Decision for dispute CAC-UDRP-100619

Case number	**CAC-UDRP-100619**
Time of filing	**2013-06-26 11:54:17**
Domain names	**topachats.info**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**RueDuCommerce**

Complainant representative

Organization	**CHAIN AVOCATS**

Respondent

Name	**Collin Marcel**

OTHER LEGAL PROCEEDINGS

NA

IDENTIFICATION OF RIGHTS

The Complainant has to the satisfaction of the panel shown themselves to be the owner of the following protected rights:
Registered trade/service mark
Registered in several countries
Well-known/famous mark

which are then further enunciated in the reason for the decision below

FACTUAL BACKGROUND

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

Factual and Legal Grounds
(Policy, paras. 4(a), (b), (c); Rules, para. 3)

The Complaint is based on the following grounds:

1. Background
The RueDuCommerce Company has been registered on April 27th, 1999 under the number B 422 797 720 R.C.S. BOBIGNY. Its head office is situated 44-50 Avenue du Capitaine Glarner – 93400 ST OUEN, FRANCE.

RueDuCommerce is the owner of a portfolio of Trademarks for the course of its internet-order selling business activities on web sites accessible in particular at the following address: www.topachat.com.

During more than eleven years RueDuCommerce has gained an important fame among the French net surfers and consumers. It is now a major e-merchant in France whose integrity and reliability are known from the Internet users.

Since 6 February 2009, date of the buyout of Top Achat's businesses by RueDuCommerce, it has notably in charge to watch over the protection of the following trademarks registered by the Top Achat Company:

The Complainant has registered the following trademarks in France:
• « TOP ACHAT », registered May 4th, 2004 under number 3289599, for goods and services class 10, 20 and 21.

• « TOPACHAT.COM », registered July 6th, 2011 under number 10103067, for goods and services class 9, 35, 36, 38, 41 and 42.

The Complainant has registered the following CTM:
• « TOP ACHAT », registered August 9th, 2004 under number 4034211, for goods and services class 11, 20 and 21.
• « TOP ACHAT », registered September 19th, 2002 under number 2827976, for goods and services class 9, 35, 36, 38, 41, 42 and 43.

The Complainant has registered the following international trademark:
• « TOP ACHAT », registered October 8th, 2004 under number 841118, for goods and services class 11, 20 and 21.

Proof of the trademarks owned by the Complainant were provided in the Annex of the Complaint.

During more than eleven years RueDuCommerce has gained an important fame among the French net surfers and consumers. It is now a major e-merchant in France whose honorability and reliability are known from the Internet users.

2. The disputed domain name is confusingly similar to trademark in which the Complainant have rights

The litigious domain name contains the two same joined words as the Complainant's protected trademark, with an addition at the end of the name of the letter "s".

The disputed domain name is almost identical to the registered trademarks of the Complainant.

Hence, the will of the Respondent to illegitimately copy the domain name is established without any possible doubt.

3. The disputed domain name has been registered by the Respondent without rights or legitimate interest in the name.

Internet inquiries as well as trademark database searches have not revealed any use or registrations by the Respondent that could be considered relevant.

The disputed domain name, "topachats.info" has been registered on February 11th 2013.

The RueDuCommerce Company reached the owner(s) of the domain name topachats.info :

- On February 19th, 2013 a recorded delivery mail addressed to,
M. Collin
Rue d'Angleur 88
4130 Tilff
BELGIUM

The domain name owner gave a first answer through his counsel on March 6th, 2013. Then, the RueDuCommerce Company sent a recorded delivery mail dated May 28th, 2013.

This exchange ended with a second letter from M. Collin's counsel on June 3rd, 2013.

According to the two letters from M. Collin, which use the same arguments, the RueDuCommerce Company has no rights on the domain name "topachats.info". M. Collin's counsel carries on saying that his client is only a mediator for a Chinese company.

However, M. Collins still appears as the owner of the disputed domain name on a whois of June 10th, 2013.

The RueDuCommerce Company also reached the registrar on February 19th, 2013, with a recorded delivery mail addressed to Host Master for which no answer was given.

Moreover, the website is not operated; nothing can be done on the website.

In fact, this nonuse of the domain name is passive holding with the aim to prevent from anyone, including trademarks owners, to be able to register the domain name "topachats.info" and use a corresponding domain name. This passive holding prevents the trademarks owner from using the rights conferred by his marks. It clearly appears the respondent is saving the domain name for himself without any rights or legitimate motivation.

Furthermore, the Respondent does not provide any elements to demonstrate, as requested by the Policy that it made preparations to use the disputed domain name in connection with a bona-fide offering of goods or services.

Accordingly, the Complainant submits that the disputed domain name is been registered without rights or legitimate interest in respect of the domain name.

4. The domain name is registered and being used in bad faith
(Policy, paras. 4(a)(iii), 4(b); Rules, para. 3(b)(ix)(3))

The domain name is registered and is used in bad faith. The purpose of the registration of the disputed domain name has been to prevent the Complainant, legitimate owner of TOPACHAT.com trademarks from reflecting the mark in a corresponding domain name while not exploiting the disputed domain name.

Indeed, UDRP rules provide several ways of establishing bad faith. One, on paragraph 4 (a) (ii) is where the domain name is used intentionally by the Respondent "in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct".

It appears that the disputed domain name was only registered in order to prevent Complainant from using the disputed domain name himself.

As the registrant of "topachats.info" has no legal right to use the Complainant trademarks', there is clearly bad faith in maintaining the domain name to the benefit of the Respondent.

UDRP rules provide other ways of establishing bad faith. One is where the domain name is inactive and is not being used.

The fact that the Respondent does not use the domain name and does not give any clue about the use it wished to make of the disputed domain name shows intention to prevent third parties from reflecting their trademarks in corresponding domain names.

The lack of satisfactory response from TOPACHATS.INFO forbid Complainant to seek damages against him.

Accordingly, the disputed domain name is registered in bad faith.

5. Conclusion

The Respondent has registered a domain name that is identical to the trademark registered and used by the Complainant. Only one neutral letter, “s”, has been added to the domain name, which does not change, nor the sonority, nor the look of RueDuCommerce trademark.

The domain name is infringing Complainant’s intellectual property rights, violating the UDRP rules registering and being used in bad faith. Additionally, the domain name is registered to prevent third parties from reflecting their trademarks in corresponding domain names.

Despite good faith attempts, the Complainant has not managed to find anything that would suggest that the Respondent has rights or legitimate interest in holding the domain name.

Accordingly, the Complainant respectfully submits that the disputed domain name is transferred to the Complainant, the RueDuCommerce Company.

PARTIES CONTENTIONS

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

Given that
1. the Complainant is the owner of trade mark "topachat.com" and that

2. the Complainant is actively using topachat.com for a legitimate range of activities that can be ascertained and which are evidenced in the attachments to the Complaint

3. the Complainant owns several tradmarks and communicates on the Internet through various websites worldwide; the main one is “topachat.com” (registered in 2004 and 2011), but the Complainant has also registered numerous domain names similar to trademark “topachat.com”

and that

4. the disputed domain name topachats.info has been registered on 11/02/2013 and that

5. there appears to be no legitimate reason or corresponding rights for which the Respondent could have registered the disputed domain name and that

6. there appears to be no legitimate reason for which the disputed domain name is currently being used and that the Domain Name has been registered in bad faith. In this latter respect the Panel is following the reasoning as adopted in UDRP Case 100540 Remy Martin vs. Jiang Yuanha, and specifically the reasoning previously cited in Thiercelin vs. MEDICALECPO.com as expounded in Telstra Corporation Limited v. Nuclear Marshmallows (telstra.org) which construed "use" broadly to include inactive use. It stated: "[P]aragraph 4(b) recognises that inaction (e.g. passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith." Passive holding is explicitly alleged by the Complainant and has also been closely looked at by the Panel which finds that one of the critical factors in this case is the lack of evidence of good faith use. If one is in good faith when registering a domain name, then the intention is understandably to use it for the purposes of one's business or activity. If it remains unused for an unreasonable length of time then such registration is open to accusation of constituting „passive holding“ Irrespective of whether the domain name was registered before or after some of the Complainant's marks, the current holder of the domain name does not seem to have used it or currently be using it. In fairness to all parties concerned, this Panel would have been prepared to consider, say, a case of genuine identical names established in different jurisdictions which just happened to be identical by pure co-incidence. In this case however we received no evidence which may have persuaded one that such was the case and when a TLD lies un-used for a length of time and this lack of use is then un-contested, the allegation of bad faith specifically made in this case regarding „passive holding“ remains un-challenged so on the balance of probability one is inclined to accept it. The panellist personally tried loading the domain (several weeks or months after the Complainant claimed to have done so) but to no avail. Had one found a genuine business there or some form of appropriate use then this decision would have been made more difficult. As it is, with no apparent good faith use and in a no response situation it is reasonable to accept the Complainant's allegation since no contrary evidence was received nor could one independently detect any proof to the contrary."

While no administratively compliant response was received from the Respondent, the Complainant had filed two letters received from the Respondent’s legal counsel in Liege, Belgium in the period February-June 2013 and which have also been examined by this Panel. The letters claimed that the Respondent was acting as an intermediary on behalf of a Chinese company but advanced no evidence for this assertion nor did they contain any evidence that either the Respondent or the alleged Chinese principal had any form of real or legitimate interest in using the TLD topachats.info. The site topachats.info remains unused to the date of delivering this decision (August 2013) thus strengthening the impression conveyed of bad faith and passive holding and serving solely to divert internet users who mispell a known name to an inactive web-site. This impression of this being a case of bad faith and passive holding is further reinforced by the fact that these letters from legal counsel on behalf of the Respondent made first an indirect and then a blatant direct attempt to sell the domain name to the Complainant first for the price of 6,000 Euro and then for a „discounted price“ of 4,000 Euro. This behaviour is inconsistent with that of a Respondent who had registered a domain name in good faith with the intention of using it for a legitimate business and this turned out to be an accidental or co-incidental similarity to the domain names in which the Complainant has proven legitimate rights.
In the light of the above, denying the use of the contested domain name to the Complainant would unreasonably prevent the trademarks owner from using the rights conferred by his marks and it is therefore reasonable and appropriate within the letter and intent of the UDRP rules that the complaint is accepted and domain name transferred to the Complainant.

The Panel finds the Complainant's contentions to be reasonable and upholds its request to have the disputed domain "topachats.com" transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TOPACHATS.INFO**: Transferred

PANELLISTS

Name	**Joseph Cannataci**

DATE OF PANEL DECISION 2013-08-09

Publish the Decision