

World Trademark Review Daily

Registration and trade in domain names containing generic words may be legitimate

Cybersquatting

International - Hogan Lovells International LLP

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In a recent case filed under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP), a single-member panel has [confirmed](#) that the registration of generic domain names may be legitimate even if the generic term included in the domain name is registered as a trademark.

The complainant was Sport 2000 Brand AG, an affiliate of the [Sport 2000 Group](#), a retailer of sporting goods based in Germany. The respondent was sport2000, an entity based in the United States. The disputed domain name, 'sport2000.com', was registered in 1998. It pointed to a parking website including sponsored links to many suppliers, including competitors of the complainant's.

On December 13 2012, Sport 2000 Brand filed a UDRP complaint with [WIPO](#). To be successful in a complaint under the UDRP, a complainant must show 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 UDRP, the complainant submitted that it was the owner of many trademarks including the words 'Sport 2000', which it had used since 1988. It also stated that it had more than 3,500 retail outlets in 25 countries.

According to the respondent, at the time of the registration of the domain name, the complainant had no word trademarks including the two generic terms 'sport' and '2000'. The respondent also pointed out that, at the time of registration of the domain name, it could not have been aware of the complainant or its trademarks. Finally, the respondent raised the defence of laches, as the domain name was registered more than 10 years prior to the filing of the complaint; the complainant must have known of the respondent's registration from at least 1999, when the complainant registered the domain name 'sport2000international.com'.

In addressing the first limb of the policy, the panel noted that the domain name contained the word elements of the complainant's trademark in its entirety. However, each of the trademark registrations which the complainant had provided as evidence for the textual elements 'sport' and '2000' were in the context of design trademarks and, as such, there was some question as to whether the complainant had acquired trademark rights in the combination 'sport 2000'. The only clear evidence that the complainant offered of acquired rights in the term 'sport 2000' was the use of this term in a number of domain name registrations alongside its use in its day-to-day business operations whereby the word combination 'sport 2000' was often used without the design elements of the trademark. Based on this, the panel found that the domain name was identical or confusingly similar to the complainant's trademark.

Turning to the second limb of the policy, the panel pointed out that, under the UDRP, the complainant was required to make out a *prima facie* case showing that the respondent lacked rights or legitimate interests. The panel noted that, in cases such as this, where the complainant's trademark consisted of generic terms that were so clearly associated with the goods and services which they describe, it is vital that the *prima facie* case is made.

However, in the view of the panel, the complainant's submissions failed to establish such a case. The complainant claimed that, due to the similarity between the domain name and the complainant's trademark, the respondent was deceiving consumers and redirecting them to a parking website containing sponsored links. The complainant also submitted that the respondent had engaged in a pattern of bad-faith domain name registrations which also showed its lack of rights or legitimate interests.

The respondent rebutted the complainant's arguments and stated that the use of a domain name comprised of generic terms to redirect to pay-per-click advertising that related to the dictionary meaning of such terms could establish rights or legitimate interests. Furthermore, the respondent claimed that, at the time of registration of the domain name, it was not aware of the complainant or its trademarks.

The panel considered that the domain name consisted of a common and widely used dictionary word term and of a numerical figure. The panel stated that the registration and trade in domain names containing

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generic words could constitute a legitimate use of them and relied, in this respect, on the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition](#) (WIPO Overview 2.0), Paragraph 2.6, which states 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."

In this case, the website at the domain name included advertising links related to the dictionary meaning of the term 'sport'. The panel found that the respondent's use of the domain name was sufficiently related to the descriptive meaning of terms included in the domain name that this could give rise to a right or legitimate interest in the domain name. In the panel's opinion, the length of time for which the domain name had been registered was a relevant factor in this particular case.

The panel also pointed out that the complainant had failed to provide sufficient evidence to rebut the respondent's claim that it was not aware of the complainant or its trademark. In addition, the panel found that the complainant's argument relating to the respondent's pattern of bad-faith domain name registration involving domain names that are similar to well-known trademarks was not relevant to the issue of whether the respondent had rights in the domain name.

As such, the panel found that the complainant had failed to establish that the respondent had no rights or legitimate interests in the domain name. The second requirement of the UDRP was not met.

In light of this, the panel did not need to decide whether the complainant had successfully shown that the domain name was registered and was being used in bad faith, and transfer was denied.

This decision shows that, in difficult cases such as this one, where the domain name consists of generic terms, complainants must draft their complaints with the utmost care. Complainants should pay great attention to the evidence brought in relation to the second limb of the UDRP as part of their burden of establishing the respondent's lack of right or legitimate interest.

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