

World Trademark Review Daily

UDRP decisions show that panels may legitimately have differing views
International - Hogan Lovells International LLP

Cybersquatting

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To be successful in a complaint under the [Uniform Domain Name Dispute Resolution Policy \(UDRP\)](#), a complainant must evidence all of the following:

- the domain name registered by the respondent 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.

In the majority of cases, complainants are able to overcome the initial hurdle of possessing a trademark, as required by the first prong, and the case usually turns on the issues set out in the second and third prongs. However, surprisingly, two recent complaints were denied on the basis that the complainants did not have the relevant trademark rights, meaning that there was no need for the panels to make any findings in relation to legitimate interests and bad faith.

In *Dyson Limited v Delas* (Case D2012-0701) the domain name in question was 'bladelessfanonline.com'. The complainant, Dyson Limited, was well known as part of a group of companies that designed and manufactured appliances such as vacuum cleaners and fans. In particular, Dyson marketed the Air Multiplier range of domestic fans which were often referred to as 'bladeless fans'. The domain name was pointing to a website selling Dyson products, some of which appeared to be counterfeit. The respondent did not submit any response.

Whilst there was no doubt that Dyson owned various registered DYSON and AIR MULTIPLIER marks, it did not have a registered BLADELESS FAN mark. However, lack of a registered trademark is not necessarily a showstopper under the UDRP, as long as a complainant can demonstrate that it has unregistered trademark rights in a term that is identical, or confusingly similar, to the domain name at issue.

Dyson argued that its use of 'bladeless fan' meant that it had acquired an unregistered trademark in the term, having used it extensively in the promotion of its products. It supplied evidence that it had sold 750,000 units since 2009, and also referred to wording on its website plus the results of various Google searches. As a result of a request from the panel for further information, Dyson also supplied statements from the directors of two large electrical goods retailers in the United Kingdom saying that the term 'bladeless fan' was widely known and used to refer to Dyson products.

The panel observed that the complainant's burden was even greater than usual in that the words 'bladeless fan' were almost completely descriptive of the goods themselves. As with any descriptive expression, it was necessary to show that there was some secondary meaning associated with the expression that indicated a specific trade origin, rather than just a characteristic or quality of the goods concerned. However, on the evidence first supplied, the panel was unable to reach this conclusion for the following reasons:

- The words 'bladeless fan' were not highlighted or emphasised on the Dyson website in a trademark sense (unlike the terms 'Dyson' and 'Air multiplier') and, instead, were mainly used descriptively as part of surrounding text describing the particular products.
- This was also true of the press cuttings supplied which identified Dyson as the specific trade provenance, rather than 'bladeless fans';
- The Google searches appeared at first glance to be more useful as the top results were all for Dyson products. However, the results did not really answer the question of whether the term was being used in a descriptive or a trademark sense. In addition, the results threw up the trademarked terms DYSON and AIR MULTIPLIER, which were clearly "stronger", which made it more difficult to show that 'bladeless fan' was being used in a trademark sense.

The further evidence consisting of the directors' statements did not really assist the panel much further. Both stated that, in their experience, when "people" used the term, they used it to refer to Dyson's fan products. However, the panel was not sure what was meant by the word 'people' and whether this was a reference to other staff members, customers or the public at large. Thus, on the material before it, the panel was unable to conclude whether the words 'bladeless fan' had been used as a trademark, rather than just as a general description of a product that was usually identified by reference to the registered marks DYSON or AIR MULTIPLIER.

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As a result, the panel found that it was unnecessary to consider whether 'bladeless fan' was identical, or confusingly similar, to the disputed domain name. However, it stated that, clearly, such a finding would have followed had the panel found for the complainant on the trademark issue. Similarly, there was no need to consider the question of whether the registrant had any rights or legitimate interests, or had registered and used the domain name in bad faith.

The complaint was thus denied, although with "considerable regret", as there appeared to be cogent evidence to indicate that the respondent was engaging in a course of conduct that may well be confusing. According to the panel, this could give rise to other causes of action against the registrant, but ceased to be relevant in the present UDRP proceeding once Dyson had failed to show that it had the relevant trademark rights.

In *Blandy & Blandy LLP v Beach* (Case D2012-0972), the panel also denied the complaint based on the complainant's failure to prove that it had the relevant trademark rights. However, the case turned on very different facts. The complainant was law firm [Blandy & Blandy](#) and the disputed domain name was 'blandyandblandy.com'. The registrant was a former client of the complainant who was using the domain name to point to a website which was critical of the complainant's services.

The complainant stated that the disputed domain name was identical to the names under which it was trading, namely 'Blandy and Blandy' and 'Blandy & Blandy', and that it owned a trademark in those words, although such mark was not registered. It argued that the registrant was attempting to misleadingly divert clients away from the complainant's website in order to cause damage to the complainant. The respondent did not reply.

The panel noted that, to rely on unregistered rights in a trademark, a complainant must go significantly further than it would if it owned a registered trademark. In this regard, the panel referred to the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition](#), which focused on the issue of what a complainant needed to demonstrate to satisfy the requirements for protection of an unregistered trademark. It stated that "a conclusory allegation of common law or unregistered rights (even if undisputed) would not normally suffice; specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required", and concluded that "unless such status is objectively clear, panels will be unlikely to take bald claims of trademark fame for granted".

In the panel's view, the evidence provided by the complainant concerning its unregistered trademark rights was "extremely weak". The complainant had not provided the requisite detail to evidence that either 'Blandy and Blandy' or 'Blandy & Blandy' had become a distinctive identifier associated with its business. It had not presented any evidence to prove that it had rights in an unregistered trademark, such as details relating to the length of time for which the mark had been used, information relating to its advertising material and revenue figures, and examples of media recognition.

The panel cited several cases which had been denied as a result of lack of evidence, and one in particular where the panel had determined that giving the complainant a second chance to submit evidence would not be in line with the spirit of expediency and efficiency suggested by the UDRP. In the present instance, the panel noted the complainant's status as a law firm and found that, in the light of such status, the complainant should have presented its complaint so as to properly address each of the three relevant elements of the UDRP.

Whilst the panel did not exclude the possibility that the complainant did have unregistered trademark rights, the fact was that it had failed to discharge its burden of proof in this respect. The panel thus denied the complaint.

These two cases are interesting not just because they were denied on the same, relatively rare, grounds, but also because they demonstrate the fact that panels may legitimately take different attitudes and have differing views. In the first case, the panel effectively decided to give the complainant a second bite of the cherry by asking for further evidence of its unregistered trademark rights, even though such rights were clearly going to be very difficult to prove due to the descriptive nature of the term at issue. However, in the second case, where the complainant had been trading under the distinctive name in question and would have been almost certain to have acquired unregistered trademark rights, the panel refused to ask for any further submissions.

In addition, had the first complainant been able to overcome the trademark hurdle, it seems likely that the complaint would have been upheld, given the registrant's counterfeiting activities; perhaps this is why the panel expended so much effort in trying to allow the complainant to pass the first hurdle. In contrast, had the second panel sought further submissions and given the complainant a second chance to prove

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unregistered trademark rights, the case would have been relatively difficult. The associated website was ostensibly a criticism website and the decision may well have gone either way. Some panels take the view that the right to criticise does not necessarily extend to registering and using a domain name that is identical to a trademark, whereas others are of the opinion that a registrant has a legitimate interest in using an identical domain name for criticism, provided that such use is fair and non-commercial.

What these two cases ultimately demonstrate is that the UDRP is not as straightforward as it may first appear. Much may depend on the attitude or viewpoint of the panel, and this in turn may be influenced by a myriad of conflicting factors stemming from all three UDRP requirements.

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