

# Use the UDRP to Reclaim That Trademarked Domain Name? Maybe Not.

November 16, 2011 | Blog | By Jamison Arterton

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UDRP proceedings are often touted as a quick and inexpensive way to resolve domain name disputes. Several recent UDRP decisions denying relief to trademark owners, however, demonstrate that in some instances the UDRP may not be the appropriate tool.

A few recent UDRP decisions have denied relief to trademark owners who were seeking to reclaim trademark-based domain names that were being used (essentially) as fan sites. For example, in October 2011, a panel **denied** a UDRP complaint filed by **LEGO** seeking the transfer of the domain name <[legoworkshop.com](http://legoworkshop.com)>. On the issue of legitimate use, the respondent claimed, and the panelist accepted, that he registered the domain name in order to show some of his son's LEGO creations and to provide videos demonstrating building techniques. Although LEGO provided evidence showing that the website located at the domain name had, at one point, displayed sponsored links for "Lego toys," "Lego guns" and "Star Wars Legos," the panelist determined that there was insufficient evidence of commercial gain to the respondent since it was unclear where the links went or with whom they were associated. Thus, the panelist denied LEGO's complaint (This loss is particularly notable as, according to an article in **Domain Name Wire**, LEGO has filed nearly 300 UDRP complaints and this decision is its first loss). Similarly, in September 2011, Stefani Germanotta (a.k.a. Lady Gaga) filed an unsuccessful UDRP complaint against the registrant of an unofficial fan website located at the domain name <[ladygaga.org](http://ladygaga.org)>. Again, the panel examined whether the respondent was profiting from use of the domain name. Finding that the website located at <[ladygaga.org](http://ladygaga.org)> lacked commercial content, the panel **denied** the complaint.

The (predominantly) noncommercial nature of these two fan sites was important to the outcomes here. As stated in the **WIPO Overview, 2.0**, "The registrant of an active and noncommercial fan site may have rights and legitimate interests in the domain name that includes the complainant's trademark. The site should be actually in use, clearly distinctive from any official site, and noncommercial in nature." Prior UDRP decisions conclude that "a degree of incidental commercial activity [on such sites] may be permissible in certain circumstances (e.g., where such activity is of an ancillary or limited nature or bears some relationship to the site's subject)." This position is consistent with the decisions reached in both the LEGO and Lady Gaga cases. Interestingly, though, these decisions were preceded by another "fan site" case that produced an entirely different result. In **Tom Welling v. Kenneth Gold**, Case No. FA1106001393893 (NAF July 29, 2011), the panel concluded that the respondent did not have rights or legitimate interests in a fan site. In that decision, the panel stated: "Here, the Respondent has used the Complainant's name without any adornment in a domain name which gives rise to a website. It does not matter that the website is a "fan site". The Panel need not enquire whether the Respondent's motivation is commercial or noncommercial, nor whether he does or does not receive monetary compensation." (The UDRP does not operate on a strict **doctrine of precedent**. Prior panel decisions dealing with similar fact situations are nonetheless persuasive.) Despite the conflicting outcomes, prior to filing a UDRP complaint, trademark owners should carefully review the content of the websites located at the domain names in order to assess the degree of (arguable) commercial activity. The LEGO decision stands as a reminder that a limited or temporary appearance of sponsored/monetized advertising may not convert an otherwise legitimately used domain name into one that meets the UDRP criteria.

In addition to the legitimately used trademarked domain names at issue in the LEGO and Lady Gaga decisions, another recent decision also highlights the potential weaknesses of descriptive trademarks in the UDRP context. For example, Save the Children recently filed an unsuccessful UDRP complaint against the registrant of the domain name <[mysavethechildren.org](http://mysavethechildren.org)>. The respondent used the disputed domain name in connection with a website that promotes aid to the indigent. The respondent's organization appeared to be a non-profit, but the panel noted that the website included "incidental commercial advertisements." The panel **concluded** that Save the Children Federation, Inc., the owner of the SAVE THE CHILDREN trademark, failed to demonstrate that the respondent registered the domain name in bad faith. Although the complainant argued that respondent's actual knowledge of its trademark should be inferred (based on the fame of the mark, the similarity of services, use of the domain for commercial gain, diversion of website traffic away from complainant, etc.), the panel concluded that this purported showing was undermined by the fact that complainant's mark was descriptive of both its services and the services offered by the respondent. Moreover, given the

descriptive nature of the trademark and the respondent's denial of actual knowledge of complainant, the panel refused to find bad faith registration based only upon constructive notice of a mark. (NOTE: Again here, prior panels have used constructive knowledge (based on trademark registrations, duration of use, fame of mark, among other things) to contribute to a finding of bad faith. See, e.g., *American Automobile Association v. Nevis Domains LLC*, Case No. D2006-0489 (WIPO Jun. 13, 2006); *American Automobile Association v. AAAC Vacations Unlimited*, Case No. D2009-0373 (WIPO May 3, 2009)).

This decision, too, should give trademark owners pause before filing a UDRP complaint, particularly where the asserted mark is arguably descriptive. Although the SAVE THE CHILDREN trademark had been in use in U.S. commerce since 1939 and had obtained a federal trademark registration in 1974, the panel relied on the descriptive nature of the words comprising the mark to deny the UDRP claim. Given the discrete nature of the UDRP inquiry and the limited scope of the proceedings, the complainant (as the panelist noted) was not in a position to cross-examine the respondent or conduct discovery into her knowledge of complainant and its trademark. Indeed, following its UDRP loss, Save the Children filed [suit](#) in U.S. District Court of Connecticut alleging trademark infringement, unfair competition, dilution, cybersquatting and violations of Connecticut's Unfair Trade Practices Act. So, this matter has moved to a forum better suited to explore the potential trademark infringement presented by use of the <[mysavethechildren.org](http://mysavethechildren.org)> domain name.

UDRP proceedings are undoubtedly less expensive and results are obtained faster than in litigation. Given that UDRP decisions are not precedential and therefore may result in conflicting decisions concerning similar subject, trademark owners should carefully evaluate whether the UDRP is the right tool based on the particular circumstances of each case. Importantly, each of the UDRP decisions discussed above hinged on the complainants' failure to demonstrate elements not required under the Lanham Act.

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