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BLOGS

Trademarks

Franchisor Uses Uniform Domain-Name Dispute-Resolution Policy to Obtain Control Over Infringing Domain

A franchisor whose trademark was being infringed in a domain name recently obtained transfer of the domain to its control through a Uniform Domain-Name Dispute-Resolution Policy (“UDRP”) arbitration action. *U.S. Structures, Inc. v. Ginger Storm*, FA1401001540563 (NAF Mar. 5, 2014). Gray Plant Mooty represented the franchisor in the matter. In this case, U.S. Structures’ trademark ARCHADECK® was infringed by the domain name archadeck-chicagoland.com. Chicagoland is a common reference to the Chicago metropolitan area, where U.S. Structures has an Archadeck franchisee. The offending domain pointed to a website that was simply a “link farm” from which the infringing registrant profited when users clicked on links to other sites, some of which were directly competitive with U.S. Structures’ ARCHADECK® franchise system and services.

U.S. Structures began an action in the UDRP, a streamlined arbitration procedure established by the Internet Corporation for Assigned Names and Numbers for the resolution of trademark disputes concerning internet domain names. The UDRP governs generic top level domains (“gTLDs”) including .com, .net, and .org, and the hundreds of new gTLDs that are currently in the process of being launched. To prevail, U.S. Structures had to show that the domain name at issue was confusingly similar to its trademark, that the registrant did not have any rights or legitimate interest in the domain name, and that the registrant registered and was using the domain name in bad faith. The domain name registrant did not respond to the complaint but, under UDRP rules, the single-arbitrator panel was still required to consider whether the complaining party satisfied the requirements for transfer or cancellation of the domain name and issue a written opinion. The panel found in favor of U.S. Structures on all of the elements. It ordered transfer of the domain name to U.S. Structures, which was then able to redirect the domain name to its Chicago-area franchisee’s subpage.

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