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Evidence of targeting is key under the UDRP

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- French company CECIA sought the transfer of 'cecia.com' under the UDRP
- The panel found that the respondent's explanation for his choice of the domain name was not lacking in credibility
- The panel was unable to find it more likely than not that the respondent intended to benefit unfairly from the complainant's mark

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied the transfer of a domain name consisting of a term commonly used as a female name due to the lack of tangible evidence of the respondent's intent to target the complainant's trademark at the time of registration of the domain name.

Background

The complainant was CECIA, a French company registered in 2000, with three offices and 42 employees all based in France. The complainant's name CECIA was the acronym for 'Cabinet d'Etudes et de Conseil en Industrie et Agroalimentaire', which designated its consulting services for the food processing sector. The complainant owned two French trademarks for CECIA, the earlier of which was registered in 1990. Its parent company, IDEC Group, registered the domain name 'cecia.fr' in 2018, which resolved to a website both in French and English providing information about the complainant and its services.

The respondent was Abid Ishaq, a domain reseller based in Pakistan. He operated a website under his business name 'AbidNetwork.com', where he promoted the sale of his portfolio of domain names, including the disputed domain name.

The disputed domain name was 'cecia.com', which was acquired by the respondent through a public auction at the end of 2020 after the domain name was allowed to lapse. It resolved to a webpage hosted by the registrar, which allowed internet users to request price information about the domain name. It was also listed for sale at the registrar's website for the price of \$6,888.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements under 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.

Decision

Paragraph 4(a)(i)

Since the domain name clearly consisted of the complainant's CECIA trademark, the panel found that the domain name was identical to the trademark in question. The first limb was therefore satisfied.

Paragraph 4(a)(ii)

The complainant claimed that the respondent was never known as 'Cecia', nor was he related to the complainant's business or authorised by the complainant to make use of the CECIA trademark in a domain name. The respondent countered that the term 'Cecia' was more commonly used as a female name and therefore was not exclusively and famously associated with the complainant. According to the respondent, the mere registration and offering for sale of a non-exclusive and common term like 'Cecia' was not illegitimate unless the complainant was able to prove that the respondent's registration was specifically motivated by the complainant's CECIA trademark. The respondent referred to his practice of registering domain names incorporating common words and phrases and asserted that, due to the lack of worldwide reputation attached to the complainant's trademark, his real intent was to resell a non-exclusive female name to people who may have a legitimate interest in buying the domain name for purposes unrelated to the complainant.

The panel found that it was not necessary to make any findings concerning the respondent's rights or legitimate interests, given its subsequent conclusion on bad faith.

Paragraph 4(a)(iii)

The complainant contended that its CECIA trademarks were registered long before the domain name was registered and that all the top results of an internet search for 'Cecia' related to it and its business. In the complainant's opinion, it was therefore clear that the respondent had registered the domain name in an attempt to target the complainant. In response to the complainant's contentions, the respondent first pointed out that a Google search for 'Cecia' conducted outside France mostly related to the female name Cecia, rather than the complainant. The respondent further submitted that the domain name was likely to be previously held by the complainant via a privacy service until it lapsed in October 2020. The respondent acquired the domain name in December 2020 as he was engaged in the acquisition of various short and memorable domain names at public auctions and he perceived that the term 'Cecia', as a female name, had value for potential resale. The respondent particularly underlined that the term 'Cecia' was more well known - and in all likelihood more valuable - when it referred to a female name than when it referred to the complainant, a small business located in France with three offices and 42 people. As a domainer located in Pakistan, the respondent claimed that he had no duty to know about the status of small businesses in France, nor of the French trademark register.

Presented with the two parties' arguments, the panel pointed out that the key issue was to determine whether it was more likely than not that the respondent was aware of the complainant or its CECIA trademark at the time of acquisition of the domain name and that he intended to benefit unfairly from that trademark and/or to damage the business of the complainant. To answer this question, the panel first noted that the term 'Cecia' was not only a relatively common female name but was also an acronym for various five-word combinations (including the complainant's full name as mentioned above). The panel then highlighted that the complainant's reputation was only established within France, given that all its projects were carried out in France and it only had French trademark rights. Further, the complainant could not rely on its parent company's global renown to ascertain its own reputation, since the complainant was the only affiliate of the group to use the company name Cecia. The panel also agreed that the internet search results provided by the complainant were evidently impacted by the fact that the search was only carried out in France. As evidence, there was only one result related to the complainant in the first three pages of text results provided by the respondent, who conducted the search outside France.

Although the panel did not exclude the possibility that the respondent may have been aware of the existence of the complainant through his pre-registration internet search, it noted that prior awareness of the complainant did not by itself demonstrate the respondent's intent to unfairly benefit from the reputation and goodwill attached to the complainant's CECIA trademark. Based on the evidence showing that the term 'Cecia' was mainly associated with a female name and given that the respondent's domain name portfolio also included domain names incorporating female names, the panel found that the respondent's explanation for his choice of the domain name (ie, reselling a non-exclusive female name to people who may have a legitimate interest in buying the domain name for purposes unrelated to the complainant) was not lacking in credibility. In this sense, the price of \$6,888 at which the respondent offered the domain name for sale only reflected the domain name's inherent value as a personal name or as a short acronym with multiple actual and potential meanings unrelated to the complainant and, therefore, was not indicative of bad faith as per Paragraph 4(b)(i) of the UDRP (registering the disputed domain name primarily for the purpose of selling it to the complainant).

In view of the above, and in the absence of any other indicia of bad faith (for example, nothing on the respondent's webpage had any particular connection to the complainant), the panel did not find it more likely than not that the respondent had attempted to take unfair advantage of the complainant's CECIA trademark; therefore, his registration and use of the domain name was not in bad faith. The third limb was thus not satisfied and the complaint was denied.

Comment

This decision is a good example of how important it is for brand owners to provide convincing evidence to establish a respondent's intent to benefit unfairly from their trademark at the time of registration, and not just their potential awareness of it. This is particularly the case when a trademark is distinctive in one context but not in another, and may not exclusively refer to the complainant. In the present case, the mere fact that the term 'Cecia' was identical to the complainant's trademark pursuant to a general internet search did not necessarily mean that the registration of the domain name would automatically be in bad faith. A more careful analysis of a respondent's real motive behind the registration and subsequent use of a disputed domain name is therefore required to exclude any eventual legitimate speculation.

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TAGS

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