

You are in preview mode

DISABLE PREVIEW MODE



27 Nov  
2019

## Compassion for well-substantiated evidence in UDRP proceedings

International - [Hogan Lovells](#)

- The owner of two KINGDOM COMPASSION trademarks sought the transfer of 'kingdomcompassion.com' under the UDRP
- The panel considered that the respondent had demonstrably selected the name Kingdom Compassion for its charity in 2012 and, when the domain name was registered, was merely putting its existing plan into place to adopt this name
- The complainant failed to prove, on balance of probabilities, that the respondent used the domain name to tarnish her trademark

In [Kalis v Kingdom Compassion Youth With A Mission](#) (Case No D2019-1509), a three-member panel has refused to order the transfer of a domain name including the complainant's trademark under the [Uniform Domain Name Resolution Policy](#) (UDRP) in light of the respondent's long-term business plan, which demonstrated its failure to target the complainant and lack of bad faith.

### Background

The complainant in the case was Vicky Kalis, an individual operating a business under the name Kingdom Compassion, offering training, counselling, education and care services with a Christian focus based in the United Kingdom. The complainant registered the domain names 'kingdom-compassion.org' and 'kingdomcompassion.org' in 2013 and 2017, respectively, and pointed them to a website promoting her services. She was also the owner of two UK trademarks: a figurative trademark depicting a bird with the words 'Kingdom Compassion' displayed in small text registered in 2014 and a word mark registered in 2018 for KINGDOM COMPASSION.

The respondent was a UK limited company called Kingdom Compassion Youth With A Mission, incorporated in 2015. The respondent's predecessor began in 1985 as a partnership between Youth With A Mission and local churches, under the name The Earls Court Community Project, to reach out to vulnerable people in the Earls Court area of London. It started providing counselling, training and pastoral care services in the 1990s.

The domain name at issue was 'kingdomcompassion.com'. It was registered on 23 November 2015 and was resolving to the respondent's website promoting its services.

### UDRP requirements

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements set out at Paragraph 4(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;
- The respondent has no rights or legitimate interests in respect of the domain name; and

- The domain name has been registered and is being used in bad faith.

## Decision

### *Identity/similarity*

With regard to the first requirement, both the respondent and the panel agreed that that the domain name was identical to the complainant's word mark. The first limb was thus satisfied.

### *Rights/legitimate interests*

Turning to the second requirement of the UDRP, and the respondent's rights or legitimate interests (or lack of them), a complainant must prove that a respondent has no rights or legitimate interests in respect of the domain name in question. A complainant is normally required to make out a *prima facie* case and it is for the respondent to demonstrate otherwise. If the respondent fails to do so, then the complainant is deemed to satisfy Paragraph 4(a)(ii) of the UDRP.

In light of its finding in relation to the third requirement, the panel did not feel the need to address the second limb. However, it did so anyway out of respect for the parties' submissions.

In the present case, the complainant put forward a *prima facie* case to the effect that the respondent had no rights or legitimate interests in respect of the domain name as she had not authorised the respondent to use her trademarks for any purpose. Given that the domain name matched the word elements of the complainant's device mark, in the complainant's opinion it could not have been registered by chance. The panel noted that Paragraph 4(c) of the UDRP sets out a list of non-exhaustive circumstances that, if found by the panel to be proved, would demonstrate the respondent's rights or legitimate interests in the domain name. Even if the complainant had succeeded in making out a *prima facie* case, which was by no means certain, the panel noted that it would have found that the respondent was using the domain name in connection with a *bona fide* offering of services (see Paragraph 4(c)(i)).

### *Bad faith*

Finally, in relation to the third requirement, a complainant is required to demonstrate that the domain name in question was both registered and used in bad faith.

The panel noted that Paragraph 4(b) of the UDRP sets out a list of non-exhaustive circumstances which may evidence registration and use in bad faith. Relying on [\*The Perfect Potion v Domain Administrator\*](#) (WIPO Case No D2004-0743), the panel underlined that the critical issue was for a complainant to demonstrate that the respondent targeted it or its trademark rights or, at least, that the respondent had the complainant or its trademark in mind at the time of registration of the domain name.

In the case at hand, the complainant asserted that the respondent had registered and used the domain name in bad faith for the purpose of disrupting her business and had intentionally attempted to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the complainant. The complainant also argued that the use of the domain name tarnished her trademark. As far as targeting was concerned, the complainant argued that the respondent must or ought to have known of the complainant.

However, the panel disagreed and noted that, as per the respondent's board minute dated 2012, the respondent chose the name Kingdom Compassion (YWAM) for its proposed new charity from a range of options. The respondent's subsequent board minute of 2013 confirmed the final decision to adopt such name. The respondent argued that each of these words was widely used in scripture and that they had relevance to the respondent's ministry. The panel further noted that the complainant's own internet search for the term 'Kingdom Compassion' showed that another third party, namely Venture Christian Church, used such term for its talks.

The panel was of the view that the respondent chose the name Kingdom Compassion at a time when the complainant had yet to commence business as a sole trader under such term and had not yet filed a trademark application and, therefore, independently of the complainant or her rights. Although the domain name was registered after the date of registration of the complainant's design mark in 2014, the panel considered that the respondent had demonstrably selected the name Kingdom Compassion for its charity some three years earlier and, by 2015 when the domain name was registered, was merely putting its existing plan into place to adopt this name. The panel also concluded that the fact that the respondent's website at the domain name was not activated before 2017 was not of any particular significance and appeared in line with a requirement to transition to its new name over a period of time.

Even if the complainant's figurative trademark had or should have come to the respondent's notice at the date of registration of the domain name, the panel agreed with the respondent's contention that this

trademark was relatively weak, particularly as the words 'Kingdom Compassion' were rendered in small text and almost blended in with the larger graphical depiction of the bird. In addition, the complainant had not demonstrated to the panel's satisfaction that such trademark was bolstered to any extent by the existence of unregistered rights. None of the evidence submitted by the complainant was sufficient to establish exclusive secondary meaning in the term 'Kingdom Compassion' associated with the complainant's counselling service. Finally, the complainant had not shown that her own website at [www.kingdom-compassion.org](http://www.kingdom-compassion.org) was in use to any substantive degree by the date of registration of the domain name and, to the contrary, the respondent had demonstrated by reference to the internet archive Wayback Machine that there were no captures for the complainant's website at [www.kingdom-compassion.org](http://www.kingdom-compassion.org) prior to 2018. Therefore, the panel was not satisfied that the respondent's registration of the domain name was intended to exploit the complainant's rights in the term 'Kingdom Compassion'.

On the balance of probabilities, the panel found that the complainant had failed to prove that the respondent had registered the domain name with knowledge of the complainant's rights or because it was either intent upon disrupting the business of a competitor or was seeking commercial gain by creating a likelihood of confusion with the complainant's mark. The panel also found that the complainant had failed to prove, on balance of probabilities, that the respondent had used the domain name to tarnish her trademark. The panel relied on [\*Dover Downs Gaming & Entertainment Inc v Domains By Proxy LLC/Carter, Purlin Pal LLC\*](#) (WIPO Case No D2019-0633), and the cases there cited to stress that "tarnishment refers to unseemly conduct such as linking unrelated pornographic, violent, or drug-related images or information meant to disparage an otherwise wholesome mark". In the panel's view, there was no evidence of any such conduct on the part of the respondent and, indeed, the respondent's use of the domain name appeared to be in line with its original plans to adopt this name for its charitable activities dating back to around a year before the complainant started to operate its business.

The panel considered that the third limb was not satisfied and the complaint was therefore denied.

#### **Comment**

The decision underlines that it is very important for respondents to submit contemporaneous evidence in support of their claims when they are involved in domain name dispute proceedings, such as board minutes, as such evidence may be essential to demonstrate that they were not targeting the complainant and thus underline their legitimate interests and lack of bad faith.

## **Jane Seager**

Hogan Lovells

## **Hortense Le Dosseur**

Hogan Lovells

## **TAGS**

[Online](#), [Internet and Online](#), [International](#)