

First UDRP decision under '.paris' new gTLD
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gTLDs
Cybersquatting

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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 leading French newspaper publisher [has obtained the transfer](#) of two domain names reproducing its well-known trademark under the new generic top-level domain (gTLD) '.paris'. It is the first decision ever under the UDRP involving a domain name registered under the '.paris' new gTLD.

The '.paris' TLD is one of the many city TLDs launched by [ICANN](#) and it aims to promote the city of Paris in France. It was delegated into the root on April 19 2014 and became available for general registration on December 2 2014 following a sunrise period for trademark holders that opened on September 9 and closed on November 11 2014. According to the '.paris' domain name registration policy, '.paris' domain names may be registered only by individuals or entities that can demonstrate that they are *bona fide* residents in the Paris region or have a direct or indirect connection with the French capital. The '.paris' new gTLD is currently the 52nd most popular new gTLD, with over 17,000 domain name registrations.

The complainant was [Société du Figaro SA](#), a leading newspaper publisher based in Paris, France. The complainant was the owner of the French daily newspaper *Le Figaro*, founded in 1826, and had registered trademarks for LE FIGARO in both Europe and in the United States. The complainant had also registered its FIGARO marks with the [Trademark Clearinghouse](#), a central trademark database designed to facilitate rights protection mechanisms under the new gTLDs.

The disputed domain names, 'le-figaro.paris' and 'lefigaro.paris', were registered by the respondent in 2015 and were pointing to a website offering the domain names for sale, along with a list of other domain names, also for sale.

The complainant decided to file a UDRP seeking to obtain the transfer of the domain names. The respondent filed a response.

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

1. the domain name is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
2. the respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.

As for the first requirement, the panel noted that the domain names consisted solely of the complainant's LE FIGARO mark and that, in the case of 'le-figaro.paris', there was a hyphen between 'le' and 'figaro', which the panel determined was insufficient to distinguish that particular domain name from the complainant's trademark.

In addition, the panel found that the use of the new gTLD '.paris', which made reference to the city of Paris, added to the likelihood of confusion with the complainant's trademark, as the complainant and its newspaper were based in Paris.

The panel therefore found that the domain names were confusingly similar to the complainant's LE FIGARO trademark. Thus, the complainant satisfied the first limb of the UDRP.

Turning to the second requirement under the UDRP, and whether the respondent had rights or legitimate interests in the domain names, the complainant argued that the respondent was not affiliated with, nor authorised by, the complainant in any way and that the respondent did not have any trademark rights in LE FIGARO. The respondent in turn argued that '*Le Figaro*' was a generic term, meaning 'curb' (but did not specify in what language), that Figaro was a character from an opera, and that there were other cities called Paris throughout the world.

The panel noted that the respondent's allegations were not consistent with the content of the website to which the domain names were pointing, as the website did not contain any reference to curbs, characters in operas or to other cities called Paris, but rather advertised that the domain names (as well as other domain

names) were for sale.

Whilst the panel acknowledged that the practice of selling domain names for profit was legitimate, in this particular case the respondent's intentions were not. The famous nature of the complainant's newspaper and the fact that it was based in Paris, coupled with the respondent's failure to put forward evidence of usage in the generic ways the respondent was alleging, were factors that strongly pointed towards a finding in support of the respondent's lack of rights or legitimate interests in the domain names.

Thus, the panel found the respondent did not have any rights or legitimate interests in the domain names.

Turning to the third requirement, a complainant must demonstrate that a respondent both registered *and* used the disputed domain name in bad faith. Paragraph 4(b) of the UDRP sets out four non-exhaustive factors which may evidence registration and use in bad faith, including but not limited to:

"circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [its] documented out-of-pocket costs directly related to the domain name" (Paragraph 4(b)(i) of the UDRP).

The panel noted that the respondent had failed to explain why it registered the complainant's famous LE FIGARO mark in conjunction with the new gTLD '.paris', which is precisely the city where the complainant was based. Furthermore, the respondent did not deny awareness of the complainant and its rights. In addition, the respondent did not provide any evidence of intended use of the domain names in ways unrelated to the complainant. The only evidence available showed that the respondent was offering the domain names for sale. The panel was of the opinion that any sum obtained from the sale of the domain names would likely be increased by the strong or even exclusive association with the complainant.

Thus, the panel found that the respondent registered and used the domain names in bad faith, as it was clear that the respondent registered the domain names with the intention of selling them and profiting from the complainant's rights.

The panel thus ordered the transfer of the domain names to the complainant.

This decision illustrates how the TLD may be relevant when assessing whether a domain name is confusingly similar to a complainant's trademark, although traditionally the consensus view amongst UDRP panels has been to disregard it. The decision also highlights how the combination of a trademark with a particular new gTLD may also be relevant in assessing the respondent's awareness of the complainant's rights at the time of registration, which is a critical factor to support a finding of bad faith.

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