

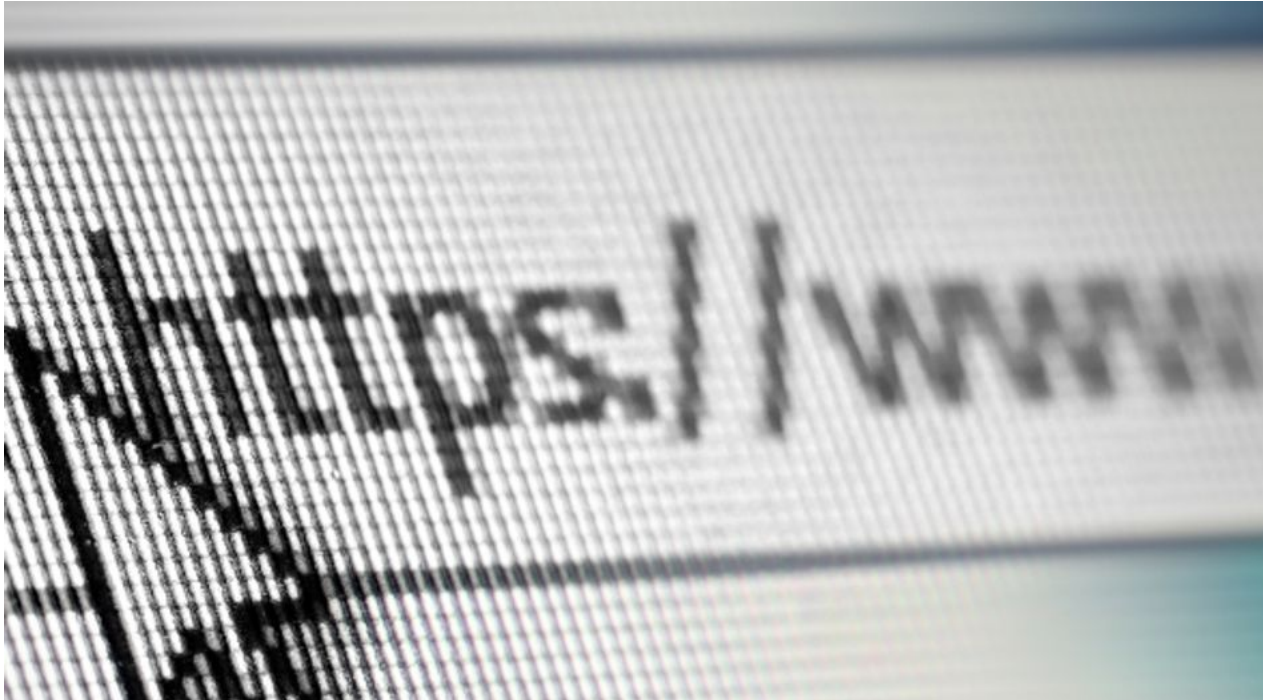


## Panel makes finding of RDNH despite exact match between domain name and trademark

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### INTERNATIONAL

Legal updates: case law analysis and intelligence

- GL Concepts LLC d/b/a Goodlife, owner of the US trademark GOODLIFE, sought the transfer of 'goodlife.com' under the UDRP
- The panel found that it was not possible for the respondent to have known of the complainant at the time the domain name was registered
- The complainant should have appreciated that it would not be able to prevail under the third element of the UDRP

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied a UDRP complaint for the disputed domain name 'goodlife.com', entering a finding that the complainant had engaged in reverse domain name hijacking (RDNH).

### Background

The complainant, US company GL Concepts LLC d/b/a Goodlife, was listed as the owner of US Trademark Registration No 4750312 for GOODLIFE, registered on 9 June 2015 for goods in Class 25, including shirts, t-shirts, tank tops, sweatshirts, pants, shorts and hats.

The disputed domain name was registered on 24 September 1998. It did not resolve to an active website.

The complainant asserted rights in the GOODLIFE trademark and submitted that the disputed domain name was identical to the trademark. The complainant argued that the respondent had no rights or legitimate interests in respect of the domain name, noting that the respondent had never made active use of the domain name, which had only ever resolved to a landing page. The complainant asserted that the respondent was using the domain name in order to mislead or divert customers for commercial gain by holding the unused domain name "hostage for an exorbitant price tag".

The complainant further submitted that the domain name was registered and was being used in bad faith. According to the complainant, the respondent had failed to use the domain name for any legitimate purpose, and had demanded significant costs from the complainant in reply to the complainant's request to acquire the domain name. The complainant pointed to this as underscoring the respondent's lack of good faith at the time that the domain name was registered, as well as throughout the domain name's subsequent renewal. The complainant further alleged that the respondent held the disputed domain name in order to prevent the complainant from reflecting its GOODLIFE trademark in a corresponding domain name.

The respondent did not come forward to submit a response to the complaint.

To be successful under the UDRP, a complainant must satisfy the requirements of Paragraph 4(a) of the UDRP:

- (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

### ***Paragraph 4(a)(i)***

The panel found the disputed domain name to be identical to the complainant's GOODLIFE trademark. The panel observed that, for purposes of the first element of the UDRP, there was no mention of the date on which the trademark holder acquired its rights, only that such rights had to be in existence at the time that the complaint was filed, and that the fact that a domain name may have been registered before the complainant acquired trademark rights did not preclude a complainant's standing to file a UDRP complaint, nor did it preclude a finding of confusing similarity.

### ***Paragraph 4(a)(ii)***

Noting that the complaint would go on to fail under the third element, the panel did not consider it necessary to address the issue of whether the respondent had rights or legitimate interests in respect of the disputed domain name for purposes of Paragraph 4(a)(ii) of the UDRP.

### ***Paragraph 4(a)(iii)***

The panel observed that the disputed domain name had been registered some 17 years prior to the complainant's registration of the GOODLIFE trademark, and that the domain name was composed of the dictionary terms 'good' and 'life', which may be used in combination for a variety of legitimate uses unrelated to the complainant or its trademark. The panel further noted that the complainant had made no attempt to provide evidence of its use of the GOODLIFE trademark dating back to 1999, the claimed first use in commerce for the mark, nor did the complainant claim to have existed in 1998 when the domain name was registered, nor was there any evidence whatsoever of the respondent having targeted the complainant in any way through the domain name. The panel found that the complainant had failed to explain how the respondent could have registered the domain name in bad faith, and noted that the complainant had provided no evidence of the respondent attempting to sell the domain name at an elevated price, as claimed by the complainant. In the circumstances, the panel found that it was not possible for the respondent to have known of the complainant at the time that the domain name was registered, and that the complainant had failed to establish that the domain name was registered in bad faith. The panel did not consider it necessary to determine whether the domain name had been used in bad faith.

## ***RDNH***

In entering a finding of RDNH, the panel observed that the complainant, who was represented by counsel, should have taken into account that the respondent had been the owner of the disputed domain name for a substantial period prior to the complainant's registration of its GOODLIFE trademark, and for nearly a year before the complainant's claimed first use in commerce of the mark. In the circumstances, the complainant ought to have followed established UDRP precedent that, where a domain name is registered prior to the accrual of a complainant's trademark rights, panels will not normally find bad faith on the part of the respondent. In the present case, the complainant should have appreciated its lack of supporting evidence that the respondent registered and used the domain name in a way that targeted the complainant, and that it would therefore not be able to prevail under the third element of the UDRP.

## Comment

The case falls into the rare class of cases where, despite the complainant having a trademark that is an exact match with the disputed domain name, the case results in a denial. Noting that it is incumbent on a complainant to prove all three elements of the UDRP, and in line with well-established UDRP precedent, where a complainant is unable to produce evidence of its existence at the time that a disputed domain name was registered, such a complaint will almost universally result in a denial, even where a complainant holds an identical trademark at the time of filing of the complaint. Failure to ignore such well-established principles laid down over a substantial body of UDRP cases will, more often than not, lead to a finding of RDNH.

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