

The importance of prior rights in domain name disputes

SIMONT
BRAUN

The importance of prior rights in domain name disputes: bpost arrives too late and misses out on the domain name “bpost.com”

On 8 February 2021, an arbitration panel of the WIPO Arbitration and Mediation Center dismissed a complaint filed by bpost NV and bpost bank NV concerning the domain name “bpost.com” (case no. D2020-2195, bpost NV and bpost bank NV v. Dong Jin Kim). Crucial in this case was the determination that the international word trademark “BPOST” invoked by the complainants was registered a long time after the registration of the contested domain name. You can read the decision [here](#) (in English).

INTRODUCTION

The first complainant, bpost NV, owns the international trademark registration no. 1064911 for word mark “BPOST” registered on 16 August 2010 and the domain name “bpost.be” registered on 4 February 2010. bpost NV turned together with bpost bank NV to the WIPO Arbitration and Mediation Center to have the domain name “bpost.com”, registered on 16 April 2001 by a natural person who is a resident of the Republic of Korea, transferred.

The WIPO Arbitration and Mediation Center applied the Uniform Domain Name Dispute Resolution Policy (“UDPR”) to resolve the dispute. Under paragraph 4(a) of the UDPR, the complainant must demonstrate that:

- (i) the disputed domain name is identical or confusingly similar to the complainant’s trademark or service mark; and
- (ii) the domain name holder has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

[Domain name - prior rights]

THE FIRST CONDITION: IDENTICAL OR CONFUSINGLY SIMILAR

The first complainant referred to its long-standing history going back to 1830 as an international mail and parcel service, and nowadays e-commerce logistics services provider and to the word and figurative trademarks incorporating the word “POST” or “BPOST” it has registered over its

lifetime. The first complainant explained the natural evolution of its old name “De Post” (in Dutch) and “La Poste” (in French) and internationally “The Belgian Post” or “Belgian Post International” into “bpost” where the letter b is understood as a reference to “Belgium” or “Belgian”.

However, the arbitration panel did not find the trademarks for the older trade names relevant. It considered that the dominant and recognisable feature of the disputed domain name “bpost.com” is the term “bpost”, which the complainants registered as trademarks in 2010. Therefore, only these trademarks were taken into consideration for the resolution of the dispute.

The first condition of the identical or confusingly similar nature of the domain name “bpost.com” and the trademark “BPOST” is met. Anteriority, unlike in trademark law, is not required under the UDRP first condition. However, it is relevant to the other two conditions.

THE SECOND AND THIRD CONDITIONS: NO RIGHTS NOR LEGITIMATE INTERESTS – REGISTRATION AND USE IN BAD FAITH

The complainants portrayed the domain name holder as a squatter who has no legitimate reasons for using the term “bpost”. They contended that the domain name holder had never used the targeted domain name in connection with a bona fide offering of goods or services. The only purpose of the domain name was to divert and confuse consumers misleadingly and to take advantage of the notoriety of the complainants’ trademarks. The complainants support their assertion by referring to the malicious content on the website intended to scam website visitors. They provided exhibits showing that the website displayed pay-per-click links referring to competing services covered by the complainants’ trademark rights. They also refer to the high amount of domain names (i.e. 1700) registered by the domain name holder and to earlier UDRP decisions where it had been held to have registered the domain names in bad faith and to the fact that the domain name holder ceased all activity on the targeted domain name shortly after receiving a notice letter.

The above did not persuade the arbitration panel. It focused on the time between the registration of the domain name (i.e. 16 April 2001) and the registration of the invoked right (i.e. 16 August 2010). Having this in mind, it did not find any imputable behaviour regarding the domain name “bpost.com”. Simply owning many domain names is not in itself evidence of bad faith. The arbitration panel considers that the domain name holder could neither reflect the then non-existing complainant’s trademark nor target the complainant at the time of registering the disputed domain name.

This finding reflects established case law where, absent exceptional circumstances, when a domain name is registered before the complainant's trademark registration (or published application), the domain name generally cannot be determined as having been registered in bad faith, as the domain name holder could obviously not have been aware of the complainant's trademark as of the time the domain name was registered. Therefore, there was no bad faith registration and no more need to examine the other conditions.

For the foregoing reasons, the complaint was denied.

CONCLUSION

This painful outcome for bpost is an important take-away for others: first-come-first-served is a key principle for registering a domain name that is also reflected in domain name disputes. There is no principle of territoriality applicable to domain names. Providing protection to the first one registering the domain name is a deliberate choice to deal with the complexity of domain names. Only under very exceptional circumstances can a holder of an identical or confusingly similar younger right contest the legitimacy of the ownership of the older domain name. This is the case for instance where the domain name holder's intent in registering the domain name was to unfairly capitalise on the complainant's unregistered mark in anticipation of obtaining trademark rights; for example, (i) shortly before or after the announcement of a corporate merger, (ii) further to the respondent's insider knowledge (e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant's filing of a trademark application.

For more information or any question, please contact the authors:

[Fernand de Visscher](#) & [Christopher Dumont](#)

fernand.devisscher@simontbraun.eu – +32 2 533 17 18

christopher.dumont@simontbraun.eu – +32 2 533 17 58