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UDRP: prior trademark rights are not always a decisive factor

International - [Hogan Lovells](#)

- **L-Nutra Inc, which owns two US trademark registrations for NUTRITION FOR LONGEVITY, sought the transfer of 'longevitynutrition.com' under the UDRP**
- **As the complainant could not establish any degree of its reputation attached to its mark, the panel was not convinced that the respondent had targeted the complainant**
- **It was more likely than not that the respondent was unaware of the complainant's trademark when he acquired the domain name for his claimed business**

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP), a panel has denied the transfer of a domain name notwithstanding the complainant's trademark rights obtained prior to the registration of the domain name.

Background

The complainant, L-Nutra Inc, was an American company based in California and specialised in the field of nutrition related to longevity and health span. It had held, since 2017, two US trademark registrations for NUTRITION FOR LONGEVITY in connection with dietary supplements and dietary nutritional guidance, and operated a website at 'www.l-nutra.com'. It also filed an application for the trademark LONGEVITY NUTRITION in 2019.

The respondent, Douglas Kantner, was an individual based in Ohio, United States, who had been engaged in the business of manufacturing, marketing and distributing food and nutritional products for over 30 years. He was connected with a company, AME Nutrition, which supplied plant and dairy ingredients to third parties. In July 2018 the respondent reserved the business name Longevity Nutrition LLC in Ohio and filed, in December 2018, a certificate of formation for the company Longevity Nutrition LLC in Delaware.

The domain name 'longevitynutrition.com' was acquired by the respondent in August 2018, shortly after he reserved the business name as described above. In December 2018 the respondent used the domain

name to point to a website, which featured "Longevity Nutrition" in connection with a stylised fork and knife logo and provided his contact details.

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

- (a) The domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
- (b) The respondent has no rights or legitimate interests in respect of the domain name; and
- (c) The domain name has been registered and is being used in bad faith.

Decision

As far as the first limb was concerned, the complainant contended that the domain name was confusingly similar to its NUTRITION FOR LONGEVITY trademarks as the term 'longevitynutrition' was merely a transposition of the dominant elements of these marks. The respondent argued that the complainant had not proved its unregistered trademark rights in the term 'longevity nutrition' and applied for this trademark six months after he had acquired the domain name. The respondent further challenged the confusing similarity as he used LONGEVITY NUTRITION as his primary mark, while the complainant used NUTRITION FOR LONGEVITY as a tagline in very small font below its L-NUTRA house mark.

The panel conducted a confusing similarity test based on the complainant's NUTRITION FOR LONGEVITY trademarks and found that the dominant elements of these marks were fully incorporated in the domain name, which was sufficient to reach the threshold required under the first limb.

With regard to the second limb, the complainant submitted that the respondent had acquired the domain name in an attempt to misleadingly divert consumers to his own website, which was likely to market substantially identical goods and services as provided by the complainant. According to the complainant, such use of the domain name should not confer any rights or legitimate interests under the UDRP. In response, the respondent underlined that he had taken good-faith steps and made substantial business investments in preparation to use the domain name before he became aware of the complainant and its business, notably including:

- the reservation of the company name Longevity Nutrition LLC and the subsequent incorporation of the company;
- the creation of a website and other promotional materials in connection with the domain name; and
- a clearance search for LONGEVITY NUTRITION performed by a trademark lawyer.

The panel first pointed out that the complainant had failed to produce any evidence showing its actual use of the NUTRITION FOR LONGEVITY trademark with any goods or services, which strongly suggested that this trademark was a relatively descriptive mark and subject to some overlapping potential third-party use, notwithstanding the complainant's established trademark rights. The only evidence of use of this trademark (ironically provided by the respondent) was the logo displayed on the complainant's website, where 'nutrition for longevity' was merely a small tagline and could hardly be seen as a dominant element. The fact that the complainant could not establish any degree of its reputation attached to this mark made it difficult to convince the panel that the respondent had targeted the complainant by registering the domain name.

As far as the respondent was concerned, the panel noted that no evidence had been submitted regarding the respondent's claimed trademark search. Furthermore, the respondent did not provide any

details as to his planned business, which could not exclude the possibility that his business might potentially compete with the complainant's goods and services. However, since the complainant had failed to provide any relevant evidence in this regard, the panel could simply rely on the respondent's link with the company AME Nutrition, which did not look to be actually competing with the complainant, and the respondent's webpage associated with the domain name, where 'nutrition for longevity' was incorporated in a logo with a fork and knife. The panel therefore considered that it was more likely than not that the respondent was unaware of the complainant's trademark when he acquired the domain name for his claimed business.

Based on the above, the panel concluded that the complainant had failed to establish that the respondent did not have any rights or legitimate interests in the domain name. However, given the gaps contained in both parties' submissions, the panel considered that the respondent's actual future use of the domain name could cast a different light on the panel's assessment under the second limb to the extent that the complainant would be entitled to refile a complaint in the event that the respondent's future use of the domain name turned out to be for a business competing with the complainant.

Since the complainant failed to satisfy the second limb, there was no need for the panel to address the issue of bad faith under the third limb, although many circumstances indicating the respondent's lack of bad faith were already covered in the panel's analysis above. Finally, it should be noted that, on the balance of probabilities, the panel rejected the respondent's request for a finding of reverse domain name hijacking, given that the complaint was not unreasonable under the circumstances.

Comment

This decision illustrates once again that prior trademark rights are not always a decisive factor in the panel's assessment under the second and third limbs of the UDRP. Another lesson that may be taken from this case is that trademark owners should always try and provide tangible evidence with regard to the actual use of the trademark in question and, where applicable, any degree of public recognition and reputation. This is particularly the case when it is not straightforward to establish that the disputed domain name has been registered in an attempt to target the trademark at issue.

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