

UDRP complaint unlikely to succeed without proof of bad-faith registration, even if respondent's subsequent use is questionable **Cybersquatting Internet issues**
International - Hogan Lovells

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- **Owner of common law rights in DRIBBBLE sought transfer of 'dribble.com'**
- **Domain name was registered 12 years before complainant adopted its mark, so registration could not have been in bad faith**
- **Panel nevertheless noted that links on corresponding website seemed to attempt to take advantage of complainant's mark**

In a [recent decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP or the 'policy') before the World Intellectual Property Organisation, a panel has denied the transfer of a domain name that was confusingly similar to the complainant's trademark rights as it had been registered some 12 years before the complainant had adopted such trademark, and thus registration could not have been in bad faith.

The complainant was Dribbble Holdings Ltd of Victoria, Canada, the operator of an internet platform through which graphic designers, web designers, illustrators, photographers and other creative professionals could demonstrate and promote their works. The complainant had a trademark application pending in the United States since 2017 and claimed first use in commerce of this mark in the United States in July 2009.

The respondent was Domain Administrator of Eden Prairie, Minnesota, United States / Hitsville LLC of St Paul, Minnesota, United States.

The disputed domain name 'dribble.com' was registered on 13 October 1997 and resolved to a website consisting of pay-per-click links.

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

- (i) the domain name registered by the respondent 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.

With regard to the first limb, even though the complainant's pending trademark application did not by itself satisfy the requirement of trademark rights under the policy, the panel found that it was likely that the complainant had acquired common law rights in DRIBBBLE as an unregistered trademark. The disputed domain name therefore differed from the complainant's trademark rights only by the omission of a single letter 'b'. The respondent underlined that the disputed domain name consisted of an ordinary English word, 'dribble', but the panel pointed out that this was not relevant regarding the first UDRP requirement, as shown by 'typosquatting' cases where a minimal difference between the complainant's trademark and the disputed domain name constituted confusing similarity under the policy. As a consequence, the panel concluded that the complainant had satisfied the first limb.

As far as the second requirement under the UDRP was concerned regarding the respondent's rights or legitimate interests, the panel did not consider it necessary to make a finding in light of its considerations as to the third limb relating to registration and use in bad faith.

Turning to the third requirement, the complainant asserted that the pay-per-click links present on the website to which the disputed domain was pointing appeared to be an attempt to take advantage of its mark. Such links were related to graphic and other design services which were linked to the complainant's field of business. However, despite this the panel noted that the respondent had registered the disputed domain name around 12 years before the complainant had adopted its trademark. Accordingly, the panel was satisfied that the respondent could not have registered the disputed domain name in bad faith and so the third limb was not satisfied. The panel stressed that it was necessary for the complainant to prove both registration and use in bad faith in order to succeed, and that such requirements were cumulative. Therefore, the panel denied the transfer of the domain name to the complainant.

Finally, the panel also considered whether a finding of reverse domain name hijacking (RDNH) was

appropriate. RDNH is defined in Paragraph 1 of the UDRP Rules as "using the policy in bad faith to attempt to deprive a registered domain name holder of a domain name". In this case, the respondent argued that the panel should make a finding of RDNH because it had suffered undue expense in both time and costs as a result of the complaint. The lack of prior contact from the complainant to resolve the issue amicably was also underlined by the respondent. However, the panel refused to make a finding of RDNH mainly because, as the complainant had argued, the links appearing on the corresponding website related to a range of graphic and other design offerings and thus appeared to be an attempt to take advantage of the complainant's trademark, given that the word 'dribble' was an ordinary English word and so did not appear apt to describe the types of services being provided by the respondent's website.

This decision highlights how having protectable rights does not necessarily mean that the rights holder will succeed in obtaining the transfer of a domain name even if it is confusingly similar to such rights. This is particularly the case when a disputed domain name was registered well before a complainant acquired any rights. As this case makes clear, under the UDRP it is crucial to prove both registration and use in bad faith. If a complainant fails to prove bad faith registration then a UDRP complaint is highly unlikely to succeed, even in the face of subsequent questionable use by a respondent. This is in contrast to some alternative dispute resolution procedures put in place by certain country-code top-level domains, which have adopted an amended version of the UDRP requiring only registration or use in bad faith. As a result, this may sometimes result in a different outcome to the UDRP on exactly the same facts.

Jane Seager and Maria Rozylo, Hogan Lovells, Paris

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