

Say cheese to '.city'
International - Hogan Lovells

Examination/opposition
Domain names

June 29 2017

In a [Uniform Domain Name Dispute Resolution Policy \(UDRP\) decision](#) before the World Intellectual Property Organisation (WIPO), a three-member panel unanimously denied the transfer of a domain name registered under the new generic top-level domain (gTLD) '.city' that was identical to the complainant's trademark.

Background

In 2012 the Internet Corporation for Assigned Names and Numbers (ICANN) launched the application process for new gTLDs. The new TLD '.city' is one of many launched by ICANN and was designed to benefit local individuals or entities by allowing them to promote their products and services. It was delegated into the root on July 3 2014 and became available for general registration on October 1 2014 following a sunrise period for trademark owners between July 29 2014 and September 29 2014. Of the new gTLDs, '.city' is the 68th most popular, with over 44,000 domain name registrations.

Facts

Complainant *Consorzio per la Tutela del Formaggio Gorgonzola* (Novara, Italy) was established in 1968 to control the use of the denomination of origin, as well as the GORGONZOLA trademark in relation to gorgonzola cheese. The complainant was the owner of trademark registrations for CG GORGONZOLA, including EU Trademark 010595015 registered on July 4 2012. The complainant had also registered its GORGONZOLA mark with the Trademark Clearinghouse – a central trademark database designed to facilitate rights protection mechanisms under the new gTLDs.

Respondent DigitalTown, Inc (Washington, the United States) was a public company that developed platforms to enable cities worldwide to provide access to local information, including restaurants, lodgings and city services.

The domain name 'gorgonzola.city' was registered on January 2 2017 resolving to a website that enabled internet users to search for amenities and events in Gorgonzola, Italy.

Decision

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

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

Identical or confusingly similar

Concerning the first limb, the WIPO panel found that the complainant had rights in the trademark CG GORGONZOLA and that the disputed domain name was identical to the most prominent element of the mark (ie, 'gorgonzola'). Thus, the complainant satisfied the first element set out in Paragraph 4(a).

No rights or legitimate interests

According to Paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Overview 2.0), complainants must prove that the respondent had no rights or legitimate interests in respect of the disputed domain name. Complainants are usually required to make out a *prima facie* case and the respondent must demonstrate otherwise. If the respondent fails to do so, the complainant is deemed to satisfy Paragraph 4(a)(ii) of the UDRP.

In this case, the complainant stated *prima facie* that the respondent had no rights or legitimate interests in the domain name 'gorgonzola.city' because it had not been authorised to use the complainant's trademark and no relationship between the complainant and the respondent would otherwise entitle the respondent to use it. The panel was of the view that a *prima facie* case had been established and it was for the respondent to prove its rights or legitimate interests in the domain name.

Pursuant to Paragraph 4(c) of the UDRP, respondents may establish rights or legitimate interests in a

disputed domain name by demonstrating any of the following:

- Before receiving notice of the dispute, the respondent's use of – or demonstrable preparations to use – the domain name or a name corresponding to the domain name was in connection with a *bona fide* offering of goods or services;
- The respondent was commonly known by the domain name, even if it had acquired no trademark or service mark rights; or
- The respondent was making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to mislead or divert consumers, or tarnish the trademark or service mark at issue.

In this case, the respondent stated that it was in the process of developing and launching a platform to allow users to search a municipality and find commodities (eg, hotels and restaurants), including those in Gorgonzola, Italy, and that the complainant had acknowledged that 'gorgonzola' was a geographic term that referred to such city. Therefore, the respondent claimed to have registered 'gorgonzola.city' due to its geographic meaning for business operations as part of a substantial domain name portfolio, which corresponded to the names of cities registered under the '.city' gTLD extension. However, the panel noted that the respondent had provided no evidence of this, and was uninclined to give it an opportunity to file further evidence that should have been filed when the response was submitted.

In this regard, Paragraph 4.5 of the WIPO Overview 2.0 states:

"A panel may undertake limited factual research into matters of public record if it deems this necessary to reach the right decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent and the use of the domain name, consulting a repository such as the Internet Archive (at www.archive.org) in order to obtain an indication of how a domain name may have been used in the relevant past, reviewing dictionaries or encyclopedias to determine any common meaning, or discretionary referencing of trademark online databases. A panel may also rely on personal knowledge. If a panel intends to rely on information from these or other sources outside the pleadings, especially where such information is not regarded as obvious, it will normally consider issuing a procedural order to the parties to give them an opportunity to comment. Alternatively or additionally, if the panel feels that it requires supplemental information to make a decision in a proceeding, it can issue a procedural order to the parties requesting the submission of such information."

Although stressing that it was not the panel's responsibility to carry out legal research to establish the respondent's contentions, the panel took the unusual steps to review the gorgonzola.city website and carry out a reverse WHOIS search in relation to the respondent. The results showed that the respondent, as per its assertions, had registered over 22,000 domain names – most of which corresponded to the names of cities registered under the '.city' extension and resolved to websites relating to their geographic meaning. Similarly, the gorgonzola.city website provided information about the city of Gorgonzola.

The complainant contended that the domain name 'gorgonzola.city' pertained to a website that offered worldwide food delivery services and that this would be commercially detrimental to its interests. However, the panel found no evidence that the respondent had specifically targeted the complainant – for example, it made no reference to cheese. In addition, the panel noted that the screenshots submitted by the complainant were taken several weeks before the complaint was filed, and that screenshots from the internet archive on dates immediately before WIPO's notice of the proceedings to the respondent showed that 'gorgonzola.city' was being used in relation to its geographic meaning. In this regard, the panel found that use of the '.city' gTLD supported the respondent's position that the domain name had been registered for use in connection with a city-based tourism business, not to sell cheese.

The complainant argued that the respondent must have been aware of its trademark rights when registering 'gorgonzola.city', as it had recorded such rights in the GORGONZOLA mark with the Trademark Clearinghouse. Considering that Gorgonzola was a small town in Italy with low touristic attraction, the panel conceded that given the respondent was based in the United States, registration of the domain name may have been prompted by the reputation of the CG GORGONZOLA trademark. However, with no evidence to support this the panel found that the respondent had made use of the domain name in connection with a *bona fide* offering of services.

The panel concluded that the respondent had rights or legitimate interests in the domain name 'gorgonzola.city', as it had been used in a descriptive manner and did not target the complainant's trademark. Given that complainants must cumulatively fulfil the three UDRP requirements and the

complainant had failed to satisfy the second, the panel found it unnecessary to examine whether the respondent had registered and used 'gorgonzola.city' in bad faith. The complaint was therefore denied.

The panel declined the respondent's request to make a finding of reverse domain name hijacking (ie, when a complaint is filed in bad faith to harass the domain name owner). It opined that nothing in this case suggested that 'gorgonzola.city' was being used in relation to its geographic meaning at the time that the complaint was filed, as the change appeared to have occurred after the complaint was filed, but before the respondent received notice of it. Further, there was no evidence that the complainant had engaged in any harassing behaviour or similar conduct.

Comment

This decision highlights the fact that owning a trademark – even if it is well known – may not be sufficient to obtain the transfer of a domain name, regardless of whether it reproduces such trademark. Respondents may well have a legitimate interest in a disputed domain name, particularly where the trademark is also descriptive and there is no indication or evidence that it was registered and used to take advantage of the complainant's rights. Therefore, complainants are advised to consider carefully the evidence that they provide to satisfy the second requirement of the UDRP, as they will likely need to demonstrate that the respondent registered the disputed domain name with intent to take advantage of such rights – which may be difficult to prove where the trademark in question also has a descriptive value, as in this case.

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