

UDRP is not convenient recourse for business disputes
International - Hogan Lovells

Cybersquatting
Internet issues

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In a [recent decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the [World Intellectual Property Organisation](#) (WIPO), a panel has denied the transfer of a domain name and declined to decide whether the three elements of the UDRP had been satisfied, as it was evident that the case was not an instance of cybersquatting but, rather, a business dispute between ex-partners involving substantive legal issues beyond the scope of the UDRP.

The complainant was Nancy L Lanard, an attorney admitted to practice in Pennsylvania, with over 38 years of experience, mainly in the areas of business and franchise law. She formed the Law Offices of Nancy L Lanard in 2001 and registered the domain name 'lanardlaw.com' on January 23 2002. The complainant began marketing her firm using the domain name the same year.

The respondent was Whols Agent, Whols Privacy Protection Service Inc of Kirkland, Washington and Josh Lignana, Spadea Lignana LLC of Philadelphia, Pennsylvania.

In 2011, after the complainant entered into discussions with two recently qualified attorneys, Mr Spadea and Mr Lignana, it appeared that all parties involved (Mr Spadea, Mr Lignana and the complainant) came to the conclusion that it would be mutually beneficial to combine their law practices. The law firm Spadea, Lanard & Lignana ('SLL') was therefore formed on November 15 2011. An operating agreement was signed in order to organise the transfer of assets – including intellectual property – from the Law Offices of Nancy L Lanard to SLL. The domain name 'spadealaw.com' was registered and the parties agreed to redirect the domain name 'lanardlaw.com' to 'spadealaw.com' in January 2012.

After about four years, on March 19 2016, the complainant notified the other parties of her intention to withdraw from the arrangement. She then formed the firm Lanard and Associates and began operating a website under the domain name 'lanardandassociates.com'. Mr Lignana and Mr Spadea started operating a law firm called Spadea Lignana LLC ('Spadea Law') using the domain name 'spadealaw.com'.

The complainant then contacted the registrar of the domain name 'lanardlaw.com' to ask that it no longer be redirected to 'spadealaw.com' and was informed that the respondent had taken control of the domain name and refused to transfer it. As of June 15 2016, the registrant and registrant organisation on the domain name WHOIS changed from Nancy Lanard and the Law Offices of Nancy L Lanard to WHOIS AGENT and WHOIS PRIVACY PROTECTION SERVICE INC.

The complainant filed a UDRP complaint to seek to recover the domain name 'lanardlaw.com' and, in parallel, filed separate ethics claims against her ex-business partners with the Pennsylvania Office of Disciplinary Counsel.

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

- (i) The 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 respect of the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

Given the complexity of the case and the clear need to assess the merits of what were essentially contract law issues, the panel declined to assess each of the above elements. The panel found that this was not a cybersquatting case and that the mere fact that the dispute concerned who had rights to the domain name did not justify filing a complaint under the UDRP, as this was rather a business dispute to be resolved and interpreted in accordance with Pennsylvania law. In addition, the panel found that the complainant's claims of ethics violations were also clearly outside the scope of the UDRP.

The panel aptly referred to a previous WIPO decision under the UDRP, *The Thread.com LLC v Poploff* (WIPO Case No D2000-1470):

"(...) To attempt to shoehorn what is essentially a business dispute between former partners into a proceeding to adjudicate cybersquatting is, at its core, misguided, if not a misuse of the policy."

Forum shopping is common practice whereby quicker, cheaper and more convenient solutions are sought. This is illustrated by the present case where the UDRP, despite not being really suitable, was preferred over court litigation. The decision must be applauded, as it is important to preserve the integrity and efficacy of the UDRP, and not allow it to be diluted and used for other ends.

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