

Fortifying Cyber Presence

Private: Stephen Jiew - Senior Associate - Intellectual Property
- Dubai International Financial Centre

What

Domain name dispute between 2 retailers.

Who

The Complainant, Rivoli Group LLC, is a well known purveyor of luxury goods in the region particularly in the UAE with a multitude of retail outlets.

The Respondent, Brilliant Watches LLC, is a competitor in the fiercely competitive retail watch market.

The Prize

www.rivoliwatch.com

Why

RIVOLI is the Complainant's house mark, which it has cultivated over decades to become a household name in luxury goods. The Complainant enjoys substantial goodwill and reputation in its RIVOLI mark.

The use of RIVOLI in www.rivoliwatch.com is unauthorised and detrimental to the Complainant as it seeks to divert business away from the Complainant and results in brand dilution of its RIVOLI mark.

Where

World Intellectual Property Organization ("WIPO") Arbitration and Mediation Centre under the Rules for Uniform Domain Name Dispute Resolution Policy

Facts of the Case

The Respondent had registered the disputed domain name and had been using it by maintaining it such that all internet traffic to the domain name is automatically diverted to the domain name, an active website which provides extensive information and offers watches for sale including RIVOLI branded watches.

The Complainant has trade mark registrations for RIVOLI in a number of countries and has been using RIVOLI as a trade name since 1976.

The Complainant had finally succeeded in cancelling a trade mark registration for RIVOLI held by a company related to the Respondent following protracted litigation.

The Complainant's Case

The disputed domain name is confusingly similar to marks in which the Complainant has rights, the Respondent has no rights or legitimate interests in use of the disputed domain name and the Respondent's registration and use of the disputed domain name is in bad faith.

The Respondent's Case

The Respondent alleged that they have trade mark registrations for RIVOLI in Pakistan, India, Kuwait and Switzerland and have been selling RIVOLI branded watches since 1994 in multiple markets such as UAE, U.K., Russia, Qatar, Saudi Arabia, Kuwait, Pakistan, Jordan, India and many African countries.

WIPO's Findings

1. The WIPO Panel agreed with the Complainant that the disputed domain name had incorporated its RIVOLI trade mark in its entirety and crucially that the addition of the descriptive term, watch, had actually

exacerbated the risk of confusion experienced by internet users because the disputed domain name implies that Respondent is offering the Complainant's goods for sale.

This significant finding underscores the Respondent's lack of bona fides.

2. It was found that the Respondent's use of the disputed domain name cannot be characterised as use in connection with the bona fide offering of goods. The Complainant had argued that the Respondent's conduct in using the domain name to divert internet users to the Respondent's own website, which offers competing watches with full knowledge of the Complainant's name and its trade mark following the lawsuits in which its related company was embroiled in must necessarily lead to the inescapable conclusion that there was no bona fide offering of goods under the disputed domain name.

3. The WIPO Panel found that the disputed domain name was registered and used in bad faith.

The Complainant had vigorously argued that there was no plausible reason why the Respondent would have chosen to use RIVOLI as part of the disputed domain name except to misappropriate the vault of goodwill and reputation, which the Complainant had painstakingly cultivated over decades of use. Quite clearly, www.rivoliwatch.com was not a domain name, which any user would have chosen unless they knew of the RIVOLI trade mark and the custom, which it attracts. The Respondent had manifestly registered the domain name solely for the purpose of attracting users who type in in the presumption that they will reach a site operated by the Complainant relating to watches.

It was obvious from the matrix of use with the auto redirect from the disputed domain name to the Respondent's own website, which offers competing watches that the disputed domain name was being used in bad faith.

Accordingly, the WIPO Panel was satisfied that the Complainant had succeeded in proving its case and ordered that the disputed domain name be transferred to the Complainant.

Learnings

Fortifying one's cyber presence has never been more important as an increasing number of users log onto the internet to shop and be entertained especially in the Middle East where internet penetration is set to balloon as indicated by the recent introduction of more available domains such as the Arabic domain names in Saudi Arabia (.alsaudiah), UAE (.emarat), Egypt (.mizr), Jordan (.alordan) and Palestine (.falasteen).

It is important to be vigilant in monitoring any unauthorised usage of your intellectual property in cyberspace and to act swiftly and decisively in rooting out the problem. Using the WIPO Arbitration and Mediation Centre as a means to do so has proven highly effective and quick in resolving domain name disputes. The fact that the Complainant has been vigilant in enforcing its rights against offenders in cyberspace was important in shoring up its arguments that any attempt to free ride on its substantial goodwill and reputation was damaging to its brand integrity and likely to cause brand dilution.

This significant case represents yet another decisive victory for the Al Tamimi & Company Domain Name Dispute Resolution practice, part of our award winning IP/IT practice which continues to counsel clients in ensuring that their valuable goodwill and reputation is well protected in cyberspace.

In the celebrated case, which reached the Abu Dhabi Supreme Federal Court, the litigation team headed by senior counsel, Al Tamimi & Company founder & Senior Partner, Essam Al Tamimi, had successfully convinced the court in overturning the Abu Dhabi Federal Court of Appeal's decision to cancel the RIVOLI registration. The decision represented a high water mark for issues concerning use of a trade name and the resultant rights thereto.