

# World Trademark Review Daily

WIPO panel orders transfer of domain name under rules for '.ma'  
International - Hogan Lovells LLP

Cybersquatting

May 07 2014

In a recent domain name dispute brought before the [World Intellectual Property Organisation](#) (WIPO), a panel has [ordered the transfer of 'vente-privée.ma'](#). '.ma' is the country-code top-level domain (ccTLD) of Morocco.

Disputes concerning domain names registered under '.ma' are decided by WIPO in accordance with "[le Règlement sur la Procédure alternative de résolution de litiges du '.ma'](#)", or the rules on the alternative dispute resolution procedure for '.ma'. Although drafted in French, the rules for '.ma' closely follow the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP), which applies to many generic top-level domains, such as '.com', and has also been adopted "as is" by a number of ccTLDs.

However, there are a couple of significant differences between the UDRP and the rules for '.ma'. First, a complainant must have rights protected in Morocco (the UDRP does not specify a particular country) and, second, registration *or* use of the domain name in bad faith is required (as opposed to registration *and* bad faith under the UDRP). Decisions under the rules are not particularly frequent - the 'vente-privée.ma' decision was the only case filed in 2013. Three decisions were made in 2012, and only one in 2011.

In the case in question, the complainant was [Vente-Privee.com](#), based in France (together with Vente-Privee.com IP Sàrl, based in Luxembourg). The complainant extensively used its trademark VENTE PRIVEE in connection with an online website dedicated to 'event sales' of a wide range of well-known brands at discount prices for its members. The complainant was the owner of several international, Community and national registered trademarks for VENTE-PRIVEE.COM and VENTE-PRIVEE, covering countries such as France, Morocco and the United States. The complainant was also the registrant of several domain names consisting of the term '*vente privée*', including 'vente-privée.fr', 'venteprivee.com', 'venteprivee.fr' and 'ventesprivees.fr'.

The respondent was Soldes Privees, a company based in Morocco.

The disputed domain name, 'vente-privée.ma', was registered on June 14 2013. It was pointing to a website offering online sale events at discount prices.

Following an unsuccessful attempt to contact the respondent, the complainant decided to file a complaint before WIPO under the rules for '.ma' to recover the domain name. The respondent did not submit any response to the complaint.

To be successful in a complaint under the rules for '.ma', a complainant must satisfy the following three requirements:

1. The domain name is identical, or confusingly similar, to a trademark in which the complainant has rights protected in Morocco;
2. The respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered or is being used in bad faith.

Similar to the UDRP, the first limb of the three-prong test appears to be a low-threshold, standing requirement, which is generally satisfied by proving trademark rights. Like the UDRP, under the domain name dispute rules for '.ma', it is irrelevant when these rights were acquired and so a complainant does not need to rely on prior rights to be able to meet this first requirement. However, although the rules for '.ma' do not require prior rights, they do require rights to be protected in Morocco.

The complainant's international trademark registration for VENTE-PRIVEE designated Morocco and so the panel found that the complainant had established rights protected in said country. In addition, the panel went a step further and found that the complainant was the holder of a well-known trademark and that Moroccan case law admitted that well-known trademarks were not subjected to the territoriality principle that governs trademark law.

Having determined that the complainant had established trademark rights in Morocco, the panel examined whether the domain name was identical, or confusingly similar, to the trademark. The panel noted that the domain name identically reproduced the verbal components of the complainant's trademark, in addition to the hyphen. The only difference was the suffix '.ma', which, according to the panel, was insufficient to distinguish the domain name from the trademark. The panel therefore determined that the complainant had

# World Trademark Review *Daily*

satisfied the first requirement under the rules.

Turning to the second prong, the panel found that the respondent did not have rights or legitimate interests in the domain name. Paragraph 2(c) of the rules provides a list of non-exhaustive circumstances that may indicate that a respondent has rights or legitimate interests, and these are very similar to the circumstances set out in the UDRP. The panel noted that the complainant had not authorised the respondent to use the trademark. In addition, it noted that the respondent's use of the domain name was neither a good-faith offering of goods or services, nor a non-commercial use of the domain name.

Turning to the third prong, contrary to the UDRP, the '.ma' rules do not require a complainant to demonstrate bad-faith registration *and* use of a domain name, but bad-faith registration *or* use of a domain name, and so the rules are more flexible than the UDRP in this regard.

The panel considered that the respondent both registered and used the domain name in bad faith. With regard to bad-faith registration, the panel found that, in view of the complainant's fame and notoriety, the respondent could not have ignored the complainant's rights at the time of registration. Concerning bad-faith use, the panel found that the respondent was using the domain name intentionally to 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 or sponsorship of the website. This finding was supported by the fact that the complainant's trademark enjoyed considerable notoriety and that the respondent was offering services that were in direct competition with those of the complainant.

Furthermore, the panel found that the respondent's failure to provide accurate information on the Whois database and to submit a response to the complaint were additional elements in support of its bad faith.

Finally, the panel found that, whilst the trademark VENTE-PRIVEE appeared to have been registered with the [Moroccan Intellectual Property Office](#) by a third party to the proceedings (TNC-The Next Clic), it had no jurisdiction to determine the validity of said trademark registration.

The panel therefore decided to transfer the domain name to the complainant.

This decision is interesting in that it highlights the fact that trademark holders should closely monitor their brands in all ccTLDs available, as domain name registrations under these extensions are becoming increasingly popular and there are over 250 of them. Fortunately, many ccTLDs have either adopted the UDRP or a domain name dispute resolution policy that closely follows it, often improving certain of its deficiencies. For example the rules for '.ma' do not impose a conjunctive requirement for bad faith, which is often a difficult hurdle to overcome (although not in this particular case).

The decision is also interesting in that it was delivered amidst some controversy surrounding the validity of the trademark VENTE PRIVEE following two somewhat contradictory decisions from the Paris Court of First Instance. However, although this issue was not raised by the panel, it is a well-established principle that pending proceedings against a trademark on which a complaint is based do not have any impact on domain name dispute resolution proceedings.

*David Taylor and Soraya Camayd, Hogan Lovells LLP, Paris*

---

**World Trademark Review ([www.worldtrademarkreview.com](http://www.worldtrademarkreview.com)) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.**