



Unsubstantiated chain of events for cycling company in UDRP case

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16 June 2022



INTERNATIONAL

Legal updates: case law analysis and intelligence

- Protanium BV, the owner of several trademark registrations for PROTANIUM, sought the transfer of 'protanium.com' under the UDRP
- The panel found that, on balance of probabilities, the respondent had maintained and used the domain name for the purpose of promoting the PROTANIUM mark during his time as member and shareholder of the complainant
- Given the registration date of the domain name and the nature of the dispute between the parties, there was no clear case of cybersquatting

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a three-member panel has refused to transfer the domain name 'protanium.com', finding that the complainant had failed to prove that it had been registered in bad faith.

Background

The complainant was Protanium BV, a Dutch company incorporated in 2008 and wholly owned by Accell Global BV, a European leader in e-bikes, bicycle parts and accessories. The complainant was the owner of several trademark registrations for PROTANIUM, including in Denmark (figurative mark registered in 1995), the European Union (word mark registered in 2008) and the United Kingdom (word mark registered in 2008).

The respondent was Lars Munscoe, located in Denmark. He was one of the shareholders (holding 20% of the shares) and a member of the board of the complainant from 2008 to October 2015, when he left the company after executing a settlement agreement. The respondent registered the domain name in 2006. It resolved to a website providing information about Protanium products and history, with the last updates dating back to 2014.

The complainant initiated proceedings under the UDRP for a transfer of ownership of the domain name. To be successful under the UDRP, a complainant must satisfy the requirements of Paragraph 4(a) of the UDRP, namely that:

- (i) the disputed domain name is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

Decision

Identity or confusing similarity

The complainant argued that the domain name was identical to its trademark PROTANIUM as it reproduced the trademark in its entirety. The panel considered, after establishing that the trademarks were still registered at the time of the drafting of the decision, that the complainant had proven that the domain name was identical to the trademark, as PROTANIUM was entirely reproduced in the domain name.

Rights or legitimate interests

The complainant claimed that the respondent had no rights in the domain name, arguing that:

- (i) the trademark PROTANIUM was registered in 1995 whereas the respondent registered the domain name in 2011;
- (ii) the respondent had full knowledge of the complainant's IP portfolio, including patent rights registered by the complainant but invented by the respondent when he was a board member and shareholder of the complainant;
- (iii) pursuant to the 2015 settlement agreement between the complainant and the respondent, all rights and obligations between the parties had ended and the respondent no longer owned shares in the complainant and was not licensed by it to use its IP rights in any way;
- (iv) the respondent was not commonly known by the domain name and did not make fair use of it because, by registering the domain name and pointing it to a website providing information on the complainant's history, philosophy, products and services, the respondent had attempted to falsely suggest an affiliation with the complainant; and
- (v) the website to which the domain name resolved also provided information on other brands owned by the Accell Group and in which the respondent had no rights.

The respondent countered that he had always been the legitimate owner of the domain name since 2006 and that he had temporarily, between 2008 and 2015, granted the complainant use of the domain name when he was a manager and shareholder of the complainant. The respondent also argued that the domain name had always been maintained and paid for by him and not by the complainant, that it had been more than six years since he stopped working for the complainant and that the complainant owned its own official domain name 'protanium.nl' registered in 2016, but never used. The respondent rejected the complainant's claim to exclusive rights in PROTANIUM based on trademark registrations in a few countries and pointed out that many other people or companies in other countries had registered PROTANIUM as a trademark. The respondent further indicated that, to his knowledge, the complainant had stopped selling PROTANIUM-branded products shortly after he left the company and that therefore the trademarks were not in use. In addition, the respondent informed the panel that, due to the non-use of the trademark by the complainant, the respondent had filed, in January 2022, a European Union trademark application for PROTANIUM, in the name of his company Lynx ApS, as well as revocation applications against the complainant's EU and Danish trademark registrations.

The panel did not judge it necessary to address the question of the respondent's rights and legitimate interests because it concluded that the complaint had failed on the third element.

Bad faith

The complainant contended that the respondent had registered and used the domain name in bad faith and that he was actively preventing it from reflecting its trademark in the domain name.

With regard to bad-faith registration, the complainant argued that the respondent, in his capacity as former board member and shareholder of the complainant, had registered the domain name without the complainant's consent, but with full knowledge of its IP rights, as highlighted by the content of the website which included information on the complainant's history, philosophy,

products and services, as well as patent rights owned by the complainant rather than the respondent himself. The complainant considered that the respondent could not have ignored the complainant's trademark rights, given his former position as shareholder and board member and the prior relationship between the parties. The complainant also pointed out that the respondent's former position could not justify the use of the trademark PROTANIUM without its consent.

With regard to bad-faith use, the complainant claimed that, in violation of the settlement agreement which requested disclosure by the respondent of the necessary information regarding the affairs of the company, including on IP matters, the respondent had never notified the complainant of the ownership of the domain name, and had not handed over any relevant data on the topic. The complainant added that the respondent had been using a privacy shield to cover his identity, excluding himself from the need to comply with the abovementioned obligation.

The respondent denied the allegation of bad-faith registration and use and pointed out that:

1. the complainant was incorporated in 2008, two years after he registered the domain name and, therefore, he had not registered the domain name with the complainant in mind;
2. to the best of his knowledge, the complainant had ceased to be in business for many years and the inactive company was sold in 2019 to focus on a different brand name and no longer on PROTANIUM-branded goods; and
3. as the complainant was no longer an active business and had not been for many years, it was highly unlikely that the complainant would need the domain name to conduct business; it was more likely that the complainant's intention was to sell the domain name for profit to the owner of its remaining activities (ie, the beneficial owner Protanium GmbH, based in Switzerland).

The panel held that the complainant had failed to prove that the respondent had registered the domain name in bad faith. First, in the absence of substantiating evidence, the panel rejected the complainant's assertion that the domain name had been registered by the respondent in 2011, and relied on records indicating that the domain name was registered in 2006 (ie, two years before the complainant's incorporation). With regard to the Danish trademark registered in 1995, the panel pointed out that public records indicated that the trademark was acquired by the complainant in 2008 by means of a transfer from a predecessor in rights. The panel also noted, as indicated by the respondent, that the domain name resolved to a website providing information on the complainant, its products, patent rights and history, including the foundation of Protanium in 2006 by the respondent and another individual, and that such website was updated until 2014, the respondent having left the complainant in 2015. Therefore, in view of the circumstances of the case, the panel found that, on balance of probabilities, the respondent had maintained and used the domain name for the purpose of promoting the PROTANIUM trademark and products during his time as member and shareholder of the complainant.

The panel concluded that, given the registration date of the domain name and the nature of the dispute between the parties, there was no clear case of cybersquatting under the UDRP, but instead a complex dispute that should be more properly addressed in a civil court. The complaint was therefore denied.

Comment

This decision shows the importance and the relevance of the trademark and domain registration dates when it comes to assessing bad-faith registration claims under the UDRP. It is also a reminder that UDRP panels will generally deny cases that go beyond the scope of cybersquatting where there are more complicated issues to consider, and this is especially true when parties are involved in parallel trademark disputes (revocation proceedings in this particular case).

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