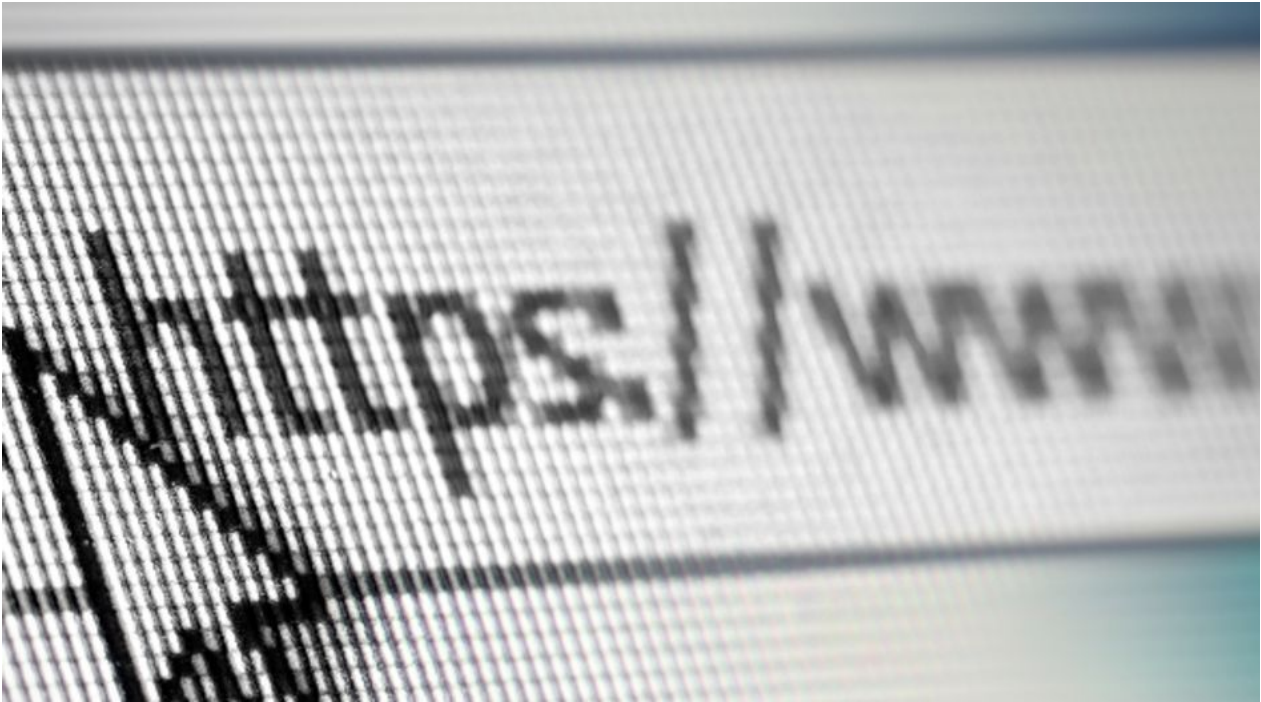


UDRP complaint proves a bridge too far

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16 October 2023



INTERNATIONAL

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- InQuik, owner of Australian and US trademarks for INQUIK, sought the transfer of 'inquik.com' under the UDRP
- The panel underlined that the domain name had been registered 10 years before the complainant's establishment and the commencement of its use of the mark
- The complainant had offered no details or evidence about the extent of its advertising of the mark or the degree of consumer renown attaching to that mark

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to order the transfer of the domain name at issue because the complainant had failed to demonstrate that the respondent had registered and used the domain name in bad faith.

Background

The complainant was InQuik IP Holdings Pty Ltd, an Australian supplier of bridging products and technology. The respondent was DPLiqGr, an individual or entity based in the United States.

The disputed domain name, 'inquik.com', was registered in 2006 and had never pointed to a fully developed website. At the time that the UDRP complaint was filed, the domain name was pointing to a pay-per-click website displaying three hyperlinks, namely "HP Printer Ink cartridges", "Fast", and "Quick Lube Nearby". Before filing the complaint, the complainant had approached the respondent through a domain name broker, proposing a purchase of the domain name for \$1,000. However, the respondent never replied to this offer, nor to any subsequent messages from the domain name broker.

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 complainant submitted that it owned an Australian trademark for INQUIK with a priority date of 13 September 2016, as well as a US trademark for INQUIK with a registration date of 13 March 2017. The respondent did not dispute this and the panel found that the disputed domain name was indeed identical to the complainant's trademark. The panel thus considered that the complainant had satisfied the first requirement under the UDRP.

Second and third limbs

In light of its findings under the third limb of the UDRP, the panel did not comment on the eventual existence of the respondent's rights or legitimate interests.

Turning to the third requirement of the UDRP, the complainant asserted that the disputed domain name had been registered in bad faith. The complainant argued that its business, launched in 2016, had developed a highly respected and expansive customer network across Australia, New Zealand and the United States. The complainant stated that it had successfully created a significant reputation in the bridge construction industry and in the trademark INQUIK. The respondent rebutted these arguments by simply stating that it had registered the domain name 10 years before the complainant came into existence and began using the INQUIK mark.

The panel agreed with the respondent and underlined that the domain name had been registered an entire decade prior to the complainant's establishment and the commencement of its utilisation of the INQUIK mark. The panel also found that there was no basis in the record to suspect that ownership of the domain name changed hands from a prior owner to the respondent at some potentially relevant point in time (ie, after the complainant began using the INQUIK mark). Further, the panel found that, apart from two "fairly esoteric" industry awards from 2019 and 2021, the complainant had offered no details or evidence about the extent of its advertising of the INQUIK mark or the actual degree of consumer renown attaching to that mark. Accordingly, the panel decided that the respondent had not registered and used the domain name in bad faith and so the complainant had not satisfied the third requirement under the UDRP. Therefore, the panel denied the transfer of the domain name to the complainant.

Comment

This decision highlights once again how having a trademark, by itself, does not necessarily mean that a trademark holder will succeed in obtaining the transfer of a domain name under the UDRP, even if it is identical to such trademark. As underlined by the panel, it is crucial to provide necessary evidence to support the submissions in the complaint. Such evidence may include not only trademark registrations and industry awards, but also market surveys and studies, media coverage and press releases, customer testimonials and user-generated content, web traffic and online analytics, product sales and market share, elements of consumer outreach, as well as brand building.

Evidence is particularly important when a domain name was registered or acquired before a complainant acquired trademark rights. Such cases often fail under the UDRP except in very specific circumstances indicting bad faith, such as significant media attention, insider knowledge or the filing of a trademark application by a complainant. Cases where a complainant also initially attempts to buy a domain name before filing a UDRP (commonly known as 'Plan B' cases) are doubly doomed.

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