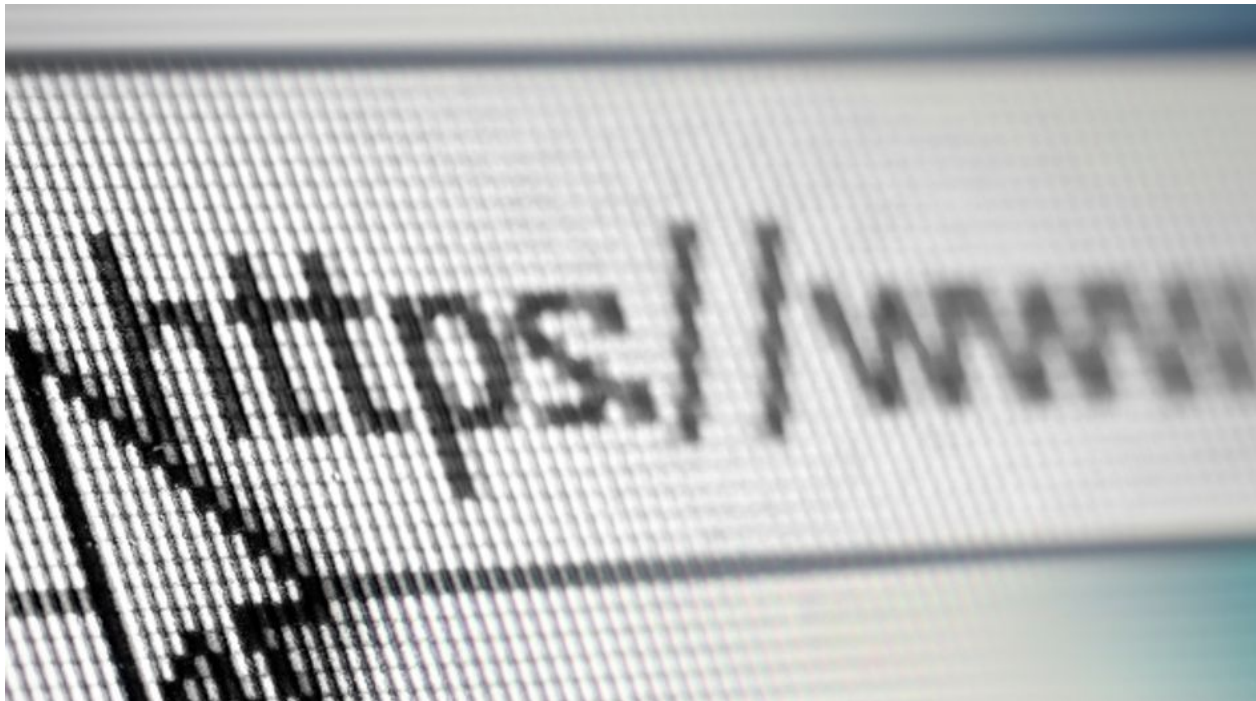


Targeting is essential for a transfer under the UDRP

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INTERNATIONAL

Legal updates: case law analysis and intelligence

- Laboratoire Terravita sought the transfer of 'terravita.shop' under the UDRP, relying on the passive holding doctrine
- The panel found that factor (ii) of the passive holding doctrine was the only factor in the complainant's favour
- The domain name resolved to a parking page which did not appear to target the complainant or its users in any way

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied the transfer of the domain name at issue, finding that the complainant had failed to prove bad-faith registration and use on the part of the respondent.

Background

The complainant was Laboratoire Terravita, a French producer of food supplements. The complainant held an International Registration for TERRAVITA designating Switzerland and registered in March 2021.

The disputed domain name was 'terravita.shop'. The domain name was registered in June 2023 by an individual based in Switzerland, and resolved to a Shopify parking page.

The complainant initiated proceedings under the UDRP for a transfer of ownership of the domain name, relying on the passive holding doctrine. The respondent did not submit a response.

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

(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;

(b) The respondent has no rights or legitimate interests in respect of the domain name; and

(c) The domain name has been registered and is being used in bad faith.

Decision

First element

The panel briefly stated that the domain name was identical to the complainant's TERRAVITA trademark, which satisfied the requirements of Paragraph 4(a)(i) of the UDRP.

Second and third elements

The panel did not address the second element, finding that this was not necessary given its ruling on the third element.

Regarding bad-faith registration and use, the panel noted that the factors that panels typically consider under the doctrine of passive holding are set out in Section 3.3 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#) - namely:

(i) the degree of distinctiveness or reputation of the complainant's mark;

(ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;

(iii) the respondent concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and

(iv) the implausibility of any good-faith use to which the domain name may be put.

The panel noted that, in this case, factor (ii) was the only factor in the complainant's favour, and the rest were not, with factor (iii) not being applicable.

The panel conducted its own online research (permitted under the UDRP in relation to information from public sources) for the sign TERRAVITA and found that a number of third parties were using it, even within the complainant's food supplement industry. Such use was found globally, but also more specifically in Switzerland where the respondent was based. The panel also found that the complainant was not included in the first pages of search results, regardless of whether such search was restricted to Switzerland. In addition, the panel searched European trademark registries and found several trademark registrations comprising the sign TERRAVITA.

The panel underlined that the domain name resolved to a parking page which did not appear to target the complainant or its users in any way (none of the complainant's branding had been adopted, for example). The panel further found that no mail exchange (MX) records were configured for the domain name, which excluded potential use to send fraudulent emails. Finally, and interestingly, the panel did not discard the possibility that the domain name had been registered to target an existing third party using the sign TERRAVITA, but underlined that targeting of the complainant needed to be established and this was not the case.

Comment

This decision underlines the difficulties of establishing bad faith in a passive holding case where targeting evidence is scarce. In such a case, registrants need to be very cautious when filing a UDRP complaint and must not rely solely on an unanswered cease and desist letter or notice. Establishing the distinctiveness and reputation of the trademark upon which the complaint is based will be critical. This is especially true for small companies without a global presence, and even more so where the trademark at hand comprises terms widely used by third parties in the same line of business. In addition, this decision serves as a reminder that panellists have the power to conduct basic online searches on information in the public domain, and many will do so if they deem that the evidence provided is insufficient.

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