

Donald Trump obtains transfer of 'trumpcard.com' under UDRP International - Hogan Lovells LLP

Cybersquatting

May 13 2015

In a recent case under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the [World Intellectual Property Organisation](#), a panel has [ordered the transfer](#) of a domain name to a well-known businessman. On the one hand, the domain name could be said to be descriptive, but on the other it had also been trademarked, and so the actions of the respondent were crucial to the panel in making its decision.

The complainant was Donald J Trump, a well-known American businessman, investor, television personality and author. He owned the trademarks TRUMP and TRUMP CARD in the United States. The respondent was Mr Dillon-Ferris, a person living in the United Kingdom.

The disputed domain name was 'trumpcard.com'. It was registered on January 19 1998 by the respondent and was pointing, at the time of the decision, to a website displaying an error message.

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 part of the UDRP, the complainant successfully evidenced that he owned rights in the trademarks TRUMP and TRUMP CARD and that the domain name was identical to the TRUMP CARD mark and confusingly similar to the mark TRUMP. In light of these elements, the panel concluded that the domain name was identical to the mark TRUMP CARD and further considered that the addition of the generic term 'card' to the mark TRUMP could not prevent any confusing similarity between the domain name and the mark.

With regard to the second limb of the three-prong test, the complainant argued that the respondent had no rights or legitimate interests in the domain name because, at the time that the complaint was filed, the respondent was using the domain name to direct internet users to a website that was an exact copy of one of the complainant's websites. The complainant contended that the first use of the trademarks pre-dated the registration of the domain name and that the respondent should therefore have been aware of his rights in the marks. In addition, the complainant stated that he had not authorised the respondent to use his marks. Finally, the complainant argued that the respondent was using the domain name either to mislead internet users into thinking that the respondent's website was affiliated to him or to offer the domain name for sale.

The respondent argued that he had been using the generic term 'trump card' in its common descriptive meaning as a gambling term (namely a winning card). Indeed, the respondent stated that he had registered the domain name to start an online card game site and was looking for partners. Therefore, the respondent claimed that he had rights or legitimate interests in the domain name.

The panel considered that the respondent did not have rights or legitimate interests in respect of the domain name and that the complainant had met its burden under Paragraph 4(a)(ii) of the UDRP. The panel agreed that the term 'trump card' was descriptive and related, as such, to gambling. Therefore, the panel stated that the respondent could have had rights or legitimate interests in the domain name, provided he was using it in connection with its descriptive meaning. However, the panel considered that the respondent had not provided sufficient evidence to demonstrate the connection between the meaning of the domain name and the use that he was planning to make of it.

Concerning the first use of the TRUMP CARD mark invoked by the complainant, the panel underlined that the date set out in the [US Patent and Trademark Office](#) records did not prove, as such, the date of first use of the trademark, but instead additional evidence was required. However, the panel pointed out the fact that the complainant was a very well-known businessman who owned common law rights in the mark TRUMP and that, amongst his activities, he was associated with casinos. On the basis of these elements, the panel decided that, at the time of registration of the domain name, the respondent should have been aware of the complainant's existence and of his rights in the marks.

The panel also noted that the respondent was not commonly known by the domain name. Finally, the panel concluded that the respondent was trading off the complainant's rights in the mark TRUMP and his reputation as he had generated revenue by linking internet users to affiliate gambling websites, such as 'www.partypoker.com'.

With regard to the third limb of the three-prong test under the UDRP, the complainant asserted that, considering his reputation and fame, the registration of the domain name without his authorisation constituted, in itself, evidence of bad faith. The complainant again contended that the respondent was trading off his goodwill and fame by confusing internet users and directing them to his website, which clearly demonstrated his bad faith in the use of the domain name.

The respondent argued that the complainant did not have any trademark rights in the term 'trump card' at the time that the domain name was registered, as the complainant had never used the term 'trump card' prior to the launch of his "Trump Card" loyalty programme in 2012. In addition, the respondent stated that, after receiving a letter from the complainant's lawyers in 2011, he had included a disclaimer on his website and was directing users to the complainant's website. Finally, the respondent claimed that he had even offered to transfer the domain name if the complainant was able to provide any evidence of his bad faith, which he never did.

The panel found that the complainant had met its burden under Paragraph 4(a)(iii) of the UDRP. The panel asserted that the fame and reputation of a complainant are always persuasive when determining a respondent's bad faith. Therefore, despite the fact that the respondent had registered the domain name before the launch of the complainant's "Trump Card" loyalty programme, the panel considered that the respondent should have been aware of the complainant's existence, his business, his trademarks and his interests relating to gambling and casinos. The panel pointed out again that the respondent was taking advantage of the complainant's reputation by creating confusion in the mind of internet users. In addition, the panel noted that, in the past, the respondent had offered the domain name for sale to the public, which further evidenced his bad faith. The panel therefore ordered the transfer of the domain name.

David Taylor and Jane Seager, Hogan Lovells LLP, Paris

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.