

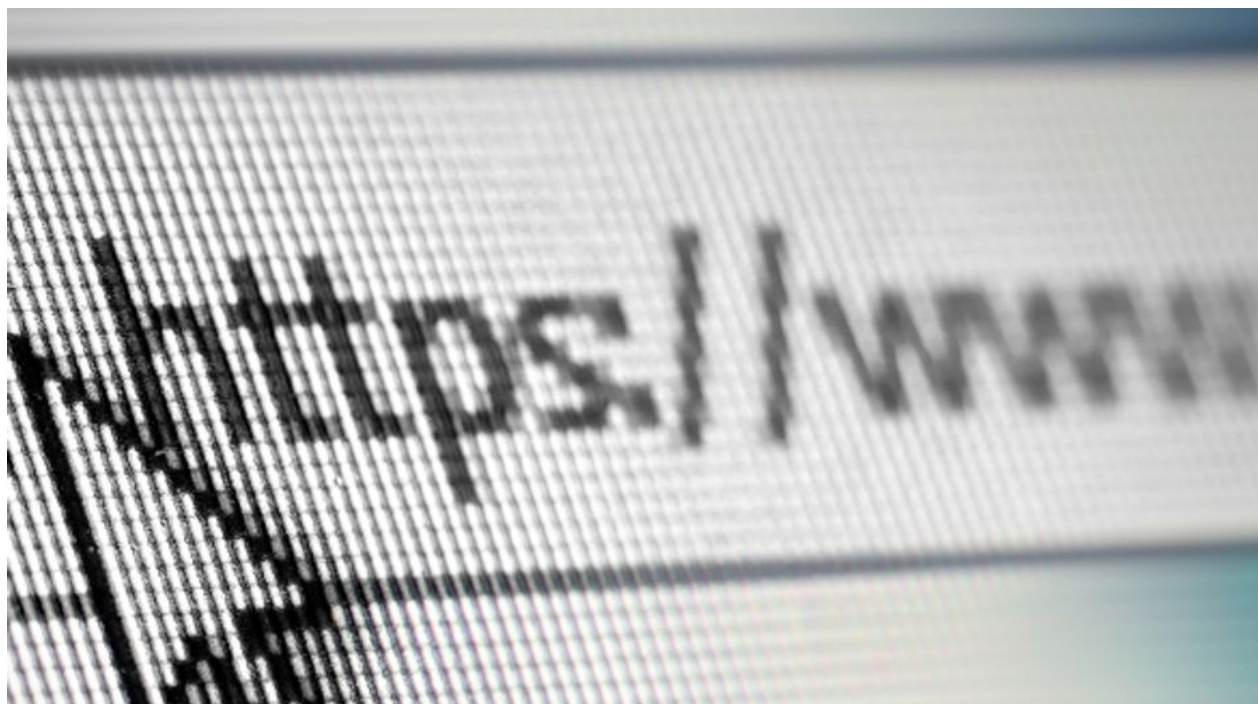


Complaint for 'chagall.com' fails as respondent's explanation is "just about plausible"

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29 April 2022



INTERNATIONAL

Legal updates: case law analysis and intelligence

- The Marc Chagall Committee, an association incorporated by the estate of well-known painter Marc Chagall, sought the transfer of 'chagall.com' under the UDRP
- The respondent argued that he had selected the domain name purely because it consisted of the English transliteration of the Hebrew word for 'concubine'
- The panel did not feel that there was enough supporting evidence that would justify dismissing the respondent's explanation

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 'chagall.com', partly on the basis that it reflected a Hebrew term with a sexual innuendo, and that the complainant had failed to prove that the respondent had acted in bad faith.

Background

The complainant was *Association pour la défense et la promotion de L'œuvre de Marc Chagall*, also known as the Marc Chagall Committee, a French association incorporated by the estate of the well-known painter Marc Chagall (1887-1985). Chagall's paintings have been sold for millions of dollars and are exhibited in famous museums worldwide. The complainant owned various trademarks for CHAGALL, including International trademark No 505527 registered in 1986 and European Union trademark No 000177709 registered in 1998. The complainant had used the trademarks CHAGALL and MARC CHAGALL in connection with merchandise derived from works by the painter.

Miri and Isaac Shepherd, two individuals based in the United States, were the joint registrants of the domain name. Because the response was written on the basis that Isaac Shepherd was the controller and decision-maker in respect of the domain name, the panel proceeded as if Isaac Shepherd were the sole respondent.

The domain name 'chagall.com' was registered on 6 March 2000. As of 10 February 2005, it was used to point to a website offering it for sale, along with various other domain names, and indicating a price range from \$5,000 to \$5 million. As of 9 December 2021, the domain name resolved to a website headed "LifeAlert", described as a medical alert system for elderly people.

In August 2021 the complainant approached the respondent to ask about acquiring the domain name, and the respondent invited the complainant to come up with an offer. In November 2021 the complainant sent a cease-and-desist letter to the respondent, to which the respondent did not respond. In December 2021, the complainant initiated proceedings under the UDRP for a transfer of ownership of the domain name.

To be successful in a complaint under the UDRP, a complainant must satisfy the requirements of Paragraph 4(a) of the UDRP, namely that:

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 disputed domain name has been registered and is being used in bad faith.

Decision

Identity or confusing similarity

The complainant contended that the domain name was identical to its registered CHAGALL trademark. The respondent did not dispute the similarity between the domain name and the complainant's trademark. However, by invoking Section 1.7 of the [WIPO Overview 3.0](#), the respondent argued that his use of the domain name for a website unrelated to the complainant's trademark was evidence of a lack of confusing similarity.

The panel accepted the complainant's submissions and found that, disregarding the top-level domain (TLD) suffix, the domain name was identical to the complainant's trademark and that the question of confusing similarity did not arise. In respect of the respondent's arguments, the panel noted that Section 1.7 could allow panels to take a respondent's website into account only in "specific limited instances" where a panel would benefit from affirmation of confusing similarity, and that such an assessment was not a replacement for the typical side-by-side comparison. Therefore, the panel found that the complainant had established the first element of Paragraph 4(a).

Rights or legitimate interests

The complainant asserted that the respondent had no permission to use its trademark and had no rights or legitimate interests in the domain name. The complainant added that the respondent was not commonly known by the domain name. According to the complainant, the lack of legitimate interests on the part of the respondent was supported by the fact that the domain name had been offered for sale since at least 2005, and that the domain name, referring exclusively to the name of the famous painter, had only been used since to redirect to the respondent's website at www.lifealert.com. In addition, the respondent's ready agreement to offer to sell the domain name at the first request also reinforced his lack of legitimate interests. As such, the complainant claimed that the domain name was not really of interest to the respondent.

The respondent refuted these arguments by stating that he registered the domain name purely because it comprised an English transliteration of a generic Hebrew term with a sexual innuendo, namely the Hebrew word for 'concubine'. Moreover, the respondent underlined that he had been registering domain names for their long-term potential value and did not register the domain name because it happened to be a surname, or the surname of Marc Chagall, or because it was a name or mark associated with the complainant. The respondent claimed that he possessed rights and/or legitimate interests in the domain name as a long-time investor in, and reseller of, domain names.

The panel did not decide under the second element, considering that it was unnecessary given its findings under the third element.

Bad faith

The complainant asserted that the respondent registered the domain name for the sole purpose of selling it at a clearly excessive price, namely between \$5,000 and \$5 million. Considering Marc Chagall's exceptional international reputation, the respondent knew or should have known about the existence and use of the complainant's well-known trademarks at the date of registration of the domain name. Further, the complainant placed weight on the fact that the respondent had redirected the domain name to a business which was unconnected with the painter and which supposedly had a poor reputation. Moreover, the complainant underlined other potential indicators of bad faith on the part of the respondent, such as:

- the respondent's use of a privacy service;
- the fact that the respondent chose to register the domain name in the '.com' TLD, which was likely to be of major importance to the complainant; and
- the fact that the respondent did not respond to the complainant's cease-and-desist letter.

In response, the respondent stated that he had no knowledge of the complainant's registered trademarks. He argued that he was born in Israel and was a Hebrew speaker, and stated that he selected the domain name not by reference to the name of the painter or the complainant's trademarks, but purely because it comprised an English transliteration of a generic Hebrew word with a sexual innuendo, namely the Hebrew word for 'concubine'. He further observed that sex-related domain names could carry a high value. As a result, he countered that he did not register or use the domain name in bad faith, but rather for its potential resale value.

Having carefully considered the various factors raised by the parties, the panel found this to be a finely balanced case, and that some factors favoured the complainant while others favoured the respondent. The panel noted that the respondent also owned the domain name 'anak.com', which was a transliteration of the Hebrew word for 'giant'. Given that the domain name formed part of a pattern of Hebrew-transliteration domain names, albeit small, it seemed at least conceivable that the respondent did indeed select the domain name based on its phonetic identity with a Hebrew word. The panel pointed out that it was not in a position to value the domain name, but was aware that the values of domain names could be enhanced if they consisted of short single words and also, as asserted by the respondent, if they were sex-related. The panel further observed that there was no unsolicited offer by the respondent as it was the complainant who made the initial approach.

Ultimately, the panel found that the respondent's explanation, if not fully compelling, fell into the category of "just about plausible". Bearing in mind that the complainant was required to prove its case on the "balance of probabilities", the panel did not feel that there was enough supporting evidence before it that would justify the panel in dismissing the respondent's explanation and depriving him of a domain name that he had owned for some 20 years. The panel therefore found that the respondent's registration and use was not in bad faith, and denied the complaint.

Comment

This decision underlines that, in UDRP proceedings, a panel must make its best assessment of a respondent's motive based on the evidence placed before it, and this differs from proceedings in conventional national courts where disclosure of documents and examination of witnesses is possible. Under the UDRP, it is essential to prove that a disputed domain name was registered and is being used to target a particular trademark owner. Attempting to buy a domain name and then filing a UDRP complaint is always a risky strategy when the evidence of targeting is thin, although the decision in question could certainly have been different had the respondent never responded.

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