

World Trademark Review Daily

Less than rosy outcome for law firm in UDRP complaints International - Hogan Lovells

Cybersquatting

September 07 2011

A set of related complaints filed under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) by partners from the law firm [Proskauer Rose LLP](#) for the transfer of domain names containing their personal names have been rejected on the grounds that the complainants did not have a trademark in their names ([Mashberg v Cox](#) (Case D2011-0677); [Leccese v Cox](#) (Case D2011-0679); [Fagin v Cox](#) (Case D2011-0678)). A related complaint filed by the law firm itself for the transfer of the domain name 'proskauerlawfirm.com' was also rejected because the matter was not deemed to fall within the scope of the UDRP ([Proskauer Rose LLP v Turner](#) (Case D2011-0675)).

In the first set of complaints, Gregg M Mashberg, Joseph Leccese and Allen Fagin sought the transfer of the domain names 'greggmashberg.com', 'josephleccese.com' and 'allenfagin.com', registered by Crystal Cox.

The complainants contended that they were "well-known and highly respected attorney[s]", highlighting their levels of experience and positions within the law firm and citing accolades by various legal publications. The complainants maintained that they practised under their respective names, "render[ing] legal services in exchange for fees", with their names appearing on the Proskauer website and in promotional materials, and also "featur[ing] prominently on bills that are sent out to clients for the complainant[s]' legal services". There was no indication, however, that the complainants entered into legal services contracts with clients in their own names, as opposed to as a lawyer of Proskauer, or that clients paid the complainants rather than the firm.

The domain names, all registered during 2010, pointed to websites containing criticism of the complainants and the Proskauer firm. The complainants alleged that Cox was "parroting Eliot Bernstein, who has been engaged in a bizarre and defamatory campaign against Proskauer Rose and its attorneys for many years", indicating that this was part of a wider dispute. In addition, the complaint mentioned that Cox had a website at '[crystalcox.com](#)' which contained further criticism of the Proskauer firm.

To be successful under the UDRP, a complainant must establish 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.

In respect of the first limb, the complainants asserted that, as a result of the commercial activities under their names, they had developed unregistered trademark rights in those names.

The panel disagreed: while there are instances where an unregistered personal name may acquire common law (or unregistered) trademark rights through use in commerce as a source identifier of goods or services, the complainants could not establish this. For a complainant to establish that he has an unregistered trademark right in his name, he must show that the name has become a distinctive identifier associated with the complainant or his goods or services.

Although the complainants were successful partners at a prominent law firm, they did not market or provide services independently of the firm. Further, they were not considered to be the driving force behind the firm. For these reasons, the panel felt that their reliance on previous UDRP decisions was misplaced, and rejected the complaint.

While certain celebrities and public figures have been recognised to hold an unregistered trademark in their names in previous UDRP decisions, these cases generally involved individuals who are seen to be synonymous with the goods or services they provide, as was the case in [Mouret v Domain by Proxy Inc](#) (Case D2009-1435) and [Kotak Mahindra Bank Limited v Brown](#) (Case D2008-0243), the decisions cited by the panel. The present decisions show that a high threshold must be satisfied to establish an unregistered trademark in one's name. While the lawyers who brought the complaints might have been leading individuals in their fields, they were not prominent enough to convince the panel that they had developed a trademark in their names.

A related complaint was brought by the Proskauer firm itself against Leslie Turner, seeking transfer of the domain name 'proskauerlawfirm.com', which pointed to a website containing criticism of the Proskauer firm

World Trademark Review Daily

operated by Cox, the respondent in the first set of complaints. The panel considered Turner and Cox as interchangeable.

In respect of the first limb, Proskauer asserted that it had rights in the trademark PROSKAUER through registration and use. The panel found that the domain name was confusingly similar to the PROSKAUER mark, and this limb was therefore satisfied.

With regard to the second limb, under the UDRP a respondent may establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

*“(i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
(ii) you [respondent] (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [respondent] are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.”*

The panel considered that the respondent had a legitimate interest in the domain name on the basis of the third point. There is a general difference of opinion among panellists who have been faced with the issue of whether a ‘trademark.com’ domain name may be legitimately used by a respondent solely as a ‘gripe site’ to levy criticism against a complainant trademark owner and/or its products or services. This is often a more complex question than that raised by a ‘trademarksucks.com’ domain name, where the use of an additional pejorative term underlines that someone visiting the site is likely to find criticism of the complainant and thus the domain name is more likely to be acceptable.

However, in this instance a majority of the panel found that the respondent had a legitimate interest in the domain name, as it pointed to a genuine ‘gripe site’ and there was nothing to suggest that the respondent made money from the site. Thus, the domain name was found to be used only in pursuit of the respondent’s free speech rights. It was not up to the panel to consider whether the content of the website was actionable under the law for reasons unrelated to the domain name itself.

One panellist disagreed with the conclusion that a non-commercial criticism site confers upon a domain name holder a right or legitimate interest if the domain name consists solely of the complainant’s (and the target of the criticism) mark, with no explanatory addition. However, he did agree with the overall conclusion of the panel, which unanimously decided that the complaint should be denied. All panellists felt that this was not a clear case of cybersquatting which the UDRP was designed to address; it appeared to be part of a wider dispute between parties, which should be decided by a forum with jurisdiction and competence to rule on all aspects of the matter.

The panel did not need to consider the third limb. This decision highlights that there is a built-in defence of non-commercial or fair use of a domain name in the UDRP allowing free speech, provided such use is genuinely non-commercial.

These related decisions also demonstrate panellists’ respect for the limits of the UDRP and an unwillingness to stray outside of its scope of application to use it to determine matters that it was not designed to resolve. While the UDRP is an effective tool for dealing with cybersquatting, it was not designed to be more than this, and cases involving other legal issues such as defamation should be left to a more appropriate forum.

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