

World Trademark Review Daily

Mark holders should send cease and desist letters before filing UDRP complaint **Cybersquatting International - Hogan Lovells LLP**

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In a recent case brought under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the [World Intellectual Property Organisation](#) (WIPO), an Israeli cosmetics and skincare company manufacturing products using mineral components extracted from the Dead Sea was [denied the transfer](#) of a domain name incorporating its brand. The domain name was pointing to a website prominently displaying the complainant's trademark together with an indication that the respondent was a certified authorised dealer of the complainant's products.

The complainant was Dead Sea Premier Cosmetics Laboratories Ltd. It was the owner of a US trademark registration for PREMIER BY DEAD SEA PREMIER, filed in 2010 and first used in commerce in 1999. Maysan Jeuness GmbH/Gal Yana, describing itself as one of the complainant's distributors, decided to register the domain name 'mypremierdeadsea.com' in November 2011. The complainant filed a UDRP complaint with WIPO on December 5 2013.

The panel was faced with two procedural issues: the language of the proceedings and the complainant's subsequent request for its complaint to be withdrawn.

The complaint was filed in English. The registrar informed WIPO that the language of the registration agreement for the domain name was German and, as a result, the language of the proceedings should be German, unless otherwise agreed by the parties or as otherwise determined by the panel (Paragraph 11(a) of the UDRP Rules). WIPO therefore sent an email to the parties requesting the complainant to provide at least one of the following:

1. satisfactory evidence of an agreement between the parties to the effect that the proceedings should be in English;
2. submission of the complaint translated into German; or
3. submission of a request for English to be the language of the administrative proceedings.

The complainant submitted a request for English to be the language of the administrative proceedings, while the respondent submitted a request for German to be the language of the proceedings.

The panel decided to accept the complaint in English and the response in German and issued its decision in English. In this respect, it is interesting to note that the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition](#) (WIPO Overview 2.0) states as follows:

"Recognising the practical need which may arise for a preliminary determination of the language of proceeding prior to their appointment, panels have found that, in certain situations, where the respondent can apparently understand the language of the complaint (or, having been given a fair chance to object, has not done so), and the complainant would be unfairly disadvantaged by being forced to translate, the WIPO Centre as a provider may accept the language of the complaint, even if it is different from the language of the registration agreement. Such acceptance is subject to the panel's authority to determine the appropriate language of the proceeding on appointment. Likewise, in appropriate circumstances, a response in a language different from that of the complainant may be accepted."

In this instance, the panel was of the opinion that the respondent understood the English language and thus accepted the complaint in English, despite the fact that the language of the registration agreement for the domain name was German.

With regard to the second procedural issue, the respondent indicated in its response to the complaint that the parties had entered into a distribution agreement. Further to the receipt of this response, the complainant requested that the proceedings be terminated without prejudice, to which the respondent objected.

The complainant informed WIPO that it was unaware of the parties' relationship at the time the complaint was filed and that, as a result, the complaint had to be considered as withdrawn. The complainant then requested to be allowed to file a supplemental filing should the panel decide to nevertheless render a decision in this case.

Paragraph 17(b) of the UDRP Rules provides that:

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"if, before the panel's decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the panel shall terminate the administrative proceeding, unless a party raises justifiable grounds for objection within a period of time to be determined by the panel."

The panel denied the complainant's request to obtain the withdrawal of the complaint because the respondent did raise justifiable grounds for objection.

The panel noted that it was required to ensure that the parties were treated with equality, in accordance with Paragraph 10(b) of the UDRP Rules. In this instance, according to the panel, allowing the complainant to withdraw its complaint without prejudice, after the respondent had invested significant time and money defending its position, would have been unfair to the respondent, as nothing would prevent the complainant from reinitiating the proceedings at any time in the future.

The panel decided not to grant the complainant a right to file a supplemental filing either, based upon the fact that the exceptional circumstances that had led to a request to terminate the proceedings had already been clarified by the complainant.

Having decided the two procedural issues of the case, the panel turned to the merits of it.

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

1. The domain name 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.

With regard to the first element, the complainant relied on its US trademark registration for PREMIER BY DEAD SEA PREMIER, and the panel did not question this.

Turning to the second two elements, the complainant provided an affidavit signed by its chief operating officer, which asserted that:

"[...] 3. The registrant of the disputed domain name is not authorised by Dead Sea Premier to register or use the disputed domain name or to offer for sale any of Dead See (sic) Premier's products; 4. Photographs of Dead See (sic) Premier products on the website using the disputed domain name are owned by Dead See (sic) Premier and are used without permission; [...]. I declare that the foregoing is true and correct."

However, given the complainant's admission that the parties had entered into a distributorship agreement, the panel found no reason why the respondent lacked rights or legitimate interests and registered and used the disputed domain name in bad faith. The panel therefore found in favour of the respondent.

This case is an obvious example of the need to fully prepare complaints, including checking whether the respondent has any commercial relationship with the complainant, but also of the need for trademark holders to send cease and desist letters to registrants of domain names using their trademarks. Had the complainant sent a cease and desist letter to the respondent in this particular case, the respondent would no doubt have simply replied to such letter by stating that it was a distributor of the complainant's products and the complainant would have therefore saved the costs of filing a UDRP complaint.

Despite the complainant's failure to send a cease and desist letter and/or to fully check the list of its distributors, it is interesting to note that the panel decided to deny the complaint on the sole basis of the existing commercial relationship between the parties, without any reference to the terms of the existing distribution agreement between them. Indeed, being a distributor does not give absolute rights to use a manufacturer's trademarks. For example, the agreement between the parties could (and perhaps should) have included provisions indicating that the respondent had no right to register domain names including the complainant's trademark.

In addition, UDRP case law contains examples of cases where registration by a distributor of a domain name including a manufacturer's trademark was considered illegitimate. The key UDRP precedent is the *Oki Data* case, which sets down general guidelines for dealing with distributors and resellers in relation to when their use of a domain name is legitimate. However, the panel in the present case did not go through such guidelines and simply concluded that, if the respondent was a distributor of the complainant, then

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there was no reason why the respondent lacked rights or legitimate interests and registered and used the disputed domain name in bad faith.

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