

[Three-member panel refuses to transfer domain name consisting of complainant's mark - but one panellist dissents](#) **Internet issues**
International - Hogan Lovells

March 08 2018

- **Three-member panel denied transfer of domain name identically reproducing complainant's mark**
- **Panel was satisfied that respondent's motivation to register domain name was its descriptive value**
- **One panellist dissented and would have ordered transfer of domain name**

In a [recent decision](#) under the Uniform Domain Name Dispute Resolution Policy (UDRP) before the World Intellectual Property Organisation, a three-member panel has denied the transfer of a domain name identically reproducing a complainant's trademark for failure to show bad-faith registration. However, the denial was not unanimous as one of the panel members dissented and would have ordered a transfer of the domain name at issue.

The complainant was Türkiye Cumhuriyeti Ziraat Bankasi Anonim Sirketi of Ankara, a large bank headquartered in Turkey. The bank, which owned the registered trademark BANKKART, had been using the term 'bankkart' on its bank cards for use in automatic teller machines and terminals.

The respondent was Rahul Jain, Jaano LLC of Edgewater, a company based in New Jersey, United States. The domain name was 'bankkart.com', which was registered by the respondent in 2013. It was currently offered for sale for \$998.

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.

As far as the first requirement under the UDRP was concerned, the panel found that the complainant's BANKKART trademark was identically reproduced in the domain name without adornment. Therefore, the panel found that the domain name was identical to the complainant's trademark, although it noted that questions such as the scope of trademark rights or the geographical locations of the parties was not relevant at this stage.

The panel then focused on the third requirement under the UDRP, namely whether the respondent had registered and used the domain name in bad faith. The complainant argued that the respondent was aware of its rights at the time of registration of the domain name, because of the fact that the disputed domain name was for sale. The respondent denied having knowledge of the complainant at that time.

The respondent further pointed to the descriptive nature of the term 'bankkart' in many different languages, as it could be translated into English as 'bank card' and was used by a number of other banks outside Turkey to refer to their own bank cards.

The panel rejected the respondent's claim that it registered the disputed domain name before the complainant had secured any registered rights in any trademark which could extend rights over the term 'bankkart'. The panel noted that under Turkish law, as in many jurisdictions, the complainant's rights ran from the date of filing, which, in the present case, was 2012.

The respondent argued, however, that the scope of protection conferred by the trademark registered by the complainant did not extend to the verbal element, 'bankkart', without the stylistic elements making up the complainant's logo. To support this claim, the respondent contended that the complainant applied to register the term 'bankkart' alone in Turkey as a trademark but the Turkish authorities refused that registration because of the descriptiveness of the term, first in 2002 and then again in 2007.

The panel, however, took note of the 2017 decision of the Re-examination and Evaluation Board of the

Turkish Patent and Trademark Institution who finally agreed with the complainant that the term 'bankkart' had acquired distinctiveness through extensive use and recognition. The panel therefore concluded that the term 'bankkart' became distinctive of the complainant in Turkey sometime between 2007 and 2017.

However, the respondent also asserted that it had registered at least 20 other similar domain names because of their descriptive significance, including 'babykart.com' and 'mobilephonekart.com'.

As a result, the panel was satisfied that the respondent's motivation to register the domain name was its descriptive value. The panel also underlined the lack of evidence that the respondent had knowledge of the complainant's rights and registered the disputed domain name in bad faith. The panel found it therefore unnecessary to address the second requirement under the UDRP (related to the respondents rights or legitimate interests in the domain name) and the complaint was denied.

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 panel concluded that it was not appropriate to make a finding of RDNH where one member of the panel dissented and would have transferred the domain name.

In this regard, one panel member did not agree with the decision issued. He found in favour of the complainant on the second element of the UDRP (the respondent's lack of rights or legitimate interests) and on the third (concerning the respondent's registration and use in bad faith).

The dissenting opinion focused on (i) the distinctive character of the term 'bankkart' that the complainant had been using since the 1980s, (ii) the bad faith of the respondent who, in the panel's opinion, was seeking to profit from the sale of a confusingly similar domain name that incorporated a third party's trademark and (iii) the respondent's absence of rights or legitimate interests in the disputed domain name.

Concerning the last point (iii), the dissenting panel member relied on the complainant's assertion that the respondent was using the website associated with the disputed domain name to create the impression that it was in some way connected to, or associated with, the complainant and its services when this was not the case. The dissenting panel member was therefore satisfied that the complainant had made out a *prima facie* case that the respondent had no rights or legitimate interests in the disputed domain name based upon these submissions. As a consequence, the burden of proof should have shifted to the respondent accordingly to bring forward evidence of its rights and legitimate interests in the disputed domain name. As far as the dissenting panel member was concerned, this burden of proof was not met by the respondent, who did not provide evidence of the use of the disputed domain name in respect of any independent business, only in connection with pay per click links. As a result, the dissenting panel member found that the respondent was not making use of the disputed domain name in connection with a good-faith offering of goods or services or making a legitimate non-commercial or fair use of the disputed domain name, and thus would have found for the complainant on the second element of the UDRP and ordered a transfer.

The decision is a reminder of how panels can sometimes come to completely opposite conclusions based on exactly the same facts, which is why it is worth considering the use of a three-member panel in particularly difficult or complex cases.

David Taylor and Maria Rozylo, Hogan Lovells, Paris

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.