

World Trademark Review Daily

**Cartier recovers domain names under '.mx' policy
Mexico - Hogan Lovells LLP**

Cybersquatting

June 05 2014

In two recent separate domain name dispute proceedings brought before the [World Intellectual Property Organisation](#) (WIPO), French jeweller [Cartier International AG](#) has obtained the transfer of two domain names under the extension '.mx', the country-code top-level domain (ccTLD) for Mexico. Both domain names identically reproduced the well-known CARTIER trademark.

'.mx' domain name disputes are administered by WIPO and are regulated by the "[Política de solución de controversias en materia de nombres de dominio para '.mx'](#)" or the Dispute Resolution Policy on '.mx' Domain Names, a variation of 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.

The main differences between the UDRP and the '.mx' policy are, first, that the '.mx' policy is much broader than the UDRP as it allows a complainant to rely not just on trademark rights but also on other rights such as appellations of origin, registered commercial slogans or licences. It should be noted, however, that, like the UDRP, the '.mx' policy does not require prior rights or rights protected in Mexico. A second difference is that, unlike the UDRP, the '.mx' policy does not require a complainant to demonstrate that the domain name was both registered and used in bad faith; rather, either registration *or* use of the domain name is sufficient to demonstrate bad faith and so the '.mx' policy is more flexible than the UDRP in this regard.

In the two cases in question, the complainant was Cartier, the well-known French jeweller founded in 1847. The complainant was the owner of several Mexican, US and international trademark registrations for CARTIER, which have been extensively used in connection with a wide range of products, including jewellery, watches and other accessories. The complainant also operates its online store at 'www.cartier.com'.

The disputed domain names were 'cartier.mx', registered on February 14 2013 by Jesús Navarro Saracibar, an individual based in Mexico City, and 'cartier.com.mx', registered on September 23 2008 by HMC, based in California.

The domain names were used to point to pages displaying commercial links that redirected users to third-party websites offering counterfeit products of the complainant or products that were in direct competition with those of the complainant.

The complainant filed two separate complaints (presumably the registrants were unrelated to each other) to recover the domain names and the same panel was appointed to resolve both disputes.

To be successful in a complaint under the '.mx' policy, a complainant must satisfy the following three requirements:

1. The domain name is identical, or confusingly similar, to a registered trademark or service mark, registered commercial slogan, appellation of origin or licence in which the complainant has rights;
2. The registrant has no rights or legitimate interests in the domain name; and
3. The domain name has been registered or is being used in bad faith.

As in 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 '.mx' policy it is irrelevant where or when these rights were acquired, although these factors may be relevant for bad-faith registration and use of the domain name. In view of the complainant's Mexican, US and international trademark registrations for CARTIER, the panel found that the complainant had established relevant trademark rights.

As part of this first hurdle, the panel is also required to examine whether the domain names are identical or confusingly similar to the complainant's trademarks. The panel noted that the domain names identically reproduced the complainant's CARTIER mark and that the suffix ('.mx' or '.com.mx') was insufficient to distinguish the domain names from the complainant's trademark.

The panel therefore found that the complainant had satisfied the first requirement, in accordance with Paragraph 1(a)(i) of the '.mx' policy.

Moving on to the second requirement, the panel examined whether the respondents had rights or legitimate

World Trademark Review *Daily*

interests in the domain names. Paragraph 1(c) of the '.mx' policy provides a list of non-exhaustive circumstances that may indicate that a respondent has rights or legitimate interests, which are very similar to the circumstances set out in the UDRP. In this regard, the panel noted that the complainant had not authorised the respondents to use the complainant's CARTIER mark. In addition, the panel noted that the respondents' use of the domain names to point to a website displaying commercial links and which led internet users to third-party websites offering counterfeit products or products that were in direct competition with the complainant was neither a good-faith offering of goods or services, nor a non-commercial or fair use of the domain names.

Thus, the panel found that the complainant had made a *prima facie* showing of the respondents' lack of rights or legitimate interests in the domain names and that the respondent had failed to rebut such showing as a result of their failure to respond. The panel found that the complainant had therefore met the second requirement, in accordance with Paragraph 1(a)(ii) of the '.mx' policy.

Turning to the third requirement, contrary to the UDRP, the '.mx' policy does not require a complainant to demonstrate both bad-faith registration *and* use of a domain name. Notwithstanding, the panel was of the view that, in the two cases at hand, the respondents had both registered and used the domain names in bad faith.

The panel found that the complainant had established that its CARTIER mark was registered long before the registration of the domain names and had been used extensively since then throughout the world, including in Mexico. In addition, the panel held that the websites to which the domain names were pointing displayed commercial links that made direct reference to the complainant's CARTIER products and competing products. The panel thus found that the respondents were aware of the existence of the complainant's trademark at the time of registration of the domain names and thus registered the domain names in bad faith. In addition, the panel found that the content of the websites supported a finding that the domain names were being used to attract internet users for commercial gain, by creating a likelihood of confusion with the complainant's trademark as to the source, sponsorship or affiliation of the websites and the products and services offered therein.

The panel therefore found that the complainant had met the third requirement in accordance with Paragraph 1(a)(iii) of the '.mx' policy.

The panel thus decided to transfer the domain names to the complainant.

These decisions highlight the fact that trademark holders should closely monitor their brands in all ccTLDs as domain name registrations under such extensions are becoming increasingly popular, and there are over 250 of them. Although trademark holders might be reluctant to attempt to recover domain names registered in foreign jurisdictions (given the costs and risks involved in bringing a court action), fortunately many ccTLDs have adopted either the UDRP or a variation thereof, providing trademark holders with an efficient, fast and less expensive alternative to court proceedings to recover infringing domain names.

The decisions (in Spanish) are available [here](#) and [here](#).

David Taylor and Soraya Camayd, Hogan Lovells LLP, Paris

World Trademark Review (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.