

Lighting company obtains transfer of domain name under '.lighting' gTLD International - Hogan Lovells International LLP

Cybersquatting

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In a [recent case](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the [World Intellectual Property Organisation](#), a well-known manufacturer of lighting products has obtained the transfer of a domain name identically reproducing its trademark under the new generic top-level domain (gTLD) '.lighting'.

The '.lighting' gTLD is aimed at any individual or business in the lighting industry, including photographers, designers, architects, engineers, gardeners, urban planners, make-up artists, theatre set developers, and manufacturers and distributors of lighting systems, although there are no specific eligibility requirements. It was delegated in November 2013 and became open for general registration on February 12 2014, following a sunrise period for trademark holders.

In the case at hand, the complainant was [Louis Poulsen Lighting A/S](#), a company based in Denmark, which has been manufacturing and distributing professional and private lighting products throughout the world for over 70 years. It owned a number of trademark registrations for LOUIS POULSEN, including Community trademark (CTM) registrations, and also the domain name 'louispoulsen.com'.

The respondent was UK company [Spear Lighting](#). No further details were known about the respondent, although it appeared to be operating in the lighting industry.

The disputed domain name was 'louispoulsen.lighting', which was registered on February 12 2014 by the respondent. It was being used to resolve to a website displaying pay-per-click (PPC) advertisements.

The complainant decided to file a UDRP seeking to obtain the transfer of the domain name. The respondent did not respond to the complaint.

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

1. the domain name registered 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.

The first test under the UDRP is two-fold and requires the panel to assess, first, whether a complainant has established trademark rights, regardless of when or where the trademark was registered (although these factors may be relevant for the purpose of the third limb of the UDRP) and, second, whether the domain name is identical or confusingly similar to the complainant's trademark.

In the case at hand, the panel found that that the complainant had established trademark rights in the LOUIS POULSEN trademark based on the complainant's CTM registration.

The panel noted that the domain name was identical to the complainant's LOUIS POULSEN mark, except for the addition of the gTLD '.lighting'. However, it noted that the '.lighting' gTLD increased the likelihood of confusion with the complainant's trademark. Thus, the panel found that the domain name was identical to the complainant's trademark in accordance with Paragraph 4(a)(i) of the UDRP.

Turning to the second requirement under the UDRP, a complainant must establish that a respondent does not have any 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:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name was in connection with a good-faith offering of goods or services;
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark rights; or

(iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the trade mark at issue.

The panel found that the complainant's trademark was well known in many countries throughout the world and, thus, the respondent must have been aware of the complainant's rights, particularly given that the respondent appeared to be involved in the lighting industry. The panel further noted that the respondent was not authorised to use the complainant's trademark. In addition, the panel found that the respondent's use of the domain name in connection with a website displaying PPC advertisements was not a good-faith offering of goods and services.

The panel thus found that the respondent did not have rights or legitimate interests in the domain name and the complainant therefore satisfied Paragraph 4(a)(ii) of the UDRP.

Turning to the third requirement, a complainant must demonstrate that the respondent both 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 be invoked by a respondent to demonstrate that it has rights or legitimate interests in a domain name, as follows:

- (i) 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;
- (ii) 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;
- (iii) the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) 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 was no doubt aware of the complainant's trademark when it registered and used the domain name, particularly as it also appeared to operate in the lighting industry. Thus, the panel found that the domain name was registered and used in bad faith.

The panel thus concluded that the complainant had met Paragraph 4(a)(iii) of the UDRP.

This is a straightforward cybersquatting case concerning a trademark registered under a new gTLD that is precisely descriptive of the goods or services covered by the trademark, namely lighting. The decision highlights the impact that the eventual introduction of almost 1,400 new gTLDs will have for brand owners across the globe and how the UDRP is still a fast, efficient and cost-effective tool to protect brands in the increasingly expanding domain name space.

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