

UDRP decision shows difficulty to prove bad faith when domain name is common dictionary word **Cybersquatting**
International - Hogan Lovells **Internet issues**

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In a [recent decision](#) under the [Uniform Domain Name Dispute Resolution Policy \(UDRP\)](#) before the [World Intellectual Property Organisation](#), a three-member panel has denied the transfer of a domain name because it was a Spanish dictionary word and there was insufficient evidence that it had been registered and used in bad faith.

The complainant was Grupo Hotelero Brisas SA de CV of Mexico City, a company founded in 1956 that owned and operated hotels in Mexico. It was the owner of various trademark registrations, including the Mexican trademark registration No 325882 for LAS BRISAS, registered in 1987.

The respondent was Domain Admin Ashantiplc Limited of Hong Kong.

The disputed domain name was 'brisas.com'. It was registered on October 9 1996 and the respondent acquired it on an undisclosed date that was no earlier than February 2014 and no later than February 2015.

At the time of filing the complaint, the domain name resolved to a webpage in English that indicated that the owner was willing to entertain a sale or other proposals and that the minimum offer was \$10,000.

The complainant requested that Spanish be the language of the proceedings because it was domiciled in Mexico and the word 'brisas' was a Spanish word. However, the respondent requested English because the registration agreement was in English and the domain name resolved to a website in English. Observing that the amended complaint and the response were both filed in English, the panel determined that English should be the language of the proceedings.

To be successful in a complaint under the UDRP, a complaint must satisfy the following three requirements set out in Paragraph 4(a):

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) The respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

As for the requirement of the first limb, the panel is first required to assess whether a complainant has relevant trademark rights, regardless of when and where such trademark was registered and, secondly, whether the domain name at issue is identical or confusingly similar to such trademark.

In the present case, the panel found that the complainant had trademark rights in LAS BRISAS. The complainant argued that the domain name was confusingly similar to such trademark because the dominant element of the domain name was the word 'brisas', which was fully incorporated in the trademark. The complainant also argued that conceptual similarity was relevant due to the recognition of the complainant's trademark, which evoked in consumers the perception that the services offered at the domain name were offered by the complainant itself.

The respondent replied that the word 'brisas' was a generic Spanish word meaning 'breezes' and added that the complainant did not present evidence of trademark rights in BRISAS *per se*, but only in LAS BRISAS. In addition, the respondent stated that dozens of entities, including many in the same field as the complainant, used combination marks which also incorporated the word 'brisas'. Therefore, the word 'brisas' was not distinctive of the complainant.

In light of the above, the panel ruled that the omission of the word 'las', meaning 'the', was a minor difference between the domain name and the complainant's trademark insofar as the domain name incorporated the dominant element of the trademark. Therefore, the domain name was confusingly similar to a trademark in which the complainant had rights and thus the latter had satisfied the first element set out in Paragraph 4(a) of the UDRP.

As to the second limb and a respondent's rights or legitimate interests (or lack of them), a complainant must prove that the respondent had no rights or legitimate interests in respect of the domain name in question. A complainant is normally required to make out a *prima facie* case and it is for the respondent to

demonstrate otherwise. If the respondent fails to do so, then the complainant is deemed to satisfy Paragraph 4(a)(ii) of the UDRP.

In the present case, the complainant argued that the respondent had no rights or legitimate interests in respect of the domain name as there was no commercial relationship between the complainant and the respondent. Furthermore, the complainant considered that the respondent undertook activities within the same line of business as the complainant because it redirected internet users to the webpages of various hotels, without the authorisation of the trademark owner and without any clear notice that it was a different website.

The respondent considered that it had a legitimate interest which was the belief that a word such as '*brisas*' had a commercial value because it was a common dictionary word: it may therefore be of interest to those involved in weather, heating and air conditioning and numerous other purposes. Furthermore, the respondent stated that it did not offer temporary accommodation to the consuming public, redirecting pages to various hotels.

Given the panel's findings in relation to bad-faith registration and use, the panel deemed that it was not necessary to consider the issue of rights or legitimate interests.

In relation to the third limb, a complainant is required to demonstrate that the domain name has both been registered and is being used in bad faith. As for use in bad faith, the complainant argued that the respondent was using the domain name to resolve to a webpage offering it for sale and intermittently redirecting to hotel websites without authorisation. As a result, the respondent was using the domain name intentionally to attract internet users for financial gain and creating confusion with the LAS BRISAS trademark. Furthermore, the complainant argued that the domain name was not being properly and legally used because the respondent's website noted that it was for sale, which constituted use in bad faith.

Turning to the question of registration in bad faith, the complainant argued that the registration of its trademark prior to the date of creation of the domain name led to the conclusion that the decision to adopt the domain name was made in order to mislead the public for profit by creating the unfounded impression of sponsorship, affiliation or endorsement by the complainant. The complainant stated that the respondent must have known about the complainant when acquiring the domain name, since it was an established international brand and the domain name intermittently redirected to the complainant's hotels. Therefore, the complainant argued that the respondent had not registered a domain name that randomly included the complainant's LAS BRISAS trademark by mere coincidence.

The respondent stated that the page to which the domain name pointed did not redirect to any hotels whatsoever but simply offered the domain name for sale. The respondent pointed out that the complainant had not evidenced its allegations in this regard and believed that the complainant was genuinely confused as to what the domain name in dispute was. The respondent emphasised that it had nothing to do with the domain name '*lasbrisas.com*'.

Regarding bad-faith registration, the panel noted that the domain name did not incorporate the complainant's trademark in its entirety, despite the complainant's assertions. The panel found that this did not necessarily demonstrate an awareness of such trademark because there existed an alternative possibility based on the dictionary meaning of that part of the trademark that was incorporated in the domain name.

The panel also found that the complainant had not proved the fact that the respondent would have had knowledge of the complainant's trademark registration at the time of acquisition of the domain name and had not provided any evidence of any promotion of its trademark. The panel considered that it was not enough to assert some reputation when there was no substantive evidence of the extent of that reputation. Therefore, the panel found that the complainant had failed to prove that the respondent had registered the domain name in bad faith.

As far as bad-faith use was concerned, the panel found that the complainant had not evidenced the fact that the domain name resolved to a webpage that intermittently redirected to hotel websites, including the complainant's own website, since all the screenshots produced showed that the domain name resolved to a parking page without links. Whilst there was evidence in the response that '*lasbrisas.com*' was resolving to a website displaying links to hotel websites, this was a different domain name, not in dispute in the present case, and there was no evidence that it was related to the respondent.

Although the panel expressed its doubts about the inherent value of the domain name due to the fact that it was a common Spanish word meaning 'breezes', it did not consider that the relatively scant evidence on the record would justify a rejection of that explanation. Therefore, the panel found itself unable to find that the

respondent was aware of the existence of the complainant's trademark at the time that it acquired the domain name or that the respondent had attempted to take advantage of the complainant's rights in such trademark.

In conclusion, the complainant failed to prove that the domain name had been registered and used in bad faith and thus failed to satisfy the third requirement of the UDRP. Therefore, the panel denied the complaint.

The present decision highlights the fact that it can be extremely difficult to prove that a respondent was targeting a particular trademark owner when a domain name is a common dictionary word. In the case at hand, even though the domain name was found to be confusingly similar to the complainant's trademark, the complaint was denied because it was not possible for the panel to make the link between the acquisition of the domain name and the respondent's knowledge of the complainant's business. Thus, there was nothing to suggest that the respondent knew of the complainant, especially since the domain name consisted of a common Spanish dictionary word only partially reproducing the trademark at issue, and could possibly have been chosen and acquired independently by the respondent.

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