

UDRP shields brand from cybersquatting under '.reviews'

International - Hogan Lovells

Cybersquatting
Domain names
Infringement

November 23 2017

- Company obtains transfer of domain name identically reproducing its trademark under '.reviews' new gTLD
- Complainant satisfied all three requirements under the UDRP
- Highlights that registration of a domain name under a TLD that connotes fair use is not sufficient to confer on the registrant rights

In a recent decision under the Uniform Domain Name Dispute Resolution Policy (UDRP) before the World Intellectual Property Organisation (WIPO), an American home warranty company obtained the transfer of a domain name identically reproducing its trademark under the '.reviews' new generic top-level domain (gTLD). The panel found that the domain name was not being used for a genuine, non-commercial criticism website, but rather was merely a pretext for cybersquatting.

The '.reviews' new gTLD is one of the many new gTLDs launched by the Internet Corporation for Assigned Names and Numbers (ICANN). Its mission is to create a forum where internet users can post and read reviews of a variety of goods and services. The '.reviews' new gTLD was delegated into the root on 11 February 2014 and became available for general registration following a sunrise period for trademark holders that opened on February 26 2014 and closed on April 28 2014. There are over 16,000 domain name registrations under the '.reviews' new gTLD.

Facts

The complainant was American Home Shield Corporation, a company based in Memphis, providing home warranty services. It owned several US trademarks for AMERICAN HOME SHIELD, which had been used commercially since 1972.

The respondent was Morris Chera, an individual based in New York. The respondent claimed to have registered the domain name for a legitimate review or criticism website of the complainant's insurance plans.

The disputed domain name was 'americanhomeshield.reviews'. It was registered on April 14 2017 and was redirecting to www.americanhomeguard.com/redirect, the website of a direct competitor of the complainant.

Decision

To be successful in a complaint under the UDRP, a complainant must prove each of the following cumulative requirements:

- the domain name registered by the respondent 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.

The first requirement under the UDRP is two-fold and requires a panel to assess, first, whether the complainant has relevant trademark rights and, second, whether the disputed domain name is identical or confusingly similar to the complainant's trademark.

The panel found that the complainant had demonstrated rights through registration and use of the AMERICAN HOME SHIELD trademark and that the domain name was confusingly similar to the complainant's trademark. In reaching this conclusion, the panel noted that the complainant's trademark was clearly recognisable in the domain name. The panel further found that the '.reviews' new gTLD did not dispel the confusing similarity of the domain name with the complainant's trademark as the TLD is generally disregarded in assessing identity or confusing similarity.

It should be noted that the respondent had argued that the complainant did not have enforceable trademark rights in AMERICAN HOME SHIELD on the basis that it was generic or merely descriptive of the complainant's goods and services. The panel rejected the respondent's contention and found that the complainant's trademark was "entitled to a presumption of validity by virtue of its registration with the

USPTO". The panel further observed that although the term 'American Home' was disclaimed in the trademark registration, the domain name did not consist solely of the disclaimed language but rather of the complainant's trademark in its entirety. Accordingly, the panel found that the complainant had satisfied Paragraph 4(a)(i) of the UDRP.

Turning to the second requirement under the UDRP, and whether the respondent had rights or legitimate interests in the domain name, Paragraph 4(c) of the UDRP provides a list of non-exhaustive circumstances which may indicate that a respondent has rights or legitimate interests in a domain name, including where the respondent is making a "legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the [complainant's] trademark or service mark", in accordance with Paragraph 4(c)(iii). The respondent claimed that he had registered the domain name intending to launch a review or criticism website about the complainant. The panel noted that to assess a claim of fair use under the UDRP, it was necessary to consider the nature of the domain name as well as circumstances beyond the domain name itself, including whether there was commercial activity taking place. The panel also noted that the use of a domain name cannot be considered reasonable where the domain name falsely suggests an affiliation with the trademark owner or if the domain name is used as a pretext to obtain commercial gain.

Taking the above into consideration, the panel found that the respondent had failed to demonstrate that he was making a legitimate non-commercial or fair use of the domain name, in accordance with Paragraph 4(c)(iii) of the UDRP. The panel noted that there was no evidence suggesting that the respondent had made any effort to use the domain name in a legitimate non-commercial or fair manner. Rather, the respondent's use of the domain name consisted solely of diverting internet users to the website of a competitor, which was likely to cause confusion. The panel thus found that the respondent's claim that he had registered the domain name for a legitimate non-commercial purpose was pretextual in order to obtain commercial gain derived from the complainant's rights in the AMERICAN HOME SHIELD trademark. Further, the panel found that none of the other circumstances listed in Paragraph 4(c) assisted the respondent as the respondent's use was neither *bona fide* nor was the respondent commonly known by the domain name, in accordance with Paragraphs 4(c)(i) and 4(c)(ii). The panel found that the respondent had failed to put forward any credible evidence to demonstrate rights or legitimate interests in the domain name. Accordingly, the panel found that the complainant had satisfied Paragraph 4(a)(ii).

Regarding the third requirement under the UDRP, and whether the respondent had registered and used the domain name in bad faith, Paragraph 4(b) of the UDRP also provides a non-exhaustive list of circumstances that may be considered evidence of registration and use of a domain name in bad faith, including "circumstances indicating that the respondent registered the disputed domain name primarily for the purpose of disrupting the business of a competitor". The respondent had argued that his intention to use the domain name for a legitimate review or criticism site was demonstrated by the '.reviews' gTLD itself. The panel appears to have rejected the respondent's contention mainly based on the respondent's knowledge of the complainant's trademark and his use of the domain name to misleadingly divert internet users to the website of a competitor of the complainant. The panel found that the respondent's actions suggested that he had registered and used the domain name primarily to capitalise on, or otherwise take advantage of, the complainant's trademark rights for commercial gain, with the likely intention of disrupting the complainant's business, including by resorting to the practice of 'bait and switch'. Accordingly, the panel found that the complainant had satisfied Paragraph 4(a)(iii).

The complainant satisfied all three requirements under the UDRP. Therefore, the panel ordered the transfer of the domain name to the complainant.

Comment

The decision highlights that mere registration of a domain name identically reproducing a trademark under a TLD that connotes fair use, such as '.reviews', is not in itself sufficient to confer on the registrant rights or legitimate interests in the domain name. The domain name in question must also genuinely be used to criticise or review the trademark holder's products or services for the respondent's fair use claim to be accepted. Brand owners can therefore rely on the UDRP to tackle domain names that resolve to websites that are not genuine non-commercial criticism websites and serve merely as a pretext for cybersquatting, which is precisely the purpose of the UDRP.

The decision is available [here](#).

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