



## NAMESCON® 2017 - "The Most Shocking UDRP Decisions of 2016"

### CASE 1: SELLING INVESTMENT-QUALITY DOMAINS MAY BE BAD FAITH

#### sihi.com

**Decision Date; July 12, 2016. Panelists: Hector Ariel Manoff (Chairman) and Scott R. Austin. Dissenting: David Sorkin.**

The Complainant alleged that it had a USPTO registered trademark from 1960 for SIHI in connection with pumps, and the domain name was identical to the trademark.

The Respondent pointed out that the domain name was merely a short and common acronym that was purchased at a public auction, thereby conferring a legitimate interest, and was registered and used in good faith, for reasons having nothing to do with the Complainant or its alleged marks. "sihi" also means "sweet" in the Kannada language, which has 50 million speakers.

The majority of the Panel found that "sihi" is not a generic term and that "Respondent's arguments about having rights and legitimate interests in the Disputed Domain Name merely because Respondent is in the business of buying and selling generic domain names or acronyms are not accepted by the Panel." The Panel was of the view that prior to purchasing the domain name, the Respondent should have first checked to see that the Complainant had trademark rights. Also, Respondent's counter offer of \$100,000 was evidence of bad faith, since it was more than the registration costs.

The Dissenting Panelist pointed out that the Complainant did not present any evidence of trademark rights prior to submitting an additional submission, and the additional submission should not have been considered. This panelist said he "was skeptical of the Respondent's claim that it was interested in the Domain Name because it was a four letter word and acronym".

---

### CASE 2: INDIAN COMPANY NOT ALLOWED TO USE ITS OWN NAME AS A DOMAIN NAME BECAUSE OF US TM

#### NutrihealthSystems.com

**Decision Date: August 23, 2016. Panelist: Eduardo Machado.**

The Complainant, a US company, alleged that it has well known and registered trademark rights for NUTRISYSTEM in the US. The Respondent is a well-known and specialized Indian healthcare provider, owned and operated by a medical doctor, and offered weight management services for 17 years.

The Panel found that the domain name was confusingly similar because it merely added the generic word "health". The Panel, after "analyzing the websites", found that the services offered by the Respondent on its website, were not "bona fide" since they were too similar to the Complainant's in that both offered weight loss services. The Panel found it "highly unlikely" that the Respondent had no knowledge of the Complainant prior to registering the domain name, as they were "competitors in the same market segment", notwithstanding that the Respondent was in India and the Complainant was in the US. The Panel found that the Respondent must at least have had "constructive notice" of the Complainant's fame, since Respondent had been operating for 40 years in the US.

---

### CASE 3: WIPO PANELIST FILES ABUSIVE COMPLAINT, COMPLAINANT FOUND GUILTY OF RDNH

#### GreenTrust.com

**Decision Date: May 18, 2016. Panelists: Nick J. Gardner, Tony Willoughby, and Richard G. Lyon.**

This case is problematic not because the decision was wrong but because the decision was correct. The unanimous decision by three WIPO panelists found that another WIPO panelist, Charne Le Roux, acting in her role as Complainant's attorney, had filed a complaint that was "an abuse of the administrative proceeding".

Ms. Le Roux is an accredited WIPO UDRP Panelist, a member of the ICANN Intellectual Property Constituency, and a member of the ICANN Policy Development Process Working Group charged with reviewing the UDRP.

The Panel found that Ms. Le Roux submitted a complaint without any "reasonable prospect for success". The Panel found in particular, that "given that the Complainant was advised by competent counsel, this was a case which the Complainant should have appreciated had no reasonable prospects of demonstrating registration bad faith". The panel found the Complainant guilty of Reverse Domain Name Hijacking.