

World Trademark Review Daily

Core diagnosis would have stopped hijack International - Hogan Lovells LLP

Cybersquatting

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In a recent decision under the [Uniform Domain Name Dispute Resolution Policy \(UDRP\)](#), a panel from the [Arbitration and Mediation Centre](#) of the [World Intellectual Property Organisation \(WIPO\)](#) has reminded complainants that they should give serious consideration to the facts of cases before deciding to attempt recuperation under the UDRP, as failure to do so could result in a finding of reverse domain name hijacking.

In *M/s Core Diagnostics v Keul* (WIPO decision 2013-1238), the complaint was brought by an Indian company, M/s Core Diagnostics, a clinical laboratory specialising in disease diagnosis. The complainant began operating in 2011 and registered various trademarks in the term 'core diagnostics' in 2012 and 2013. The complainant already held the domain name 'corediagnostics.in' and wished to obtain the transfer of 'corediagnostics.com' from the respondent, a Mr Keul, who had registered it in 2001 and had been using it since then to promote various medical diagnostic products.

In order to be successful under the UDRP, a complainant is required to establish the three following cumulative criteria:

- 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.

However, the first paragraph of the UDRP Rules also provides that complainants may be found guilty of attempting reverse domain name hijacking if it is found that they are using the UDRP "in bad faith to attempt to deprive a registered domain name holder of a domain name".

The complainant essentially alleged that, in addition to the obvious identity between its trademark and the domain name 'corediagnostics.com', the respondent had no rights or legitimate interests in the domain name. According to the complainant, the respondent allegedly did not operate any business activities under the name Core Diagnostics since the corresponding website did not evidence any such activity and only provided "mere information". Finally, as an argument for bad faith, the complainant relied on the fact that, when contacted about a transfer of the domain name, the respondent had offered to sell it for an amount significantly higher than standard out-of-pocket expenses.

The respondent replied to the complaint by putting forward the anteriority of the domain name registration in comparison to the trademark relied upon by the complainant, as well as evidence demonstrating that he had operated a business using the domain name prior to the creation of the complainant's company. The respondent asserted that the domain name was registered many years before the complainant was founded and started doing business. Furthermore, the respondent argued that the attempt to recuperate the domain name amounted to attempted reverse domain name hijacking.

The panel summarily dismissed two of the three UDRP criteria out of hand, given that an analysis was not necessary in view of the panel's findings under the third criterion relating to registration and use in bad faith. As far as bad faith was concerned, the domain name had been registered at least 10 years before Core Diagnostics had even started its own operations and had registered trademarks to protect its IP rights. In this regard, the panel found that "the respondent could not have registered the domain name in bad faith", in line with the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions](#), according to which:

"when a domain name is registered by the respondent before the complainant's relied-upon trademark right is shown to have been first established (whether on a registered or unregistered basis), the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the complainant's then non-existent right".

The WIPO overview does outline certain exceptions to this rule, for example when a respondent is clearly aware of a complainant, and it is clear that the aim of the registration was to take advantage of the confusion between a domain name and any potential complainant rights (eg, shortly before or after a publicised merger between companies, but before any new trademark rights in the combined entity have arisen). However, there were no such exceptions in this particular case.

Finally, addressing the issue of reverse domain name hijacking, the panel noted that the registration of the domain name far predated the complainant's rights in the CORE DIAGNOSTICS trademark and that the

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complainant must have known this because it produced the Whois record for the domain name as an attachment to the complaint. Thus, the complainant knew or ought to have known that it was unable to prove that the respondent had registered and was using the domain name in bad faith.

The panel therefore found in favour of the respondent. It ordered that no action should be taken and concluded that the complaint had been filed in bad faith, thus resulting in a finding of attempted reverse domain name hijacking.

Whilst a finding of reverse domain name hijacking under the UDRP currently does not lead to any actual sanctions for complainants in practice (eg, payment of the registrants' fees to file their responses or a prohibition on filing further complaints), it at least clearly sets out panels' displeasure in a publicly available decision. This should mean that the complainant in this particular case may think twice before filing another complaint, knowing that that it has a finding of reverse domain name hijacking against it. This finding may also act as a deterrent to discourage such behaviour on the part of other complainants going forward.

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