

UDRP proceedings: hedge your bets by demonstrating proof of bad faith
International - Hogan Lovells

Cybersquatting
Internet issues
Domain names

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- **WIPO panel refused to transfer 'dafabetuganda.com' to owner of Ugandan mark DAFABET**
- **Panel not convinced that respondent was aware of complainant's rights**
- **Registration more likely to have been done in good faith based on respondent's own rights**

In a [recent decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the World Intellectual Property Organisation, a panel has denied the transfer of a domain name consisting of an identical reproduction of the complainant's trademark followed by the name of the country in which the complainant operated, as there was insufficient evidence that it was registered and used in bad faith to take advantage of the complainant's rights.

The complainant was Dafabet Uganda Limited of Kampala, Uganda, a company offering an online auctioning service for household goods and appliances in Uganda and other parts of Africa on websites accessible via the domain names 'dafabet.co.ug' and 'dafabet.ug' (both registered in 2017), and also through a mobile application. It was also the registrant of the trademark DAFABET with the registrar of trademarks of the Republic of Uganda since 2017.

The respondent was Angelito Teves, Emphasis Services Limited of Grand Turk, Turks and Caicos Islands, Overseas Territory of the United Kingdom, engaged in the sports betting industry. Apart from the domain name 'dafabet.com', registered in 2009, the respondent was also the registrant of a European Community trademark (a design mark and a word mark) in the term 'D Dafabet' since 2014 and in the term 'Dafabet' in the Philippines and Kenya.

The disputed domain name, 'dafabetuganda.com', was registered on April 26 2017 and resolved to a parking page at the time the complaint was filed.

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.

With regard to the first limb, the complainant contended that the disputed domain name was confusingly similar to the DAFABET trademark in which it owned rights and that the inclusion of the word 'Uganda' exacerbated that confusion. According to the respondent, the similarity was due to the complainant's unlawful use of the respondent's DAFABET trademark. The respondent argued that it had used the mark in commerce since 2004 and owned trademark registrations that predated the complainant's trademark registration.

Given the fact that the respondent did not object to the argument that the disputed domain name was confusingly similar to the complainant's trademark, the panel found that the complainant had satisfied the first limb of the UDRP.

As far as the second requirement under the UDRP was concerned, the complainant pointed out that the respondent was not using the disputed domain name to offer any goods or services in Uganda and, therefore, had no rights or legitimate interests in respect of this domain name. The complainant further argued that it had not authorised the respondent to use the disputed domain name. On the other hand, the respondent underlined the fact that it was holder of senior rights in the DAFABET trademark.

In the panel's view, although the respondent was making a good-faith use of its 'dafabet.com' domain name, it was correct that it was not using the disputed domain name except to resolve to a parking page. However, the panel found that it was not necessary for it to make a finding with respect to the respondent's rights and legitimate interests, as the complainant had failed to prove bad faith under the third limb.

Turning to the third limb, the complainant contended that the addition in the disputed domain name of a

geographic indicator where the respondent did not operate proved the respondent's attempt to confuse internet users. The respondent underlined again that it had pre-existing rights in the DAFABET trademark and asserted that its mark was internationally well known.

The panel considered that the complainant had failed to demonstrate the respondent's bad faith. First of all, the panel was not convinced that the respondent was aware of the complainant's rights. The complainant applied for its trademark on March 30 2017 and obtained the registration on July 4 2017. The disputed domain name was registered by the respondent on April 26 of the same year. For the panel, this short time period - less than a month - was not enough to prove the respondent's knowledge of the complainant's legal rights.

Moreover, the complainant presented evidence that "100+" people had installed its related app by April 25 2017. However, the panel decided that, under the circumstances, this fact was not sufficient evidence of the respondent's awareness of the complainant's trademark rights in Uganda. Additionally, the panel emphasised the anteriority of the respondent's rights in comparison to those of the complainant. The panel also took into account the respondent's well-known reputation in betting circles in many countries and stated that the respondent's registration of the disputed domain name was more likely to have been done in good faith based on the respondent's own rights.

The panel noted that the complainant had not attempted to demonstrate that the respondent's parked page reflected any bad-faith use.

Accordingly, the panel found that the respondent had not registered and used the disputed 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.

Finally, the panel 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 because the complainant did have a registered trademark in Uganda.

This decision highlights how having a trademark by itself does not necessarily mean that the trademark holder will succeed in obtaining the transfer of a domain name, even if it consists of an identical reproduction of such trademark followed by the name of the country in which the complainant operates. A complainant must also demonstrate that the respondent had awareness of the complainant's rights and registered the disputed domain name to take advantage of such rights. This may prove difficult, particularly if the respondent has a reputation and registered trademarks in other countries that predate the registration of the complainant's trademark and domain names.

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