

Complainant fails to obtain transfer of three-letter domain name consisting of its mark **Cybersquatting** International - Hogan Lovells International LLP

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In a recent case under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the [World Intellectual Property Organisation](#), the panel has [denied the transfer](#) of a three-letter domain name, even though it consisted of the complainant's trademark.

The complainant was [RV Kuhns & Associates](#) (now RVK), an investment consulting firm based in Oregon, United States, founded in 1985. The complainant was the owner of the trademark RVK, registered with the [US Patent and Trademark Office](#) (USPTO) on August 3 2004 (first use in commerce listed as April 7 2000) and used in connection with investment consulting services.

The respondent was Gregory Ricks (Texas, United States), who had registered the disputed domain name using a privacy protection service.

The disputed domain name was 'rvk.com'. It was registered on February 20 2000 and was pointing to a website displaying click-through links to websites unrelated to the complainant's business activity.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements set out at Paragraph 4(a):

1. the domain name 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 requirement, the panel found that the complainant's trademark registration with the USPTO was sufficient to establish rights in the term 'RVK' and that the domain name was identical to said mark, except for the '.com' generic top-level domain, which was generally irrelevant in this assessment. Therefore, the complainant satisfied the first requirement under the UDRP.

With regard to the second requirement, the respondent, who appeared to be a domainer, argued that he registered the domain name as part of his business of acquiring domain names and that he had no knowledge of the complainant at the time of registration. He stated that three-letter domain names are known to be valuable and provided evidence of various acquisitions. The panel found that, in the absence of any evidence that the respondent was seeking to trade on the complainant's goodwill, the respondent's claim was plausible. The complainant did not provide any evidence in this regard and so the panel found that it had failed to meet the second requirement under the UDRP.

Turning to the third requirement, a complainant must demonstrate that the respondent both registered and used the disputed domain name in bad faith. In this case, given that the domain name was registered on February 20 2000, and thus preceded the complainant's first use in commerce of its trademark on April 7 2000 (as per the complainant's trademark registration), the panel examined whether the complainant could demonstrate use of its trademark rights prior to the registration date of the domain name. The panel noted that the fact that the complainant was founded in 1985 was of no consequence without such evidence.

The complainant had submitted a letter displaying the RVK mark to prove use of its trademark since 1992. However, the panel found that this was insufficient. The panel referred to the USPTO's [Trademark Manual of Examining Procedure](#), Section 1301.04(h)(i), which provides that "letterhead stationery, business cards or invoices bearing the mark may be accepted if they create an association between the mark and the services". The panel found that the evidence submitted did not meet this standard, as the letter did not make any reference to the specific services the complainant alleged were associated with its trademark.

In view of the above, the earliest date of the complainant's first use of its trademark was April 7 2000, the date set forth in the trademark registration. Given that said date post-dated the date on which the respondent registered the domain name, the panel found that the respondent could not have registered the domain name in bad faith. In addition, the panel pointed out the fact that, even if such evidence had been sufficient proof of trademark use, there was no indication that the respondent was aware of it.

Furthermore, the panel reasoned that the fact that the respondent was using the domain name to point to a website displaying pay-per-click links unrelated to the complainant was a strong indication that the respondent was not aware of the complainant. Thus, the panel found that the respondent had not registered or used the domain name in bad faith.

The complaint was thus denied. In addition, the panel granted the respondent's request for a finding of reverse domain name hijacking, defined in the UDRP Rules as "using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name". The panel reasoned that the complainant's assertion of trademark use in 1992 was only made in its amended complaint (as opposed to in its original submission) and that, even if this was made in good faith, the complainant "did not have a basis to believe that the respondent was aware of this letter or of any other evidence of the complainant's alleged claim of right to the RVK mark". As a result, the panel found that the complainant must have been aware that the respondent could not possibly have known of the complainant's trademark when he registered the domain name, and thus registration could not have been made in bad faith.

This decision thus highlights that a complainant's date of incorporation or commencement of business is generally irrelevant to demonstrate bad-faith registration without further evidence that a respondent is aware of this. In addition, the decision not only sheds light on what constitutes sufficient proof of use to establish unregistered trademark rights, it also shows that such proof of use alone is insufficient for a finding of bad faith, as under the UDRP it is also crucial to demonstrate the respondent's prior knowledge or awareness of a complainant's rights. This is particularly the case concerning very short domain names, as the smaller the number of letters, the less distinctive they are. Thus, proof of a respondent's prior knowledge is especially important when it comes to three-letter domain names, as in the case at hand.

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