

World Trademark Review *Daily*

Grand Theft Auto maker triumphs under UDRP International - Hogan Lovells LLP

Cybersquatting

November 05 2013

In a [recent decision](#) issued by the [World Intellectual Property Organisation](#) (WIPO) in accordance with the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP), a single-member panel has ordered the transfer of the domain name 'gta5betagiveaway.com' to the complainant, [Take-Two Interactive Software Inc.](#) The complainant was a well-known US publisher, developer and distributor of video games and owned numerous US trademark registrations for GRAND THEFT AUTO and GTA.

The respondent, Null a/k/a Cielo Vivas of Birmingham, Alabama, did not respond to the complaint. The domain name was being used "in a phishing scheme disguised as an offer to consumers of a downloadable beta version of the complainant's video game".

The complainant filed a UDRP complaint with WIPO on May 29 2013. 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.

As for the first limb of the UDRP, the complainant claimed common law rights in the mark GTA: V and stated that it was not significant that GTA: V was not yet a registered trademark. Citing previous UDRP decisions, the complainant alleged that "common law rights can be recognised in a domain name dispute to prevent unauthorised use of a mark name". However, the panel rejected the evidence submitted by the complainant supporting common law rights and found that it was not sufficient.

Even so, the complainant evidenced that the domain name was identical or confusingly similar to its GTA trademark, as it combined the complainant's trademark with the words 'beta' and 'giveaway', and the number 5. The panel found that the addition of these terms and number strengthened the confusion by implying that the beta version of the complainant's highly anticipated new video game was available at the site associated with the domain name.

Once this condition was satisfied, the second limb of the three prong test required the complainant to demonstrate that the respondent had no rights or legitimate interests in the domain name. The complainant asserted that the respondent had registered the domain name without any authorisation or permission from the complainant. In addition, the complainant argued that the respondent was acting in a phishing scheme as it was falsely offering a non-existent 'beta version' of the complainant's "Grand Theft Auto: V" video game.

In this case, the panel considered that the respondent's aim was obviously to use the complainant's copyrighted material in order to mislead consumers and to collect personal information belonging to internet users in a blatant phishing scheme. Thus, the evidence raised by the complainant was sufficient to ascertain the second requirement of the three-prong test.

Turning to the third limb of the UDRP and the question of registration and use in bad faith, the complainant alleged that the respondent was clearly attempting to capitalise on the fame of the complainant's GTA mark and to hijack the complainant's goodwill. The panel considered that the respondent could not have been unaware of the complainant's trademark at the time of the domain name registration and thus that the domain name had been registered in bad faith. Given the use of the domain name to fraudulently collect information from consumers for commercial gain, it was also clear that it was being used in bad faith. The panel therefore decided to transfer the domain name to the complainant.

Given the notoriety of the complainant and its trademarks, the sole panellist did not have a particularly difficult decision. The success of the complainant was due to the effectiveness of the UDRP in such cases: the respondent's domain name fully incorporated the complainant's trademark with the mere addition of a number and generic words, and the use being made of it was clearly in bad faith.

It is worth noting that complainants faced with such obvious cases under one of the new generic top-level domains will be able to file a complaint under the Uniform Rapid Suspension System (URS) as an alternative to the UDRP. The URS provides rapid relief to trademark holders for the most clear-cut cases of infringement and offers a cheaper, faster solution than the existing UDRP, although the only remedy is suspension of the domain name at issue, as opposed to transfer. This makes sense as, in many cases like

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the one described above, brand owners do not actually require the domain name at issue in their portfolio, they just need to urgently prevent harm to consumers by bringing an end to phishing schemes and suchlike. The URS has already been adopted by certain other existing registries, such as '.pw' (the country-code top-level domain for the pacific island nation of Palau, also marketed as being short for 'personal web').

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