

Intellectual Property - France

A perfect 10 for Eleven

Contributed by **Hogan Lovells International LLP**

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In a recent domain name dispute under the [Uniform Domain Name Dispute Resolution Policy \(UDRP\)](#) before the [World Intellectual Property Organisation](#), a French company obtained the transfer of a domain name incorporating its trademark, which had pointed to a website offering counterfeit products.

Background

The complainant was Eleven Paris, a fashion company based in Paris, France. The complainant owned several French and international trademark registrations for ELEVEN PARIS, including French Trademark 3837770, registered on June 9 2011 and used in connection with various goods and services, including those in Classes 3, 14, 18 and 25. The complainant's official website is www.elevenparis.com, where it offers for sale its products, including clothing, shoes and accessories.

The respondent was Howword Flower, based in New York. No other details were known about the respondent.

The disputed domain name was 'elevenparisfr.com'. It was registered on July 16 2013 and pointed to a website which was very similar to that of the complainant's and which offered for sale counterfeit versions of the complainant's products.

The complainant sent a cease and desist letter to the respondent on August 9 2013. The respondent did not respond. The complainant filed a UDRP complaint shortly thereafter in order to obtain the transfer of the domain name.

UDRP requirements

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

- 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.
- The domain name has been registered and is being used in bad faith.

The first limb of the three-prong test under the UDRP is a low-threshold standing requirement, which is generally satisfied by providing evidence of trademark rights, regardless of when or where the trademark was registered. However, these factors may be relevant for the purpose of the third limb of the test – namely, registration and use of the domain name in bad faith.

The complainant argued that the domain name reproduced the complainant's exact trademark, ELEVEN PARIS, and that the mere addition of the letters 'fr', which is the country-code top-level domain for France, did not diminish the confusing similarity between the complainant's trademark and the domain name, but rather reinforced it, given that it directly referred to the country in which the complainant was based and was a direct reference to the mark itself.

The panel was satisfied that the complainant held trademark rights in ELEVEN PARIS and that the domain name was confusingly similar to such trademark. Thus, the panel held that the complainant met the first requirement under the UDRP.

Turning to the second requirement, a complainant must establish that the respondent

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has no rights or legitimate interests in the disputed domain name. In this regard, Paragraph 4(c) of the UDRP sets out a non-exhaustive list of circumstances which may suggest that a respondent has rights or legitimate interests in a domain name as follows:

- Before any notice to it of the dispute, the respondent's has used, or made demonstrable preparations to use, the domain name in connection with a good-faith offering of goods or services;
- The respondent has been commonly known by the domain name, even if it has acquired no trademark rights; or
- The respondent is making legitimate non-commercial or fair use of the domain name, without intent of commercial gain, diverting consumers misleadingly or tarnishing the trademark or service mark at issue.

The panel held that the complainant had made a *prima facie* case that the respondent had no rights or legitimate interests in the domain name. The facts that the domain name identically reproduced the complainant's trademark and was pointing to a website offering similar or identical products to those of the complainant were, in the panel's view, strong indications that the respondent has no rights or legitimate interests in the domain name. In addition, the complainant had also asserted that the respondent was not authorised or licensed to use the complainant's trademark, nor that it was commonly known by the domain name. The respondent had the opportunity to respond but chose not to do so. Therefore, in view of the circumstances, the panel found that the respondent had no rights or legitimate interests in the domain name. Thus, the panel determined that the complainant had satisfied the second requirement under the UDRP.

Turning to the third requirement of the UDRP, a complainant must demonstrate that the respondent registered and used the disputed domain name in bad faith. In this regard, Paragraph 4(b) of the UDRP sets out a list of non-exhaustive circumstances that may suggest registration and use of a domain name in bad faith as follows:

- The respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring it to the complainant or to a competitor, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- The respondent registered the domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct;
- The respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- The respondent is intentionally using the domain name in an attempt to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the respondent's website.

The panel found that the respondent registered the domain name in bad faith. According to the panel, the distinctiveness of the complainant's trademark meant that the respondent's choice of the domain name could not be reasonably explained except in relation to the complainant. In terms of use of the domain name, the panel found that the fact that the respondent was using the domain name to point to a website offering for sale products under the complainant's trademark without the complainant's consent supported a finding of use of the domain name in bad faith.

Thus, the panel found that the respondent both registered and was using the domain name in bad faith, and so the complainant also satisfied the third requirement under the UDRP. The panel therefore **ordered** the transfer of the domain name to the complainant.

Comment

This case is a classic example of cybersquatting of emerging trademarks and highlights the importance for trademark holders, particularly those whose trademarks are increasingly acquiring notoriety, of regularly monitoring their trademarks online in order to be able to act swiftly to protect their business, IP rights, reputation and goodwill.

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