



## UDRP complaint loses its mojo

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### INTERNATIONAL

Legal updates: case law analysis and intelligence

- The owner of the mark MOJO CLOUD sought the transfer of 'cloud-mojo.com' and 'cloudmojo.tech', among others, under the UDRP
- The panel noted that the respondent had a subsisting registered trademark for CLOUDMOJO TECH in India, and appeared to be using that mark for the services for which it was registered
- Therefore, the complainant had failed to establish that the respondent had no rights or legitimate interests in respect of the domain names

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to transfer the disputed domain names 'cloud-mojo.com', 'cloudmojo.tech', 'cloudmojotech.com' and 'cloudmojotech.website', finding that the complainant had failed to demonstrate that the respondent had no rights or legitimate interests in respect of the domain names.

### Background

The complainant was Easy Online Solutions Ltd, d/b/a MojoHost, a US company providing web-hosting, content distribution and other 'software as a service' ('SaaS') services. The complainant had registered a number of trademarks, including US trademark registration No 5,895,310 for MOJO CLOUD, registered on 29 October 2019. In addition, the complainant owned the domain name 'mojocloud.com', which redirected to the complainant's main website at '[www.mojohost.com](http://www.mojohost.com)'.

The respondents were Ahmed Parvez Banatwala, Cloudmojo Tech LLP, and Ahmed Parvez Banatwala, Construma Consultancy Pvt Ltd, both of India (collectively, 'the respondent'). The disputed domain names had been registered between 8 May 2020 and 12 February 2021 for use by Cloudmojo Tech LLP, the respondent's limited liability partnership registered in Mumbai, India in or

around June 2020. The respondent carried out a business of sales and distribution of Microsoft products, making active use of the disputed domain names 'cloudmojo.tech' and 'cloudmojotech.com' for this purpose. The other two disputed domain names were not actively used by the respondent.

At the time of submission of the complaint, the respondent had a pending trademark application in India for CLOUDMOJO TECH in respect of computer programming, technology consulting and SaaS services in Class 42. The application was filed on 22 June 2021, approximately three months prior to the filing of the complaint on 27 September 2021. It was advertised as accepted on 12 November 2021, and was entered on the register (registered trademark No 5,014,870) on 9 December 2021.

In order to prevail, a complainant must demonstrate, on the balance of probabilities, that it has satisfied the requirements of Paragraph 4(a) of the UDRP:

1. the disputed domain name 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 the disputed domain name; and
3. the disputed domain name was registered and is being used in bad faith.

## Decision

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

Under Paragraph 4(a)(i) of the UDRP, the panel observed that the disputed domain names contained the complainant's MOJOCLOUD trademark, with the two word elements reversed, and with minor additions, notably hyphens and the term 'tech' in the respective disputed domain names. The panel found that such alterations and additions did not prevent a finding of confusing similarity between the complainant's MOJOCLOUD trademark and the domain names, and that the complainant had met the requirements of the first element of the UDRP.

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

Under Paragraph 4(a)(ii) of the UDRP, the panel noted that the respondent had been carrying on a business involving the sale and distribution of Microsoft products, albeit on a modest scale. The panel also took note of the respondent's claim not to have knowledge of the complainant when registering the disputed domain names, and held that such a denial of knowledge was in fact plausible, given that the complainant had failed to produce evidence in the nature of sales revenues, advertising expenditure or website traffic, such that knowledge of the complainant and its relevant trademark rights could be presumed on the part of the respondent.

The panel further observed that the disputed domain names were resemblant of the respondent's limited liability partnership name, and that the respondent had registered CLOUDMOJO TECH as a trademark in India. The complainant had not sought to invalidate the respondent's trademark, despite being aware of the respondent's trademark application at the time that the complaint was filed, and the respondent's trademark had subsequently matured to registration without being subject to any limitations under Indian law. The panel commented that, in circumstances where the respondent had a subsisting registered trademark in India for the CLOUDMOJO TECH mark, and appeared to be using that trademark in connection with the services for which it is registered, the complainant had not established that the respondent had no rights or legitimate interests in respect of the disputed domain names. Accordingly, the complaint failed under the second element of the UDRP.

### ***Bad faith***

In light of the complainant's failure to carry its burden under the second element of the UDRP, the panel found it unnecessary to consider the third element.

## Comment

The present case sits at the intersection between the UDRP and national trademark law. While domain names are unique and registered on a 'first-come, first-served' basis, the UDRP recognises that coexistence between similar or even identical trademarks is possible. In circumstances where a respondent has taken steps to register a business name, and/or obtain trademark rights that correspond to a domain name that is being used for what appear to be *bona fide* purposes, any resulting conflict will often not be limited to the domain name alone, and will likely be better resolved through proceedings in national courts of competent jurisdiction.

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