

# World Trademark Review Daily

## Addition of generic word to mark does not reduce confusing similarity of domain name **Cybersquatting**

**International - Hogan Lovells International LLP**

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In a decision issued by the [World Intellectual Property Organisation \(WIPO\)](#) under the [Uniform Domain Name Dispute Resolution Policy \(UDRP\)](#), Italian company [Barilla G e R Fratelli SpA](#), one of the leading companies in the pasta market, was granted the transfer of the domain name 'barillaalimentare.com'. The domain name was registered on April 21 2008 by a Canadian company, Sahand Consulting Inc.

The complainant had been established since 1877 and had for many years manufactured and sold different sorts of pasta products. The complainant stated that it had not given the respondent any authority to reflect its trademarks in the domain name at issue.

The respondent was engaged in registering companies and domain names. The domain name 'barillaalimentare.com' was being used to redirect to web pages which featured sponsored links to various websites. An indication at the top of the home page stated that the domain name was for sale and there was a link to a web page where it was possible to contact the respondent.

The complainant's agent enquired about the sale of the domain name. The respondent replied: "If the price is right, we are interested in selling our domain names". The complainant then sent a cease and desist letter to the respondent but received no reply.

On December 13 2012 the complainant filed a UDRP complaint with WIPO. To be successful in a complaint under the UDRP, a complainant must prove all of the following:

- 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.

With regard to the first limb of the test, the complainant submitted that it owned numerous BARILLA marks registered in Canada and elsewhere, and various international trademarks. The complainant's first Canadian trademark was registered in 1970 and its first international trademark was registered in 1965. The complainant also owned Canadian trademark registrations for BARILLA PICCOLLINI and ACADEMIA BURILLA. It submitted that the addition of the generic word '*alimentare*' did not render the domain name distinctive. The complainant further maintained that its trademarks were highly distinctive for pasta and pasta sauces worldwide, and that the respondent was unlawfully benefiting from the complainant's reputation in the trademarks.

The respondent asserted that it was approached by a Mr and Mrs Nourbakhsh to register the domain name in 2008. According to the respondent, Mr and Mrs Nourbakhsh had operated a café in Vancouver called 'Bambo' for 14 years. The respondent defended Mr and Mrs Nourbakhsh by stating that they had consulted an Italian friend who suggested that they converted their café business which was losing revenue to an Italian restaurant. It further claimed that Barilla was a surname often encountered in North America. The respondent also asserted that Mr and Mrs Nourbakhsh picked the name Barilla because of its similarity to the word 'brilliant'. The friend apparently also recommended the addition of the word '*alimentare*', which means food in Italian. The respondent said that it had conducted a Canadian trademark search and found no registration for 'barillaalimentare', and thus registered the domain name.

The panel held that the domain name was confusingly similar to the complainant's registered trademarks and that the addition of a generic word in Italian, '*alimentare*', referring to food, did not detract from the confusing similarity and rather strengthened the confusing similarity of the domain name to a trademark which related to food products.

With regard to the second limb of the three-prong test, the complainant contended that the respondent had not provided evidence of any right to use the domain name. The complainant further asserted that its trademarks were highly distinctive for pasta and pasta sauces worldwide and that the respondent was unlawfully benefiting from the complainant's reputation.

The respondent asserted that Mr and Mrs Nourbakhsh did not operate a restaurant at the present time, but stated that the idea of an Italian restaurant was still alive. Furthermore, the respondent claimed that Mr and Mrs Nourbakhsh were not in the pasta-marketing business but were making a *bona fide* offering of goods

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and services. Furthermore, the respondent claimed that Mr and Mrs Nourbakhsh were not infringing the complainant's trademarks.

The panel noted that the complainant had not given the respondent any rights to reflect its trademarks in a domain name. The panel determined that, if the respondent's story were to have any credibility, then Mr and Mrs Nourbakhsh should have made some statement themselves, preferably by a statutory declaration or affidavit. In particular, the panel ruled that, bearing in mind that the onus of proving that the respondent had rights or legitimate interests in the domain name was on the respondent, the evidence offered was "quite underwhelming". The panel pointed out that the domain name did not resolve to a veritable restaurant business, but was merely parked and pointing to a 'click through' website which had links to products of the complainant's competitors. Therefore, it could not be said that the use of the domain name was a *bona fide* offering of goods or services. In this respect, the panel referred to Paragraph 2.6 of the [WIPO Overview](#), which concerns whether parking and landing pages or pay-per-click links generate rights or legitimate interests in a disputed domain name. This provides as follows:

*"Panels have generally recognised that use of a domain name to post parking and landing pages or PPC links may be permissible in some circumstances, but would not of itself confer rights or legitimate interests arising from a 'bona fide offering of goods or services' or from 'legitimate non-commercial or fair use' of the domain name, especially where resulting in a connection to goods or services competitive with those of the rights holder. As an example of such permissible use, where domain names consisting of dictionary or common words or phrases support posted PPC links genuinely related to the generic meaning of the domain name at issue, this may be permissible and indeed consistent with recognised sources of rights or legitimate interests under the UDRP, provided there is no capitalisation on trademark value (a result that PPC page operators can achieve by suppressing PPC advertising related to the trademark value of the word or phrase). By contrast, where such links are based on trademark value, UDRP panels have tended to consider such practices generally as unfair use resulting in misleading diversion."*

Finally, regarding registration and use in bad faith, the complainant argued that the respondent must have known of the complainant's trademark at the time of registration, referred to the offer to sell the domain name on the website to which the domain name was pointing and claimed that the links to sponsored websites showed that the respondent was earning 'click through' commissions and therefore was using the domain name for commercial gain. It further stated that there was a likelihood of confusion for internet users who could have thought that the respondent's website had some connection with or endorsement from the complainant. Finally, the respondent's failure to respond to the complainant's cease and desist letter and the fact that the respondent had registered numerous domain names for an illegitimate purpose were further evidence of bad faith according to the complainant.

The respondent, however, insisted on the fact that the domain name was not registered in bad faith, but with the intent of opening an Italian restaurant in the future. Moreover, the respondent argued that it did not list the domain name with any agents for the purpose of sale at a profit, and that Mr and Mrs Nourbakhsh did not wish the domain name to be sold. If anyone was interested in purchasing one of the domain names controlled by the respondent, the respondent would advise its client of this.

The panel determined that the domain name was registered and used in bad faith on the basis of the following factors:

- The respondent's version of events gave rise to considerable scepticism. If Mr and Mrs Nourbakhsh had genuinely wanted to set up an Italian restaurant, it is hard to think why they would select the name of a globally-famous brand of pasta and pasta sauce which are essential items on the menu of any Italian restaurant. Moreover, most Italians would know of the BARILLA brand even if Mr and Mrs Nourbakhsh did not.
- Any proper search of the Canadian trademark register would have shown the complainant's registrations for BARILLA. Anyone with elementary knowledge of trademark law would have known that the mere addition to a trademark of a generic word (particularly one which is complementary to the trademark) does not reduce the confusing similarity of a domain name.
- The approach of the complainant's agent to the respondent displayed the respondent's willingness to sell the domain name, which rather detracted from the respondent's subsequent statement about the domain name not being for sale.
- The website at the domain name included links to competitors of the complainant and their products.

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This was conduct creating likely confusion for internet users that there was some connection between the domain name and the complainant, or some endorsement from the complainant of the respondent.

- The respondent had failed to reply to the complainant's cease and desist communications.
- The respondent should have known of the complainant's trademarks at the time of registration of the domain name as a result of the fame of the complainant's brands and the complainant's worldwide marketing and advertising campaigns.

The request to transfer the domain name to the complainant was thus granted.

For the respondent to succeed, it is clear that the panel would have required much more concrete evidence concerning the respondent's reasons for registering the domain name and its assertions that a Mr and Mrs Nourbakhsh wanted to set up a genuine business using the domain name which did not trade on the complainant's goodwill. A simple internet search shows that there is indeed a café called 'Bambo' in Vancouver operated by the Nourbakhsh family, but this is not something that a panel would be expected to do. In this regard, Paragraph 4.5 of the WIPO Overview, relating to whether a panel may perform independent research, reads as follows:

*"A panel may undertake limited factual research into matters of public record if it deems this necessary to reach the right decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent and the use of the domain name, consulting a repository such as the Internet Archive (at 'www.archive.org') in order to obtain an indication of how a domain name may have been used in the relevant past, reviewing dictionaries or encyclopaedias to determine any common meaning, or discretionary referencing of trademark online databases."*

Thus, it is unlikely that panels will undertake much independent research, if any at all, and parties should never simply rely on this, but should instead supply all the evidence that they wish a panel to examine in clear and simple form. Moreover, in this particular case, the panel would have wanted to see concrete evidence that demonstrable preparations to genuinely use the domain name had been made before the respondent had notice of the dispute (as per paragraph 4(c)(i) of the UDRP), such as business plans and receipts, rather than simply vague assertions which are never sufficient.

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