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UDRP decision shows that brand owners may prevent use of marks for alleged fan **Cybersquatting sites**

International - Hogan Lovells LLP

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In a recent domain name dispute under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the [World Intellectual Property Organisation](#) (WIPO), the Centre Vinicole Champagne Nicolas Feuillatte, a French union of champagne producers, has [obtained the transfer](#) of a domain name incorporating its trademark that was used for a purported fan site by the registrant.

The complainant was founded in 1972 and is based in Chouilly, France. The complainant comprises 82 winemaking cooperatives that represent 5,000 vineyards, and is the registered owner of various French, Community and international trademark registrations for NICOLAS FEUILLATTE for goods and services used in connection with wines and spirits, including champagne. The earliest of the complainant's trademarks dates back to 1976. The complainant further held that its NICOLAS FEUILLATTE trademark enjoyed considerable renown and goodwill throughout the world, including in the United Arab Emirates, the country of residence of the respondent.

The respondent was Collector Consulting FZ, based in Dubai, United Arab Emirates. No other details were known about the respondent.

The disputed domain name was 'champagne-nicolas-feuillatte.com'. It was registered by the respondent on August 5 2011 and was used to resolve to a fan site or blog about Nicolas Feuillatte champagne, which displayed images of the complainant's products. In addition, the website associated with the domain name displayed a similar layout and colour scheme to the complainant's official website.

The complainant sent the respondent two cease and desist letters which did not result in the transfer of the domain name, and so the complainant decided to file a complaint under the UDRP.

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

- 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.

The first limb of the three-prong test under the UDRP is a low-threshold, standing requirement, which is generally satisfied by providing evidence of 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 test.

The complainant argued that the domain name was confusingly similar to its NICOLAS FEUILLATTE trademark, given that it was incorporated in its entirety in the domain name with the mere addition of the term 'champagne', which is descriptive of the goods and services for which the trademark is registered. The respondent did not deny that the domain name was identical, or confusingly similar, to the complainant's mark, and so the panel found that the complainant had met the first requirement under the UDRP.

Turning to the second limb of the three-prong test, the complainant argued that the respondent's use of the domain name for an alleged fan site did not constitute a good-faith offering of goods or services that would give rise to a right or legitimate interest in the domain name. In this regard, the complainant argued that the fact that the website lacked a personal contribution from the respondent and that it was inactive for a considerable amount of time were strong indications that the respondent had created the website for other purposes.

In turn, the respondent claimed that its use of the domain name for a fan site dedicated to the complainant's products was a legitimate non-commercial and fair use of the domain name. It argued that it provided positive comments on the Nicolas Feuillatte product and that the website associated with the domain name included a disclaimer to avoid confusion with the complainant's official website.

There are two views amongst WIPO panellists when it comes to fan sites, as provided in the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition](#) (WIPO Overview 2.0). According to the first view, a fan site may generate rights or a legitimate interest in a domain name as long as the website is actively used, clearly distinguishes itself from any official site and is non-commercial in nature:

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“View 1: The registrant of an active and non-commercial fan site may have rights and legitimate interests in the domain name that includes the complainant’s trademark. The site should be actually in use, clearly distinctive from any official site, and non-commercial in nature. Panels have found that a claimed fan site which includes pay-per-click (PPC) links or automated advertising would not normally be regarded as a legitimate non-commercial site. However, some panels have recognised that a degree of incidental commercial activity may be permissible in certain circumstances (eg, where such activity is of an ancillary or limited nature or bears some relationship to the site’s subject).”

According to the second view, the panel will examine the respondent’s motivation for using the domain name:

“View 2: A respondent does not have rights or legitimate interests in expressing its view, even if positive, on an individual or entity by using an identical or confusingly similar domain name, if the respondent is intentionally misrepresenting itself as being (or as in some way associated with) that individual or entity, or seeks to derive commercial advantage from its registration and use. Also, where the domain name is identical to the trademark, panels have noted that such respondent action prevents the trademark holder from exercising its rights to the trademark and managing its presence on the Internet.”

In the present case, whilst the respondent’s fan site did not seem to be commercial in nature and also displayed a disclaimer, the panel considered that there were numerous indications that strongly suggested that it was a sham. For instance, the website’s layout and content, the lack of a membership base and the fact it was set up after the complainant had sent its first cease and desist letter. In addition, the fact that the website was no longer active was an additional element taken into consideration by the panel. Thus, the panel found that the respondent’s website was not a legitimate non-commercial or fair use of the domain name. The complainant therefore satisfied the second limb of the three-prong test of the UDRP.

Turning to the third limb of the test, a complainant must establish that the domain name was registered and is being used in bad faith. In this regard, awareness or knowledge of the complainant’s trade mark is generally essential for a finding of bad-faith registration and use of a domain name.

The panel noted that the complainant’s NICOLAS FEUILLATTE trademark significantly predated the registration of the domain name by at least 35 years and enjoyed a high degree of goodwill and renown worldwide, including the country of residence of the respondent. The panel thus found that the respondent was aware of the complainant’s trademark and thus registered the domain name to take unfair advantage of the international reputation of the complainant’s trademark and of the well-known appellation of origin ‘champagne’. In addition, the panel found that the respondent was using the domain name to cause “initial interest confusion” among internet users, in order to divert traffic away from the complainant to the respondent’s website. The panel therefore held that the complainant had also satisfied the third limb of the three prong test.

The complainant satisfied all three requirements under the UDRP and thus the panel transferred the domain name to it.

This decision highlights that, whilst the use of a domain name for a non-commercial fan site may generate rights or legitimate interests in the domain name and may constitute a legitimate defence under the UDRP, brand owners may still be able to prevent the use of their trademarks for supposed fan sites in cases where the overall circumstances suggest that the registrant’s motivation for registering and using the domain name was nevertheless to profit from the trademark owners’ rights.

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