



## UDRP respondent skilfully shows unbroken chain of possession

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### INTERNATIONAL

Legal updates: case law analysis and intelligence

- Skillful Communications Inc sought the transfer of the domain name 'skill.com' under the UDRP
- The panel found that the transfer of the domain name in around 2007 appeared to simply be a change in relation to which company within the corporate family would hold the domain name
- The respondent was not targeting the complainant within the meaning of the UDRP

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a three-member panel has refused to order the transfer of a domain name because it found that the complainant had failed to demonstrate that the respondent had registered the domain name in bad faith.

### Background

The complainant was Skillful Communications Inc, an American company providing interview and career-related training for both individuals and companies. The respondent was Aquent, LLC, an American staffing company and provider of temporary employees.

The disputed domain name, 'skill.com', was registered by the respondent's predecessor in 1995. Since the registration of the domain name, the respondent had changed its name twice: in 1999 to Aquent Inc and around 2007 to Aquent LLC. At the time the complaint was filed, the domain name resolved to a website promoting a network of recruiters, boutique agencies and global search firms operated by a company called Scout Exchange LLC, a company under common ownership with the respondent.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements under Paragraph 4(a):

- (i) the domain name registered by the respondent 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 respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

## Decision

With regard to the first limb, the complainant contended that it had trademark rights in SKILLFUL since 2010 and in SKILL since 2020. In addition, the complainant submitted that it owned various domain names, including 'skillfullydone.com' and 'skill.net'. The complainant also argued that the disputed domain name was identical to its SKILL mark and confusingly similar to its SKILLFUL mark.

As far as the second requirement under the UDRP was concerned regarding the respondent's rights or legitimate interests, the complainant asserted that the respondent could not claim trademark rights in SKILL.COM, given that any rights in this term were abandoned at least 20 years ago. More specifically, the complainant submitted that, between 2000 and 2009, the disputed domain name merely resolved to a page containing a message stating that "SKILL.COM has changed its name to Aquent". Then, between 2009 and 2020, the disputed domain name was redirected to websites at '[www.aquent.com](http://www.aquent.com)' or '[www.aquent.us](http://www.aquent.us)'. The complainant further contended that the disputed domain name was recently transferred to Scout Exchange, despite the fact that the underlying registrant details still mentioned the respondent's data. Moreover, the complainant argued that, since the recent transfer, the disputed domain name started pointing to a website that contained design and messaging elements similar to those of the complainant's website, and mimicked the same colour scheme. As such, the complainant argued that the respondent was using the disputed domain name to misleadingly attract internet users to a website operated by the respondent or its affiliates.

The respondent rebutted these arguments by stating that it had been operating as a staffing company since the 1980s and that its trademark rights predated the complainant's rights. The respondent contended that the disputed domain name was registered in 1995 and that its subsequent transfer by Aquent Inc to its subsidiary Aquent LLC did not constitute a new registration as it was done in good faith in furtherance of a legitimate business purpose. Moreover, the respondent underlined that, contrary to the complainant's arguments, the disputed domain name was not recently transferred to Scout Exchange LLC, but only licenced to it. The respondent added that Scout Exchange was its sister company.

In light of its findings under the third limb of the UDRP, the panel did not comment on the first two requirements. Turning to the third limb of the UDRP, the complainant argued that the transfer of the disputed domain name between 2007 and 2008 constituted a new registration that occurred after the complainant had developed its trademark rights in SKILLFUL. Furthermore, the complainant contended that a second transfer, and new registration, took place between 2020 and 2021. In addition, according to the complainant, the respondent used the disputed domain name in bad faith to misleadingly attract internet users to a website which was "strikingly similar" to the complainant's. On the other hand, the respondent highlighted that it registered the disputed domain name in 1995, well before the complainant started operating. The respondent also argued that the complainant could not monopolise the common English word 'skill'. Finally, the respondent asserted that it legitimately used the domain name in connection with its activity.

The panel found that the transfer of the disputed domain name in around 2007 appeared to simply be a change in relation to which company within the corporate family would hold the domain name. The panel observed that there was no evidence that such transfer was done to take advantage of any trademark rights the complainant might have claimed in its SKILLFUL mark. When it came to the use of the domain name by Scout Exchange in 2021, the panel considered that the respondent was not targeting the complainant within the meaning of the UDRP. The panel explained that:

- the domain name consisted of a common word;
- there existed multiple parties using the same term in their trademarks; and
- the respondent's services were different from those offered by the complainant.

In light of the above, the panel made a finding that the complainant had failed to demonstrate the requirements prescribed by the third limb of the UDRP and so transfer of the domain name was denied.

## Comment

This decision illustrates that, where a respondent can provide evidence of an unbroken chain of possession of a disputed domain name, the changes to registrant contact information in the WHOIS record will not be treated as a new registration. This is why it is important to conduct a thorough search on the owner of a domain name prior to commencing UDRP proceedings. It is useful (where possible) to understand the registrant's history and structure and, as a consequence, to establish the date that the panel will take into consideration when assessing bad-faith registration. One should also bear in mind that, in order to be sure that a

chain of possession of the domain name can be considered legitimate and therefore unbroken, panels may consider, among other things, the strength of a complainant's mark and whether the transfer has resulted in a change of use specifically to take advantage of a complainant's rights.

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