

UDRP panel: UDRP is not universal remedy for online trademark abuse International - Hogan Lovells LLP

Cybersquatting

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In two recent cases filed under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before the [World Intellectual Property Organisation](#) (WIPO) (*Plein v Webb* (Case No D2014-0778) and *Plein v Deruyter* (Case No D2014-0779)), a single-member panel has denied the transfer of the domain names 'peopleincasinos.com' and 'supportpeopleinneed.org' on the rather unusual grounds that they were not confusingly similar to the complainant's trademark PLEIN, even though they both incorporated this trademark in its entirety.

The complainant in both cases was Philipp Plein, a German fashion designer heading up a Swiss company of the same name, founded in Switzerland in 1998. The complainant was the registered owner of a number of US, international and Community trademark registrations for PLEIN and PHILIPP PLEIN.

The respondents were Kimberly Webb (United States) and Randall Deruyter (United States), both of whom wrote to WIPO upon receipt of the hard copy of the complaint explaining that their name and home address details had been falsely used without their permission and that they had had nothing to do with the domain name registrations.

The domain names were registered on March 11 and 12 2014. They were both pointing to online stores selling Philipp Plein clothing, which was alleged by the complainant to be counterfeit. The websites in question made prominent use of the PHILLIP PLEIN and PLEIN trademarks and also included such trademarks in their meta data.

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

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.

Considering the first limb, the panel observed that this was not a typical case where a domain name included a trademark in its entirety together with a descriptive prefix or suffix, negative term or another trademark. Instead, the domain names in question consisted of a meaningful phrase in which the trademark (consisting of the last three letters of 'people' and the word 'in') was hidden.

In view of this, the panel turned to [Paragraph 1.2](#) of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (WIPO Overview 2.0) for guidance. This states as follows:

"The first element of the UDRP serves essentially as a standing requirement. The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognisable as such within the domain name, with the addition of common, dictionary, descriptive or negative terms [...] typically being regarded as insufficient to prevent threshold Internet user confusion. Application of the confusing similarity test under the UDRP would typically involve a straightforward visual or aural comparison of the trademark with the alphanumeric string in the domain name. While each case must be judged on its own merits, circumstances in which a trademark may not be recognisable as such within a domain name may include where the relied-upon mark corresponds to a common term or phrase, itself contained or subsumed within another common term or phrase in the domain name (eg, trademark HEAT within domain name 'theatre.com')."

In the cases at issue, a straightforward visual or aural comparison of the trademark with the domain name did not result in confusing similarity. The panel pointed out that, visually, the eye immediately discerned the English phrase and not the trademark, and that aurally the trademark could not be heard at all when the phrase was pronounced. Under normal circumstances, this alone would have been enough to lead to a denial, but what was unusual about this case was the fact that the trademark contained within a common phrase was clearly no mere coincidence because of the infringing content of the corresponding website.

In this regard, the complainant argued that the trademark had been deliberately embedded within the domain names not to deceive internet users either visually or aurally, but to lead them to the relevant websites via their search engines. In the complainant's opinion, the inclusion of the trademark PLEIN in the domain names increased the likelihood that internet users would arrive at the websites when searching for the complainant's products.

However, the panel was of the opinion that, whilst this was something that could well be logically inferred, in fact the complainant had offered no concrete evidence, merely a simple assertion. In the panel's view, it was not self-evident that inclusion of a search term (here the PLEIN mark) in a domain name would have more than a trivial effect on search results where that search term also appeared a large number of times in the website content and meta data.

The panel also thought that trademark confusion in the domain name context required internet users to be confused. However, users may simply discard results when they do not see the trademark in the domain name. Furthermore, if a user sees a domain name in a search result and does not recognise the trademark within it, but then continues to the website anyway, can that user really be said to have been confused? In short, the panel thought that it was by no means obvious that an improvement in search engine rankings would inevitably lead to domain name confusion.

Having said this, the panel went on to consider whether the two main facts were sufficient by themselves to satisfy the confusing similarity test, namely:

- the trademark PLEIN being incorporated into the domain names in its entirety; and
- the corresponding websites clearly targeting the PLEIN trademark.

Even though the confusing similarity test was generally seen as a low-threshold test, the purpose of which was simply to assess whether complainants had enough legal rights to give them standing to bring a complaint, the panel concluded that these two facts were not enough, even though they were strong indicators of confusing similarity. In the panel's opinion, ultimately an element of confusion was necessary, whether visual, aural, conceptual or technological. Here the complainant had alleged technological confusion but simply failed to demonstrate it.

Furthermore, the panel did not ultimately appear to be convinced that technological confusion would be sufficient anyway, even if it was proved. If this were the case, then a consequence of the complainant's argument would be that any trademark appearing in a domain name would satisfy the confusing similarity test on the basis that it would be recognised within the domain name by search engines. So, to take the example given in the WIPO Overview, the domain name 'theatre.com' would be confusingly similar to the trademark HEAT. In the panel's opinion, such a result would change the current understanding of confusing similarity, and therefore suggested that, even if technological confusion were to be accepted, some element of visual or aural confusion would still be required.

In conclusion, the panel found that the complainant had failed to demonstrate confusing similarity in accordance with Paragraph 4(a)(i) of the UDRP on the grounds that there was no visual or aural confusion at all between the PLEIN mark and the domain names. It was not sufficient that the trademark was only visible when the viewer was told it was definitely there. Given this, it was not necessary for the panel to go on to consider the other two limbs of the UDRP, and the complaints were denied.

The panel acknowledged that this result appeared hard on the complainant, given the online trademark infringement by a seller of purported counterfeit products, but underlined that confusing similarity and bad faith were separate and cumulative criteria under the UDRP. Although the complainant had not been able to demonstrate cybersquatting, which was the specific abuse that the UDRP was intended to address, the panel emphasised that the UDRP was not a universal remedy for internet trademark abuse in general, and that the decision would not prevent the complainant from seeking relief by other means. Indeed, at the time of writing, even though the domain names were still in the names of the respondents, the corresponding websites no longer appeared to be active, suggesting that the complainant had been able to find another solution to the problem (eg, by requesting the hosting provider of the websites to take down the infringing content).

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