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## UDRP complainants take note: trademark reputation must be evidenced

International - [Hogan Lovells](#)

- **Agfa HealthCare, owner of various IMPAX marks, sought transfer of 'impax.digital' and 'impax.solutions' under UDRP**
- **Based on evidence provided, panel was not convinced that complainant's IMPAX mark was famous**
- **There was no evidence that respondent had used domain names, or was intending to do so, in manner that took unfair advantage of complainant's mark**

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied the transfer of two domain names because the complainant had failed to demonstrate that the respondent was targeting the complainant's trademark, even though the domain names were identical to it.

### Background

The complainant was Agfa HealthCare Inc, Canada, a company operating in the photographic, medical imaging and software sectors. It was the owner of various trademarks, including International and European trademarks in IMPAX.

The respondent was Sam Pike, the owner of a company named Impax IT Ltd, registered in the United Kingdom on 8 February 2019 and operating in the IT contracting and solutions sector.

The disputed domain names were ['impax.digital'](#) and ['impax.solutions'](#), registered on 23 September 2018. At the time of filing, the domain names were forwarding to a website available at [www.impax.it](#), displaying a small header indicating "Impax | IT Solutions | Coming Soon!" and the following messages "We're currently working on our new website!" and "To find out more email [info@impax.it](#)."

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

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

- the respondent has no rights or legitimate interests in respect of the domain name; and
- the domain name has been registered and is being used in bad faith.

## Decision

With regard to the first requirement, the panel found that the complainant had established trademark rights in IMPAX and, therefore, the domain names were identical to the complainant's trademark. The first limb was thus satisfied.

Turning to the second requirement of the UDRP, a complainant must prove that a respondent has no rights or legitimate interests in respect of the domain name in question. A complainant is normally required to make out a *prima facie* case and it is for the respondent to demonstrate otherwise. If the respondent fails to do so, then the complainant is deemed to satisfy Paragraph 4(a)(ii) of the UDRP.

In the present case, the complainant contended that, to its best knowledge:

- the respondent had not been commonly known under the name IMPAX;
- it had not licensed or otherwise authorised the respondent to use its IMPAX trademark or any domain name including the mark; and
- the domain names were forwarding to a website that was under construction.

The panel was of the view that the complainant had satisfied the minimum requirements for a *prima facie* showing.

The respondent replied that it had a legitimate interest to use the domain names as they incorporated the name of his registered company, Impax IT Ltd. In addition, the respondent claimed that he had used the domain names to operate his business and to correspond with its customers. As for the website available at '[www.impax.it](http://www.impax.it)', the respondent argued that he was in the process of developing it since early December 2018.

The panel considered that, on the balance of the probabilities, the respondent had successfully rebutted the complainant's *prima facie* case, given that the respondent was the owner of a registered limited company in the United Kingdom under the name Impax IT Ltd, and that the respondent had provided information regarding both his company and use of the domain names. Further, the panel stressed that there was no evidence that the domain names had been used in a manner that was intended to target the complainant or its IMPAX trademark.

Given this, the panel considered that the complainant had failed to establish that the respondent had no rights and legitimate interests in the domain names.

Finally, in relation to the third requirement, a complainant is required to demonstrate that the domain name in question was both registered and used in bad faith. As stated in Section 3.1 of the [WIPO Overview 3.0](#): "[B]ad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of, or otherwise abuses, a complainant's mark."

In the present case, the complainant argued that its IMPAX trademark was registered in 1991 and was well known in the medical sector and relatively famous elsewhere; therefore, the respondent must have been fully aware of it when he registered the domain names. The complainant further contended that the respondent chose the domain names with reference to the complainant and its IMPAX trademarks, and this was an indication that the respondent had registered the domain names in bad faith. However, based on the evidence provided, the panel was not convinced that the complainant's IMPAX trademark was famous, whether in the medical sector or more generally. In particular, the panel noted that the

complainant did not provide sufficient indication of actual or potential confusion between the domain names and its trademark and only submitted the trademark certificates.

Moreover, in support of his contention, the respondent submitted plausible information showing that he was unaware of the complainant and its IMPAX trademark when he registered the domain names along with tracking analytics data to evidence that there was no confusion between the two parties. The panel emphasised that the domain names corresponded to the respondent's company name and further noted that there was no evidence that the respondent had used the domain names, or was intending to do so, in a manner that took unfair advantage of the complainant's IMPAX trademark.

As a result, the panel found that the complainant had failed to demonstrate that the domain names were registered and used in bad faith. The panel therefore denied the transfer of the domain names to the complainant.

### **Comment**

The decision underlines that it is generally necessary for UDRP complainants to prove that respondents registered the domain names at issue with the complainant in mind, with the specific intention of profiting from their goodwill and reputation. It is also crucial for respondents who registered domain names identical to a trademark to provide sufficient evidence in order to convince a panel, on the balance of probabilities, that there is a legitimate use as the burden of proof usually shifts to them. In general, complainants whose trademarks are not immediately recognisable as globally famous would be well advised to adduce some evidence of targeting to succeed, such as an active website or prior cybersquatting on the part of the respondent.

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