

Decision for dispute CAC-UDRP-100552

Case number	CAC-UDRP-100552
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Time of filing	2013-01-25 13:09:54
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Domain names	sing-cointreau.com
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Case administrator

Name	Lada Válková (Case admin)
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Complainant

Organization	COINTREAU
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Complainant representative

Organization	Nameshield (Laurent Becker)
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Respondent

Organization	Cointreau
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant uses the Domain name "www.cointreau.com" which is connected to one of the main websites of the Complainant, and is also owner of several trademarks for the name "Cointreau", protected on worldwide basis, among others:

- International nominative Trademark "Cointreau" n° 144083, registered on 21 November 1949, for goods in classes 32 and 33;
- International semi-figurative Trademark "Cointreau" n° 297658, registered on 17 May 1965, for goods in class 33;
- International semi-figurative Trademark "Cointreau" n° 224330, registered on 2 October 1959, for goods in class 33;
- International semi-figurative Trademark "Cointreau" n° 917242, registered on 15 December 2006, for goods in classes 32 and 33;
- "Cointreau" Community nominative Trademark n° 8809964, registered on 13 June 2010, for goods and services in classes 41, 43 33;
- "Cointreau" Community tridimensional Trademark n° 4021986, registered on 3 January 2006, for goods in class 33;
- etc.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

See numerous WIPO decisions:

- Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003;
- CBS Broadcasting, Inc. v. Dennis Toeppen, WIPO Case No. D2000-0400;
- WIPO case No. D2001-1085, Cointreau SA, Remy Cointreau v. Greenhouse Inc;
- WIPO case No. DCO2010-0019, CLS Rémy Cointreau v. Luke Skywalker, X Wing.

The Complainant's facts can be summarized as followed:

- Founded in 1849 in Angers, Cointreau (currently a branch of Remy Cointreau Group) produces a liqueur made of orange peels;
 - Its main activities are the production of cognacs, liquors, rums and spirits;
 - The Complainant is owner of several word/semi-figurative/tridimensional trademarks;
 - Its communication is done through many websites worldwide. The main one is "www.cointreau.com" registered on 11/10/1995;
 - The disputed domain name "sing-cointreau.com" has been registered on 02/12/2008. The Whois information for the Domain Name records that the Organisation's Name owner of the disputed domain domain name is "Cointreau";
 - According to the Complainant, this domain name "is confusingly similar to the trademarks and products "COINTREAU";
 - On 7 January 2013, the Complainant has sent a cease and desist letter to the Respondent "Cointreau, 9-7-1, Akasaka, Midtown Tower Minato-ku, 107-6211 Tokyo Japan", requesting him the transfer of ownership of the disputed Domain Name;
 - The Respondent did not answer.
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PARTIES CONTENTIONS

The Complainant's contentions can be summarized as followed:

As to the first condition, the Complainant contends that its trademark "Cointreau" is well known in the world especially in Japan where the trademark "Cointreau" is registered since 1950. In his opinion, the contested Domain Name "sing-cointreau.com" is confusingly similar to its prior trademarks "Cointreau". This Domain name wholly incorporates the trademark "Cointreau". The addition of a gTLD ".com" and term "Sing" is, according to the Complainant, "not sufficient to escape the finding that the domain name is confusingly similar to the trademark (...). It does not prevent the likelihood of confusion between the disputed domain name and Cointreau, its trademark and its domain name associated".

As to the second condition, the Complainant asserts that the Respondent "is not affiliated with nor authorized by Cointreau in any way", that he "has nor right or legitimate interests in respect of the domain name and is not related in any way to the Cointreau's business". The Complainant adds that he "does not carry out any activity for, nor has any business with the Respondent" and that the Respondent is not known under "Cointreau". The Organisation's name located in the Respondent's address is not "Cointreau" but well "Yahoo Japan Corporation". Then, the Website related to the Domain name appears to be linked to an inactive page (exhibit n° 7) since its registration. Those circumstances stress the absence of right or legitimate interest of the Respondent in respect of the contested Domain Name.

As to the third condition, in the Complainant's mind, the bad faith of the Respondent is blatant based on the followings:

- Registration of a well-known/famous trademark
- Deliberate provision of false/misleading Whois data
- No response to the cease and desist letter
- Inactive Website
- Non use of the domain name

To this regard, the Complainant contends that "since its registration, the domain name is inactive and therefore is considered as a passive holding. As prior WIPO UDRP panel have held, the incorporation of a famous trademark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use."

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that Complainant possesses established legal rights in the term "Cointreau" by reason of its long use and in consideration of the several trademark registrations for "Cointreau" obtained by Complainant in many countries of the World. The Panel can easily infer from the exhibits and the use of the trademarks that "Cointreau" is a well-known trademark worldwide (including in Japan).

As to the first condition, the Panel finds that the disputed Domain Name "sing-cointreau.com" even if not identical, is at least confusingly similar to the Complainant's trademarks.

Firstly, this Domain Name wholly incorporates the trademark "Cointreau".

Secondly, the fact that the word "sing" is added to Complainant's trademark does not eliminate the similarity between Complainant's trademarks and the disputed Domain Name, as "sing" is a descriptive and generic component of the disputed Domain Name (see WIPO Case N° D2007-1817). "In numerous cases, it has been held that a domain name that wholly incorporated a complainant's registered mark may be sufficient to establish confusion similarity for purposes of the Policy despite the addition of other descriptive words to such marks" (WIPO Case N° D-2005-0458).

In the present case, the Panel finds that this term "Cointreau" is the most distinctive part of the combination "sing-cointreau". In other words, the distinctive part of the disputed Domain name and the Complainant's trademarks are identical. The term "sing" is a generic one and does not in itself - as well as the ".com" suffix - impact on the analysis of whether a domain name is identical or confusingly similar to the Complainant's trademark. It does not take away the overall impression that the domain name is connected to the Complainant (see: ADR.EU Dispute n° 100195; WIPO Case N° D2006-1268; WIPO Case N° D2007-1325; ADR.EU Dispute n° 100077) .

The Panel is aware of the fact that in most cases similar to this one, the Complainant's trademark was reproduced with another word describing the activity of the Complainant. For example, the bank "ABC" would complain about the domain name "bank-ABC" or "money-ABC". While in the present case, there is no apparent intellectual link between the famous liquor of the complainant and the word sing. However, the respondent has decided to keep silent in this procedure and did not provide any explanation as to the choice of the word sing in relation with the word cointreau. In such circumstances, the Panel finds that the domain name at stake is confusingly similar to the Complainant's trademark.

As to the second condition, the Complainant substantially contends that the Respondent is not related to any way to the Complainant's business, that he is not known under the word Cointreau and that the domain name is not used for any active website.

The Panel notes that the Domain Name holder's name or contact details through the Whois database contain reference to

"Cointreau". Nevertheless, as pointed out by the Complainant, the company who is located at the contact address is in fact "Yahoo Japan Corporation", and not "Cointreau". The Panel also notes that the website related to the Disputed Domain Name display an inactive page, although the Domain Name was registered more than four years ago.

Based upon the Complaint and its exhibits, in the Panel's view, it is clear that the Respondent does not enjoy any right on the word "Cointreau" and the actual use of the disputed domain name does not correspond to a bona fide offering of goods or services.

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of "sing-cointreau.com".

As to the third condition, the Complainant also proved that the Respondent has engaged in a pattern of conduct regarding bad faith domain name registration and use of domain names.

Given that the Complainant's marks have a strong reputation and are widely known (even in Japan), the Panel finds that it is likely that Respondent was aware of Complainant's trademark rights when it registered the Disputed Domain Name (WIPO Case N° 2088-1892).

The Panel also notes that the domain name is currently inactive for more than four years. In his opinion, said "passive use" with the other particular circumstances of this case, is deemed to be indicative of bad faith (WIPO Case N° 2006/0557).

Such circumstances are:

- the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the domain name;
- the Respondent did not answer to the Complainant's cease and desist letter before the proceeding and did not reply to the Complainant's contentions.

In the light of the above, and based on the sole Complaint and its exhibits, the Panel is convinced that the three requirements of the Policy are met in this case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **SING-COINTREAU.COM**: Transferred

PANELLISTS

Name	Mr. Etienne Wéry
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DATE OF PANEL DECISION	2013-03-20
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Publish the Decision
