

World Trademark Review Daily

Free speech in UDRP cases: settled rules or context-based approach?
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Cybersquatting

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In *Equality Charter School Inc v Davids* (Case D2011-1226), complainant *Equality Charter School Inc*, a charter school based in New York, has lost a complaint under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) against Mona Davids, an individual also residing in New York, concerning the domain name 'equalitycharterschool.com' on the grounds that it had failed to establish any of the requirements under Paragraph 4(a)(ii) and 4(a)(iii) of the UDRP.

To be successful in a UDRP procedure, a complainant must evidence that:

- the domain name is identical, or confusingly similar, to a trademark or service mark in which it has rights;
- the respondent has no rights or legitimate interests in respect of the domain name; and
- the domain name has been registered and is being used in bad faith.

The use of a domain name in connection with a non-commercial forum for criticism and sharing of negative information concerning a third party is frequently the subject of UDRP complaints. Nevertheless, UDRP panels still adopt different views as to whether such use constitutes 'fair use' (see [WIPO Panel Views on Selected UDRP Questions, Second Edition](#), Paragraph 2.4). The assessment of fair use will depend on the weight a panel is willing to grant in relation to the registrant's right to free speech in each case. For certain panels, free speech does not give right under the UDRP to register a domain name that is identical to a complainant's trademark to use it for third-party criticism, even if it is non-commercial. Others take the opposite view, claiming that non-commercial free speech may justify fair use of a domain name used to criticise a third party under the UDRP, having regard to a certain number of factors. The present decision is interesting in that it follows this latter approach, and gives details on what kind of evidence panels might have regard to in such cases.

The domain name 'equalitycharterschool.com' was registered on March 21 2011 and the website to which it resolved displayed non-commercial commentary criticising the complainant's management. The complainant decided to file a complaint under the UDRP.

Having regard to the first limb of the UDRP, the complainant did not own any registered trademarks in the phrase 'Equality Charter School', and produced little evidence of having acquired unregistered trademarks in such a phrase. However, the panel explained that, in cases where only factual statements were made by a complainant, it may accept them as true even if these statements were not supported by actual evidence. Despite giving such indications, the panel resolved not to give its opinion on this point, observing that the second and third limbs of the UDRP had in any case not been proved by the complainant.

With regard to the second limb, the panel found that the complainant had failed to establish a *prima facie* case that the respondent lacked rights or legitimate interests in the domain name. The issue on this point was whether the respondent's use of its website for criticism of the complainant amounted to fair use of the domain name. Had the domain name been used for commercial purposes, the proof of a lack of legitimate interest would have easily been satisfied.

After setting out the different views panels may have on the issue of rights or legitimate interests in the use of a domain name for criticism, the panel assessed this for the purpose of the present case. The panel followed the view of a certain number of previous panels, finding that a lack of legitimate interests in a domain name used for the purpose of criticism cannot be inferred from the mere fact that a respondent incorporates a complainant's trademark in its entirety in its domain name. Whilst some panels believe that the internet user's initial confusion caused by the incorporation of a complainant's trademark in the domain name is in itself sufficient to fulfil the second limb of the UDRP, others, such as the panel in the present decision, believe that, in such cases, a flexible, context-based approach is required.

Surprisingly, the panel considered this after having decided that it was not necessary to assess whether the complainant had acquired unregistered trademark rights. Instead, the panel could have decided to cover the unregistered trademark point beforehand, rather than building its whole reasoning on the 'alleged' unregistered trademarks the complainant might have had. This perhaps demonstrates that assessing whether a complainant has acquired an unregistered trademark in a term or phrase is still a difficult question that the panel decided not to cover.

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The panel thus sought to examine whether, in fact, there was a risk that an internet user may believe that the respondent's website was the complainant's in view of the fact that the domain name incorporated the complainant's alleged trademark in its entirety. Interestingly, the panel provided details on what kind of evidence should be submitted in such cases.

Firstly, the panel took account of the respondent's position in the listings of popular search engines after typing the complainant's alleged trademark. The panel noted that "the listing for the respondent's website in the extremely popular Google search engine did not appear until the bottom of the second page of listings". The fact that the search engines displayed descriptive content that users could see before clicking the link to be taken to the respondent's website was also an important point, as they could be "alerted to the critical nature of respondent's website before clicking on the link indexing the website in the search tool".

Secondly, the panel considered the respondent's home page. Unlike other UDRP panels, it held that a formal disclaimer was not indispensable to alert users that they had reached a website that was not the complainant's. The panel sought, again, to employ a context-based approach and, in its opinion, the subtitle "A Failing, Mismanaged Charter School" at the top of the home page, as well as other headlines and the tone of postings on the website, was sufficient to alert any reader that the website was not endorsed by the complainant.

Turning to the third limb of the UDRP, the complainant alleged that the respondent had registered the domain name to prevent the complainant from reflecting its trademark in the corresponding domain name and for the primary purpose of "disrupting the business of a competitor" (Paragraphs 4(b)(ii) and (iii) of the UDRP).

The panel rejected the first allegation after observing that the complainant had registered its name and alleged trademark under the '.org' and '.com' extensions, and owned a domain name identical to the respondent's under the '.info' extension. The second allegation was easily rejected as the complainant gave no evidence proving that the respondent was a competitor.

This decision is a good illustration of the uncertainty that lies around the use of a website used to criticise third parties and, generally, of the different ways panels can apprehend a UDRP case. If some panels may prefer to rely on strict rules to be followed (eg, the mere fact that a respondent has incorporated a complainant's trademark in its domain name resolving to a website used to criticise a complainant can be sufficient for certain panels to prove the respondent's lack of rights or legitimate interests), other panels prefer context-based approaches. If context-based approaches may lead to what one may believe to be a 'fair' decision, this might also be at the expense of having a clear legal framework one can rely on to assess rights for the purpose of the UDRP. This point clearly underlines the importance of submitting a thoroughly drafted complaint backed up by relevant evidence to maximise chances of winning a case.

In any case, the assessment of fair use in such cases will also depend on the weight panels are willing to give to the right of free speech, which will naturally be closely linked to their respective legal systems. For example, as the panel in the present decision underlines, US panels will be more reluctant to find a lack of fair use of a domain name when it come to a respondent's freedom of speech.

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