

World Trademark Review Daily

**No room for approximation under the UDRP
International - Hogan Lovells**

**Cybersquatting
Internet issues**

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In two cases decided under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP), the same panel from the [World Intellectual Property Organisation](#) (WIPO) has ordered transfer of the domain name 'atlasshuggedmovies.com' (*Atlas Productions LLC v toptendiets.org* (Case D2011-0585, May 17 2011)) and denied transfer of 'atlasshuggedmovie.com' (*Atlas Productions LLC v Oneandone Private Registrant* (Case D2011-0519, May 18 2011)).

Although based on different facts, the panel highlighted that both complaints were on shaky ground given the absence of direct proof of the complainant's rights. While this omission to produce suitable evidence did not impact on one of the complaints, it contributed to the denial of the other complaint. This highlights the importance of being familiar with all UDRP requirements and of complying thoroughly with them. As the panel pointed out:

"[c]omplainants' professional representatives in [UDRP] proceedings are advised to familiarise themselves with the policy's procedural and substantive requirements, and to comply with them, particularly those that differ from their counterparts in civil litigation, before choosing to take advantage of the cost savings and expedited resolution that the UDRP process provides."

The complainant in both cases was Atlas Productions LLC, a company claiming to have acquired exclusive rights to produce and distribute a motion picture adaptation of the novel *Atlas Shrugged*. The novel was written by Ayn Rand and published for the first time in the United States in 1957. It was eventually made into a movie, *Atlas Shrugged: Part 1*, which was released in the United States on April 15 2011.

The respondent in the 'atlasshuggedmovies.com' case was [toptendiets.org](#), which registered the domain name in July 2009 and used it to display a page containing various hyperlinks. The respondent in the 'atlasshuggedmovie.com' case was a Phil McCarty of Gainesville, Florida, who was, among other things, a screenwriter and director. McCarty registered the domain name 'atlasshuggedmovie.com' in 2004.

The complainant filed two complaints with WIPO, respectively on March 31 2011 and March 21 2011, requesting transfer of the respective domain names. To be successful under the UDRP, a complainant must prove that:

- the domain name registered is identical, or confusingly similar to, a trademark or service mark in which the complainant 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.

Richard G Lyon, who was appointed as the panel for both cases, ordered transfer of 'atlasshuggedmovies.com', but denied transfer of 'atlasshuggedmovie.com'.

Although the different outcomes can be explained by the specific underlying facts of each individual case, such as differences in registration dates (2009 and 2004), registrant profiles and use made of the respective domain names, both complaints failed to live up to the standard of proof of the UDRP, which was fatal for one of them.

To satisfy the first requirement of the UDRP, the complainant asserted that it had acquired rights (including trademark rights) to ATLAS SHRUGGED, at least in relation to movies, by means of an assignment which took place in 1992. However, the complainant failed to provide evidence to support this assertion even though, as the panel noted, such evidence should have been available to the complainant. The panel added that the complainant had shown that it had "expended considerable funds recently to promote its forthcoming movie, and on this basis might be said to have proven common law rights in the movie's title", although this was not sufficient to dispel the panel's doubts about the complainant's entitlement to bring the respective proceedings.

As it is clear under the UDRP that a complainant must prove each of the three elements, this omission on the complainant's part unsurprisingly affected the strength of the complainant's case, and it was only in light of its findings on the second and third requirements of the UDRP that the panel was able to determine the respective disputes.

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Given the weakness of the evidence produced in relation to the first element of the UDRP, the complainant might consider itself lucky to have obtained a transfer in the 'atlashruggedmovies.com' case.

These decisions highlight the risks of using the UDRP inappropriately and show that there is no room for approximation under the UDRP. It is also a reminder that, although faster and cheaper than court proceedings, the UDRP is not a loose 'one size fits all' alternative to court proceedings, and that complaints filed under the UDRP are reviewed with a fine-tooth comb. The principles and requirements of the UDRP simply cannot be ignored by complainants and their legal counsel.

David Taylor, Vincent Denoyelle and Jane Seager, Hogan Lovells LLP, Paris

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