

UDRP complaint falls at the first hurdle

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- Majors Law Group PC sought the transfer of 'majorslawgroups.com' under the UDRP, claiming unregistered or common-law rights in MAJORS LAW GROUP
- The panel found that the complainant had made assertions, unsupported by evidence, that it had made continuous and extensive use of the mark
- The complainant had failed to satisfy the first element of Paragraph 4(a) and lacked standing to bring the complaint

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 'majorslawgroups.com'. The panel found that the complainant did not enjoy common-law rights in the claimed mark and so did not have standing to bring the complaint.

Background

The complainant, Majors Law Group PC, was a US law firm specialised in debt relief agency. The complainant was founded on 1 June 2019 in Arizona and expanded to Washington state in 2021. The complainant provided legal services under the name Majors Law Group and promoted its services on its website in connection with the domain name 'majorslawgroup.com', but did not own any registered trademarks for 'Majors Law Group' or 'Majors Law Group PC'.

The disputed domain name was registered on 8 June 2021 with the registrar OVH. At the time of filing the complaint, the disputed domain name resolved to a website in English that provided criticism of the complainant and its attorneys.

Originally, the respondent's identity was concealed behind a privacy service, but the registrar subsequently revealed that the respondent was an individual. The underlying registrant details showed that the respondent was based in Mexico, but his social media accounts indicated that he was based in California, United States.

Parties' contentions

The complainant argued that it enjoyed unregistered or common-law rights in the trademark MAJORS LAW GROUP (or MAJORS LAW GROUP PC). It claimed that it had represented over 2,000 clients in Arizona since 2019 and had provided legal services under this trademark continuously and extensively since 1 June 2019.

The complainant submitted that, as a result of its continuous and extensive use of the MAJORS LAW GROUP trademark, the trademark had accrued substantial goodwill and was known locally, in at least Arizona and Washington state, to represent its law firm.

The complainant argued that the disputed domain name was identical or effectively identical to its MAJORS LAW GROUP trademark.

The complainant also submitted that the respondent had no rights or legitimate interests in the disputed domain name. Although the respondent had a right to establish a website for the purpose of legitimate criticism and commentary, the complainant argued that it may not do so via a domain name that was identical or confusingly similar to the complainant's trademark and domain name. The complainant added that the respondent registered the disputed domain name for the sole purpose of confusing and diverting internet users from the complainant's website to the respondent's defamatory site, which did not constitute fair or non-commercial use and, furthermore, constituted registration and use in bad faith.

The respondent did not submit a response to the complaint.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements under Paragraph 4(a):

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 domain name has been registered and is being used in bad faith.

Analysis

Under Paragraph 4(a)(i) of the UDRP, the panel found that to establish common-law trademark rights, the complainant must show that its claimed mark had become a distinctive identifier that consumers associated with its goods or services. To show this, the complainant must provide specific evidence on a range of factors including:

- the duration and nature of use of the trademark;
- the amount of sales under the trademark;
- the nature and extent of advertising; and
- the degree of actual public recognition.

The panel found that the complainant had not presented any evidence in support of its claimed common-law rights in the trademark. Rather, the complainant had made assertions, unsupported by evidence, that it had made continuous and extensive use of the trademark for three years, including that it had represented over 2,000 clients in Arizona since 2019.

In light of the absence of evidence adduced by the complainant, the panel used its general powers under Paragraphs 10 and 12 of the Rules for UDRP to view the complainant's website and the website to which the disputed domain name resolved. The panel found that, although both websites referred to the complainant as 'Majors Law Group', the content of these websites was not sufficient for the complainant's claimed trademark to enjoy acquired distinctiveness and for the complainant to have accrued common-law rights in the trademark.

In particular, the panel noted that the logo displayed on the complainant's website with the words 'Arizona's Premier Law Firm' and the graphic of five stars and two badges with laurel wreaths did not constitute awards or ratings that indicated public or industry recognition.

The panel also considered whether the respondent's challenges to the complainant on its website (including the challenge to the complainant's assertion that it had represented 2,000 clients despite only having been licensed for two years) constituted evidence of recognition of the complainant's trademark. Ultimately, the panel found that the challenges were insufficient for common-law rights to have accrued in the claimed trademark.

Decision

The panel found that the complainant failed to satisfy the first element of Paragraph 4(a) of the UDRP and so lacked standing to bring the complaint.

The panel also rejected the complainant's additional claim that the disputed domain name was identical, or confusingly similar, to its own domain name ('majorslawgroup.com'), noting that the first element of Paragraph 4(a) of the UDRP requires a demonstration of identity or confusing similarity to a trademark or service mark.

Comment

This case falls into the rare class of cases where a complainant is found not to have standing to bring a complaint under Paragraph 4(a)(i) of the UDRP. The decision highlights the importance of providing specific evidence across a range of factors when seeking to prove common-law rights, including - but not limited to - the duration and nature of use of the trademark, the amount of sales under the trademark and the degree of actual public recognition. Where a complainant cannot or does not produce evidence of its common-law rights in a trademark and instead makes conclusory allegations, the complaint will almost universally result in a denial, even if the complainant's allegations are undisputed.

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