

## WIPO panel not convinced by respondent's alleged use of domain name to "celebrate" family pet International - Hogan Lovells International LLP

Cybersquatting

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In a [recent decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the [World Intellectual Property Organisation](#) (WIPO), a panel has ordered the transfer of a domain name because the respondent had failed to demonstrate that he was not trying to disrupt the complainant's business by pointing it to a website allegedly celebrating his dog.

The complainant was Pier Giorgio Andretta, who had been producing clothing and apparel for cycling under the GIORDANA trademark since 1980 (originally a reference to his daughter's name). The complainant was the owner of various trademark registrations, including the international trademark registration No 529214 for GIORDANA, registered on September 20 1988.

The respondent was Corrado Giubertoni, an enthusiastic cyclist and an official member of the Alè Cycling Team. The Alè Cycling Team was sponsored by APG SRL, an Italian company which also sold cycling outfits under the trademark ALÈ.

The disputed domain name was 'giordana.com'. It was originally registered on December 30 1999 by APG SRL as a result of a licence granted by the complainant to APG SRL covering use of the GIORDANA mark. Upon its termination of such licence, the complainant filed a UDRP complaint against the CEO of APG SRL seeking transfer of the domain name (see [Andretta v Zecchetto](#) (WIPO Case D2014-2244)). However, this complaint was denied on the basis that the domain name had not been registered in bad faith but in accordance with the licence agreement, and thus with the complainant's permission.

The domain name was subsequently transferred to the respondent, who pointed it to an active website showing photos and information about a dog named Giordana, supposedly belonging to the respondent.

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

1. The domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
2. The respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

As for the first limb, the panel found that the complainant owned several trademark registrations for GIORDANA. The panel therefore considered that the domain name reproduced the complainant's trademark in its entirety under the '.com' top-level domain. Thus the panel found that the complainant had satisfied the first element set out in Paragraph 4(a) of the UDRP.

As for the second limb, a complainant must prove that the respondent has 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, then the complainant is deemed to satisfy Paragraph 4(a)(ii) of the UDRP.

In the present case, the complainant first noted that the respondent had no trademark registrations for GIORDANA. The complainant argued that the respondent knew that GIORDANA was a brand of cycling apparel, not only because the brand was well known worldwide, but also because he was an enthusiastic cyclist and a member of Alè Cycling Team, sponsored by APG SRL. Furthermore, the complainant underlined that APG SRL employed the respondent's wife and sister-in-law, and was a direct competitor of the complainant. Finally, according to the complainant, the real purpose of the respondent was not to "celebrate" his dog, but to prevent the complainant from using his brand for commercial purposes and to misleadingly divert consumers looking for his products.

The respondent argued that the complainant did not have a word trademark but only a graphic representation, and thus the complainant could not invoke his trademark registrations to protect the term 'Giordana'. The respondent also stated that he was using the website to celebrate his dog called Giordana, named after the famous basketball player Michael Jordan as a tribute to "his airness" (one of the nicknames of Michael Jordan). According to the respondent, he was making a legitimate non-commercial and fair use of the domain name, since his website had no commercial purpose. In the respondent's opinion, no-one would associate a dog with a company selling sporting clothes, and in addition a dog undisputedly transmitted a

"nice feeling".

The panel first noted that the respondent had not provided any documentary evidence, such as vaccination certificates, veterinarian records or affidavits by the respondent's neighbours, proving that the name of his dog was Giordana. Furthermore, the panel found that there was no clear evidence regarding the date when the respondent had acquired the dog. The panel added:

*"This panel would not like this decision to encourage future respondents to conveniently acquire and/or rename animals - of any kind in the animal kingdom - just to improve their position in domain name disputes, ie, giving their pets names ex post, to use them as evidence of rights or legitimate interests."*

In this regard the panel also referred to *YUM! Brands Inc v Ether Graphics a/k/a Andrew Gruner* (NAF Claim Number 212651), where the panel stated:

*"Needless to say, respondent cannot acquire rights to the Colonel Sanders domain name simply by naming (or possibly even re-naming) his pet guinea pig after (or in honour of) Colonel Sanders. First of all, a pet guinea pig is not a party to this proceeding so Policy Paragraph 4(c)(ii) does not apply (it applies only to respondents and animals cannot be respondents). Second, allowing this defence would simply promote a plethora of pet guinea pig websites (whether the pet guinea pig has died or not), all with rather esoteric names that just happened to be famous trademarks. This panel declines to walk down that road."*

As a result, the panel considered that simply alleging that his dog was called Giordana could not confer on the respondent any rights or legitimate interests in the domain name and found that the complainant had therefore satisfied the second element set out in Paragraph 4(a) of the UDRP.

In relation to the third limb, a complainant is required to demonstrate that the domain name in question has both been registered and is being used in bad faith.

In the present case, the complainant argued that the respondent registered the domain name to confuse potential customers and to disrupt his business. The respondent argued that the use of the domain name was far removed from the complainant's activities and that he had never mentioned nor criticised the complainant and his clothing brand. The respondent also noted that a customer looking for the complainant's clothing would immediately be directed to the complainant's website when searching for the term 'Giordana'.

The respondent noted that, after APG SRL's licence terminated at the end of 2014, it ceased any use of the term 'Giordana'. However, under the contracts signed between APG SRL and the complainant, APG SRL had no obligation to transfer the domain name to the complainant and thus decided to transfer it to the respondent to use in relation to his dog. The respondent admitted that he was a cyclist and knew APG SRL, but that his relationship with this company was "weak and non-commercial".

The panel noted that the respondent had admitted himself that he knew of the GIORDANA trademark at the time of the domain name registration. The panel also pointed out that the respondent was a member of the Alè Cycling Team and had acquired the domain name from APG SRL, a direct competitor of the complainant. Furthermore, the panel noted that the complainant had asserted that the respondent's wife and sister-in-law were working for APG SRL, and the respondent had not denied this.

In view of this, the panel concluded that the respondent's argument that he was not a competitor of the complainant was not convincing and that he did have an economic purpose in registering the domain name, as it was reasonable to infer that he, more likely than not, was interested in helping APG SRL under the circumstances. In the panel's opinion, the respondent's alleged use of the domain name to "celebrate" a family pet when he had failed to prove that he owned a dog named Giordana did not carry much weight given the evidence that suggested that he had used the domain name to create an obstacle to the complainant's business. The panel therefore concluded that the complainant had satisfied the third requirement set out in Paragraph 4(a) of the UDRP and ordered the domain name to be transferred to the complainant.

Perhaps the lesson to be learned from this decision is that, ideally, trademark licences should also deal with the registration and use of relevant domain names, preferably providing that ownership should remain with the trademark owner and setting out the conditions upon which the licensee may use them during the term of the licence. However, if the licensee does register any domain names in its own name, then the licence should clearly provide for their transfer upon termination. In the present case, unambiguous reference to domain names in the trademark licence and/or any subsequent termination agreements would

have perhaps avoided the complainant having to file not one, but two UDRP complaints, to recuperate the domain name.

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