

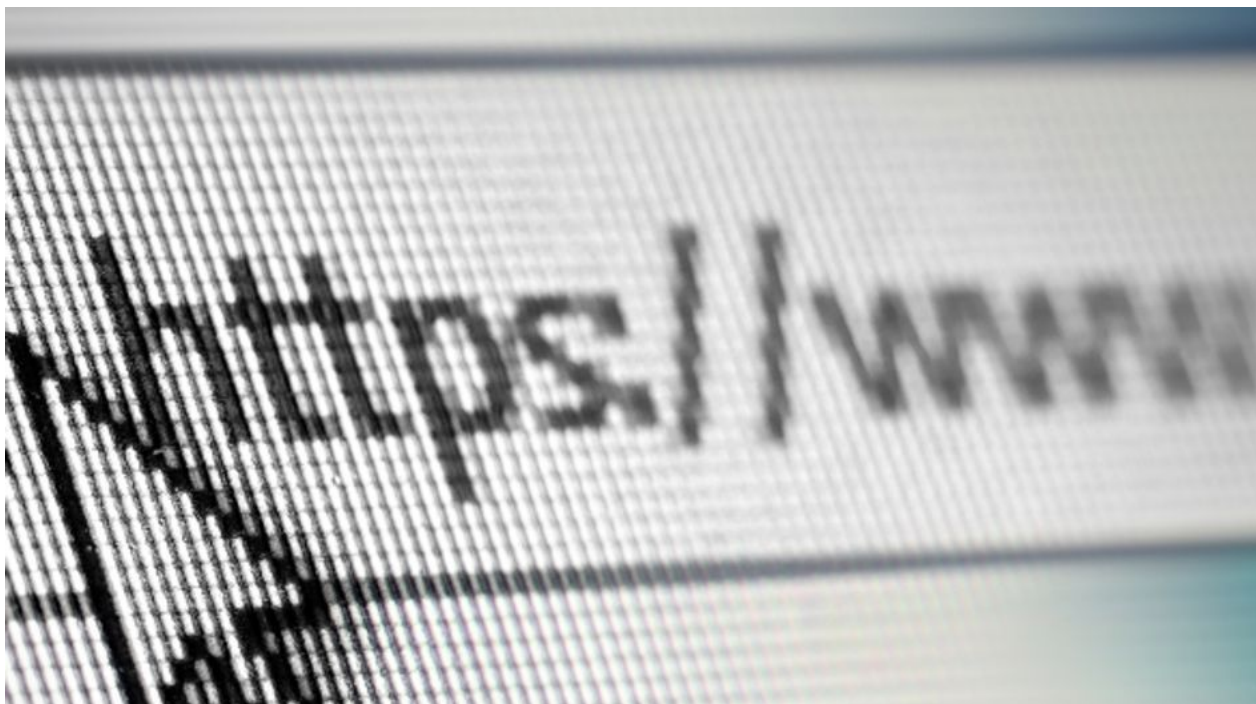


## Registration date of a domain name is key to UDRP panels

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### INTERNATIONAL

Legal updates: case law analysis and intelligence

- The owner of figurative marks containing the term 'NLix' sought the transfer of 'nlix.net' under the UDRP
- The panel found it more likely than not that the domain name was originally registered before 2001, when the complainant filed its trademark
- The panel was not of the opinion that the complaint should never have been made and thus declined to make a finding of RDNH

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 because the complainant failed to prove that it had been registered and used in bad faith. The panel's research demonstrated that it was more likely than not that the respondent had registered the disputed domain name before the complainant's rights came into existence.

### Background

The complainant was Broadband Hosting BV, a Dutch company established in 2001. It was the owner of EU and UK figurative trademarks for NLIX THE INTERCONNECT EXCHANGE, registered in 2017 and 2018 respectively.

The respondent was Peter van Rotterdam of the Netherlands.

The disputed domain name was 'nlix.net'. It was not resolving. It was not clear from the parties' submissions when the respondent acquired the domain name.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements set out at 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*

The panel was satisfied that the complainant had rights in the figurative trademark incorporating the term 'NLix' and that the domain name was identical to the textual and dominant element of this trademark. Thus the complainant satisfied the first element set out in Paragraph 4(a) of the UDRP.

### *Rights or legitimate interests*

Given its finding as to whether the respondent had registered and used the domain name in bad faith, the panel concluded that there was no need to address the existence of rights or legitimate interests.

### *Bad faith*

Under Paragraph 4(a)(iii), a complainant must demonstrate that a domain name has both been registered and is being used in bad faith.

The complainant claimed that, as the respondent lived in the Netherlands, the respondent was at least familiar with the Dutch market and therefore aware of the complainant and/or its trademark rights at the time that the domain name was registered on 7 April 2003. In addition, the complainant asserted that the domain name was acquired in order to be sold to the complainant.

The respondent argued that he acquired the domain name for personal and business use more than 25 years ago, and therefore not for financial gain. Furthermore, the respondent contended that he could not have been aware of the complainant or its trademark rights at the time the domain name was registered for the following reasons:

1. he was living in New Zealand when he registered the domain name in 1996 and chose the term 'nlix' as an acronym for 'Next Level Information eXchange'; and
2. he registered and used NLIX as a trade name in 2000, while the complainant registered and started using its trade name in the Netherlands in 2001, and its domain names 'nl-ix.net', 'nl-ix.nl' and 'nlix.nl' in 2002.

According to the respondent, he did not engage in internet activities similar to those of the complainant and he had never engaged in internet activities that could tarnish the complainant's trademark or goodwill, nor had he registered the domain name primarily for the purpose of selling it to the complainant.

In light of this, it was necessary for the panel to determine the actual date of registration of the domain name. In this regard, as stated in Section 4.8 of the [WIPO Overview 3.0 of WIPO Panel Views on Selected UDRP Questions, Third Edition](#):

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*Noting in particular the general powers of a panel articulated inter alia in Paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.*

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With respect to the registration date of the domain name, the panel reviewed the WHOIS record of the domain name and noted that the creation date was 7 April 2003, which matched the expiry date of the domain name as communicated by the registrar to the WIPO Arbitration and Mediation Centre (ie, 7 April 2022). However, although the panel found the respondent's evidence unclear, it appreciated that it may be difficult and even impossible for the respondent to obtain evidence of actual registration of the domain name more than 20 years ago, especially as the domain name had been registered with several registrars. The WHOIS history confirmed that the domain name was already registered in 2002 in connection with name servers in New Zealand, as evidenced by reference to the Internet Archive Wayback Machine dated 2001 submitted by the respondent in support of his response. It also showed that the domain name was not connected to a nameserver between 1 February 2003 and 18 May 2003, after which the domain name remained registered on different nameservers in the Netherlands. These facts appeared to corroborate the respondent's contention that he initially registered the domain name in New Zealand and then moved to the Netherlands while keeping the domain name.

The panel came to the conclusion that the domain name was originally registered and then possibly allowed to lapse, or that accurate records were not kept by the relevant registry and/or registrars. The panel concluded that it was more likely than not that the respondent registered the domain name before 7 April 2003 and found the respondent's claim that he registered the domain name around 1996 and started using it in 2000 to be credible.

All things considered, the panel found in favour of the respondent, ruling that it was more likely than not that the domain name was originally registered by the respondent before 2001, when the complainant was first established and filed its trademark. The respondent could therefore not have known of the complainant's rights and did not register the domain name in bad faith. Furthermore, even if the domain name had been registered a few years later in 2003, the complainant had not shown conclusively that at such time the respondent would have done so to target the complainant's recently acquired rights.

### **RDNH**

As per the respondent's request, the panel considered the issue of reverse domain name hijacking (RDNH), 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". The panel therefore reviewed the overall circumstances of the case, namely that:

- it was possible that the complainant had believed that the domain name was registered in 2003 when it was established and using the term 'NLIX';
- the domain name did not resolve to an active website; and
- the respondent admitted in correspondence prior to the filing of the complaint that he intended to use the domain name for a project which he abandoned, and was only willing to transfer the domain name to the complainant for a considerable amount.

In light of this, the panel was not of the opinion that the complaint should never have been made and accordingly declined to make a finding of RDNH.

### **Comment**

The decision serves as a reminder to brand owners considering filing a UDRP complaint that the date of registration is key when it comes to bad faith.

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