020, the domain name resolved to a website promoting the 'App Annie' service (one of the complainant's supposed competitors), as well as to a website containing articles about various applications and topics.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements under Paragraph 4(a):

1. the domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
2. the respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.

## Decision

### ***Identity or confusing similarity***

With regard to the first limb, the complainant submitted that it owned a Finnish trademark registration for the mark APPFOLLOW dating from May 2021. The complainant also claimed rights in this term as an unregistered trademark.

The respondent did not dispute this and the panel found that the disputed domain name was identical to the complainant's trademark. In addition, the panel 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 also found that the complainant had submitted sufficient evidence, consisting of sales revenues and examples of use of the term 'Appfollow', to prove the existence of its unregistered rights. The panel therefore considered that the complainant had satisfied the first requirement under the UDRP.

### ***Rights or legitimate interests***

In light of its findings under the third limb of the UDRP, the panel did not comment on the eventual existence of the respondent's rights or legitimate interests.

### ***Bad faith***

The complainant asserted that the disputed domain name had been registered in 2017 in bad faith. The complainant argued that its business, conducted at first via the matching domain name 'appfollow.ru', had already started in 2014. A year later, the complainant registered and started to use the domain name 'appfollow.io' and created a Twitter account. The complainant also submitted its results associated with Google AdWords between 2016 and 2021 and with its advertising through QuoraAds. In addition, the complainant stated that its website at 'appfollow.io' had over 22 million visitors in the period 2017 to 2021. As a consequence, the complainant stated that it was clearly using the term 'Appfollow' before the respondent registered the disputed domain name and, as such, it was likely that the respondent was aware of the complainant's use of the term 'Appfollow' before registering the domain name in 2017. Furthermore, according to the complainant, the content of the respondent's website was clearly targeting the complainant given the redirection to one of the complainant's competitors in 2020.

The respondent rebutted these arguments by asserting that he had no knowledge of the complainant when registering the domain name. He contended that his aim was to offer a not-for-profit service to provide information about various applications. The respondent also indicated that, upon closer analysis of the complainant's statistics, the complainant's sales revenues, as well as use of the term 'Appfollow' before 2017, were limited to the Russian Federation and were not substantial. Moreover, the respondent argued that the articles and website postings referring to the complainant as 'Appfollow' dating from 2016 appeared to be from fairly specialised publications.

The panel admitted the possibility that the respondent could have been aware of the complainant's unregistered trademark when registering the domain name in 2017. Nevertheless, the panel highlighted the fact that the term '**Appfollow**' was largely descriptive in many contexts. The panel also found that the scale of the complainant's use of this term at the time that the domain name was registered was not sufficient to reject the respondent's denial of awareness of the complainant's unregistered trademark. Accordingly, the panel decided that the respondent had not registered and used the 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 did not decide to make a finding of RDNH as the complaint was not necessarily bound to fail. Indeed, the panel underlined that it was possible that the respondent was aware of the complainant's unregistered trademark when registering the domain name. In addition, the panel noted that the domain name used to redirect to one of the complainant's competitors.

## 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 domain name has descriptive connotations. Similarly, having matching domain names under different extensions will not automatically allow a complainant to claim rights to similar domain names.

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