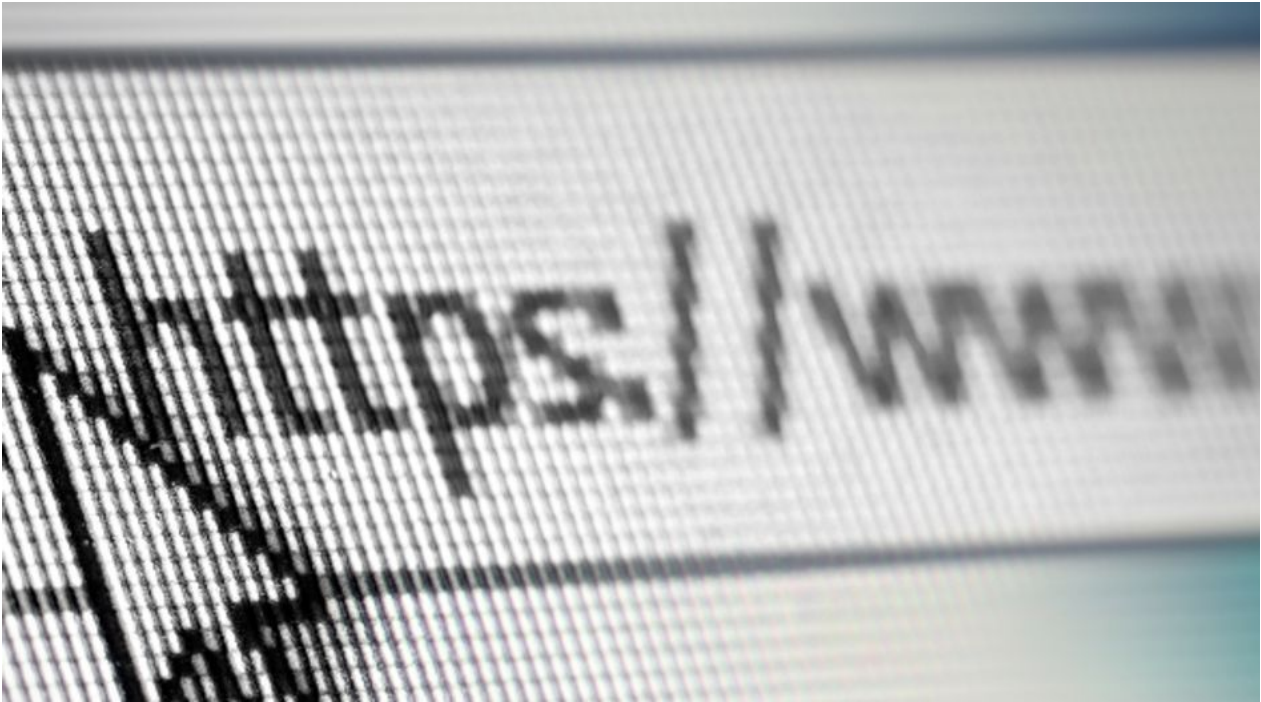


The central role of the UDRP: abusive cybersquatting cases

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03 October 2023



INTERNATIONAL

Legal updates: case law analysis and intelligence

- Kallpa Generación SA, owner of the Peruvian mark KALLPA, sought the transfer of 'kallpagas.com' under the UDRP
- The panel found that the respondent appeared to have operated a business of some substance under its business name prior to the registration of the domain name
- The dispute could not reasonably be considered to be a "clear case of cybersquatting" of the type that the UDRP was intended to address

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied the transfer of a domain name, considering that the circumstances around its registration and use could not sufficiently demonstrate abusive cybersquatting.

Background

The complainant was Kallpa Generación SA, a Peruvian company dedicated to the generation, transmission and distribution of electric energy, as well as the production of hydrocarbons from natural gas. It had been the owner of the Peruvian trademark KALLPA since 2019 and had held, between 2006 and 2016, trademark rights for CENTRAL KALLPA in Peru.

The respondent was revealed by the registrar to be an individual based in Peru, although the domain name was pointing to a website making reference to a company called Kallpa Gas Ingeniería y Servicios SAC, incorporated in Peru in 2012, and the response was filed in the name of this entity. The panel therefore decided to name both parties as joint respondent.

The domain name was 'kallpagas.com', registered on 10 January 2013.

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

1. The domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
2. The respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

Decision

First limb

The complainant contended that the domain name was confusingly similar to its KALLPA trademark, which was entirely incorporated in the domain name with the addition of the descriptive term 'gas'. The respondent mainly argued that the goods and services covered by the complainant's trademark were not identical, nor related to those offered through the website to which the domain name resolved.

The panel accepted the complainant's arguments, finding that the addition of the term 'gas' was not sufficient to avoid confusing similarity with the complainant's mark. The first limb was therefore satisfied.

Second limb

The complainant argued that the respondent did not have any rights or legitimate interests in the term 'Kallpa Gas', underlining that the respondent's trademark application for this term was recently denied by the Peruvian IP office (INDECOPI). The respondent countered that the domain name corresponded to its trade name, under which its company had been operating since 2012. The respondent further argued that the term 'kallpa' was commonly used in the Quechua language, meaning "effort, energetic use of physical force, vigour or activity of the mind".

In order to address the central question as to whether the respondent genuinely adopted the term 'Kallpa Gas' as part of its business name, without intent to target the complainant's trademark rights, the panel considered the assertions and evidence submitted by both parties. The panel first found it plausible that the respondent could have selected the term 'kallpa' given its meaning in the Quechua language, independently of the complainant's trademark rights. More importantly, the panel underlined that the respondent appeared to have operated a business of some substance under its business name prior to the registration of the domain name. Further, the panel was not convinced that the complainant's reputation had any impact on the respondent's choice of business name or the domain name, especially noting that the two parties operated in different businesses and provided different type of services. On this basis, the panel concluded that this dispute could not reasonably be considered to be a "clear case of cybersquatting" of the type that the UDRP was intended to address and, for that reason, the complainant had failed to establish the respondent's lack of rights or legitimate interests in the domain name. The second limb was therefore not satisfied and the complaint was denied.

Third limb

Although it was not strictly necessary for the panel to address the third limb, for the sake of completeness the panel went on to assess this and the question of bad faith. In this regard, the complainant contended that it had become a well-established company in its industry before the domain name was created, and so the respondent could have been aware of the complainant and its KALLPA CENTRAL trademark then in force when registering the domain name in 2013. However, the panel found no decisive evidence proving that the respondent had registered the domain name to trade upon the complainant's rights, as opposed to selecting the term 'kallpa' based on its dictionary meaning in the Quechua language. In the absence of any other indicia of bad faith, such as the respondent's intent to sell the domain name to the complainant or its use of this name to create confusion with the complainant and its business, the panel was persuaded that it was more likely that the domain name had been registered to reflect the respondent's trade name and to promote its own products and services.

Additionally, the panel pointed out that the denial of the respondent's trademark application in Peru could not be considered as evidence of bad faith in this case, noting that the complainant's KALLPA trademark registration had also been partially cancelled by INDECOPI based on the panel's limited investigation. In the panel's view, this underlined that the term 'kallpa' was used in Peru by different parties, in distinct sectors, offering varying products and services. Finally, the panel noted that this matter appeared to fall outside of the scope of the UDRP and thus would perhaps be better adjudicated by the administrative authorities and/or courts of competent jurisdiction.

Comment

This case provides interesting insight into the circumstances in which a registrant may successfully claim rights or legitimate interests in a domain name reflecting its business/corporate name. As illustrated by this dispute, such circumstances may include the registrant's substantive business operations under the same name prior to the registration of the disputed domain name, as well as the lack of factors suggesting the targeting of a pre-existing trademark. It is therefore advisable for brand

owners to undertake a thorough assessment of the history and use of a domain name before taking action under the UDRP, and to keep in mind that it was not designed to deal with all types of disputes relating to domain names, only those relating to abusive cybersquatting.

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