

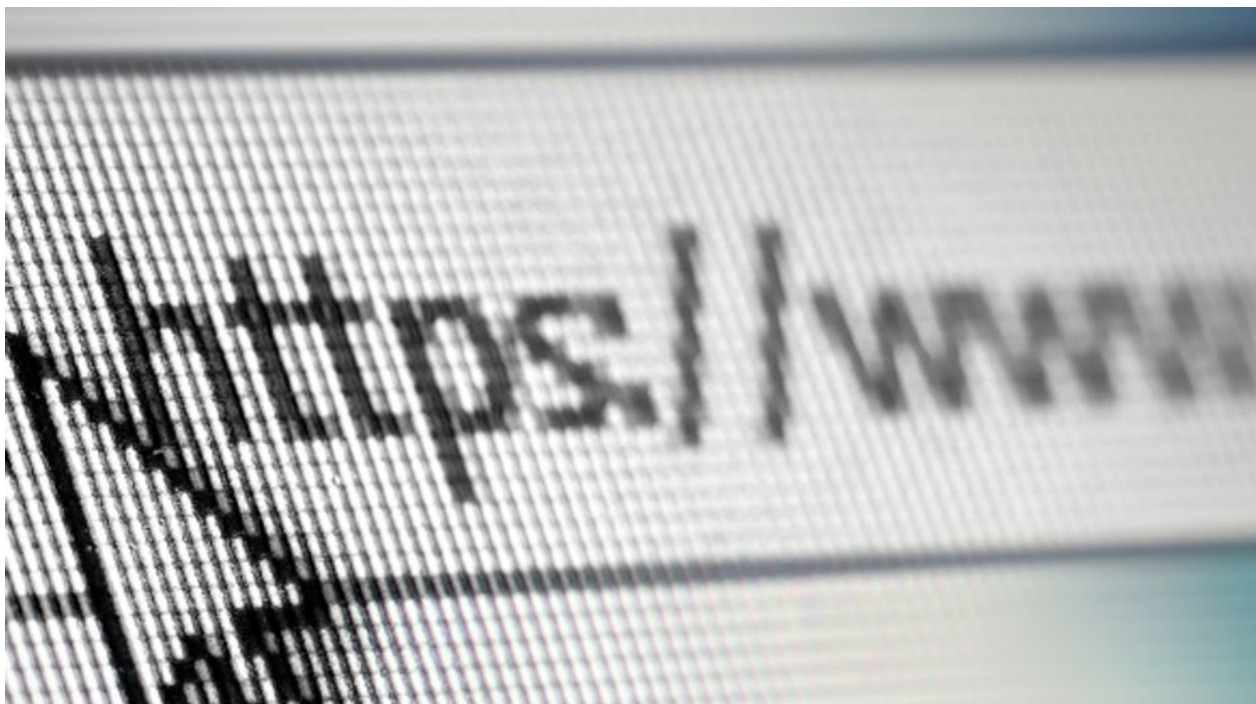


## UDRP complainant makes a false step

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### INTERNATIONAL

Legal updates: case law analysis and intelligence

- The complainant, which makes available the StepsApp pedometer app and owns various STEPSAPP marks, sought the transfer of 'step.app' under the UDRP
- The panel found that the combination of the descriptive words 'step' and 'app' in the domain name was insufficient to demonstrate that the respondent targeted the complainant
- The panel did not agree with the complainant's assertion concerning the similarities between the parties' respective websites

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, finding no indicia of typosquatting, despite the fact that the domain name was merely the singular version of the complainant's domain name and trademark.

### Background

The complainants were Gunther Marktl, an individual, and StepsApp GmbH, a company of which Mr Marktl was the CEO, both based in Austria. The complainant company owned a pedometer application named 'StepsApp' and used the domain name 'steps.app' in connection with a website that promoted the StepsApp pedometer app. Mr Marktl owned various trademarks for STEPSAPP, including International trademark No 1329875 and EU trademark No 015179989, both registered in 2016. The respondent was an individual.

The domain name was 'step.app', registered by the respondent on 6 May 2018. It resolved to a website that promoted a 'Step' development protocol for fitness finance. The website stated that the first app on the protocol was "Step App", which turned fitness goals into income, "powered by technology in metaverse, augmented reality, and blockchain".

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

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

The panel found that the complainant had established rights in the STEPSAPP trademark, which was a figurative mark. The panel was of the opinion that the figurative elements of the mark did not overtake the textual element in prominence and, therefore, should be disregarded in the comparison between the domain name and the trademark. However, the panel found that the figurative elements were relevant to the evaluation of bad faith under the third element. The panel noted that the domain name incorporated most of the textual element of the STEPSAPP mark, omitting only the plural 's' and adding the dot. The panel found that these minor differences would not prevent a finding of confusing similarity because most of the textual element of the mark was recognisable within the domain name in its entirety. Therefore, the domain name was confusingly similar to the complainant's registered trademark.

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

The panel considered that it was unnecessary to evaluate the second limb, given its findings under the third limb.

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

The complainant submitted that the respondent was aware of the complainant's app and domain names and had intentionally misspelt the complainant's trademark in the domain name. The complainant asserted that its domain name and pedometer app were already widely used and known in the fitness-interested consumer market when the domain name was registered in 2018. Moreover, the complainant argued that the similarity between the domain name (including the gTLD extension) and the textual element of its trademark was evidence that the respondent had targeted the trademark. The complainant further claimed that there were similarities between the parties' respective websites, and referred in particular to the capitalisation and position of the logo in the top left-hand corner of each page on the respondent's site.

In response, the respondent stated that he had obtained the most directly descriptive domain name for a step app when seeking to plan and launch a 'play to earn' crypto app based upon counting steps. He argued that the domain name corresponded to the descriptive words 'step' and 'app' and that the complainant could not claim to have acquired distinctiveness in a descriptive term as a mark. He further countered that the names of multiple pedometer apps incorporated the word 'steps' or 'step', and that the complainant's trademark could not confer a monopoly in the words 'steps' and 'app' in the apparently crowded market of apps involving steps.

The third element of the UDRP requires a complainant to establish that the disputed domain name has been registered and is being used in bad faith. Here, the panel underlined that the complainant must demonstrate, with evidence, that the respondent targeted the complainant or its trademark when he registered the domain name.

The panel accepted the respondent's contention that the complainant's trademark had obvious descriptive characteristics. The panel found that the evidence produced by the complainant did not indicate that its mark was well known or particularly associated with the complainant. The panel considered that the combination of the descriptive words 'step' and 'app' in the domain name was insufficient by itself to demonstrate that the respondent targeted the complainant or its mark, even though the domain name spanned the dot in the same way as the complainant's steps.app domain name, contained the singular of the word 'steps' in the complainant's trademark, and was registered after such trademark.

Further, the panel did not agree with the complainant's assertion concerning the similarities between the parties' respective websites. In the panel's view, the capitalisation and position of the respondent's logo were commonplace and could not support either party's case. The respondent's logo also included a running shoe which was not present in the complainant's trademark and it also omitted the plural 's'. Moreover, the panel noted that the respondent's app was a fitness finance app, unlike the complainant's app, and the respondent's website made no reference to the complainant or its app. The panel therefore concluded that the respondent's registration of the domain name was not in bad faith, and it was unnecessary to evaluate use in bad faith. The complaint was thus dismissed.

## Comment

This decision is a reminder that it is often more difficult to prove bad faith when the disputed domain name is similar to a descriptive trademark. In such cases, it is important to prove that the disputed domain name was registered and is being used to target the trademark owner and profit from their goodwill and reputation. In the absence of any tangible evidence of targeting, a UDRP complaint is unlikely to be successful.

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