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What's the Parramatta matter? Decision highlights limited scope of UDRP

International - [Hogan Lovells](#)

- **The City of Parramatta Council sought the transfer of the domain name 'parramatta.com' under the UDRP**
- **The panel noted that the legal authority of a geographical area does not, as a matter of principle, have an exclusive right over the name of that area**
- **The complainant had failed to demonstrate that 'Parramatta' by itself had acquired secondary meaning**

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has refused to transfer the disputed domain name 'parramatta.com', finding that the complainant had failed to prove that the domain name was identical, or confusingly similar, to a trademark or service mark in which the complainant had rights.

Background

The complainant was the City of Parramatta Council, Parramatta being the second-oldest city in Australia, having been founded in 1788, some months after Sydney. The complainant had registered a number of trademarks, including:

- THE COUNCIL OF THE CITY OF PARRAMATTA N.S.W. (and device) (Australian trademark No 387468, registered on 15 February 1983);
- PARRAMATTA LANES (figurative mark) (Australian trademark No 1936396, registered on 25 June 2018); and
- RIVERSIDE NATIONAL THEATRE OF PARRAMATTA (stylised) (Australian trademark No 1936400, registered on 25 June 2018).

The complainant's Australian trademark No 387468 included a disclaimer, stating that "[r]egistration of this trademark shall give no right to the exclusive use of the geographical name Paramatta NSW".

The complainant also held pending trademark applications for PARRAMATTA LANES and stylised versions of PARRAMATTA, as well as a stylised version of WHERE IT'S PARRAMATTA.

The disputed domain name was first registered in 2004. The respondent purchased it in March 2012 with a view to developing a website promoting Parramatta. Prior to submission of the complaint to WIPO, the domain name resolved to a parking page displaying pay-per-click links, including to such items as 'Parramatta Eels', 'Sales', 'restaurant store', 'used cars', 'used car sales' and 'Australian'.

In order to prevail, a complainant must demonstrate, on the balance of probabilities, that it has satisfied the requirements of Paragraph 4(a) of the UDRP:

- 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 noted that, insofar as Australian trademark No 387468 - THE COUNCIL OF THE CITY OF PARRAMATTA N.S.W. (and device) - was concerned, the complainant was required to disclaim exclusive rights over the name Paramatta, as it corresponded to the name of a place. In light of this, the complainant was unable to rely on that trademark in order to prove rights over 'Paramatta' alone. The panel further observed that the complainant's other registered trademarks included significant additional verbal elements, which distinguished them from the word 'Parramatta' alone. In addition, the panel found that the complainant's trademark applications, on their own, did not qualify as trademark rights under the UDRP.

In relation to the complainant's claim of unregistered trademark rights in PARRAMATTA, the panel held that, for purposes of the UDRP, the legal authority of a geographical area does not, as a matter of principle, have an exclusive right over the name of that geographical area. Such a governing body may have such rights if it succeeds in proving that the term has acquired secondary meaning distinguishing the entity as the trade source of goods or services. However, in the present case, the complainant had failed to demonstrate that 'Parramatta' by itself had acquired secondary meaning designating the complainant or its goods or services. Noting that 'Parramatta' corresponded to the name of a place, the verbal differences of the complainant's remaining trademarks were of such a nature that the panel was unable to find that the domain name was confusingly similar to them.

The complainant had therefore failed to establish the first element of the UDRP.

In light of the complainant's failure to carry its burden under the first element, the panel found it unnecessary to consider the remaining requirements.

Comment

The present case is a clear example of the limited scope of the UDRP, as it applies to trademarks. Whether protection under the UDRP could be extended to geographical indications was considered in the Final Report of the First WIPO Internet Domain Name Process, which stated that:

registrations that violate trade names, geographical indications or personality rights would not be considered to fall within the definition of abusive registration for the purposes of the administrative procedure.

Part of the rationale for such a limitation appears to be keeping in line with the legislative intent to create a truly international dispute resolution system, as the report went on to state that "the law with respect to trade names, geographical indications and personality rights is less evenly harmonised throughout the world [...]". Prior UDRP panels have held that a fragment of a trademark may, in certain cases, be sufficient to establish confusing similarity for purposes of standing under the UDRP. Reading between the lines, it is clear that broader policy considerations surrounding geographical indications underpin the final outcome of this case.

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