

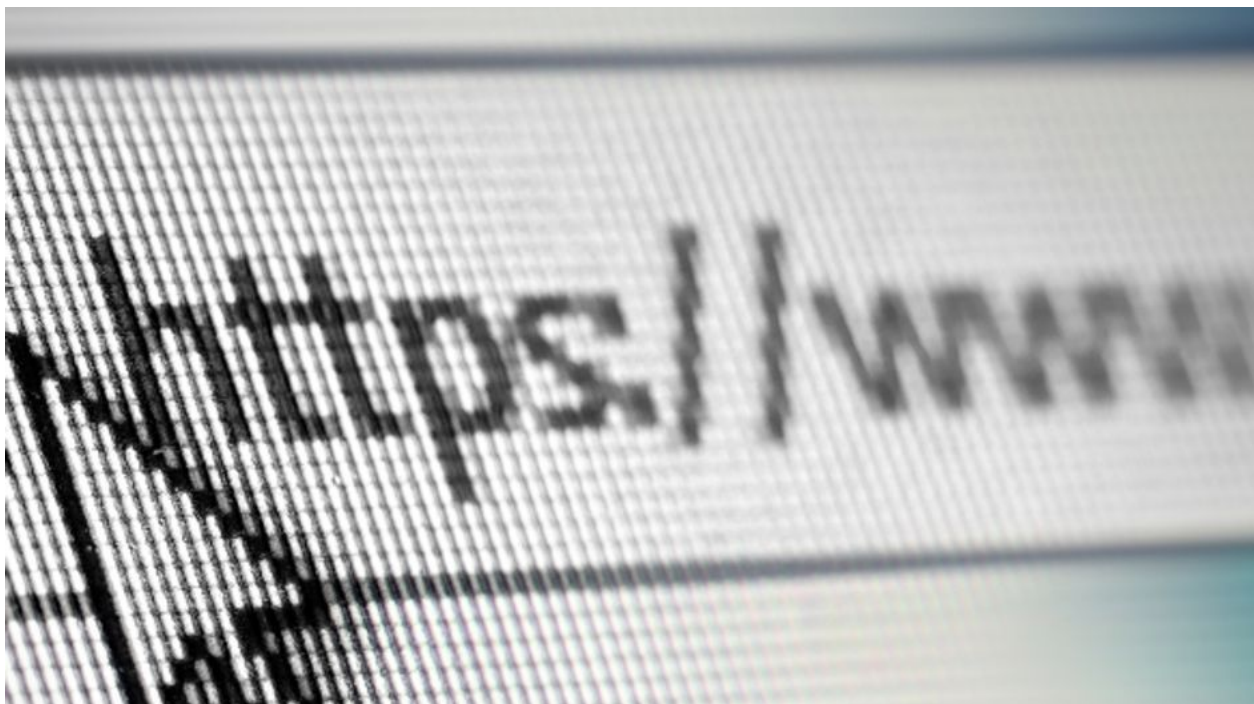


UDRP complainant loses bet for Bette

Jane Seager and Ying Lou

Hogan Lovells

27 June 2022



INTERNATIONAL

Legal updates: case law analysis and intelligence

- Bette GmbH & Co KG, the owner of several BETTE trademarks, sought the transfer of the domain name 'bette.com' under the UDRP
- The panel found that the complainant had failed to substantiate its common law trademark rights at the time the domain name was registered
- The respondent's reason for registering the domain name was plausible, and there was no compelling reason to conclude that he intended to target the complainant

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 at issue as it was registered before the complainant was able to prove that it had trademark rights, and the respondent's explanation that it was registered because it was a common female name was "plausible".

Background

The complainant was Bette GmbH & Co KG, a German company founded in 1952 and specialised in manufacturing and selling bathroom furnishings and products. It held several trademarks for BETTE, including an international trademark (designating the United Kingdom) registered in 2003. It also owned the domain name 'my-bette.com', which was registered in 2019 and pointed to its official website available in seven languages.

The domain name at issue was 'bette.com', registered in 1998 through a privacy registration service. It previously pointed to a parking page with pay-per-click (PPC) links to third parties offering bath-related products, including the complainant's competitors. The parking page also contained a link to the Sedo domain name auction site, stating that the domain name "may be for sale" for £35,000.

The respondent, Anthony Stewart, was based in the United Kingdom. He stated that he was the original registrant and that, in 2015, he was approached by the complainant and declined its offer to purchase the domain name for €1,000.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements:

- (a) the domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
- (b) The respondent has no rights or legitimate interests in respect of the domain name; and
- (c) The 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 BETTE trademarks, irrespective of the fact that its trademarks were registered after the domain name was created. This assertion was accepted by the panel. The first limb was therefore satisfied.

Rights or legitimate interests

The complainant argued that the respondent had no permission to make use of its trademarks, while the respondent claimed that he registered the domain name to establish a female-facing online betting site, without any intent to target the complainant and its business. The respondent added that the name Bette was a common derivative of the name Elisabeth and stated that, as first name domain names were highly sought after, he had refused numerous offers from potential buyers over the years.

The panel considered that the respondent, despite his holding of the domain name for 24 years, had failed to provide any evidence of demonstrable preparations to use it in connection with his stated project. Furthermore, the respondent's use of the domain name to point to a parking page with PPC links and offer to sell the domain name could not be regarded as a *bona fide* offering of good and services under the UDRP. For these reasons, the panel found that the respondent had not established rights or legitimate interests in the domain name and so the second limb was also satisfied.

Bad faith

The complainant argued that the respondent's use of the domain name to point to a parking page with PPC links redirecting to competitor websites and his offer to sell the domain name for an amount largely exceeding out-of-pocket costs clearly indicated bad faith. The respondent denied having control over the content of the parking page to which the domain name resolved, claiming that both the PPC links and offer to sell the domain name were automatically generated. He further argued that he registered the domain name in good faith as it was created five years before the complainant registered its earliest trademark for BETTE and 21 years before the complainant registered its domain name 'my-bette.com'.

Given the early registration date of the disputed domain name, the complainant filed a supplemental filing with additional evidence to establish its common law trademark rights at the time of registration of the domain name, including an earlier German design trademark (subsequently abandoned) and its historical sales volumes in the period between 1996 and 1998.

With regard to the complainant's supplemental filing, the panel considered that this filing did not address any newly discovered evidence and the complainant should have anticipated that it would be required to establish its common law trademark rights for the purposes of the third limb of the UDRP when filing the complaint. In spite of this, the panel still decided to take into account the additional evidence for the limited purposes of addressing the respondent's bad faith at the time of registration of the domain name. In the panel's opinion, the additional evidence provided by the complainant was not sufficient to support its common law trademark rights in light of the criteria specified in [WIPO Overview 3.0](#), Section 1.3, which provides as follows:

“

To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (eg, consumer, industry, media) recognition, and (v) consumer surveys.

”

Despite the complainant's long history (founded in 1952) and its continued use of the name Bette, the panel considered that the complainant had failed to substantiate its common law trademark rights in 1998, even with the unsupported statements of sales in the period between 1996 and 1998 submitted in its supplemental filing.

In any event, the panel found that the respondent's reason for registering the domain name based on a common female name was plausible, and there was no compelling reason to conclude that he had prior knowledge of the complainant or intended to target it when registering the domain name in 1998. The fact that the respondent never contacted the complainant to sell the domain name and held it for years without listing it for sale further indicated the lack of bad faith.

In view of the above, the third limb was not satisfied and the complaint was denied.

Comment

This case illustrates, once again, that to be successful under the UDRP complainants must prove both bad-faith registration AND use. In cases such as this, where the complainant's registered trademarks post-date registration of the domain name, it is generally difficult to prove bad-faith registration and obtain a transfer order. In such cases, complainants have an uphill battle to establish not only the existence of unregistered trademark rights at the time of the registration of the domain name, but also that the respondent was aware of these rights and was targeting them.

Jane Seager

Author | Partner

jane.seager@hoganlovells.com

Hogan Lovells

Ying Lou

Author | Associate

ying.lou@hoganlovells.com

Hogan Lovells