

Evidence of targeting is essential under the UDRP

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- The complainants, which owned US trademark registrations for CRESSET, sought the transfer of 'cresets.com' under the UDRP
- The panel was not persuaded that the respondent had registered the domain name with knowledge of, and in order to target, the complainants' trademark
- It was not persuaded that the respondent had created and used its website as a sham or pretext to cybersquat upon the complainants' trademark

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied the transfer of the disputed domain name 'cresets.com' given the lack of any evidence suggesting that the domain name had been registered and used in bad faith.

Background

The complainants were Cresset Administrative Services Corporation and Cresset Partners LLC, two US companies offering financial advisory and wealth management services. They held various trademark registrations for CRESSET in the United States, including a US trademark registered on 31 July 2018 for financial planning and related services. The respondent was a company based in Bangladesh.

The disputed domain name was 'cresets.com', registered on 17 December 2022. It resolved to a website that appeared to offer resources for photo, design and mock-up applications and suggested that free downloads were available upon an account being created.

To be successful in a complaint under the UDRP, a complainant must satisfy the requirements of Paragraph 4(a), namely that:

(i) the domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;

(ii) the respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

Decision

First limb

The complainants relied on their trademark registrations for CRESSET and asserted that the domain name was a common misspelling of this with the transposition of one letter 's'. The panel applied the test for confusing similarity and found that the domain name was confusingly similar to the complainants' trademark.

Second and third limbs

Given its findings under the third limb, the panel considered that it was unnecessary to decide whether the respondent had rights or legitimate interests in respect of the domain name.

Regarding the third limb, the complainants had to demonstrate that, on balance, the domain name had been registered and used in bad faith.

Concerning the registration of the domain name, the complainants contended that the respondent must have been aware of their CRESSET mark due to the notoriety of the trademark among consumers. However, they provided no evidence concerning the level of public recognition of their trademark outside of the United States, nor any specific reasons as to why the respondent ought to have been aware of it. Viewing both CRESSET and 'Cresets' as names that could have independent meanings and applications in commerce in different geographical locations, the panel did not consider that the latter was obviously parasitical upon, or necessarily called to mind, the former.

Based on its own limited research, the panel found that the complainants were not the owner of the domain name 'cresset.com' and operated their principal websites from 'www.cressetcapital.com' and 'www.cressetpartners.com', which would appear to dispel any suggestion that the domain name was intended to impersonate the complainants' domain name.

Although the respondent had provided no explanation for its choice of the domain name, the panel noted that it used the name 'Creset' instead of 'Cresets' in one instance on its website. The panel was not persuaded that the respondent had registered the domain name with knowledge of, and in order to target, the complainants' trademark.

Concerning the use of the domain name, the panel found that the respondent's website indicated no obvious route to commercial gain for the respondent, nor any content related to financial or investment services or linked to any commercial provider of such services. In the circumstances, the panel was not persuaded that the respondent had created and used its website as a sham or pretext to cybersquat upon the complainants' trademark or otherwise to cause confusion with that trademark.

The complainants submitted that the respondent had registered the domain name with the intention of selling it to the complainants for a sum in excess of the respondent's out-of-pocket costs associated with the domain name. The panel found this contention speculative as the complainants had provided no evidence in this regard.

The complainants also contended that the respondent had registered the domain name with the intention of diverting internet users to its own website by causing confusion with the complainants' trademark. Again, the panel found that there was no evidence to demonstrate that this was the case. In the panel's opinion, bad faith could not be established merely upon the complainants' assertion that the domain name was so similar to their CRESSET trademark that it could only have been registered and used to target that trademark.

As stated in Section 3.1 of [WIPO Overview 3.0](#):

“ *Complaints alleging the types of conduct described in UDRP Paragraph 4(b) should be supported by arguments and available evidence... Even in cases of respondent default, panels have held that wholly unsupported conclusory allegations may not be sufficient to support a complainant's case.* **”**

In the present case, the panel did not find on the available evidence that the domain name had been registered and used in bad faith. The complaint was therefore denied.

Comment

This decision illustrates the importance for complainants to collect sufficient evidence to establish a respondent's bad faith in the registration and use of a disputed domain name before filing the UDRP. This is particularly the case when a trademark is distinctive in one jurisdiction but not in another, and may not exclusively refer to the complainant. In the present case, the mere fact that the disputed domain name was considered similar to the complainant's trademark did not necessarily mean that the respondent's registration and use of the domain name was in bad faith. Evidence that the respondent had the complainant in mind and was attempting to profit from the complainant's goodwill and reputation when registering and using the disputed domain name was also necessary. In short, evidence of targeting is key when it comes to filing a successful UDRP complaint.

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