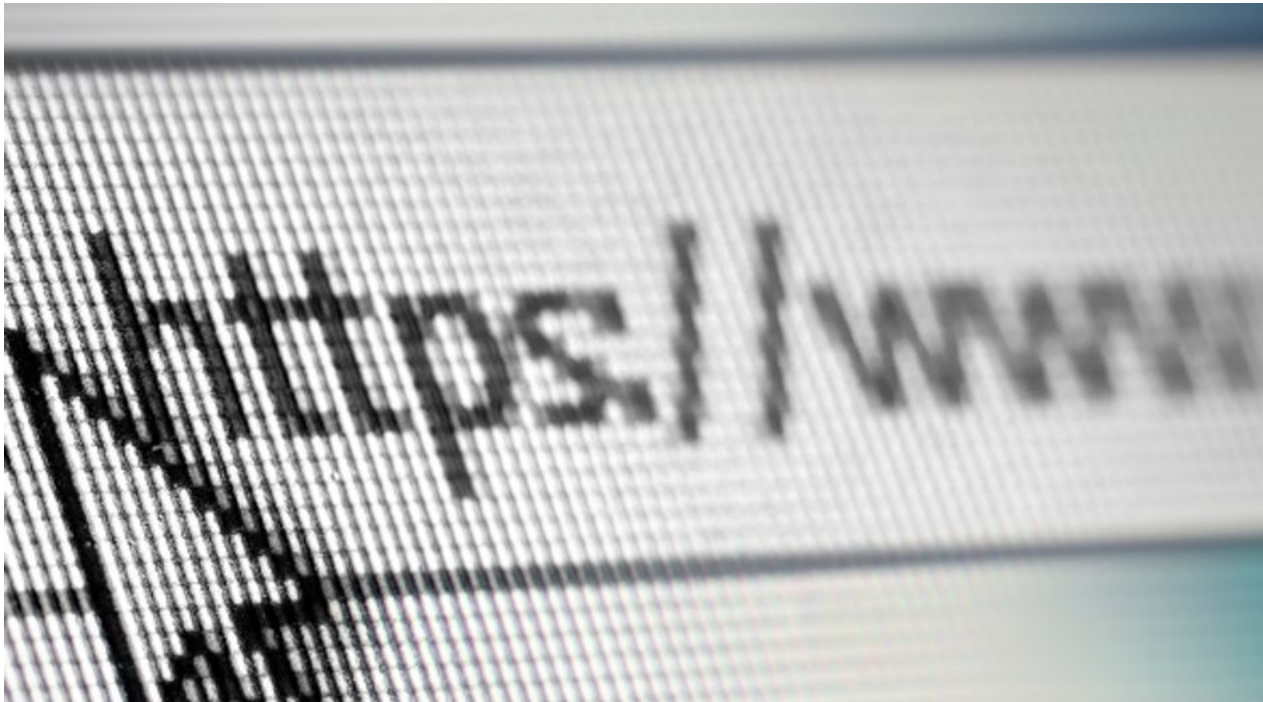


UDRP complainants: beware when domain names predate trademark rights

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INTERNATIONAL

Legal updates: case law analysis and intelligence

- Unicaf Ltd (previously UNIC Online Limited), the owner of the EUTM UNICAF, sought the transfer of 'unicaf.com' under the UDRP
- The respondent claimed that he had registered the domain name in 2011, much earlier than the complainant's change of corporate name
- The panel found that there was nothing in the record to suggest that the respondent had the complainant in mind when registering the domain name, or even that the complainant was active at the time

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied a complaint for the domain name 'unicaf.com' on the basis that the complainant had failed to show that the respondent registered and used the domain name in bad faith. The panel also entered a finding that the complainant had engaged in reverse domain name hijacking (RDNH).

Background

The complainant was Unicaf Ltd, a Cypriot company running an online platform linked to higher education. The complainant's corporate name, Unicaf Ltd, had been registered in the Register of Companies for Cyprus since 2019, although previously, from 2012, it had been UNIC Online Limited.

The complainant was the owner of the EU trademark UNICAF (figurative) (No 013502075), registered on 5 May 2015. The complainant also owned domain names such as 'unicaf.org' (registered in 2013) and 'unicafuniversity.com' (registered in 2014).

The respondent was an individual located in Canada. The respondent registered the domain name on 18 November 2011. It resolved to a pay-per-click page (PPC page) which included links related to university scholarships.

The complainant initiated proceedings under the UDRP for a transfer of ownership of the domain name. It argued that it had established all three elements required under Paragraph 4(a) of the UDRP for a transfer of the domain name.

The respondent claimed that he had registered the domain name in 2011, much earlier than the change of corporate name of the complainant, which took place in 2019. He also stated that he had no intention of taking advantage of the complainant's programmes, and that the corresponding website did not look like the complainant's website. Finally, the respondent sought a finding of RDNH.

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.

Decision

First limb

The panel accepted that the complainant owned a registered trademark for UNICAF and that the domain name included the trademark in its entirety and was therefore identical to the trademark in which the complainant had rights.

Second and third limbs

The panel did not 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 prove that the respondent had registered and used the domain name in bad faith. The panel noted that the respondent registered the domain name in 2011, whereas the complainant filed its UNICAF trademark in 2014. The panel noted that, where a respondent had registered a domain name before a complainant's trademark rights had accrued, panels would not normally find bad faith on the part of the respondent.

Further, the panel underlined that the complainant had been initially incorporated in 2012 under the name UNIC Online Limited and had only registered domain names containing the term 'unicaf' from 2013.

Consequently, the panel stated that there was nothing in the record to suggest that the respondent might have had the complainant in mind when registering the disputed domain name in 2011, or even that the complainant was active at the time.

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". In the present case, taking into account the circumstances detailed above, the panel found that the complainant had engaged in RDNH.

Comment

Complainants should think seriously about filing a UDRP complaint if their trademark was registered after the domain name at issue. As Section 3.8.2 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#), notes, if this is the case, panels are prepared to find that a respondent has acted in bad faith only in certain very limited circumstances, where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalise on the complainant's nascent trademark rights. For example, such scenarios include registration of a domain name shortly before or after the announcement of a corporate merger or further to a respondent's insider knowledge. If there is no evidence to suggest that the respondent had the complainant in mind when registering a domain name, then the complaint will almost certainly be denied. In addition, there is a high risk that the panel will make a finding of RDNH.

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