

# World Trademark Review Daily

## Geographical name standing alone difficult to protect under UDRP International - Hogan Lovells

## Cybersquatting

June 06 2011

In *Ipiranga Produtos de Petróleo SA v Domain Admin, Mrs Jello LLC* (Case D2011-0163, May 4 2011), a three-member World Intellectual Property Organisation (WIPO) panel has allowed the registrant of the domain name 'ipiranga.com' to keep it. Essentially, the case was lost because the name Ipiranga alone is a geographical name in which the complainant could not establish any kind of exclusivity. As the panel pointed out:

*"Only where a place name is associated more readily with its product than with the place, for instance Champagne, might the word arguably be claimed to stand alone as a trademark for the product."*

The complainant was *Ipiranga Produtos de Petróleo SA*, a major Brazilian oil distribution company with a history dating back to 1933. The respondent was Domain Admin, Mrs Jello LLC (United States). The respondent was involved in internet and domain name matters, including the ownership of, and trading in, domain names, and the generation of revenue from domain names.

The domain name 'ipiranga.com' was registered on January 9 2003 and was pointing to a parking website with links relating to travel and accommodation and associated matters, including car rental and air travel. The complainant was the owner of many registered trademarks consisting of, or including, the term 'Ipiranga', including several trademarks significantly predating the registration of the domain name.

Ipiranga filed a complaint with WIPO requesting the transfer of the domain name. To be successful under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP), a complainant must prove that:

- the domain name is identical, or confusingly similar, to a trademark or service mark in which it 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.

First, Ipiranga contended that the domain name was identical to several trademarks in which it had rights and which it claimed were famous in Brazil.

Second, Ipiranga argued that the respondent was not commonly known by the name Ipiranga and that it had not operated a business by that name. Ipiranga added that, while the name Ipiranga means 'red river' or 'muddy river' in the indigenous language of Brazil and is the name of a small borough of the city of São Paulo, Ipiranga's trademarks and the respondent's use of the domain name had nothing to do with such meanings. In addition, Ipiranga asserted that the domain name was used for pay-per-click references to sites relating to car rental, as well as services such as car maintenance and fuel, which could include Ipiranga's services and could result in purchases triggering the collection of points in Ipiranga's loyalty service. Thus, the respondent attempted to trade on Ipiranga's good name in this field.

Third, Ipiranga alleged that the respondent would have been aware of Ipiranga's trademark when registering the domain name, since IPIRANGA was first registered in 1959 and was notorious in 2003 when the domain name was registered. In addition, Ipiranga submitted that, as the respondent was a large-scale dealer in domain names, it would be expected to make necessary enquiries about the rights of others. Furthermore, Ipiranga contended that the domain name had been registered to generate commercial gain as a result of the likelihood of confusion between the domain name and Ipiranga's trademarks, since Google search results for the term 'Ipiranga' predominantly referred to Ipiranga. Finally, Ipiranga submitted that the domain name had been registered to be offered for sale to Ipiranga or a competitor for a higher price than the cost of registration.

In his defence, the respondent stated that, having failed to obtain the domain name years ago, Ipiranga was now trying to take it from its legitimate owner. The respondent highlighted that 'Ipiranga' was the name of one of the most famous rivers in Brazil and that the domain name had value for that reason. The respondent also referred to the report of the Second WIPO Internet Domain Name Process where WIPO declined to extend protection to geographical names under the UDRP; it pointed out that the domain name was merely used as a 'geodomain', and not in relation to a petroleum distributor, Ipiranga or its competitors. The respondent also raised the fact that Ipiranga had waited eight years after the registration of the domain name to bring a complaint. Finally, it requested the panel to find that Ipiranga was guilty of reverse domain

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name hijacking.

The panel was satisfied that Ipiranga had established the first requirement of the UDRP. In relation to the second requirement, the panel found that Ipiranga had made a *prima facie* case that:

- it had not permitted or licensed the respondent to use the IPIRANGA mark in any way;
- the use of the domain name could not be considered as non-commercial; and
- there was no evidence that the respondent was known by the domain name.

However, the panel did not come to a conclusion on whether the respondent's offering of goods or services was in good faith, as this was closely inter-related with the bad faith of the respondent or absence thereof.

Turning to the third prong of the UDRP, the panel rejected Ipiranga's assertions and thus denied the complaint. To come to that conclusion, the panel based its reasoning on an undisputed fact, namely that 'Ipiranga' is a "geographical place name and a name of cultural and historical significance, well known in Brazil". In view of this, the panel stated that the term 'Ipiranga' might not necessarily, in itself, be protected under the UDRP and that it could only be otherwise if the name Ipiranga was more readily associated with Ipiranga's products than with the geographical place, which the panel unanimously believed not to be the case.

As for the long period of time between the registration of the domain name and the filing of the complaint, the panel considered that, while not decisive, this factual circumstance may be weighed by the panel, since it can at least be said that it allowed "the respondent to believe for seven years that its possession of the disputed domain name was uncontested". As a result, the panel found that Ipiranga had failed to "outweigh on balance the established principle that a geographical name standing alone is difficult to protect under the UDRP unless there are extraordinary circumstances."

Finally, the panel unanimously refused to find attempted reverse domain name hijacking.

This decision illustrates very aptly the fact that:

- the UDRP is not a loose, one-size-fits-all alternative to court proceedings; and
- increasingly, complaints filed under the UDRP will be subject to close scrutiny and considered according to an ever-widening set of principles which are unique to the UDRP and which simply cannot be ignored by complainants and their legal counsel.

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