

Versailles fails to recover domain name
International - Hogan Lovells

Examination/opposition
Geographical indications/appellations of origin
Domain names

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- In a UDRP decision, WIPO denies transfer of 'visitversailles.com' domain name
- Complainant failed to demonstrate that the domain name had been registered in bad faith
- Decision highlights that geographical terms carry heavier burden of proving that the domain name was registered to take advantage of the complainant's name and reputation

In a recent decision under the Uniform Domain Name Dispute Resolution Policy (UDRP) before the World Intellectual Property Organisation (WIPO), a single-member panel denied the transfer of a domain name consisting of a city name for failure to prove that the registrant had registered the domain name for its trademark value, as opposed to its descriptive value.

Background

The complainant was the Commune de Versailles, the governing body for the city of Versailles in France. The complainant owned a number of trademark registrations in France using the term 'Versailles' in connection with a wide range of goods and services, including French Trademark 3424555, registered on April 21 2006, for goods and services in Classes 3, 8 and 25 (namely cleaning and cosmetic products, cutlery and apparel). The complainant also had a pending international trademark application filed in 2015, designating a number of countries, including the United States.

The respondent was Kimberly Kubalek, Kubalek, LLC, based in Laredo, Texas. The respondent operated a tourism website at www.visitsanmiguel.com, which provided travel information for visitors to San Miguel in Mexico.

The disputed domain name was 'visitversailles.com'. It was registered on September 20 2006 and resolved to a 'coming soon' website that displayed the following message: "This site is currently being developed. Interested in placing advertising? Please let us know here."

Decision

To be successful under the UDRP, a complainant must demonstrate each of the following cumulative requirements:

- 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.
- The domain name has been registered and is being used in bad faith.

The first requirement under the UDRP is two-fold and requires a panel first to assess whether the complainant has relevant trademark rights and, second, whether the disputed domain name is identical or confusingly similar to the complainant's trademark.

The complainant owned a number of trademarks using the term 'Versailles' and so the panel found that the complainant had established relevant trademark rights.

The panel then examined whether the domain name was identical or confusingly similar to the complainant's trademark. The panel noted that the domain name contained the complainant's trademark in its entirety and concluded that it had satisfied the first requirement under the UDRP.

As far as the second requirement under the UDRP was concerned, the panel found that it was unnecessary to consider whether the respondent had rights or legitimate interests in the domain name in view of its findings on bad faith registration and use.

Turning to the last requirement under the UDRP and whether the domain name had been registered and used in bad faith, the complainant argued that the respondent was aware of the complainant's trademark rights and had registered the domain name in bad faith in order to take advantage of the complainant's notoriety and attract users to her website for commercial gain.

However, the panel noted that the respondent was located in the United States and the complainant did not

own registered trademark rights in the term 'Versailles' in the United States. Further, the panel held that there was no evidence to suggest that the respondent was aware of the complainant's rights before the commencement of the proceedings. The panel noted that, while it was safe to assume that the respondent had awareness of Versailles as a place, there was no evidence that the respondent had knowledge of the complainant's trademark rights in the term 'Versailles'.

The panel also highlighted that the nature of the domain name itself, which consisted of the terms 'visit' and 'Versailles', was consistent with a descriptive use of a geographic name for a place, as opposed to an abusive use of a trademark. The fact that the respondent had registered other domain names consisting of geographical terms and was using them for tourism websites (eg, www.visitsanmiguel.com) was a factor that tipped the balance in favour of the respondent. In this regard, the panel relied on Paragraph 2.10 of the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition* which provides that:

"Panels also tend to look at factors such as the status and fame of the relevant mark and whether the respondent has registered and legitimately used other domain names containing dictionary words or phrases in connection with the respective dictionary meaning."

The panel held that the complainant had failed to provide sufficient evidence to demonstrate that the respondent had registered and used the domain name in bad faith. The panel therefore decided that, on balance, it was more likely than not that the respondent had registered the domain name for its descriptive value, as opposed to its trademark value. The panel therefore found that the complainant had failed to satisfy the third and final requirement under the UDRP.

Accordingly, the complainant did not satisfy all three requirements under the UDRP and so the panel denied the transfer of the domain name to the complainant.

Comment

This decision highlights that although having a trademark consisting of a geographical term may be sufficient to satisfy the first requirement under the UDRP, it is not enough to successfully obtain the transfer of a domain name. In cases where a complainant is relying on a trademark that consists of a geographical or descriptive term, the complainant has a heavier burden to establish that the domain name in question was registered and used in bad faith, even if the domain name is identical to the complainant's trademark. It must be shown that the respondent registered the domain name for its trademark value, as opposed to its descriptive value, which generally requires a complainant to demonstrate not only awareness of such trademark rights but also that the domain name was registered to take advantage of the complainant's name and reputation.

The decision is available [here](#).

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