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UDRP case shows when complaint may be filed against several respondents  
International - Hogan Lovells International LLP

Cybersquatting

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A recent case filed under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) has provided a useful reminder of the circumstances in which a complaint may be filed against several respondents, despite the general rule that all domain names covered by one complaint must be registered by the same holder, as set out at Paragraph 3(c) of the UDRP Rules.

The complaint was filed by Minnetonka Moccasin Company Inc against 22 different Chinese registrants and concerned 27 domain names such as 'buyminnetonkamoccasins.com' and 'fashionminnetonkasale.com'. Founded in Minnesota in 1946, Minnetonka makes traditional hand-crafted American footwear which is now sold across the globe. It sells its products both through retailers and online using 'minnetonkamoccasin.com' as its main web address. Many of the 27 domain names at issue were pointing to websites selling counterfeit Minnetonka products.

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

- the domain name(s) is/are 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(s); and
- the domain name(s) has/have been registered and is/are being used in bad faith.

However, in this case, the [World Intellectual Property Organisation](#) (WIPO) panel first had to decide whether it was permissible to file the complaint against 22 different respondents. The UDRP and UDRP Rules remain silent on this point, but this issue has been considered by previous panels in other cases and the panel sought to review the prior case law to assess what the consensus of opinion was.

The general rule was asserted in *Kimberly-Clark Corporation v N/A Po Ser* ([WIPO Case D2009-1345](#)):

*"A number of panels deciding cases under the policy have permitted a single complaint in respect of multiple domain names for which the registrants were not the same person, where the circumstances suggested that the registrants (being the named respondents) were controlled by a single entity."*

The panel in *Speedo Holdings BV v Programmer* ([WIPO Case D2010-0281](#)) broadened this approach and concluded that:

*"the consolidation of multiple domain name disputes under Paragraph 3(c) or 10(e) of the rules may be appropriate, even where differently named domain name registrants are involved, where the particular circumstances of a given case indicate that common control is being exercised over the disputed domain names or the websites to which the domain names resolve."*

According to the panel, the concept of 'common control' has been given a broad interpretation. UDRP panels have found that common control can be exercised in various circumstances, including where the content of the websites was substantially identical and referred internet visitors to a common homepage (see *CSA International (aka Canadian Standards Association) v Shannon* ([WIPO Case D2000-0071](#))), and in circumstances where the domain names were registered with the same registrar and resolved to essentially identical websites (see *Sharman License Holdings Limited v Dorrance* ([WIPO Case D2004-0659](#))).

Minnetonka provided the following evidence and arguments to indicate a connection between the 22 respondents:

- The websites to which the domain names were pointing were identical in appearance, with the exception of the website to which the domain name 'minnetonkamoccasinboots.com' was pointing, which was similar but not identical, and the website to which the domain name 'minnetonka-boots.com' was pointing, which was inactive.
- The domain names were registered within a short time of one another.
- The domain names were all registered with one of two registrars: Jiangsu Bangning Science & Technology Co Ltd or Bizcn.com Inc.
- Except for 'minnetonkamoccasinboots.com', the domain names were hosted at one or two combinations of DNS servers.
- With the exception of the website that the domain name 'minnetonka-boots.com' was pointing to,

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which was inactive, the domain names were all pointing to websites offering identical counterfeit products.

The panel was of the opinion that the above facts were sufficient for a finding of common control or connection between the disputed domain names, with the exception of 'minnetonkamoccasinboots.com' and 'minnetonka-boots.com'. This was also evidenced by the fact that the email addresses for all of the respondents, except the registrant of 'minnetonka-boots.com', consisted of one of three domain names: '126.com', '163.com' and 'yeah.net', all registered to the registrant Netease.com Inc.

The panel noted that the domain names 'minnetonkamoccasinboots.com' and 'minnetonka-boots.com' differed from the other domain names as follows:

- The websites that they were pointing to did not share the same visual appearance as the websites to which the other domain names were pointing.
- The DNS server of 'minnetonkamoccasinboots.com' was different from the DNS servers of the other domain names.
- The registrant of 'minnetonka-boots.com' did not share a similar email address to the email addresses of the other respondents.

In the panel's opinion, the above gave rise to a concern that the domain names 'minnetonkamoccasinboots.com' and 'minnetonka-boots.com' may not in fact be under the same common control or connected to the other domain names.

As a result, the panel found that, under the particular circumstances of the case, Minnetonka had established that all the domain names at issue were subject to the common ownership or control of the same person or company, with the exception of 'minnetonkamoccasinboots.com' and 'minnetonka-boots.com'. In the panel's opinion, this connection was sufficient to permit the filing of a single complaint, and accordingly, the panel allowed the consolidation to go ahead.

However, the panel did not feel that the circumstances at hand were appropriate to grant Minnetonka's request to consolidate 'minnetonkamoccasinboots.com' and 'minnetonka-boots.com' in the same case and declined to discuss these domain names any further.

The panel also had to decide a second procedural issue before considering the case itself, namely that of the correct language of the proceeding. Paragraph 11(a) of the UDRP Rules provides as follows:

*"Unless otherwise agreed by the parties, or specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding."*

In this case, the language of the registration agreements for the domain names at issue was Chinese, but, in its submission, Minnetonka had requested that the language of the proceeding be English. In this regard, the panel considered the following case citation:

*"Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the registration agreement shall dictate the language of the proceeding. However, the panel has the discretion to decide otherwise having regard to the circumstances of the case. The panel's discretion must be exercised judiciously in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case" (Groupe Auchan v xmxzl (WIPO Case DCC2006-0004)).*

In deciding on the language of the proceeding, the panel took the following factors into consideration:

- Some of the domain names incorporated English words such as 'discount', 'sale' and 'boots';
- The domain names resolved to online marketplaces, mainly in English;
- The websites offered the option of transactions in predominantly English-related currencies such as US dollars, British pounds and euros;
- None of the domain names was pointing to a website in Chinese;
- The respondents did not object to Minnetonka's request that English be the language of proceedings; and

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- All case-related communications were sent in both English and Chinese.

Given the above, the panel decided to allow the proceedings to continue in English.

The case itself was then relatively simple to decide, given the fact that Minnetonka was the owner of numerous worldwide trademark registrations for MINNETONKA and MINNETONKA MOCCASIN and the fact that the domain names were being used to point to websites selling counterfeit goods. The panel ordered the transfer of all of the domain names at issue, apart from 'minnetonkamoccasinboots.com' and 'minnetonka-boots.com'. However, the panel clearly stated that this was without prejudice to Minnetonka's ability to file future UDRP complaints concerning these domain names against the respondents concerned.

The case serves as a useful reminder of when it may be possible to file a UDRP complaint against more than one respondent. Interestingly, there are also circumstances where a UDRP complaint may be filed by multiple complainants, for example in situations where the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants' individual rights in a similar fashion. However, once again the UDRP and UDRP Rules do not make explicit reference to this issue, and what is generally acceptable has evolved over time via previous case law. Although the UDRP does not operate on a strict doctrine of precedent, panels usually consider it desirable that their decisions are consistent with prior panel decisions dealing with similar fact patterns.

The case demonstrates that there is much more to the UDRP than just the basic policy and rules. In fact, they are quite simply drafted and have remained substantially similar since the UDRP was first introduced in 1999. Evidently, many situations have subsequently arisen which were unseen back in 1999, such as the potential for multiple complainants and respondents, but a substantial body of case law has since developed to fill the gaps. This not only shows that the UDRP has proved itself to be a flexible tool in the fight against cybersquatting, but also that it is capable of adaptation to accommodate future fact patterns that may arise given rapidly changing technology.

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