

Beware of RDNH: UDRP panel finds that complainant deliberately filed complaint without proper basis **Cybersquatting Internet issues**
International - Hogan Lovells

July 16 2018

- **UDRP panel found that complainant had deliberately filed complaint without any proper basis**
- **Complainant had intentionally omitted key information**
- **Panel made finding of RDNH against complainant**

In a [recent decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the World Intellectual Property Organisation (WIPO), a panel has denied the transfer of a domain name and declared that the complaint, which was brought without any proper basis, constituted an abuse of the UDRP proceeding.

The complainant was UMix LLC of Windermere (Florida, United States), a company providing background music services in the United States and worldwide. The complainant owned two business entity names, UMix Media (registered in 2011) and UMix (registered in 2016), and a US device trademark incorporating the term 'UMix' since January 2017.

The respondent was Memplex LTD of Manchester (United Kingdom), a technology consultancy company developing music software for different platforms. The respondent owned a UK trademark for a series comprising UMIK (word mark) and UMIK (stylised) since May 2017.

The domain name 'umix.com' was initially registered in 1996 then acquired by the respondent in 2011. The respondent used the domain name to point to a website promoting an application known as 'Umix', which was also available for download via the Apple App Store. Based on the Wayback Machine records provided by the complainant, the domain name also occasionally resolved to a parking page containing the message "test umix.com" since its acquisition by the respondent in 2011.

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 submitted that the domain name was confusingly similar to its device mark registered in 2017. The respondent rebutted this in its response by arguing that the device trademark on which the complainant relied incorporated a logo element, which would lead the mark to be perceived as UM UMIK rather than UMIK.

The panel first pointed out that, although the complainant referred to its registered business names UMIK Media and UMIK, it was not clear that the complainant was seeking to rely on these names in support of its common law/unregistered trademark rights in UMIK, and it had not provided any evidence to establish such rights. However, the panel was of the view that the complainant could rely on its UMIK device trademark as the design elements could be disregarded for the purpose of assessing identity or confusing similarity. The first limb was therefore satisfied.

Regarding the second limb, the complainant had merely submitted that the respondent was using its device trademark to create confusion and had not addressed any of the matters set out in Paragraph 4(c) of the policy to establish a *prima facie* case of the respondent's lack of rights or legitimate interests in the domain name. In contrast, the respondent had provided sufficient evidence to demonstrate its active use of the domain name since its acquisition in 2011, as well as considerable time and money invested in developing and advertising the UMIK software. Furthermore, the respondent underlined that the absence of web content at a single point in time, as evidenced by the complainant's Wayback Machine record, could not hide the fact that the domain name had hosted an active website relating to the UMIK Software from as early as 2011.

In view of the above, the panel considered that the complainant had failed to make out a *prima facie* case on

the respondent's lack of rights or legitimate interests in accordance with the UDRP. The second limb was therefore not satisfied.

Since the complainant had failed to establish the second limb, the panel considered that it was not strictly necessary to reach a finding under the third limb. For the sake of completeness, the panel briefly addressed the key aspects of the third requirement, notably including the fact that the complainant's device trademark on which it relied was registered in 2017 (over five years after the respondent had acquired the domain name) and that the complainant had not made any clear assertions in regards to its unregistered trademark rights or its reputation prior to filing the device trademark. On this basis, the panel found that the complainant had failed to prove the respondent's knowledge of the complainant at the time of acquisition of the domain name and thus could not establish the respondent's bad-faith registration under the UDRP. The third limb was therefore not satisfied.

It should be noted that the respondent specifically requested that a finding of reverse domain name hijacking (RDNH) be made against the complainant. RDNH is defined by 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 regard, prior panels have held:

When the complainant filed the complaint, the complainant knew that there was no proper basis for the complaint yet it went ahead and filed the complaint. This alone merits a finding of RDNH. (Dextra Asia Co Ltd v Lakeside Enterprises Limited (WIPO Case No D2012-0403))

The panel found that the complainant had deliberately filed a complaint without any proper basis as the complaint was "thoroughly deficient and consist[ed] of less than half of one page in submissions in support of the complainant's case". Furthermore, the panel found that the complainant had intentionally omitted certain key information in its submissions. For instance, in order to establish the respondent's bad faith, the complainant referred to its complaint filed with the Apple App Store in relation to the respondent's UMIK application without specifying that its complaint had already been closed by Apple further to the respondent's response. The complainant also selectively chose to provide a historical screen capture in which the domain name pointed to a parking page, deliberately ignoring the fact that the domain name had been actively used by the respondent to point to a website promoting its UMIK software. Finally, the panel took into account the complainant's silence on its unregistered trademark rights and reputation, and considered that the complainant must have known that relevant evidence would be necessary to establish bad-faith registration. The panel therefore made a finding of RDNH against the complainant.

Although a complaint under the UDRP is much more straightforward than court proceedings, it does not imply that any party, once having registered a trademark that is identical or confusingly similar to a domain name, can obtain the transfer of that domain name by rashly filing a complaint without addressing the matters required by the UDRP or providing necessary evidence to support its submissions. On the contrary, the filing of a UDRP complaint with no proper basis may not only result in the denial of transfer, but also lead to a finding of RDNH.

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