



Domino match: complainant fails to prove bad-faith registration and use

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- Domino Printing Sciences PLC sought the transfer of 'dominopl.com' under the UDRP
- The panel found insufficient evidence to conclude, on balance of probabilities, that it was more likely than not that the respondent had the complainant's DOMINO mark in mind when registering the domain name
- The nature of the respondent's business was deemed legitimate, with the panel noting that the parties were not competitors in any meaningful sense

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to transfer the disputed domain name 'dominopl.com', finding that the complainant had failed to prove that the respondent had registered and used the domain name in bad faith.

Background

The complainant was Domino Printing Sciences PLC, a company based in the United Kingdom, operating in the printing sector. The complainant owned several trademarks incorporating the term 'domino', registered between 1983 and 2014.

Respondent Yegara, a web hosting, design and advertising company based in Ethiopia, managed the disputed domain name for the benefit of respondent Domino Marketing Solution PLC, also based in Ethiopia (collectively 'the respondent').

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

Under the first element of Paragraph 4(a) of the UDRP, the panel found that the complainant had established rights in the DOMINO trademark, and that the domain name incorporated the complainant's registered mark in its entirety. The complainant therefore satisfied Paragraph 4(a)(i).

The arguments of the complainant under Paragraph 4(a)(ii) were set aside by the panel on the basis that it was not necessary to make a decision on this point, given its findings under Paragraph 4(a)(iii).

Under Paragraph 4(a)(iii) of the UDRP, the panel held that the complainant had failed to establish bad-faith registration and use by the respondent. Although the complainant did have registered trademarks by the time of the domain name registration, the panel found insufficient evidence to conclude, on balance of probabilities, that it was more likely than not that the respondent had the complainant's DOMINO mark in mind when registering the domain name. Given that the DOMINO trademark was not registered in Ethiopia and the complainant's previous sales in Ethiopia were not particularly high, it was not possible for the panel to conclude that the respondent was probably aware of the complainant's DOMINO trademark. The nature of the respondent's business was also deemed legitimate by the panel, who noted that the parties were not competitors in any meaningful way. Finally, the panel noted the complainant's assertion that the respondent's use of the domain name constituted passing off under English law, but underlined that this was not for the panel to consider under the UDRP. In effect, a successful claim under the UDRP did not necessarily coincide with a passing off or trademark infringement claim under local law.

Comment

This decision illustrates several points that may be taken into account when filing a complaint to recuperate a domain name that includes a seemingly generic term. It is crucial to submit persuasive evidence of a complainant's reputation, ideally also in the respondent's country. This is even more so when, as in the present case, the respondent's company name contains the relevant term. Establishing bad faith will then be more difficult, but not necessarily impossible, and will require assembling information and data to evidence the respondent's knowledge of and, more importantly, intention to target the complainant and its rights.

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