

UDRP decision highlights that evidence of targeting is key

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- The owner of the mark I LOVE ART GERSTAECKER G sought the transfer of 'iloveart.com' under the UDRP; it claimed to have owned the domain name for 19 years, but had supposedly let it lapse
- The panel held that it was impossible to assess whether the complainant had ever been the owner of the domain name
- There was nothing to support a claim of targeting in bad faith

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied the transfer of the domain name at issue, finding that the complainant had failed to prove bad-faith registration on the part of the respondent and entering a finding of reverse domain name hijacking (RNDH).

Background

The complainant was Le Géant des Beaux-Arts SARL, a French company selling art supplies. The complainant held an EU figurative trademark for I LOVE ART GERSTAECKER G. This trademark was also previously registered in the United States, but was cancelled in 2022.

The disputed domain name was 'iloveart.com'. The complainant claimed to have owned the domain name for 19 years, but had supposedly let it lapse due to a provider change. The domain name was acquired by the respondent in 2022, via an auction, after the previous owner had failed to renew its registration.

The complainant initiated proceedings under the UDRP for a transfer of ownership of the domain name. The respondent submitted a response requesting the panel to enter a finding of RDNH.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements under Paragraph 4(a):

1. the domain name registered by the respondent 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.

Decision

Somewhat unusually, the panel did not address the first and second element in its ruling, choosing to focus solely on the third element. In that regard, the panel found that the complainant had not established that the domain name had been registered in bad faith.

First, the panel underlined that merely registering domain names to resell them was not sufficient to prove bad faith. Reselling was allowed unless it could be said to breach the provisions of the UDRP. In this regard, the panel held that the complainant had not provided any evidence substantiating its claim that the respondent knew of its activities and trademarks. Rather, the panel found that the respondent rightfully argued that the sentence "I love art" was commonly registered and used as trademarks, as well as domain names, and that the complainant had failed to demonstrate its notoriety in the United States, where the respondent was based.

Secondly, the panel noted the lack of evidence regarding ownership of the domain name by the complainant. The complainant asserted that it had owned the domain name for 19 years, but submitted no substantiating evidence. Conversely, the respondent brought forward evidence that the domain name had frequently changed hands and was merely redirected to a website associated with the complainant at some point, without the complainant being the rightful registrant at the time. The panel held that it was therefore impossible to assess whether or not the complainant had ever been the owner of the domain name and, moreover, there was nothing to support a claim of targeting in bad faith.

Finally, the panel concluded by entering a finding of RDNH, considering that the lack of relevant evidence, combined with the fact that the complainant was represented by counsel, were proof that the complaint was brought in bad faith.

Comment

Once again, this decision underlines that evidence of targeting is key, especially where a domain name comprises a generic term or sentence. Registrants of such domain names should take great care not to allow them to lapse, as it is very difficult to mount a case against domainers who snap them up at auction, sometimes for significant sums, and who can plausibly assert that they have never heard of the previous registrant. The purpose of the UDRP is not to assist registrants or their agents who forget to renew their domain names.

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