

# World Trademark Review Daily

**UDRP complaints: only one bite of the cherry is permitted  
International - Hogan Lovells LLP**

**Cybersquatting**

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Swedish fashion company **5 PRE VIE W AB** has recently filed an **unsuccessful complaint** under the **Uniform Domain Name Dispute Resolution Policy (UDRP)** with the **World Intellectual Property Organisation (WIPO)** concerning the domain name '5preview.com'.

The complainant owned several semi-figurative trademarks composed of the number and letters '5 PRE VIE W':

- Italian trademark No 1400411 registered on January 11 2011 in Classes 14, 18 and 25;
- International trademark No 1058683 registered on October 22 2010 in Class 25 (designating China, Japan and the United States); and
- Swedish trademark No 0410207 registered on April 1 2010 in Class 25.

The complainant stated that it used these trademarks to sell fashion clothing and accessories through its own official website.

The domain name '5preview.com' was registered on February 19 2008 by Diego Manfreda of Rome, Italy. No other details were known about the respondent as he did not submit a formal response to the complaint.

The website associated with the disputed domain name stated on the homepage "5PW | 5PREVIEW WARDROBE | OFFICIAL WEBSITE", together with the words "OUTDOOR COMING SOON" and a rather intriguing short film. There was also a link to various photographs, although it was clear that the website had not been updated since 2010.

In order to succeed under the UDRP, a complainant must satisfy all of the following three requirements of Paragraph 4(a):

1. The domain name is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
2. The respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

With regard to the first limb, the complainant asserted that the domain name was identical to its registered figurative trademark, consisting of a design formed by the number 5 placed above the abbreviation 'PRE', which in turn was placed above the abbreviation 'VIE W'.

As is stated in the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition](#) (WIPO Overview 2.0) at Paragraph 1.11:

*"as figurative, stylised or design elements in a trademark are generally incapable of representation in a domain name, such elements are typically disregarded for the purpose of assessing identity or confusing similarity, with such assessment generally being between the alpha-numeric components of the domain name, and the dominant textual components of the relevant mark. However, design elements in a trademark may be relevant to the decision in certain circumstances – such as where, for example, they form an especially prominent or distinctive part of the trademark overall".*

The panel noted that there was no disclaimer of any textual content in the complainant's trademark registrations and the elements '5', 'PRE', 'VIE' and 'W' appeared in that order and were all clearly represented. The panel noted that there were no non-textual elements of the mark. In conclusion, the panel found that the disputed domain name was identical to the complainant's trademark.

The complainant's marks all post-dated the date of registration of the domain name. The panel noted that the time of registration did not affect the complainant's case under Paragraph 4(a)(i) of the UDRP (see the consensus view in paragraph 1.4 of the WIPO Overview 2.0, which states that registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the UDRP, although in such circumstances it may be difficult to prove that the domain name was registered in bad faith under the third element of the UDRP). Accordingly, in the present case, the panel found that the first element under the UDRP had been established.

Concerning the second requirement of the UDRP, Paragraph 4(c) of the UDRP sets out a non-exhaustive list

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of circumstances which may suggest that a respondent has rights or legitimate interests in a domain name, as follows:

1. Before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name in connection with a good-faith offering of goods or services;
2. The respondent has been commonly known by the domain name, even if it has acquired no trade mark rights; or
3. The respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the trademark at issue.

The panel noted that the requirements of Paragraph 4(a) were conjunctive. Given that the third requirement of the UDRP could not be established, it was therefore unnecessary for the panel to address the issue of the respondent's rights or legitimate interests in the domain name.

Concerning the third requirement of the UDRP, Paragraph 4(b) sets out a list of non-exhaustive circumstances that may suggest registration and use of a domain name in bad faith, as follows:

1. The respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring it to the complainant or to a competitor, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
2. The respondent registered the domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct;
3. The respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
4. The respondent is intentionally using the domain name in an attempt to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the respondent's website.

However, the complainant's submissions did not focus on any particular element of the above. Instead, the complainant claimed that the respondent had a prior relationship with the complainant's founder, the nature of which was not specified, whereby the respondent came to register the disputed domain name on the complainant's behalf. The complainant indicated that, for reasons which it did not specify, the respondent had recently denied the complainant access to the domain name and had demanded money in exchange for its release.

The respondent argued that the domain name was registered before the date on which the complainant acquired trademark rights - the domain name was registered in February 2008 while the earliest trademark cited by the complainant was filed in September 2009 and registered in April 2010.

Consensus panel opinion states in the WIPO Overview 2.0 at Paragraph 3.1 that:

*"Generally speaking, although a trademark can form a basis for a UDRP action under the first element irrespective of its date..., when a domain name is registered by the respondent before the complainant's relied-upon trademark right is shown to have first been established, 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."*

However, the WIPO Overview 2.0 provides an exception to this general rule, namely when "the respondent is clearly aware of the complainant, and it is clear that the aim of the registration was to take advantage of the confusion between the domain name and any potential complainant rights". The panel respectfully adopted the consensus view and underlined that bad faith may be found when the domain name was registered before the trademark, provided that it could be shown that the domain name was registered "with intent to target and take unfair advantage of rights ultimately vesting in the complainant, which the respondent knew were likely to arise at a later date". According to the panel, this appears to be "the thrust of the complainant's case in the present dispute in that the complainant cites a prior relationship between the respondent and the founder of the complainant, arising out of which the disputed domain name was allegedly registered".

However, the panel found itself with a very limited record, providing insufficient indications to support a finding of bad faith. There was no evidence to suggest that the respondent "intended to target and take unfair advantage of the complainant's rights at the point of registration" or was "simply effecting the registration in good faith as part of its then existing relationship with the complainant".

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Moreover, the panel highlighted the fact that, according to the principles of the UDRP, the parties must present their case fully in the first instance and any invitation to provide further information should be exceptional and of necessity. In the present case, the panel considered that "the relevant matters were known to the complainant and/or should have been in its reasonable contemplation at or before the time of filing of the complaint". The panel thus decided against making a procedural order asking the complainant for further information and answers to questions relating to the precise nature and history of the relationship between the parties, and whether the complainant had communicated its intentions regarding the disputed domain name and/or its proposed plans to the respondent.

Given that it was necessary to prove both registration and use in bad faith, the panel found that, in the present matter, the complainant had failed to establish the third element under the UDRP and the complaint was therefore denied.

This case highlights the fact that it is crucial for complainants to set out all their arguments in their initial complaint as, under the UDRP, it is very unlikely that they will have another chance to present further evidence. In other words, only one bite of the cherry is permitted and complainants have to get it right first time. In this case, vital explanations were missing and the panel did not have enough information to decide whether or not the registration had in fact been made in bad faith as required under the UDRP. The UDRP is intended for clear-cut cases of cybersquatting, which is reflected in its relatively low cost and speedy turnaround time; thus, if the evidence is not clear, it is likely that a panel will not seek to dig further by means of a discretionary procedural order, but instead will simply deny the complaint.

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