

OCTOGEN DOCTRINE DEALT DAMAGING BLOW

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A decision by a UDRP panellist that again rejects the so-called Octogen line of thinking on bad faith has raised doubts about the sustainability of the doctrine

For a domain to be transferred in a UDRP case there must be evidence that it was both registered and used in bad faith.

In August 2009 [Octogen Pharmacal Company vs Domains By Proxy / Rich Sanders and Octogen e-Solutions](#) argued that bad faith registration could be found retrospectively if the domain was used abusively. The case has since caused controversy.

But on August 2, panellist Christopher S Gibson found in [Puget Sound Software LLC vs A Rahman](#) that there was insufficient evidence to support bad faith registration despite finding that the domain was being used in bad faith.

The dispute centred on the respondent's domain [www.askleo.com](#). It was almost identical to the complainant's site [www.ask-leo.com](#), which answered technical questions about the internet, software and computers.

The complainant argued that the respondent, by using its website for 10 years without providing any evidence of running an authentic business, had in effect adopted the position: "Trust me, I'm planning to put the domain to legitimate use."

In its defence the respondent said the complainant did not possess trade mark rights at the time of the domain's registration and thus could not have been aware of its mark. The respondent's domain was registered some two years before the complainant's.

Panellist Gibson decided that the respondent was using its website as a parking page that diverted traffic from the complainant's site and subsequently profited from it; under WIPO's policy this amounts to bad faith use.

However, he said: "Despite the respondent's disingenuous explanations for how it has been planning to use the domain name, it is undisputed that the respondent registered the domain name in 2001, before the complainant registered its own domain name in 2003."

This was "before the complainant acquired any common law or registered trademark rights in its ask leo mark", he added. As a result, the complaint was denied.

Panellist Scott Donahey first challenged the traditional view of good faith registration and bad faith use in the 2009 case [City Views Limited v Moniker Privacy Services / Xander Jeduyu. ALGEBRALIVE](#).

His views broke with the consensus that both registration and use of a domain must be carried out in bad faith in order for paragraph 4(b) of the UDRP policy to be satisfied.

He maintained this approach in [Phillip Securities Pte Ltd v Yue Hoong Leong](#) before the decision in the *Octogen* case gave birth to the doctrine's name.

The Octogen line was challenged in January 2010 when panellist Warwick Smith rejected it, saying: "Panellists must still adhere to the provisions of the policy."

Tony Willoughby, whose ruling in [Camon SpA v. Intelli-Pet, LLC](#), was influential for future rejections of the doctrine, said: "I think Octogen is probably now dead."

But he added: "Most panellists deplore having to find in favour of bad faith users of domain names on the basis that the original registration was in good faith, but users of the system are entitled to consistency in decision-making."

He said he regretted his decision in *Camon* but the application of the law had to come first.

Because there is no system of precedent in the UDRP system, Willoughby argued that no one could be sure what the future would bring.

"It will be interesting to see what Scott Donahey would do if he was given another Octogen-type case. While I have no doubt that he still stands by his Octogen interpretation, I hope that he will feel able to accept that consistency is of paramount importance," he said.

Donahey was unavailable to comment this week.

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