

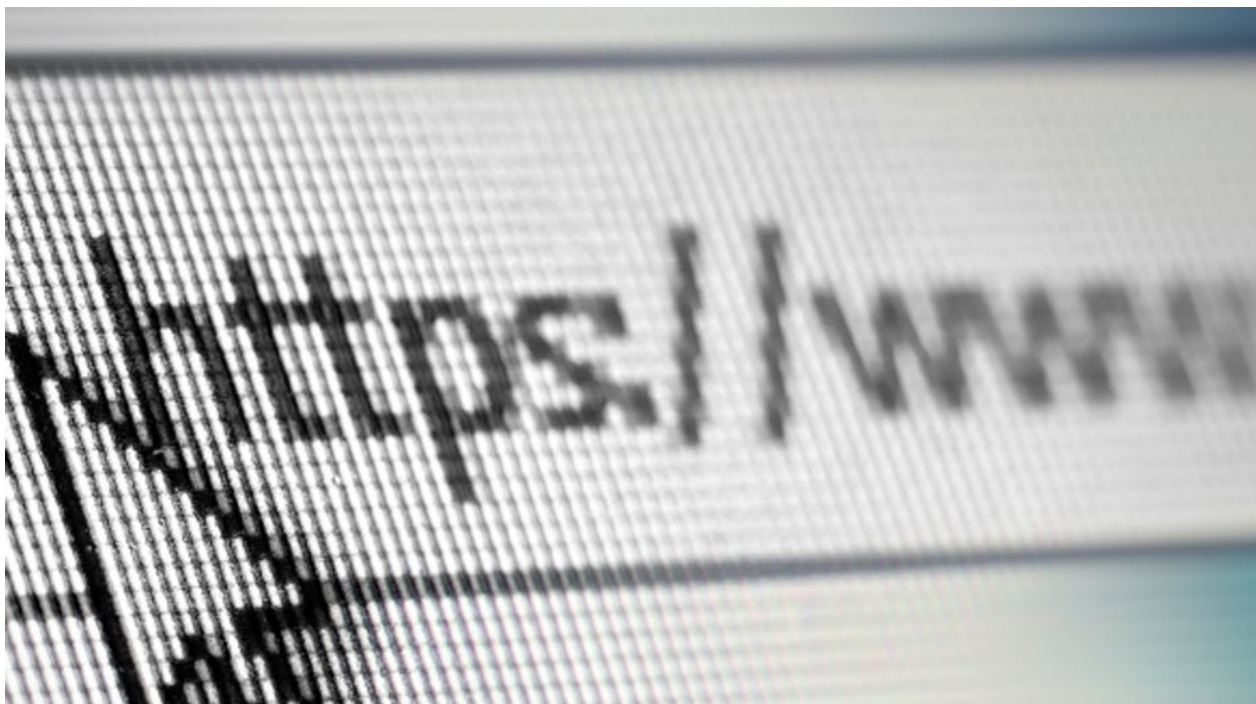


UDRP: proof of targeting essential for acronym trademarks

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- The complainant, a French public body which owns several IRSN trademarks and the domain name 'irsn.fr', sought the transfer of 'irsn.com' under the UDRP
- The panel found that that the respondent had acquired the domain name as a result of its four-letter value, rather than by reference to the complainant
- The complainant had not highlighted any notable features of the present case that evidenced any particular pattern of cybersquatting incorporating the disputed domain name

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to order the transfer of a domain name that was identical to the complainant's prior trademark because the complainant failed to prove that the domain name had been registered in bad faith.

Background

The complainant was *Institut de Radioprotection et de Sûreté Nucléaire*, a French public body operating in the field of research and expertise about nuclear and radiation risks. It owned several trademark registrations for IRSN, including French trademark No 4186540 and International trademark No 1290146, both registered in 2015. It also owned the domain name 'irsn.fr'.

The respondent was Domain Admin, FindYourDomain, based in the United States.

The disputed domain name was 'irsn.com', registered on 16 April 2021. It resolved to a parking page with sponsored links and was offered for sale at the website 'www.perfectdomain.com' for \$29,999.

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 IRSN trademark and the respondent conceded this. The panel accepted the complainant's submissions and found that, disregarding the top-level domain suffix, the domain name was identical to the complainant's trademark. Therefore, the panel found that the complainant had established the first element of Paragraph 4(a) of the UDRP.

Rights or legitimate interests

The complainant asserted that the respondent had registered the domain name only for commercial gain, either from the pay-per-click links or from an eventual sale at an amount in excess of the documented fees directly in relation to the domain name. The complainant added that the respondent was not commonly known by the domain name. In addition, the complainant argued that the website at the domain name had a parking page with sponsored links relating to the complainant's field of activity. As such, the complainant claimed that the respondent had no rights or legitimate interests in respect of the domain name.

The respondent rebutted these arguments by submitting that it acquired the domain name in connection with its legitimate business of buying and selling short, generic, otherwise appealing and inherently valuable domain names. Moreover, the respondent stated that the domain name consisted of the acronym 'irsn', which was used to identify many organisations, individuals and concepts, and that it was therefore entitled to buy the domain name corresponding to that acronym.

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

Bad faith

The complainant asserted that the respondent acquired the domain name for the sole purpose of making a profit from the pay-per-click links or from selling it to the complainant or to a competitor of the complainant for an amount higher than the documented fees in relation to the domain name. 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 owned almost 1,500 domain names, some of them corresponding to famous third-party trademarks; and
- the fact that the complainant was a well-known government agency in France, whose trademark predated the domain name by a number of years.

In response, the respondent stated that it had no knowledge of the complainant's trademark as it consisted of a French government agency whose mandate did not extend to the United States. It argued that, even if some of its domain name registrations violated third-party trademark rights, that would not suffice as evidence of a pattern of bad-faith domain name registrations. In addition, the US version of the parking page did not list ads related to the complainant's field of activity. It further observed that the price of \$29,999 for the domain name was not unusually high for a four-letter '.com' domain name.

The panel first noted that a number of prior UDRP cases had explored screening obligations on domainers. However, the panel found that this was not applicable in the present case given that the arguments presented by the complainant failed to create even an inference that it was being targeted. The panel was of the opinion that the respondent had demonstrated that it was not aware of the complainant when it registered the disputed domain name, and that it acquired the domain name as a result of its four-letter value, rather than by reference to the complainant. In respect of the respondent's other registrations of domain names including famous third-party trademarks, the panel did not feel that the complainant had highlighted any notable features of the present case that evidenced any particular pattern of cybersquatting incorporating the disputed domain name. The panel therefore found that the complainant had failed to prove that the domain name had been registered in bad faith and denied the complaint. The panel did not need to decide whether the respondent was using the domain name in bad faith, given its findings in relation to bad-faith registration.

Comment

This decision illustrates how important it is to prove that a disputed domain name was registered to target a particular trademark owner, especially when it consists of an acronym that may be subject to various interpretations. Complaints brought under the UDRP will fail when bad-faith registration is not apparent, regardless of any use (under the UDRP it is necessary to prove both bad-faith registration and use). In the present case, even though the domain name was identical to the complainant's prior trademark, in the absence of any tangible evidence of targeting the panel was obliged to deny the complaint.

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