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International
Examination/opposition
Unfair use
Domain names

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In a [Uniform Domain Name Dispute Resolution Policy \(UDRP\) decision](#) before the World Intellectual Property Organisation (WIPO), a panel ordered the transfer of a domain name containing ordinary English words that was registered seven years ago.

Facts

The complainant was New York-based Consumer Reports, Inc, a non-profit consumer product testing and advocacy organisation responsible for publishing a family of *Consumer Reports* publications. The organisation had been using the CONSUMER REPORTS trademark continuously since 1942 and owned several trademark registrations that included or consisted of the words “Consumer Reports”, including a US trademark registered on January 20 1959 for periodic publications.

The respondent was Wu Yan of Common Results, Inc based in Victoria, Seychelles.

The dispute arose over the domain name ‘eyeglassesconsumerreports.com’, which was registered on January 7 2010 and resolved to a website which provided a range of materials and articles relating to eyeglasses. The website contained text stating that it was part funded by advertising and sponsorship, as well as various disclaimers stating that it was not associated with the complainant.

Decision

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

- 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.

Domain name is identical or confusingly similar

As for the first limb, the panel must assess:

- whether the complainant has relevant trademark rights, regardless of when and where such trademark was registered; and
- whether the domain name at issue is identical or confusingly similar to such trademark.

In the present case, the complainant argued that the domain name consisted of the whole of its registered trademark in the term CONSUMER REPORTS, followed by the additional generic term ‘eyeglasses’, and was thereby confusingly similar. The panel took the opportunity to recall the following well-established doctrines:

- Where a mark is the distinctive part of a disputed domain name, the disputed domain name is considered to be confusingly similar to the mark (*DHL Operations BV v DHL Packers*, WIPO Case D2008-1694);
- The addition of a descriptive term to the disputed domain name has little, if any, effect on a determination of legal identity between the domain name and the mark (*Quixtar Investments, Inc v Dennis Hoffman*, WIPO Case D2000-0253); and
- The mere addition of a generic or descriptive term does not exclude the likelihood of confusion (*PRL USA Holdings, Inc v Spiral Matrix*, WIPO Case D2006-0189).

The panel considered that the addition of the generic word ‘eyeglasses’ was not sufficient to avoid confusion with the CONSUMER REPORTS mark and that the domain name suggested that it was likely related to a report produced by the complainant concerning eyeglasses.

The panel concluded that the complainant had satisfied the first element of the UDRP.

Respondent has rights or legitimate interests

Turning to the second limb, the complainant argued that the respondent had no rights or legitimate interests

in the domain name and had received no licence or authorisation to use the CONSUMER REPORTS mark.

Paragraph 4(c) of the UDRP lists three non-exhaustive examples of ways in which a respondent may establish rights or legitimate interests in a domain name:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

With regard to Paragraph 4(c)(i), the panel noted that the question of whether the respondent had made *bona fide* use of the domain name depended on his reasons and motives for choosing it. The respondent admitted that he was aware of the complainant and noted that he had ensured that there were no prior registrations for domain names dealing specifically with eyeglasses. The panel noted that ‘consumer’ and ‘reports’ were ordinary English words and that a person could conceivably use them as part of a domain name while offering reports of interest to consumers, particularly if that person was based in a different country to the complainant.

However, the respondent’s admission to knowledge of the complainant in combination with the disclaimers on his website led the panel to conclude that he deliberately chose to use the CONSUMER REPORTS mark as part of the domain name in order to attract internet users to the website who were searching for reports prepared by the complainant concerning eyeglasses. The panel saw no reason to infer that the respondent had made prior *bona fide* use of the domain name to give him rights or interests.

With regard to Paragraph 4(c)(ii), the respondent contended that he has become commonly known by the domain name after several years. However, no evidence was produced to substantiate this claim and the panel considered that internet users were led to the website thinking that it was connected to the complainant.

The panel concluded that the respondent had no rights or legitimate interests in the domain name.

Domain name is registered and used in bad faith

In relation to the third limb, a complainant must demonstrate that the domain name in question has been registered and is being used in bad faith.

In this case, the complainant argued that, by registering and using the domain name, the respondent had intentionally tried to attract internet users to his website for commercial gain by creating a likelihood of confusion with its trademark. Although the respondent relied on disclaimers contained on the website, the panel did not consider them to be clearly visible or particularly prominent.

The panel’s finding was in line with the consensus view among WIPO panels:

“The existence of a disclaimer cannot by itself cure bad faith, when bad faith has been established by other factors. [...] A disclaimer can also show that the respondent had prior knowledge of the complainant’s trademark. However a disclaimer, especially if it is sufficiently clear and prominent, may sometimes be found to support other factors indicating good faith or legitimate interest.” (Paragraph 3.5 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition.)

The panel added that even if the disclaimers had been prominent, the overall circumstances in this case pointed to the respondent’s bad faith; in fact, the disclaimers confirmed that the respondent was aware of the complainant and that his website was likely to attract internet users looking for the complainant’s website.

The panel then examined the laches defence invoked by the respondent, as the domain name was registered seven years before the filing of the complaint.

In this respect, Paragraph 4.0 of the WIPO Overview states as follows:

“Panels have recognised that the doctrine or defence of laches as such does not generally apply under the UDRP, and that delay (by reference to the time of the relevant registration of the disputed domain name) in bringing a complaint does not of itself prevent a complainant from filing under the UDRP, or from being able to succeed under the UDRP, where a complainant can establish a case on the merits under the requisite three elements. Panels have noted that the remedies under the UDRP are injunctive rather than compensatory in nature, and that a principal concern is to avoid ongoing or future confusion as to the source of communications, goods, or services.

However: Panels have also noted that a delay in bringing a complaint under the UDRP may make it more difficult for a complainant to establish its case on the merits, particularly in relation to the second and third elements requiring the complainant to establish that the respondent lacks rights and legitimate interests and that the respondent registered and used the domain name in bad faith. A small number of panels have also begun to acknowledge the possible applicability, in appropriate and limited circumstances, of a defence of laches under the UDRP where the facts so warrant.”

Although a minority of panels tend to recognise that such defence should apply to UDRP cases, in this case the panel followed the generally recognised position that the doctrine of laches does not apply to UDRP proceedings. The panel considered it irrelevant that the respondent had spent time and money during this period developing his website, and pointed out that he had in any event also earned revenue from the website during the same period.

The panel also noted that portions of the website were similar to text displayed in one of the complainant's previous reports on eyeglasses, which further evidenced the respondent's bad faith.

The panel therefore found that the domain name was registered and used in bad faith.

The complainant satisfied all three requirements under the UDRP and the panel ordered the transfer of the domain name to it.

Comment

This decision shows that each case turns on its own facts. It may have been difficult to win, given the fact that the panel was presented with little evidence of the complainant's notoriety (eg, how many customers it had, how much revenue it generated, what publications it produced or what its circulation was), especially as the domain name comprised three ordinary English words and had been registered seven years ago. However, the respondent's admission that he was aware of the complainant and the appearance of the disclaimers which served only to emphasise this awareness were enough to swing the balance back in the complainant's favour.

Jane Seager and Hortense Le Dosseur, Hogan Lovells LLP, Paris

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