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- UDRP panel has denied the transfer of 'physiothérapie.com' to the owner of a figurative mark containing the word '*physiotherapie*'
- Respondent had legitimate interests in the domain name and that there was no evidence of bad faith
- Decision shows that, generally, a UDRP complainant must prove that the respondent registered the domain name at issue with the complainant in mind

In a recent decision under the Uniform Domain Name Dispute Resolution Policy (UDRP) before the World Intellectual Property Organisation (WIPO), a panel denied the transfer of a domain name that was almost identical to both the complainant's trademark and domain name apart from the fact that it contained the character 'é' as opposed to 'e'.

The complainant was Sarl Impulseo of Béziers, France. The complainant owned a figurative trademark containing the word '*physiotherapie*' with a stylised 'o' in the middle and the addition of the domain '.com'. The complainant had also owned the domain name 'physiotherapie.com' since 2003, and this was pointing to a website offering products for sale relating to physiotherapy and kinesiotherapy.

The respondent was IDNenterprises of Merriwa, Australia, a company which asserted that its legitimate business model was to hold a medium-sized portfolio of internationalised domain names and point them both to fully developed websites and those containing sponsored links in order to generate revenue. The domain name was 'physiothérapie.com', registered on December 1 2011. It resolved to a parking page with sponsored links redirecting to third party offers for physical therapy equipment, physiotherapy and medical tapes.

## UDRP requirements

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

- The domain name registered by the respondent must be identical or confusingly similar to a trademark or service mark in which the complainant has rights.
- The respondent must have no rights or legitimate interests in respect of the domain name.
- The domain name must be registered and be being used in bad faith.

## Similarity

As far as the first limb was concerned, the complainant contended that the domain name was confusingly similar to its figurative mark containing word elements. The complainant noted that the letter 'é' in the domain name was insignificant and that both parties were operating in the field of promotion and sale of products relating to physiotherapy and kinesiotherapy. The respondent replied that the complainant's trademark was not distinctive and that '*physiothérapie*' was a generic term.

Relying on *Ville de Paris v Salient Properties LLC* (WIPO Case D2009-1279), the panel noted that the design aspect of a figurative trademark may be discarded, as it was normally the word element that conveyed the principal meaning or impression. However, the panel noted that the word element must be a fundamental, easily identifiable and readable part of the combined mark.

The panel stated that in the present case the word '*physiotherapie*' was easily identifiable as the dominant part of the figurative trademark and the figurative element was reduced to the use of fanciful characters. Given that the generic top-level domain '.com' was not considered when assessing identity or confusing similarity, the panel found that the complainant had rights in the figurative trademark and that the domain name was confusingly similar to this as the only difference was the accented letter 'é'.

The complainant therefore satisfied the first element set out in Paragraph 4(a) of the UDRP.

## Respondent's rights and interests

The second limb regards a respondent's rights or legitimate interests (or lack of them). According to Paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Overview 2.0) a complainant must prove that the respondent had no rights or legitimate interests in respect of the domain name in question. A complainant is normally required to make out a *prima facie* case and it is for the respondent to demonstrate otherwise. If the respondent fails to do so, the complainant is deemed to satisfy Paragraph 4(a)(ii) of the UDRP.

In the case at hand, the complainant put forward a *prima facie* case to the effect that the respondent had no rights or legitimate interests in respect of the domain name as the website associated with the latter resolved to a parking page with sponsored links which could not be considered as a legitimate offering of goods and services. However, the respondent argued that use of the domain name in connection with pay-per-click advertisements for physiotherapeutic products was a *bona fide* purpose given that the domain name was describing physiotherapy.

As stated in Section 2.10.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition:

*"In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights."*

The panel agreed with the panels in *Unilabs SA v Gregg Ostrick, GNO, Inc* (WIPO Case D2017-0738) and *Marco Rafael Sanfilippo v Estudio Indigo* (WIPO Case D2012-1064) considering that:

*"a registrant may legitimately register a domain name comprised of a dictionary word in circumstances where the registrant is not targeting or seeking to take unfair advantage of a complainant's trademark. The legitimate use of a domain name may include the generation of revenue through pay-per-click websites corresponding with the descriptive nature of the domain name."*

In the panel's view, the complainant had not provided evidence that its reputation was such that the domain name could be related only to its products and services, nor that its trademark consisting of a generic term had acquired considerable renown. In light of this, the panel concluded that the respondent had rights or legitimate interests in the domain name as it was using it in a descriptive manner and did not target the complainant's trademark.

Given this finding, the panel did not need to address the third limb as a complainant must cumulatively fulfil the three requirements under the UDRP. However, for the sake of completeness, the panel decided to do so.

### **Bad faith**

The panel noted that Paragraph 4(b) of the UDRP set out a list of non-exhaustive circumstances indicating that a domain name had been registered and used in bad faith, including:

- the respondent had registered or acquired a disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the disputed domain name;
- the respondent had registered the disputed domain name in order to prevent the complainant from reflecting the complainant's trademark or service mark in a corresponding domain name, provided that the respondent had engaged in a pattern of such conduct;
- the respondent had registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- by using the disputed domain name, the respondent had intentionally attempted to attract, for commercial gain, internet users to the respondent's website or other online location by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the respondent's website or location, or of a product or service on the respondent's website or location.

In the case at hand, the complainant argued that the respondent had registered the domain name purposefully in order to use the reputation of the complainant and create confusion. In addition, the complainant asserted that the domain name had been registered in order to be sold to the complainant.

The respondent claimed that it owned several other domain names that corresponded to generic terms and pointed to websites with pay-per-click links. Contrary to the complainant's assertions, the respondent denied having knowledge of the complainant's rights or any intention to sell the domain name to the complainant.

The panel found in favour of the respondent, considering that the complainant's trademark was a generic term and not well known. The panel further ruled that the complainant had failed to establish that the respondent had registered the domain name with the intention of creating a likelihood of confusion with the complainant's trademark, especially since the sponsored links on the website to which the domain name was resolving did not display any trademarks but generic terms. The panel underlined that both parties were using domain names consisting of generic terms that described the products offered. Further, the panel pointed out that there was no evidence that the respondent registered the domain name primarily for the purpose of selling it to the complainant. The panel considered that the third limb was not satisfied and the complaint was therefore denied.

### Comment

The decision underlines that it is generally necessary for UDRP complainants to prove that respondents registered the domain names at issue with the complainant in mind, with the specific intention of profiting from the complainant's goodwill and reputation. The more descriptive the domain name, the harder this is, and if the complainant is not a global brand and the respondent is based on the other side of the world, proving this will be very difficult. The decision also underlines that registrants of domain names which usually contain an accented term should also secure the version with the accent if possible in order to avoid any confusion going forward.

The decision can be found [here](#).

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