

# PATTISHALL

*insights*

APRIL 2015

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“ TRADEMARK  
RIGHTS ALONE  
DO NOT  
DEMONSTRATE THE  
RESPONDENT'S  
REQUISITE  
KNOWLEDGE OR  
TARGETING. ”

## When Not to File a UDRP Complaint

By Joseph N. Welch II

Online UDRP (Uniform Dispute Resolution Policy) proceedings are a relatively inexpensive way to go after cybersquatters who have registered infringing domain names. See <https://www.icann.org>. The proceedings are somewhat like summary judgment motions, with all evidence and argument taking place in writing. The Complainant needs to show that the accused domain name is identical or confusingly similar to Complainant's trademark, that the accused registrant has no legitimate interest in the domain name, and that the domain name was registered and is being used in bad faith. If successful, the domain name registration will be cancelled or transferred to the Complainant.

But when is it a good idea to use a UDRP proceeding, rather than a federal court action or other means of challenge? Two recent UDRP decisions demonstrate some of the issues a trademark owner should be thinking about before filing.

In *The Teaching Company LLC d/b/a The Great Courses v. Brendan Hight*, WIPO Case No. D2014-448, the Complainant owned the well-known and registered trademark THE GREAT COURSES for those widely-advertised lifelong learning courses. The Respondent acquired his *greatcourses.com* domain name in 2004 from a third party, and used it for a website described as having advertising links for educational resources. (Currently it is used to promote computer technology-related courses).

The Respondent defended based on descriptive use of "great courses", descriptive use by third parties, and the creation and registration of the *greatcourses.com* domain name prior to Complainant's mark maturing to registration.

To show bad faith, the Complainant was required to show Respondent had actual knowledge of Complainant's mark and selected the domain name to take advantage of the mark's value or goodwill. In holding for Respondent, the Panel found the Complainant here submitted insufficient evidence of the renown of its mark, and no evidence of Respondent's bad faith, in 2004 or subsequently. "Trademark rights alone do not demonstrate the Respondent's requisite knowledge or targeting. Especially is that so when the mark is descriptive."



“ A FEDERAL COURT  
ACTION MAY BE A  
BETTER CHOICE. ”

In *Nationwide Mutual Insurance Company v. Tim Parker*, WIPO Cast No. D2014-0655, the Complainant was the well-known company which had provided insurance and financial services for almost 60 years under its registered NATIONWIDE mark. Respondent was an individual who provided online automobile loan financing services on websites under the three disputed domain names: *nationwideautoapproval.com*, *nationwideautocredit.com*, and *nationwideautolending.com*.

Respondent's domain names therefore included the Complainant's mark for similar services, but relief was denied. Where did Complainant fall short?

The Panelist explained that “policy was not intended to permit a party who elects to register or use a common term or terms as a trademark to bar others from using the common term in a domain name, unless it is clear the use involved is seeking to capitalize on the goodwill created by the trademark owner.”

Nationwide Insurance did effectively demonstrate the strength and reputation of its NATIONWIDE marks. But Nationwide Insurance had not registered its mark for auto loans, and its evidence of common law use for auto loans was limited to use in connection with members of one credit union, not the general public. This contributed to the Respondent making “a plausible claim of descriptive use” that was not sufficiently rebutted by Complainant.

What might either of these Complainants have done differently? Obviously, there may well be circumstances that we are unaware of that affected the choices that were made. However, normally in this position, the Complainant is going to first want to show what essentially is the renown of its trademark – sales and advertising figures, examples of high profile advertising, media mentions, industry rankings, that kind of thing. According to the Panel, The Great Courses didn't effectively do that, and Nationwide apparently didn't sufficiently do it for the key area of auto loans. A NATIONWIDE registration covering auto loans apparently would have helped, too.

More importantly, both of these disputes may not have been well-suited to UDRP proceedings. In UDRP proceedings, a showing of bad faith is essential. How do we normally obtain evidence of bad faith in trademark disputes? Through discovery, that is, through documents, depositions, admissions and so on. There is no discovery in these “come-as-you-are” online UDRP proceedings. So a potential Complainant is normally going to need the Respondent's bad faith to be pretty obvious if the Complainant is invoking the UDRP – evidence of an intentional association on the Respondent's website, for example, or the lack of any credible good faith explanation for incorporating someone else's well-known non-descriptive mark into the domain name.

Descriptive marks obviously are problematic in UDRP proceedings. The Complainant typically needs to show consumer recognition of the trademark, and to overcome the Respondent's defense of descriptive use by showing bad faith. In a federal court action, likely confusion, and perhaps dilution, can be asserted, with no need to show bad faith. A federal court action also may be a better choice if the dispute is highly factual, involves non-UDRP issues as well as alleged cybersquatting, or there is a significant possibility of a damages award.

UDRP proceedings are much less expensive than federal court litigation, but less expensive doesn't always mean the expense is worthwhile.

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## APPOINTMENTS

### ■ Seth I. Appel

Seth has been appointed Co-Chair of the Midwest Chapter of the Copyright Society of the U.S.A.

### ■ Ashly Iacullo Boesche

Ashly has been appointed President-Elect of the Chicago Intellectual Property Alliance. She was also named as the Chair of the Infrastructure Committee.

### ■ Bradley L. Cohn



Brad has been reelected to the Board of Directors for the Illinois Institute for Continuing Legal Education.

### ■ Jonathan S. Jennings

Jonathan was appointed to the Nominating Committee of the Chicago Bar Association.

### ■ Robert W. Sacoff

Bob has been appointed by Intellectual Property Owners to its Planning Committee for the IPO Annual Meeting in Chicago from September 27-29, 2015.

## PRESENTATIONS

### ■ Phillip Barengolts



Phil spoke to the Intellectual Property Committee of the Chicago Bar Association Young Lawyers Section on the “Supreme Court’s Recent Lanham Act Decisions” on April 19.

### ■ Ashly Iacullo Boesche

Ashly moderated a Chicago Bar Association panel on April 7, entitled “Perspectives from In-House IP Counsel.” She will also be speaking on “Trademarks in Practice: Searching, Clearance and the Application Process in the U.S.” at the Practising Law Institute’s Understanding Trademark Law in the Global Marketplace Program in Chicago on June 16, and in New York on July 14.

### ■ Jessica A. Ekhoﬀ



Jessica spoke on “Gray Market Goods,” as a guest speaker at a Chicago-Kent College of Law Trademarks Class on March 23. Jessica also spoke on “Advertising in the Food Industry: How to Avoid Getting into Hot Water,” at Good Food Business Accelerator at 1871, in Chicago on April 6.

### ■ Andrew R. W. Hughes

Andrew was a panelist on “Law 101: Careers in Intellectual Property” at Northwestern University School of Law on March 17.

### ■ Belinda J. Scrimenti

Belinda spoke as a panelist on an American Bar Association webinar titled: “Do You Hear What I Hear?: Advising Clients on the Registration of Non-Traditional Trademark Sounds,” on March 5.

### ■ Joseph N. Welch II

Joe spoke on “Tacking Your Practice Through Confusing Winds,” at the Practising Law Institute’s Advanced Trademark Law Annual Review 2015 in New York City on March 24.

### ■ Uli Widmaier

On May 12, Uli will co-present a Stafford Live CLE Webinar on the recent Supreme Court decision in *Be&B Hardware*, which held that decisions by the Trademark Trial and Appeal Board may have preclusive effect in subsequent federal court litigation.

## PUBLICATIONS

### ■ Seth I. Appel

Seth’s case note, “Trademark Tacking is a Question of Fact, Properly Decided by a Jury, U.S. Supreme Court Holds,” was published in the February edition of *AIPPI e-News*.

### ■ David C. Hilliard, Joseph N. Welch II and Janet A. Marvel

At the 2015 Annual INTA Meeting in San Diego in May, LexisNexis Publishing will launch the 7th edition of *Trademarks and Unfair Competition*, a treatise co-authored by David, Joe and Janet.

### ■ Jonathan S. Jennings



Jonathan’s article entitled “Developing Domain Name Enforcement Options” will be published this spring in the *Franchise Law Journal* (Vol. 34-4/Spring 2015). Jonathan is also a columnist for the PTMG newsletter *Law, Lore & Practice* covering U.S. updates, and will publish his first article in May. Finally, Jonathan once again authored the update to the Illinois chapter of the International Trademark Association’s *U.S. State Trademark and Unfair Competition Law* with the assistance of Andrew Hughes.

## TEACHING

### ■ Jonathan S. Jennings

Jonathan will teach a summer course online at The John Marshall Law School on Right of Publicity law.

# *firm* NOTEWORTHY, HONORS & AWARDS

## AWARDS

### Martindale-Hubbell AV® Preeminent Rating

Brett A. August, Ashly I. Boesche, Thad Chaloeintiarana, David C. Hilliard, Jonathan S. Jennings, Robert M. Newbury, Robert W. Sacoff and Joseph N. Welch II have each received an AV® Preeminent rating from the Martindale-Hubbell Bar Directory for 2015.

### World Trademark Review (WTR) 1000

**Pattishall McAuliffe** has been ranked Gold in the 2015 WTR 1000 rankings in Illinois of *The World's Leading Trademark Professionals*. **Robert W. Sacoff** ranked Silver nationally for “enforcement and litigation.” **Jonathan S. Jennings, Janet A. Marvel, Robert W. Sacoff** and **Joseph N. Welch II** ranked Silver for “enforcement and litigation” in Illinois. **Phillip Barendolts, Thad Chaloeintiarana** and **Bradley L. Cohn** ranked Bronze for “enforcement and litigation” in Illinois. **David C. Hilliard** honored as one of two trademark Luminaries in Illinois.

WTR writes, “**Pattishall, McAuliffe, Newbury, Hilliard & Geraldson** is a mainstay of the national and international trademark scene...” “It is legendary, particularly in litigation. Just that it still exists as an exclusive trademark boutique says something special about it.” **Bradley L. Cohn** joined in 1995 after a federal court clerkship and thrives on the mission-critical disputes that cross his desk. He recently won a case for Robert Bosch after three years of hard-fought litigation, acting alongside *WTR 1000* newcomer and rising star **Thad Chaloeintiarana**. **Phillip Barendolts** is another esteemed advocate on the squad. Like his colleagues, he is not afraid to take on crucial briefs for marquee clients and has recently secured victories for the likes of PepsiCo, Bayer and Eli Lilly. He frequently acts alongside the more senior **Jonathan S. Jennings**, an admired litigation and transactional ace. **David C. Hilliard** is the firm's most experienced conflict resolution sage, whose performances before juries are especially acclaimed. Other seasoned trial attorneys include **Robert W. Sacoff**, a ‘thought leader’ whose sheer range of experience inspires confidence. ‘An expert in every aspect of trademark law’, **Joseph N. Welch II** is a hard, but fair fighter who goes the extra mile for clients such as Owens Corning. For non-contentious instructions, there is no better choice than **Janet A. Marvel**, a meticulous brand strategy planner.”

## AWARDS

### Managing Intellectual Property Magazine

**Pattishall McAuliffe** has been named the Trademark Contentious Midwest Firm of the Year.

**Brett A. August, Bradley L. Cohn, David C. Hilliard, Jonathan S. Jennings** and **Joseph N. Welch II** have been named as “IP Stars.”

## NOTEWORTHY

### First Annual Undergraduate Chicago Fire Mock Trial Invitational Tournament

In January, **Brett A. August** served as a presiding judge.

## PRO BONO

**David C. Hilliard** and **Andrew R. W. Hughes** were acknowledged by Kay Mimms, the author of the book *Fighting Lupus Battles—Hope for a Cure*, for their pro bono legal counsel.

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