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The UDRP is not a forum for parties to resolve complex business disputes

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- **The parties in this UDRP case were involved in several trademark disputes against one another**
- **Whether the complainant had acquired rights in INNVECTRA to the exclusion of the respondent was not an issue that the panel could determine**
- **The respondent had not targeted the complainant at the time the domain name was registered**

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied a UDRP complaint for the domain name 'innvectra.com', finding, among other things, that the dispute between the parties fell well outside the scope of the UDRP.

Background

The complainant, Innvectra Softech Pvt Ltd, was an Indian company operating as a provider of IT services. It was incorporated in 2010 and had registered trademarks for INNVECTRA.

The respondents were named as Innvectra Info Solutions Pvt Ltd ('the respondent company'), an Indian company incorporated in 2007, together with Mr Venkata Ravindra Babu Mannam, aka Ravindrababu MV ('the respondent'). The respondent served as the managing director of the complainant from 2010 to 2017, during which time the disputed domain name was used by the complainant. In May 2017 the respondent appears to have resigned from his role as managing director of the complainant.

The complainant asserted that it was incorporated in 2010, when the respondent, together with a third-party company based in the United States, decided to form a new company. The complainant alleged that it had been the sole exclusive owner and user of the INNVECTRA trademark since 2010, and that the respondent had transferred the domain name and website unconditionally to the complainant. The complainant further argued that the respondent had stopped using the INNVECTRA trademark and that no worthwhile business was carried out by the respondent after forming the complainant in 2010. The complainant asserted that the respondent's prior interests in the INNVECTRA trademark had therefore lapsed, and that these had been subsumed by the complainant in 2010. The complainant claimed that there was an implicit understanding between the parties that the respondent would cease using the INNVECTRA trademark and the domain name after forming the complainant. The complainant asserted that payment for the domain name was borne by the complainant from 2010 to 2017, during which time the domain name was used exclusively by the complainant. The complainant asserted that the respondent company was covertly operated and kept active. The complainant claimed that:

- disputes had arisen between the parties due to the wrongful use of the domain name;
- the respondent had applied for a trademark registration for INNVECTRA, despite having surrendered his rights in the same as well as the domain name; and
- the respondent had hijacked the domain name and made changes to the website to which it resolved, in order to benefit from the goodwill and internet traffic associated with the INNVECTRA trademark.

The respondent asserted that the INNVECTRA trademark was adopted when the domain name was registered by the respondent on 2 December 2003, noting that 'Innvectra' was part of the respondent company's name, which was incorporated on 3 August 2007. The respondent provided evidence of its use of the trademark prior to the incorporation of the complainant. The respondent claimed that no rights in the INNVECTRA trademark had been transferred to the complainant. The respondent asserted that, in October 2017, it was agreed between the parties that the complainant company would be dissolved, but that the complainant had continued to use the INNVECTRA trademark, and that the complainant had obtained a trademark registration for INNVECTRA in June 2017. The respondent further claimed that a settlement agreement had been entered into between the parties regarding the use of the INNVECTRA trademark, but that the complainant had not honoured the terms of that agreement. The respondent submitted that the complaint had been filed in bad faith, and requested that the panel enter a finding of reverse domain name hijacking (RDNH).

The panel noted that the parties had filed several trademark disputes against one another, and that the respondent had filed a civil proceeding against the complainant before a court in India.

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

- 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

Preliminary statement

The panel noted that this case involved a highly complex dispute between the parties, which happened to involve the disputed domain name. The panel accepted that the domain name was registered by the respondent in 2003, and that the complainant had used the domain name from 2010 to 2017 under a business arrangement between the parties. At the same time, the panel noted that there were no documents on record to show whether rights in the INNVECTRA trademark and domain name had been transferred outright by the respondent to the complainant. Rather, it appeared to the panel that the parties had entered into an undocumented arrangement and had relied on an "implicit understanding" insofar as the complainant's use of the domain name was concerned. Whether the complainant had acquired rights in the INNVECTRA trademark to the exclusion of the respondent based on such "implicit understanding" was not an issue that the panel was able to determine. The panel considered that such a determination involved complex findings of fact, to be resolved by a court of competent jurisdiction, noting that the UDRP did not provide a forum for parties to resolve complex business disputes, such as in the case at hand.

Paragraph 4(a)(i)

The panel noted that the domain name reproduced the INNVECTRA trademark, but declined to make a decisive finding, in light of the unusual circumstances of the case.

Paragraph 4(a)(ii)

Similarly, the panel refrained from entering a finding under Paragraph 4(a)(ii) in light of the ongoing business dispute between the parties, noting that the complainant's use of the INNVECTRA trademark from 2010 to 2017 gave rise to complex questions as to the rights of each party in the mark.

Paragraph 4(a)(iii)

The panel noted that it was not disputed that the respondent had registered the disputed domain name in 2003, and that the respondent was the first to adopt the INNVECTRA trademark. Accordingly, the panel found that the respondent had not targeted the complainant at the time that the domain name was registered, and that the complaint therefore failed on the basis that the complainant had not established that the domain name had been registered in bad faith.

RDNH

Given that the issue of the parties' rights in the INNVECTRA trademark was still subject to determination before the relevant authorities, the panel determined that the respondent had not established that the complainant had engaged in RDNH.

Comment

There are two important considerations that may be taken away from this decision.

First, under a plain reading of the UDRP, it ought to have been clear to the complainant that it would not succeed under the third element. Indeed, the complaint appears to be founded in the misguided view that the transfer of rights in a trademark somehow negated the respondent's initial good-faith registration of the domain name later corresponding to that trademark, when in fact, there was simply no evidence of the respondent's bad-faith intent to target any then-nascent trademark rights, where the domain name was registered several years prior to the creation of the complainant company.

Secondly, this case underscores the importance of clear contractual provisions that account for the use of a domain name pursuant to a business relationship, separate from other classes of intellectual property, including those that are to take effect upon both the planned as well as unexpected termination of the business relationship.

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