

Legal Issues in UDRP

Can an Unauthorized Reseller/Distributor Claim Legitimate Interests in a Domain Name?

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Relevant Provisions

- ❖ **Uniform Domain Name Dispute Resolution Policy, Paragraph 4(a); Rules for Uniform Domain Name Dispute Resolution Policy, Paragraph 3(b)(ix)**

“Describe, in accordance with the Policy, the grounds on which the complaint is made including, in particular,

(1) the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(2) why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint; and

(3) why the domain name(s) should be considered as having been registered and being used in bad faith...” [Emphasis supplied]

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WIPO Overview of WIPO Panel Views on Selected UDRP Questions

❖ How do panels assess claims of nominative (fair) use by resellers or distributors?

“Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name.” [Emphasis supplied]

❖ The panels primarily rely on the **Oki Data** test.

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(Link: <https://www.wipo.int/amc/en/domains/search/overview3.0/#item28>)

Relevant UDRP Decisions

❖ *Oki Data Americas, Inc. v. ASD, Inc.* [Case No. D2001-0903]

- “... Respondent **must actually be offering** the goods or services at issue...”
- “...Respondent **must use the site to sell only the trademarked goods**; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods...”
- “...The site **must accurately disclose the registrant's relationship with the trademark owner**; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents...”
- “...The Respondent **must not try to corner the market in all domain names**, thus depriving the trademark owner of reflecting its own mark in a domain name. *Magnum Piering, Inc. v. Mudjackers*, WIPO Case No. D2000-1525 (WIPO Jan. 29, 2001) (“a single distributor is extremely unlikely to have a legitimate interest in precluding others from using numerous variants on a mark”)....”
[Emphasis supplied]

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Relevant UDRP Decisions (Contd.)

❖ *General Motors LLC v. Flashcraft, Inc DBA Cad Company* [Case No. D2011-2117]

Trademark: CADILLAC ; **Disputed Domain Name:** <cadillacperformance.com>

- “...The Respondent here meets the Oki Data criteria. It is offering and has since registering the disputed domain name offered the goods or services at issue. The record indicates that the Respondent deals only in Cadillac parts and service, and does not use the Complainant’s mark to bait and switch customers to other goods. The website, whether treated as a test page or operating website, discloses the Respondent’s non-affiliation with the Complainant in prominent and unmistakable terms, and nothing on the website suggests an affiliation. The record reveals no other domain names incorporating the CADILLAC mark owned or used by the Respondent. **That the Respondent has actively sought to reduce any incidental confusion**, and that the Respondent serves a market no longer supplied by the Complainant, add further legitimacy to the Respondent’s website and the disputed domain name...” [Emphasis supplied]

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Relevant UDRP Decisions (Contd.)

❖ *Karen Millen Fashions Limited v. Danny Cullen* [Case No. D2011-1134]

Trademark: KAREN MILLEN ; **Disputed Domain Name:** <karenmillenoutletonline.com>

- “...the predominant concern is *deceptiveness in the subject website, in the sense of conduct likely to mislead Internet users as to some relationship between the website operator and the trade mark owner. Conversely, if the absence of such a relationship is obvious from the website, even if not expressly stated, so that no reasonable person could be misled in the required way, this should be sufficient to absolve the website operator...Had the Complainant provided evidence to substantiate its claim in this case that the goods offered on the website were counterfeit (because, for example, they had been obtained and validated by an appropriate person as such), the Panel would have had little hesitation in concluding that the offering on the website was not bona fide for the purposes of the Policy. However, the Panel sees no such evidence in this record.*” [Emphasis supplied]

Relevant UDRP Decisions (Contd.)

- ❖ *Intuit, Inc. v. Privacyprotect.org / Niveditha.G, Cosmic IT Services Pvt. Ltd* [Case No. D2011-1714]

Trademark: QUICKBOOKS; **Disputed Domain Name:** <quickbooksindia.com>

- “...The Respondent’s very prominent and repeated use of a representation of the Complainant’s QuickBooks product featuring the QUICKBOOKS logo mark...The question is **whether, in spite of this use, the Respondent has adequately differentiated itself from the Complainant so that Internet users would not be confused into thinking that there was some association between the parties.** The Panel notes that, although the Respondent has included a disclaimer in appropriate terms, it is not in a particularly large or obvious font. However, there is no suggestion on the website that the Respondent is authorized by or affiliated with the Complainant and, on considering the combined effect of the website text, the references to the Respondent as “Cosmic”, the disclaimer itself, and the express acknowledgement of the Complainant’s status as supplier of the QuickBooks product on the FAQ page, **the Panel is prepared to give the Respondent the benefit of the doubt...** Overall the Panel finds that the Respondent has developed a legitimate business over a period of years in training services for the Complainant’s QuickBooks product..” [Emphasis supplied]

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Relevant UDRP Decisions (Contd.)

❖ *Samsung Electronics Co., Ltd. v. Gestion Integral Inovages* [Case No. D2012-0570]

Trademark: SAMSUNG ; **Disputed Domain Name:** <samsungcentralitas.com>

- “...Complainant’s contention that the general public may have a **false impression that Respondent is connected to Complainant** just because Respondent is using the SAMSUNG trademark on the website associated to the disputed domain name has given this Panel pause for thought, especially **in view of the widely-recognizable nature of the SAMSUNG mark**. However, this Panel further notes that **Complainant’s contention in this regard is not supported by any evidence and even if it had been it would still need to be considered in light of the circumstances overall**. The Oki Data standard is not meant to lay down an inflexible test, and the effect of otherwise of respondent claims or disclaimers on the website, or of any resultant risk of misrepresentation or customer confusion, need to be considered in the particular context and evidence of record. From the evidence that is in the file in this case it seems to this Panel that Respondent is displaying the SAMSUNG mark precisely to offer products bearing such trademark and not to hold itself out as if it were officially connected to Complainant or to otherwise engage in bait and switch activities with other non-SAMSUNG branded products...” [Emphasis supplied]

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Relevant UDRP Decisions (Contd.)

❖ *Aktiebolaget Electrolux v. Pablo Rodriguez Guirao* [Case No. D2013-1223]

Trademark: ELECTROLUX ; **Disputed Domain Name:** <electroluxmallorca.com>

- “...The evidence...shows that on the webpage to which the disputed domain name devolves, there are four statements at the top, in the middle and end of the webpage, that the Respondent (1) is an unofficial technical service of Electrolux and other brands, (2) is a technical service independent of the manufacturer Electrolux, (3) is not an official technical service of the manufacturer Electrolux, and (4) that the trademark ELECTROLUX is the property of its legitimate owners...It appears that the **Respondent is an independent repairer of domestic electrical appliances who has included the ELECTROLUX mark in the disputed domain name so that Internet users are aware of the availability of its repair services for that mark of domestic appliance in Mallorca.** The Respondent makes it reasonably clear on his website that it is independent of the Complainant so Internet users are unlikely to be confused as to the relationship of the Complainant’s trademark with the Respondent. There is no evidence the Respondent is taking business from the Complainant and neither is there any allegation the Respondent is selling third party products or services on the relevant website. There is also no evidence that the Respondent is harming the Complainant’s trademark or business in any way...”
[Emphasis supplied]

Relevant UDRP Decisions (Contd.)

- ❖ *Hizlipara Ödeme Hizmetleri ve Elektronik Para A.S. v. Privacy Protected by Hostnet / Seber Holding B.V.*[Case No. D2020-2358]

Trademark: PAYPORTER; **Disputed Domain Name:** <payporter.com>

- “...The Panel notes, however, that the Respondent appears to have carried out a degree of business formation-related activity utilizing the PayPorter name, including the incorporation of a company bearing the same name, as well as credible investment in website development. The Complainant has not at any point suggested that the services offered via the Respondent’s website are fraudulent or otherwise illegitimate in nature. Indeed, it appears that the Respondent is operating under a licence granted by the Dutch Central Bank. Moreover, it is clear from the “Company Information” page of the Respondent’s website that the entity operating the website is PayPorter B.V. of the Netherlands, and not the Complainant...**The Panel’s finding under this element ought not to be interpreted as a positive finding that the Respondent does in fact have rights or legitimate interests in the disputed domain name, but rather that the Complainant’s assertions and evidence have failed to establish the contrary within the meaning of paragraph 4(a)(ii) of the Policy.**” [Emphasis supplied]

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THANK YOU!

Questions?

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