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Unlucky (Louis) thirteen: cognac producer fails to obtain transfer of 'louisthirteen.com'

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- Rémy Martin, a cognac producer which owned several LOUIS XIII marks, sought the transfer of 'louisthirteen.com' under the UDRP
- The panel found that there was a genuine possibility that the domain name could be being used in connection with a *bona fide* offering of goods/services
- The complainant's claims regarding the reputation of the mark would require an assessment of trademark law that went beyond the scope of the UDRP

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to transfer the domain name 'louisthirteen.com', finding that the complainant had failed to prove that the respondent lacked rights or legitimate interests.

Background

The complainant was E Rémy Martin & C, a subsidiary of the Remy Cointreau Group, a French company producing and selling cognac. The complainant registered several trademarks for LOUIS XIII as early as 1880 in France, and had a large trademark portfolio comprising the word element 'louis' and 'louis xiii', including, but not limited to, the international trademark LOUIS XIII DE REMY MARTIN registered in 1995. The complainant also used the domain name 'louisxiii-cognac.com'. Needless to say, one of the cognacs sold by the complainant was called Louis XIII.

The respondent was an individual based in the United Kingdom. He was a director of a company called Louis Thirteen Group Limited, incorporated in 2019. The respondent registered the domain name in November 2017. At the time of the proceedings, the domain name resolved to a website offering a range of white-label products including protective masks against bacteria and viruses in the context of the covid-19 pandemic.

The complainant initiated proceedings under the UDRP for a transfer of ownership of the domain name. The respondent did not reply.

To be successful under the UDRP, a complainant must satisfy the requirements of Paragraph 4(a) of the UDRP, namely that:

- the disputed domain name 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 the disputed domain name; and
- the disputed domain name was registered and is being used in bad faith.

Decision

The panel first underlined that the respondent's failure to submit a formal response did not by itself mean that the complainant would be deemed to prevail, and pointed out that the respondent's default was not necessarily an admission that the complainant's claims were true.

Paragraph 4(a)(i)

The complainant argued that the domain name was confusingly similar to its trademark LOUIS XIII because it incorporated the term 'louis' and a misspelling of the Roman number 'xiii'. The panel rejected the misspelling argument, but underlined that a domain name that consists of a translation of a trademark will normally be found to be identical, or confusingly similar, to such trademark. The panel found that 'thirteen' was a literal English translation of 'xiii' (a Roman numeral), and as a consequence held that the domain name was confusingly similar to the trademark.

Paragraph 4(a)(ii)

The complainant claimed that the respondent had no rights or legitimate interests in the domain name because:

- he was not known as 'louis thirteen' at the time of registration of the domain name; and
- he did not own any trademarks justifying the registration of the domain name.

The panel acknowledged that the complainant's trademark enjoyed a broad scope of protection, but found several aspects supporting a claim to a *bona fide* offering of goods or services. In particular, the panel underlined that the website to which the domain name resolved related to what could be a genuine offering of white-label goods as, for example, it contained legally required information such as contact details, street address, and company and VAT numbers. Further, the panel conducted a brief internet search and found that the respondent was the director of a company named Louis Thirteen Group Limited, which was incorporated 18 months before the complaint was filed. The panel concluded that there was a genuine possibility that the domain name could be being used in connection with a *bona fide* offering of goods or services and, as such, the complainant had not satisfied the second element of Paragraph 4(a) of the UDRP.

In addition, although the panel underlined that the complainant's trademark enjoyed broad protection (possibly even as a famous mark) and noted that the complainant could still initiate a trademark infringement action against the respondent in a court of law, in the panel's opinion it was not certain, without further substantiation, that the complainant could oppose the respondent's use of 'louis thirteen' in relation to activities that did not have any link to the activities of the complainant (based on the evidence provided). The panel emphasised that the reputation of the trademark on which the complainant relied and the inferences that the complainant suggested were drawn from that would require an assessment of trademark law and principles that went beyond the scope of the UDRP. Had the complainant put forward clear evidence that it had registrations for, and engaged in commercial activity in relation to the goods seemingly sold by the respondent, the panel's analysis may have been different, but that was not the case.

As a consequence, the panel found that complainant had failed to prove that the respondent had no rights or legitimate interests in the domain name and so the complaint was denied. It was not necessary for the panel to address the question of registration and use in bad faith.

Comment

This decision shows that complainants must be cautious when invoking trademark law principles in UDRP proceedings. In this case, it appears that the panel denied the complaint in part because the question of whether the famous or well-known trademark doctrine applied was beyond the scope of the UDRP, which is intended to deal with cybersquatting and not trademark infringement under national trademark law. Moreover, this case is a reminder that complainants should put forward strong evidence of a respondent's bad-faith registration and use of a domain name in order to profit from the complainant's goodwill and reputation, especially when the commercial activities of the parties differ greatly.

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