

# World Trademark Review Daily

UDRP complainants only required to demonstrate rights, not necessarily prior rights **Cybersquatting**  
International - Hogan Lovells International LLP

November 30 2012

Mariline Fiori, professionally known as Garance Doré, has recuperated the domain name 'garancedore.com' in a successful case filed under the [Uniform Domain Name Dispute Resolution Policy \(UDRP\)](#), which was decided by a panel from the [World Intellectual Property Organisation \(WIPO\)](#). Doré is a well-known French fashion blogger, photographer and illustrator. Her blog can be found at '[www.garancedore.fr](http://www.garancedore.fr)'.

To be successful in a complaint under the UDRP, a complainant must evidence that:

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

As far as the first limb is concerned, it should be noted that this clearly refers only to trademarks and does not extend to personal names in general. [The Internet Corporation for Assigned Names and Numbers \(ICANN\)](#) based the UDRP on the [Report on the First WIPO Internet Domain Name Process](#) in 1999, which contained recommendations for resolving domain name disputes and had concluded that it was premature to extend the notion of abusive registration beyond the violation of trademarks and service marks. The [Report on the Second WIPO Internet Domain Name Process](#) in 2001 did not alter this position, based on the fact that the international legal framework is not as well developed for personal names as it is for trademarks. There are currently no internationally harmonised norms covering personality rights as such and, consequently, a range of legal approaches are deployed to protect personal names at the national level. The report therefore recommended that no modification be made to the UDRP.

Thus, complainants who wish to recover their personal name but do not have a registered trademark matching it generally face difficulties, unless they can prove that they have acquired unregistered trademark rights in their name. Unregistered trademarks are sometimes referred to as common law trademarks.

In addition, the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition \(WIPO Overview 2.0\)](#) makes clear that merely having a famous name is not necessarily sufficient to demonstrate unregistered trademark rights (Paragraph 1.6). The name itself should actually be used in trade or commerce and must have acquired a secondary meaning so that it is associated with particular goods or services. In *Israel Harold Asper v Communication X Inc* (WIPO Case D2001-0540), relating to businessman Izzy Asper, the panel refused to find that any such secondary meaning had been acquired and commented as follows:

*"There are two dominant concerns inducing the protection of marks. The first is the protection of consumers who associate the name with goods and services of a known source and quality. The second is to preserve the value of goodwill built up over time by the owner of the mark. In the case of those (primarily entertainers and professional athletes) who sell their goodwill to others in the marketing of goods and services not directly associated with the holder, the first rationale, above, is likely to be dominant. This is much less likely to be the case with other personal name marks, particularly those which have not obtained a secondary meaning. It is the view of this panel that the name of the complainant falls within the latter category."*

However, in the case at hand, the complainant had applied for the US trademark GARANCE DORÉ (No 4,124,451) on April 12 2011 and it was registered on April 10 2012 in connection with services in Classes 38 and 41. Thus, there was no need for Doré to prove her unregistered rights and demonstrate that her name had become undeniably associated with fashion blogging services.

The domain name itself was registered on June 1 2007, almost five years before the GARANCE DORÉ trademark, but for the purposes of the first limb, a complainant is only required to demonstrate rights, not necessarily prior rights (although in cases where the domain name at issue pre-dates the trademark by a significant period of time, as is the case here, it is often more difficult to prove bad faith). In this case, the panel found that the domain name incorporated the complainant's GARANCE DORÉ mark by merely omitting the acute accent above the final letter 'e' and was therefore confusingly similar to such mark, it being clear that the omission of an accent did not significantly affect the overall impression of the GARANCE DORÉ mark and did not have any bearing as regards the question of confusing similarity.

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Turning to the second limb, the panel found that the registrant's use of the domain name was not in good faith, as it was simply using it to point towards a website containing sponsored links related to fashion. The registrant (Private Registrations Aktien Gesellschaft) did not reply to the complaint and thus did not do anything to deny this.

As for the third limb, the panel was satisfied that the registrant had registered the domain name in June 2007 with full knowledge of the complainant, despite Doré's later trademark registration. This was because the name Garance Doré was highly distinctive and used by the complainant on the internet for a year prior to the registration of the domain name ('garancedore.fr' was actually registered by Mariline Fiori on December 5 2006, although the blog itself began in June 2006). In the panel's opinion, it was therefore inconceivable that the registrant had registered the domain name without knowledge of the complainant. The panel commented:

*"The fact that the complainant's registered and unregistered rights in GARANCE DORÉ might have been established only after the registration of the disputed domain name does not per se hinder a finding of bad-faith registration. It is well established that, in certain situations, when the respondent is clearly aware of the complainant, and it is clear that the aim of the registration was to take advantage of the confusion between the domain name and any potential complainant rights, bad faith can be found."*

Interestingly, this underlines the fact that complainants with trademark rights that postdate the domain name in question do not have to prove that they had unregistered rights at the time that the domain name was registered (which appears to be a common misconception), but merely that the registrant was aware of the complainant and intended to profit from the complainant's existing reputation at the time the domain name was registered.

As for bad-faith use, the panel found that, by incorporating the GARANCE DORÉ mark in the domain name and by pointing it towards a parking website providing links to third parties, the registrant was, in all likelihood, trying to divert traffic intended for the complainant's website, and that the use and exploitation of trademarks to obtain click-through revenues from the diversion of internet users has, in many UDRP decisions, been found to be use in bad faith under Paragraph 4(b)(iv) of the UDRP.

As a result, the panel ordered the transfer of the domain name 'garancedore.com' to Doré, to the relief of fashionistas across the globe.

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