



UDRP complainants beware: investigations are essential before filing a complaint

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- The complainant, which traded as LABE and owned the Spanish trademark LABE, sought the transfer of 'labe.com' under the UDRP
- The panel found that the respondent could not have had the complainant and its eventual use of LABE in mind as at the date of registration
- The panel concluded that the complainant had failed to properly investigate the facts and made a finding of RDNH

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied a UDRP complaint for the domain name 'labe.com', finding that the complainant had failed to prove that the respondent had no rights or legitimate interests and had registered and used the domain name in bad faith, and entering a finding of reverse domain name hijacking (RDNH).

Background

The complainant was Law and Business Enterprises Worldwide SL, a Spanish company established in 2009. The complainant provided legal, accountancy, securities assets management and tax services for a variety of entities. It traded as LABE and owned a figurative Spanish trademark for LABE, registered on 23 September 2010. It also owned a number of domain names comprising 'LABE', including 'labe.es', redirecting to a website providing information about its services.

The respondent was Rada Ann Labé, an individual who had practised as a real estate agent in the United States. She registered the domain name 'labe.com' on 9 June 1998, and it had previously resolved to a website containing information about her real estate practice. Archived screen captures from the Wayback Machine showed that, as of October 2014, the domain name

resolved to a website featuring a biography about the respondent and containing her contact details. Although the respondent's website was inactive at the time that the complaint was filed, she continued to use email addresses associated with 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 panel found that the complainant had established rights in the LABE trademark, and that the domain name was identical to the complainant's registered trademark.

Rights or legitimate interests

The complainant alleged that the domain name had been inactive since the date of registration. According to the complainant, the respondent did not own any trademark or trade designation that had any connection with the domain name, nor had she made any serious preparations to use the domain name in connection with a *bona fide* offering of goods and services. As such, the complainant claimed that the respondent's registration of the domain name did not reflect a desire to use it in connection with her own activities but, rather, to take advantage of the notoriety of the complainant's LABE trademark and its 'labe.es' domain name.

In response, the respondent stated that she had registered the domain name in 1998 and had been using it to resolve to a website promoting her real estate business and for her email addresses. She argued that her website was taken down very recently as she no longer had any need to use it for the promotion of her business.

The panel considered that the respondent had produced evidence that she was commonly known as "Ann Labe" or "Rada Ann Labe", including screen captures of her Twitter account, her entry in an online directory of real estate agents, her Arizona and California real estate licenses, and her biography on the website to which the domain name had previously resolved, each of which had recorded her name as "Ann Labe" or "Rada Ann Labe". The panel took the view that the respondent had demonstrated that she was commonly known by her surname, Labe, which corresponded to the domain name, and found that the complainant had failed to establish that the respondent had no rights or legitimate interests.

Bad faith

The panel noted the domain name had been registered over 10 years before the complainant was established and approximately 12 years prior to the registration of the complainant's LABE trademark. Accordingly, the panel found that the respondent could not have had the complainant and its eventual use of LABE in contemplation as at the date of her registration, as it did not come into existence until over a decade later. The panel disagreed with the complainant's allegation that the domain name not currently resolving to an active website could comprise bad-faith use under the doctrine of passive holding, in that the factors allowing this doctrine to be applied were absent in the present case - such as the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, as well as the implausibility of any good-faith use to which the domain name may be put. Except in certain specified circumstances, the panel was of opinion that bad faith would not be found where the domain name at issue had been registered prior to the complainant's registration of its mark. In light of the above, the panel concluded that the complainant had failed to establish bad-faith registration and use by the respondent.

RDNH

In its finding that the complainant had engaged in RDNH, the panel was of the opinion that the complainant had failed to properly investigate the facts. The complainant had made a series of misconceived and irrelevant allegations against the registrar and had shown a lack of understanding of the UDRP. Moreover, many of its assertions were factually incorrect. The panel noted that the evidence available to the complainant, such as the WHOIS record, should have made it apparent to the complainant that it was likely to encounter substantial difficulties in establishing bad-faith registration by the respondent. A Google search or a basic search for archived screen captures of the domain name would have revealed the respondent's prior

use. The complainant's decision to proceed with the complaint meant that the respondent was obliged to file a response, and the panel noted that the UDRP should not be misused in this manner. The panel therefore found that the complaint was brought in bad faith and made a declaration of RDNH.

Comment

This decision once again illustrates that a complainant should think twice before filing a complaint under the UDRP when a domain name registration substantially pre-dates their trademark rights, in which case bad faith can be established only in very limited circumstances. In this particular case, the mere fact that the domain name was not resolving to an active site at the time of filing was insufficient, as it had previously been used in good faith, and such information can be obtained through consultation of publicly-available resources, including the Wayback Machine available at 'www.archive.org'. Furthermore, the domain name corresponded to the respondent's surname and was still being used for email. Trademark owners should therefore find out as much as possible about a domain name registrant and previous use of a domain name to gather reliable and convincing evidence of bad faith before filing a UDRP, otherwise their complaint may be denied.

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