

Lacoste fails to obtain transfer of 'lacostejewelers.com'
International - Meisser & Partners

Cybersquatting

September 25 2009

In *Lacoste Alligator SA v LaCoste Healing Jewelry* (Case D2009-0700, July 16 2009), a [World Intellectual Property Organization \(WIPO\)](#) panellist has refused to order the transfer of the domain name 'lacostejewelers.com' to [Lacoste Alligator SA](#) (Geneva, Switzerland).

Lacoste, the well-known clothing and accessories company, owns several trademarks containing the name Lacoste in numerous countries. LaCoste Healing Jewelry (Massachusetts, United States) is the owner of the domain name 'lacostejewelers.com'. At the time of the proceedings, the domain name was not (and is still not) in use.

On May 28 2009 Lacoste filed a complaint under the [Uniform Domain Name Dispute Resolution Policy \(UDRP\)](#) against LaCoste Healing alleging that:

- the domain name 'lacostejewelers.com' was confusingly similar to its earlier registered trademarks;
- the generic term 'jewelers' in the domain name was merely descriptive;
- LaCoste Healing had no legitimate interests in the domain name; and
- there was no good-faith offering of goods through the domain name and, as such, the domain name was used in bad faith.

LaCoste Healing did not file a reply.

To obtain the transfer of a domain name under the UDRP, a complainant must prove that:

- the domain name at issue is identical or confusingly similar to a trademark or service mark in which it has rights;
- the respondent has no rights or legitimate interests in the domain name; and
- the domain name was registered and is being used in bad faith.

With regard to the first prong of the test, the panellist held that "confusing similarity" requires both similarity and a potential for confusion. The panellist further stated that in the present case:

"it might be argued that the added word 'jewelers' could have the converse effect of introducing a distinction between [Lacoste]'s trademark, which appears to be known principally in the field of clothing, sportswear and accoutrements, and [LaCoste Healing]'s business in the field of healing jewellery. On the other hand, [Lacoste]'s expansive business includes a small line of watches that might not unreasonably be classed as jewellery."

As the panellist found that the two other prongs of the test had not been met, he did not decide whether the domain name was confusingly similar to Lacoste's trademarks. With regard to the second prong, the panellist held that the word 'Lacoste' was a recognized

surname and a French place name. Therefore, the word was capable of innocent usage by, at the very least, people named Lacoste or LaCoste, and by businesses and other entities associated with the place. Since the domain name was registered by LaCoste Healing and the administrative contact was Audrey LaCoste, the panellist found that LaCoste Healing had legitimate interests in the domain name. Finally, the panellist was not satisfied that the domain name had been registered and was being used in bad faith. Consequently, the complaint was dismissed.

The decision is interesting with regard to the panellist's application of the 'confusing similarity' test. The panellist carefully differentiated the concept of similarity and the likelihood of confusion resulting therefrom. Thus, although the domain name and the trademarks were similar, the domain name was not held to be confusingly similar to the marks due to the addition of the word 'jewelers' (despite the fact that Lacoste's business included a small line of watches). This approach does not seem to be in line with previous WIPO decisions. For example, in *Nokia Corporation v Nokiagirls.com* (Case D2000-0102), *Nokia Corporation* obtained the cancellation of the domain name 'nokiagirls.com'. Similarly, in *Microsoft Corporation v SL Mediaweb* (Case D2003-0538), *Microsoft Corporation* obtained the transfer of the domain name 'msnporno.com'. However, while WIPO's interpretation in previous decisions is favoured, other circumstances may weigh in favour of the respondent under the second and third prong of the test.

Importantly, the decision highlights that the mere fact that a respondent has failed to submit a formal response does not automatically result in a finding for the complainant by default. Moreover, non-use of a domain name does not automatically lead to a finding of bad faith.

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