

## WIPO panel finds that domain name registrant intended to disrupt complainant's business

Cybersquatting

International - Hogan Lovells LLP

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In a [recent decision](#) issued by the [World Intellectual Property Organisation](#) (WIPO) in accordance with the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP), a company established in New York under the name [Vitamin World Inc](#) was granted the transfer of the domain name 'vitaminworlddiscount.com'. The domain name was registered on March 16 2013 by Healthport 61, an American company.

The complainant manufactured and sold over 1,000 vitamins, herbs and other nutritional supplements in various forms (eg, capsules and tablets liquids) via its 414 retail stores located throughout the United States and on its website at 'www.vitaminworld.com'. For these activities, the complainant owned numerous US and Canadian trademark registrations that contained the term 'vitamin world'. The complainant's parent company owned several domain names containing the term 'vitaminworld', such as 'vitaminworld.com', 'vitaminworld.net', 'vitaminworld.info', 'vitaminworld.us' and 'vitaminworld.ca', all of which were pointing to the complainant's website.

The domain name was first registered in 2010 by Health Port Natural Foods and was transferred to the respondent in March 2013. The respondent had a retail website selling vitamins, minerals, herbs and other nutritional supplements to the public.

On April 29 2014 the complainant sent a cease and desist letter to the respondent requesting the transfer of the domain name. The complainant claimed that it never received an answer to this letter, although the respondent evidenced that its counsel had replied by email offering to discuss. On December 3 2014 the complainant filed a UDRP complaint with WIPO.

To be successful in a complaint under the UDRP, a complainant must prove 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 requirement, the complainant submitted that it owned trademark rights in the term 'vitamin world', as it had registered trademarks that contained or consisted of the term 'vitamin world' since 1974. The complainant also asserted that the dominant part of the domain name was the trademark VITAMIN WORLD and that the addition of the suffix 'discount' was not sufficient to distinguish the domain name from the trademark.

The respondent argued that both terms of the trademark were merely descriptive and generic and, therefore, could not be appropriated or monopolised by the complainant for the sale of vitamins and supplements. In particular, the respondent claimed that the word 'vitamin' was a generic term for the goods that the complainant offered on its website and that the word 'world' was a merely descriptive term indicating the scope of the complainant's services. The respondent affirmed that the addition of the word 'discount' to the trademark in the domain name simply denoted value pricing.

The panel pointed out that whether a trademark was distinctive or not was not a question for a WIPO panel and that the proper forum for this would be cancellation or invalidity proceedings in court. The panel considered that the evidence of registration of the mark brought by the complainant was sufficient to establish the existence of its rights in relation to the mark. In addition, by comparing the mark with the domain name, the panel noted that the dominant portion of both the mark and the domain name was the term 'vitamin world' and, therefore, concluded that the domain name was confusingly similar to the mark.

With regard to the second limb of the three-prong test, the complainant submitted that the respondent was neither its agent nor its licensee, nor authorised to use the mark. The complainant also noted that the respondent had never been known under the domain name for its products and services and that, considering the business area of the respondent, it should have been aware of the complainant's rights in the mark. Considering the fact that the domain name was pointing to a webpage offering products of the complainant's competitors, the complainant argued that the registration of the domain name was not a coincidence and that the respondent was actually trading on the complainant's fame. In light of these

circumstances, the complainant contended that the registration and use of the domain name did not constitute a good-faith offering of goods or services.

The respondent asserted that it had legitimate interests in registering the domain name as the words 'vitamin' and 'world' were generic and as it did not sell 'Vitamin World Discounted' branded vitamins or nutritional supplements. The respondent stated that it had registered the domain name to serve as a generic description of its business that consisted of selling a large variety of discounted vitamins across the world. In addition, the respondent affirmed that it had used the domain name for nearly five years without any actual confusion. In light of these facts, the respondent considered that it had used the domain name for a good-faith offering of goods without any intent for commercial gain.

The panel considered that the respondent had not been making a legitimate non-commercial use of the domain name. The panel found that the respondent must have known of the complainant and its prior rights in the trademark VITAMIN WORLD as the complainant had had rights in that mark since 1976 and operated a website located at 'www.vitaminworld.com', as well as various social media sites. The panel stressed that the respondent was a competitor of the complainant and had been confusingly using the domain name on a website to sell competing products. In the panel's opinion, the respondent had therefore been taking advantage of the similarity between the mark and the domain name for commercial gain. Further, the panel considered that the world 'discount' described an aspect of both the complainant's and the respondent's business. The panel therefore found that the respondent was not making a good-faith use of the domain name.

With regard to the third limb of the three-prong test under the UDRP, the complainant asserted that the respondent had registered the domain name for the purpose of disrupting the business of the complainant and had used the domain name to attract, for commercial gain, internet users to its website. In addition, the complainant argued that the absence of an answer to its cease and desist letter further supported a finding of bad faith.

The respondent re-affirmed that the domain name had been registered to serve as a generic description of a large variety of discounted vitamins sold across the world via the world-wide-web. In addition, the respondent denied that it had registered and used the domain name in bad faith, and the examples of bad faith provided in the UDRP were not satisfied. However, the panel pointed out that the choice of a domain name featuring the complainant's mark as the dominant or principal component could not have been a coincidence, especially given the complainant's extensive use of its trademark for over 40 years and the fact that the parties operated in the same field.

The panel noted that the likelihood of confusion created between the domain name and the mark illustrated the respondent's intention to disrupt the business of the complainant when registering the domain name. In addition, the panel considered that the use of the domain name indicated the respondent's attempt to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the trademark as to the source, affiliation or endorsement of the respondent's website and the products on the website.

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

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