

Use of domain name containing trademark for criticism site may generate rights or Cybersquatting legitimate interests on respondent's part International - Hogan Lovells LLP

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In a [recent decision](#) under the [Uniform Domain Name Dispute Resolution Policy \(UDRP\)](#) before the [World Intellectual Property Organisation \(WIPO\)](#), a panel has denied the transfer of a domain name used for a genuine non-commercial criticism website.

The complainant was Azimo Ltd of London, United Kingdom, a company authorised to issue electronic money and provide online money transfer services around the world. The complainant owned trademark registrations in the United Kingdom and Europe for AZIMO, registered respectively in 2012 and 2014 in connection with its money service business. The respondent was Vladimir Zubkov, an individual based in the United Kingdom who was dissatisfied with the complainant's services.

The domain name was 'azimoreview.com', registered on May 9 2015. It was used to resolve to a website on which the respondent published, in May 2015, a review criticising the poor quality of the service provided by the complainant.

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

- (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.

As far as the first limb was concerned, the complainant contended that the domain name consisted of the whole of its registered trademark AZIMO followed by the descriptive word 'review' and, as a result, it was confusingly similar. This argument was accepted by the panel considering that the complainant's AZIMO trademark was a dominant and confusing part of the domain name. The first limb was therefore satisfied.

The real merits of this decision are however set out in the panel's assessment of the respondent's rights and legitimate interests under the second limb. In this regard, the panel referred to the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition \(WIPO Overview 2.0\)](#), and particularly the question as to whether a criticism site could generate rights and legitimate interests. According to the panel, this was the central issue of this proceeding.

Pursuant to the WIPO Overview 2.0, there are two main views on this issue. The first view provides that the right to criticise does not necessarily extend to registering and using a domain name that is identical, or confusingly similar, to the complainant's trademark (this is especially the case if the respondent is using the trademark alone as the domain name). The second view, which was adopted by the panel in this decision, recognises a respondent's legitimate rights in using a trademark as part of a domain name used for a criticism site, as long as such use is fair and non-commercial.

In order to determine whether the website in question reflected genuine non-commercial criticism, the panel assessed the following considerations as outlined in various previous WIPO decisions:

1. Whether the domain name has been registered and is used genuinely for the purpose of criticising the mark owner - in the panel's view, the respondent's negative review published on the website prominently stated in the header that it related to "My Bad Azimo Experience", suggesting that the blog was being used to genuinely criticise the complainant. It should be noted that the accuracy of those criticisms was irrelevant to the assessment of this consideration.
2. Whether the registrant believes the criticism to be well-founded and lacks intent for commercial gain - once again, the panel found that the respondent's criticism appeared to be well-founded on the basis of a bad experience with the complainant and there was insufficient evidence suggesting the respondent's intent for commercial gain.
3. Whether it is immediately apparent to internet users visiting the website at the domain name that it is not operated by the owner of the mark - the panel held that this should be the case in view of the analysis under the first consideration above.
4. Whether the respondent has refrained from registering all or most of the obvious domain names

reasonably suitable for the owner of the mark - as the respondent seemed to have registered only one domain name, this consideration was assumed to be met in the present dispute from the panel's point of view.

The panel found that the respondent did not meet the remaining two considerations, namely whether, where appropriate, a prominent and appropriate link was provided to the relevant trademark owner's website, and whether, where there was a likelihood that email intended for the complainant would use the domain name at issue, senders were alerted in an appropriate way that their emails had been misaddressed. However, the panel held on balance that the domain name was being used as part of a genuine criticism site and the respondent was not primarily motivated by commercial considerations. The second limb was therefore not satisfied because the panel found that it was not the case that the respondent had no rights or legitimate interests in respect of the domain name.

With regard to the third limb, the panel stated that it was difficult to conclude that the respondent had registered and used the domain name in bad faith in view of the findings above.

For the sake of completeness, the panel also addressed the question as to whether the respondent intended to sell the domain name to the complainant for valuable consideration exceeding the registration cost of such domain name, as this could potentially indicate bad faith. The panel pointed out that, although the respondent had approached the complainant once to sell the domain name, this potential sale offer was not seriously pursued with any identified price or value and was shortly withdrawn by the respondent. On this basis, the panel concluded that the third limb was not satisfied either, and the complaint was therefore denied.

This case illustrates how the UDRP balances freedom of critical speech on the one hand and the protection of trademark owners on the other. It is important to note that the use of a domain name containing a trademark for a criticism site may generate, under certain circumstances, rights or legitimate interests on the part of a respondent and finally justify, along with other factors, the denial of a complaint. Trademark owners are therefore advised to seek other solutions in these cases, bearing in mind the so-called 'Streisand effect' whereby an ill-judged attempt to stifle criticism that may be relatively well hidden could in fact have the opposite effect and only serve to bring it out into the glare of the public eye.

Jane Seager and Ying Lou, Hogan Lovells LLP, Paris

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