

Ignoring well-established UDRP principles results in RDNH

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- ProjectPay Pty Ltd, the owner of various registrations for PROJECTPAY, sought the transfer of 'projectpay.com' under the UDRP
- The panel noted that, when the respondent registered the domain name, the complainant was not yet established and had no rights in the trademark

- **The complainant knew, or should have known, at the time of filing the complaint that it was unable to prove one of the essential elements required by the UDRP**

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a three-member panel has denied the transfer of the domain name 'projectpay.com'. The decision was on the basis that the complainant had failed to show that the respondent registered the disputed domain name in bad faith, and the panel entered a finding that the complainant had engaged in reverse domain name hijacking (RDNH).

Background

The complainant was ProjectPay Pty Ltd, an Australian company that started running an online payment and accounting platform for use in the construction industry in 2015. The respondent was an individual based in Canada.

The respondent registered the domain name 'projectpay.com' on 27 June 2001.

The complainant owned various trademark registrations for the word mark PROJECTPAY throughout the world, including in Canada and a supplemental registration in the United States. The earliest of the complainant's trademarks was registered on 29 May 2017.

The complainant also had registered domain names containing the trademark PROJECTPAY dating back to May 2017.

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

- (a) The domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
- (b) The respondent has no rights or legitimate interests in respect of the domain name; and
- (c) The disputed domain name has been registered and is being used in bad faith.

Parties' contentions

Regarding the first limb, the complainant argued that the disputed domain name was confusingly similar to its PROJECTPAY trademark and, more specifically, that it incorporated the trademark in its entirety. The respondent, who submitted a comprehensive response, argued that the complainant's supplemental registration in the United States was insufficient for the purposes of the first element. The respondent also argued, in terms of use of the trademark, that the complainant first used the trademark "as early as 2015" prior to its formation in 2017, yet the respondent registered the disputed domain name in 2001.

In relation to the second limb, the complainant argued that the respondent had no rights or legitimate interests in the disputed domain name. In response, the respondent contended that it did in fact have rights or legitimate interests as the disputed domain name was a two-word domain name registered for prospective use by the real estate development company with which the respondent was engaged

Regarding the third limb, the complainant argued that, by registering the disputed domain name, the respondent intended to take advantage of the complainant's activities as it was offering items that were identical or directly related to the complainant's goods and services on the webpages to which the domain name resolved. The complainant also argued that the respondent was aware of the complainant's business and had intentionally attempted to attract internet users to the corresponding

webpages for financial gain by creating a likelihood of confusion with the complainant's trademark. In addition, the complainant asserted that the respondent was attempting to interfere with the complainant's business and was preventing the complainant from reflecting its business name in the '.com' top-level domain.

In response, the respondent argued that it simply could not have registered the disputed domain name in bad faith in 2001 as, at that time, the complainant's rights were non-existent. The respondent also noted that the complainant had made no attempt to explain how the disputed domain name was registered in bad faith.

Analysis

In relation to the first limb, the panel accepted that the complainant owned registered trademarks for PROJECTPAY and that the disputed domain name included the trademark in its entirety and was therefore identical to the trademark in which the complainant had rights.

The panel found that it was not required to consider the second limb in light of its analysis of the third limb.

In this regard, the panel found that the complainant had not satisfied the third limb as it had failed to make out a case that the respondent had registered the disputed domain name in bad faith. Importantly, the panel noted that the respondent's registration of the domain name was at least 14 years before the complainant was established and acquired trademark rights. The panel referred to [Section 3.8](#) of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions 3.0, and found that this timing precluded a finding of bad-faith registration since the respondent had registered the disputed domain name at a time when the complainant was not yet established and had no rights in the trademark. As a result, the respondent could not possibly have been aware of the complainant and its business or known about the complainant's trademark rights when registering the disputed domain name.

RDNH

The UDRP Rules define RDNH as "using the policy in bad faith to attempt to deprive a registered domain name holder of a domain name". The panel found that the complainant knew, or should have known, at the time of filing the complaint that it was unable to prove one of the essential elements required by the UDRP, namely registration in bad faith. The panel noted that it was "very clear" that the respondent had registered the domain name many years before the complainant came into existence and filed and registered the PROJECTPAY trademark.

The panel noted that the complainant or its attorney must have been fully aware of the cumulative requirements of registration and use in bad faith when filing the complaint, given the statements included therein, and therefore found that the facts justified a finding of RDNH.

Comment

This case highlights the need for complainants to consider carefully whether they should file a UDRP complaint if the trademark on which they intend to rely was registered after the disputed domain name was registered. In line with well-established UDRP precedent, where a complainant did not exist 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. While there is an exception to this rule, the circumstances in which the exception will apply are limited. A 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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