

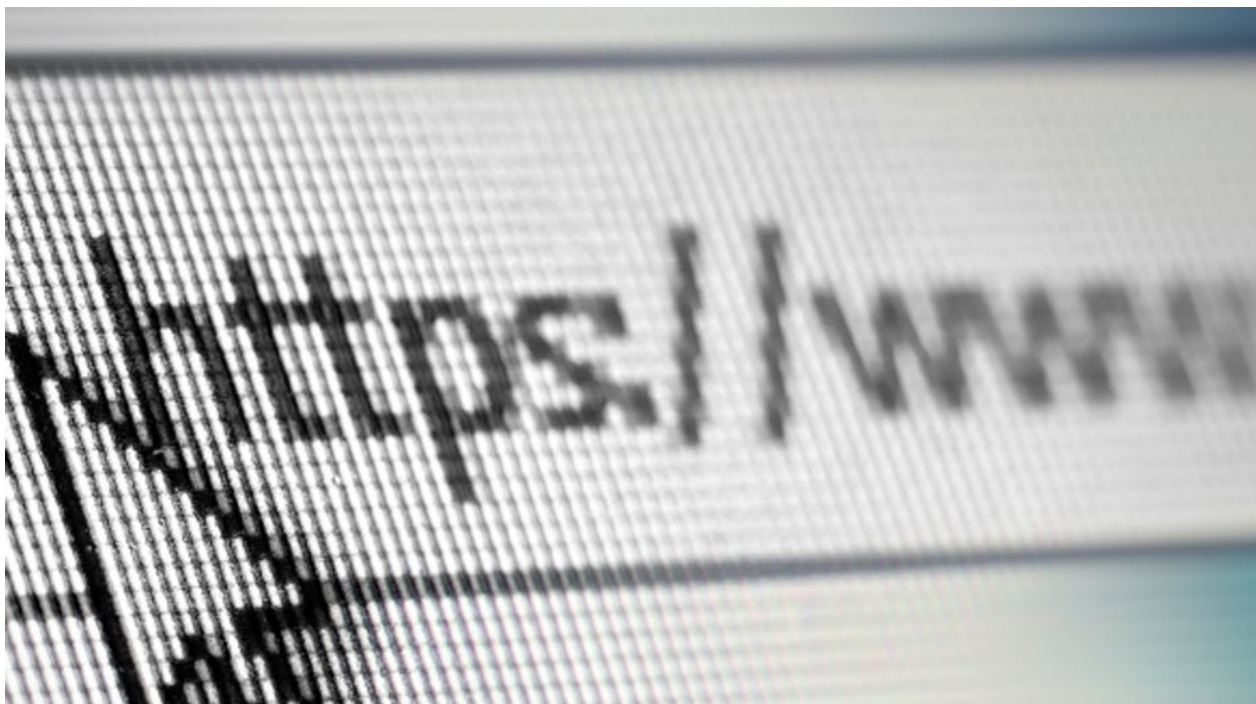


UDRP not 'in service' for complex legal issues

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- Service List Registry Limited sought the transfer of four domain names involving the element 'servicelistregistry' under the UDRP
- The panel found that the UDRP was not a suitable procedure to resolve the dispute
- The nature of the relationship between the parties, and any previous agreements between them, had to be closely examined, which was not possible under the UDRP

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to transfer the domain names 'servicelistregistry.com', 'servicelistregistry.net', 'servicelistregistry.org' and 'servicelistregistry.tv', considering that the complex issues at hand were unsuitable to be decided under the UDRP.

Background

The first complainant was Service List Registry Limited, a company based in the United Kingdom, operating in the television and broadcasting sector. The second complainant was an individual, sole trader at an independent consultancy operating in the television and media sector and sole director of the first complainant. The respondent was also an individual, sole director of Peckham Data Centre Limited, a company based in the United Kingdom, and initially incorporated as Service List Registry Project Limited.

The second complainant and the respondent began their business relationship before the incorporation of the first complainant and Peckham Data Centre Limited in 2022. In 2021 they worked together on a response to a request for proposal (RFP) issued by the DVB Project to develop a DVB-I Central Service List Registry. As part of their response, the respondent offered to register the domain names, and then did so listing his personal email address and "Peckham Data Centre Limited" (although the company was not incorporated until later, in June 2022). The response to the RFP was submitted in July 2021, with the second complainant identified as the project director and the respondent as the technical architect.

In April 2022 the first complainant was incorporated and the respondent noted that he would update the contact details for the domain names. However, the parties' relationship subsequently broke down and the respondent decided that he no longer wished to participate in the project. When the second complainant provided the information for transfer of the domain names, the respondent requested to be compensated for work done. The second complainant offered to cover certain costs (including registration of the domain names), but the respondent refused and indicated that the second complainant could purchase the domain names for £5,000. The respondent then modified the website that 'servicelistregistry.org' pointed to so that it read "Dude, where's my content?".

The complainants initiated proceedings under the UDRP for a transfer of ownership of the domain names. 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 first complainant claimed to own an unregistered trademark for SERVICE LIST REGISTRY which had been used on the homepage of the complainants' website since 2021. The respondent disputed this, noting that they were common words.

Under the second element of Paragraph 4(a), the complainants argued that the respondent registered the domain names for the purposes of the project in accordance with their agreement, and therefore then breached that agreement by using his personal details. The respondent denied the existence of any implied agreement in this regard.

Under the third element of Paragraph 4(a), the complainants contended, among other things, that the respondent's offer to sell the domain names was in bad faith. The respondent retorted that neither the first complainant nor any trademarks existed when the domain names were registered, and stated that he no longer wished to sell the domain names due to the complainants' conduct.

Setting aside the arguments of the parties, albeit after a lengthy description of their numerous submissions, the panel found that the UDRP was not a suitable procedure to resolve such a dispute. The panel explained that, in order to determine whether the respondent had rights or legitimate interests in the domain names, or whether he had registered and used the domain names in bad faith, the nature of the relationship between the parties, and any previous agreements or trust arrangements between them, had to be closely examined. The panel underlined that such determination was unavailable under the UDRP, given the lack of means traditionally available to the courts, such as cross-examination or discovery orders, among other things.

Comment

This decision serves as a reminder of a fundamental notion regarding alternative domain name dispute resolution proceedings: they were originally designed to tackle clear-cut cybersquatting cases. Complex issues involving a prior business relationship and requiring a determination on the existence of a binding agreement, as in the present case, are not suitable for a ruling under the UDRP, which is a written submissions-only procedure.

Beyond domain dispute proceedings, this case also illustrates the difficulties surrounding domain name ownership in the context of a joint venture. Ideally, a domain name created for the purpose of a joint venture should be registered from its inception by the entity which will be used to carry on the joint venture. If this is impossible, then it would be preferable to draft a clear and unambiguous agreement concerning the registration, as well as the potential transfer of any domain name to the relevant entity, in order to avoid future disputes surrounding ownership of the domain name.

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