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When 'Nova Tela' is as common as telenovelas

International - [Hogan Lovells](#)

- **NovAtel Inc, the owner of the US trademark NOVATEL, sought the transfer of 'novatela.com' under the UDRP**
- **The panel found that 'novatela' could be read as the combination of two common words and could be applied in multiple contexts unrelated to the complainant and its activities**
- **The complainant failed to demonstrate that the respondent knew or should have known of the trademark, or had targeted the complainant when registering the domain name**

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to transfer the domain name 'novatela.com', finding that the complainant had failed to prove that the domain name had been registered in bad faith.

Background

The complainant was NovAtel Inc, Canada, a company specialised in global navigation satellite system solutions. The complainant registered the NOVATEL trademark in the United States in 2001. The complainant indicated that it had, since then, registered the trademark in at least 30 countries. The complainant also claimed that it had first used the trademark in 1992 in connection with navigation and positioning transceivers, GPS receivers and related goods.

The respondent was Registration Private, Domains By Proxy LLC, United States/Domain Admin, FindYourDomain.com, United States, which had registered the domain name 'novatela.com' in 2007. At the time of the decision, the domain name did not resolve to an active website.

The complainant initiated proceedings under the UDRP for a transfer of ownership of the domain name.

To be successful under the UDRP, a complainant must satisfy the requirements of Paragraph 4(a), namely that:

- the disputed domain name 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 the disputed domain name; and
- the disputed domain name was registered and is being used in bad faith.

Decision

Identity/similarity

Under the first element of Paragraph 4(a) of the UDRP, the complainant argued that the domain name fully incorporated the trademark, thus causing a likelihood of confusion as to the source and/or sponsorship of the domain name. The complainant added that the letter 'a' at the end of the domain name did not mitigate the confusing similarity between the domain name and the trademark.

The respondent argued that the domain name involved a generic, descriptive and common phrase in the Portuguese language and that the test of confusing similarity had to follow the recommendation described in Section 1.7 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#), of a typical side-by-side comparison of the domain name and the textual components of the relevant trademark so as to assess whether the mark was recognisable within the domain name. The respondent concluded that the test would have revealed that, in Portuguese, '*nova tela*' meant 'new screen', thus making the domain name distinct from the NOVATEL trademark. The respondent added that the results of a Google search for 'novatela' did not show the complainant or its trademark in the first five pages.

The panel found that the requirement under the first element was satisfied because the complainant had established rights in the NOVATEL trademark and that the domain name incorporated the trademark entirely.

Rights/legitimate interests

With regard to the second element of Paragraph 4(a) of the UDRP, the complainant contended that:

- the respondent was not commonly known by the Novatel name and that it was not affiliated with the complainant;
- the respondent had not been commonly known by the domain name as an individual or business and it owned no registered trademark in any variation of the term 'novatel';
- the complainant's trademark registration preceded the registration of the domain name by at least six years;
- the respondent was not making a legitimate non-commercial or fair use of the domain name since the domain name resolved to a webpage indicating that the respondent was offering it for sale, which indicated that the respondent was not using and had made no reasonable preparations for the use of the domain name; and
- there were no other circumstances justifying the respondent's registration or use of the domain name.

The respondent explained that its business involved selling legitimately acquired generic and descriptive domain names and that the disputed domain name was a combination of the Portuguese words '*nova*' and '*tela*' - making the combination a common, well-known and descriptive phrase, commonly used in advertisements for smart phones in Brazil. The respondent concluded that it had made good-faith use of the domain name and pursued a legitimate interest.

The panel concurred and found that the respondent had made a plausible case of legitimate interest. The phrase could be read, in multiple languages, as the combination of two common words meaning 'new screen' in English and could be applied in multiple contexts unrelated to the complainant and its activities. The panel considered that the complainant had not shown that the respondent had no rights or legitimate interests in respect of the domain name.

Bad faith

As regards the third element of Paragraph 4(a) of the UDRP, the complainant contended that the distinctiveness and reputation of the NOVATEL trademark suggested opportunistic and bad-faith registration of the domain name, as it was implausible that the respondent could have been unaware of the trademark at the time of the domain name registration. The complainant added that it was the respondent's obligation to ascertain that the registration of the domain name would not have been in breach of third-party rights and that a quick internet search would have revealed the existence of the trademark. In an unsolicited submission, the complainant informed the panel that the respondent, after the filing of the complaint, had offered to sell the domain name to the complainant for \$3,200. The complainant alleged that the offer was a fraudulent attempt to pressure it to buy the domain name at a premium price to avoid the risk and cost of litigation.

The respondent argued that it owned thousands of common generic and descriptive terms as domain names in different languages as part of its business of selling such names and that it did not have the knowledge or intention to take advantage of the complainant's rights. The respondent further stated that the complainant had offered no additional arguments or evidence that the respondent knew of the trademark at the time of the domain name registration in 2007. It indicated that the trademark applied to products that were not consumer-facing and were therefore not well known to the public and that the respondent had never heard of the trademark before receiving the complaint. The respondent added that the due diligence it had conducted had not revealed any reasonable likelihood that the domain name infringed third-party rights, as it was composed of two generic terms frequently used in conjunction with each other in the context of the related concepts of a new screen, which was in line with the respondent's business strategy.

The panel confirmed the respondent's assertion that the complainant had not provided evidence establishing why the respondent knew or should have known of the trademark or establishing that the respondent had targeted the complainant when registering the domain name. The complainant had provided the panel with a translated document establishing that the Spanish Trademark Office had declined a third party's application to register Novatel FIBRA as a trade name. However, the panel found that the translation did not accurately capture the original Spanish version of the decision and that it was, in fact, not linked to the complainant's trademark and thus did not prove the complainant's notoriety. These findings were corroborated by the panel's independent research conducted at the Spanish Trademark Office database, which revealed that the basis of the rejection decision was a trademark registration by another company unrelated to the complainant. The panel also found that a reasonable enquiry into whether the domain name infringed third-party rights would not necessarily have led to the discovery of the complainant's trademark because the domain name included two words with different meanings in different languages. The panel pointed out that an internet search showed that third parties were using the term.

The respondent claimed that the complaint had been brought in bad faith and constituted a case of reverse domain name hijacking as the complainant "ought to have known that it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint", as noted under Section 4.16 of the WIPO Overview 3.0.

The panel, however, held that the complainant's case was not doomed from the start, but rather that the complainant had not adequately argued its case (although it may still have lost a better argued case).

Comment

This case highlights the importance of providing sufficient evidence that, at the time of registration of a domain name, the reputation of the complainant and the string in question is known, or ought to have been known, by the respondent. It is also an illustration of the challenges in establishing an absence of legitimate interest when domain name resellers register domain names comprising common and widely used terms.

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