

# World Trademark Review Daily

WIPO panel recaps 'bad-faith essentials' under the UDRP  
International - Hogan Lovells International LLP

Cybersquatting

April 11 2012

In *Cortix v Bogatchikova* (Case D2012-0129), complainant [Cortix](#), a French internet company, has lost a case filed under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) in relation to the domain name 'elliweb.info'. The domain name was registered on March 30 2011 and was being used to point to a pornographic website in English. A single-member panel ruled that the respondent, Lyubava Bogatchikova, based in Russia, was allowed to retain ownership of the domain name.

To be successful in a complaint under the UDRP, a complainant must evidence that:

- the domain name 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.

The panel was satisfied that the complainant had established the first requirement. Despite the fact that the complainant's trademark was figurative, the panel decided that, as the principal element of the mark was wholly incorporated into the disputed domain name, this was confusingly similar to the complainant's figurative mark.

In relation to the second requirement of the UDRP, the panel based its decision on the balance of probabilities, finding that the respondent had no rights or legitimate interests in the domain name. The complainant argued that, to its knowledge, the respondent had no rights in respect of the term 'elliweb' and that it had not granted the respondent any right to use the disputed domain name. Given that the respondent did not file any response, the panel agreed.

Turning to the third prong of the UDRP, the panel considered that the complainant had failed to make an argument showing that the respondent had registered and used the domain name in bad faith. It was necessary for the complainant to prove, at the very least, that the respondent was aware of the complainant's brand upon registration of the domain name and intended to take unfair advantage of it, but the complainant's trademark registration (May 2011) post-dated registration of the domain name (March 2011). Thus, according to the panel, additional information proving that the complainant had unregistered trademark rights at the time that the domain name was registered was required in order to prove bad faith. To this end, the panel cited Paragraph 1.7 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions](#), which states as follows:

*"The complainant must show that the name has become a distinctive identifier associated with the complainant or its goods or services. Relevant evidence of such 'secondary meaning' includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition."*

The complainant produced nothing in the way of evidence to establish unregistered trademark rights. In addition, the panel had no information to hand concerning the dates of registration of the other domain names held by the complainant, nor of the initiation of actual business of the complainant's company. Although the panel did not recognise the term 'elliweb' as a dictionary word (and this could lead one to believe that the respondent had prior knowledge of the complainant), there was nothing about the respondent's use of the name to support that allegation. However, the panel pointed out that, "[i]f the complainant's trademark had been a household name such as Kodak or Coca-Cola, then again it would have been easier for the panel to draw those inferences."

In addition, while the respondent failed to provide a response explaining the pornographic content of the website, this alone could not be used as evidence to infer that the use of the domain name was in bad faith. Although, in many UDRP decisions, pornographic content of a website has been indicative of bad faith, here the panel underlined that the mere connection of a domain name to a pornographic website could not of itself be determinative of such an issue.

The panel thus denied the complaint. The panel emphasised that, in order to prove bad-faith registration and use, there must be something to indicate that:

- the complainant's trademark rights were in existence at the date of registration of the domain name; and

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- the respondent was likely to have been aware of those rights.

In this case, the complainant had not made any mention of the fact that the only rights claimed by the complainant (registered trademark rights) post-dated the registration of the domain name.

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