Decision for dispute CAC-UDRP-100840

Case number	CAC-UDRP-100840
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Domain names	Monaco-grand-prix.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	AUTOMOBILE CLUB DE MONACO

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Organization	PLATINIUM GROUP

Respondent representative

Organization	CASALONGA AVOCATS

OTHER LEGAL PROCEEDINGS

No other legal proceedings related to the disputed domain name < MONACO-GRAND-PRIX.COM > are known to the Panel.

IDENTIFICATION OF RIGHTS

The Complainant has proved to be the owner of several registered trademarks amongst others:

1. MONACO GRAND PRIX (fig.), i.e. CTM 001725449 (Registration date 28/08/2001), CTM 002046472 (Registration date 20/06/2002) and CTM 004258877 (Registration date 28/01/2005).

These three CTMs consist respectively of the verbal elements in French language < MONACO GRAND PRIX > and the device elements consisting respective of stylized racing cars. These figurative marks are collectively registered for goods and services in classes 3, 4, 5, 8, 9, 11, 12, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 32, 33, 34, 35, 36, 38, 41, 42.

2. GRAND PRIX DE MONACO (verbal), IR 629519 with priority of the basic registration in Monaco (of 1994) for goods and services in classes 3, 12, 16, 18, 24, 25, 28, 34, 35, 42. This trademark has been granted protection in different countries (such as Benelux, Germany; additionally in France and Switzerland but limited to only some of the above goods or services).

FACTUAL BACKGROUND

The Complainant that was founded in 1890 is a car club based in Monaco and organizes the Formula 1 Grand Prix of Monaco (“Grand Prix de Monaco”) and the Monte-Carlo Rally.

The Respondent was founded in 1985 in Monaco and incorporates two main activities, i.e. a travel agency focused on business and high-end leisure travel and an e-commerce business specialised in ticketing for sports and entertainment events such as Formula One, MotoGP, Tennis, Golf, Motocross. It operates in over 30 countries and resells tickets which it purchased from event organizers and sells to individual consumers through its websites.

The disputed domain name < MONACO-GRAND-PRIX.COM > has been registered on 12 April 2005.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. According to the Complainant's allegations the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant further states that the Respondent is not affiliated with him nor authorized by him in any way and has no business relationship with the Complainant.

The Complainant further alleges that the Respondent is not commonly known by the <monaco-grand-prix.com> domain name but at best by its company name < PLATINIUM GROUP >.

Further, according to the Complainant, by using the domain name, the Respondent has intentionally attempted to attract for commercial gain internet users to its website(s) by creating a likelihood of confusion with the Complainant’s marks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the Respondent’s website or location.

Additionally, the Complainant alleges that the disputed domain name is not used for non-commercial use, because the use of the disputed domain name for a website, through which tickets are sold, trades on the Complainant's trademark.

2. The Complainant further contends that the disputed domain name has been registered in bad faith. It is confusingly similar to the Complainant's trademarks and used for the Respondent's own benefit in order to maximize the chances of visits of its website by the Internet users. In addition, the Complainant alleges that the Respondent uses the disputed domain name to offer for sale tickets of events organized by other Grand Prix and also further services such as hotel reservation services that are unrelated to the Complainant’s activity. In fact, the Complainant further states that the domain name is currently used for a website offering tickets for the Formula 1 Grand Prix of Monaco but also the others F1 Grand Prix as the Grand Prix of Germany, Hungary and Belgium.

The Complainant therefore requests the transfer of the disputed domain name.

RESPONDENT:

1. According to the Respondent, the disputed domain name is neither identical nor confusingly similar to the protected mark, because the terms used and their composition are different from the Complainant’s trademarks. Furthermore, the Complainant’s trademarks are allegedly composed of descriptive terms for a Formula One race in Monaco.

2. In addition, the Respondent alleges that it has rights and/or legitimate interest in the domain name.

According to the Respondent, it only uses the website under the disputed domain name to sell and provide only tickets and services in relation with the Formula 1 race taking place in Monaco and with the Principality of Monaco. Furthermore, the Respondent alleges to be authorized by the Complainant to sell official tickets for the Grand Prix de Monaco that it purchases from the Complainant, being the organizer of the Formula 1 race.

For this purpose, the Respondent accepts and sends back each year the applicable general terms and conditions of the Complainant. Only after that it purchases the tickets for the Grand Prix de Monaco-event from the Complainant in order to officially resell them, as it has been doing for many years through its website under the disputed domain name.

Accordingly, the Complainant is fully aware of the Respondent's activities.

3. In addition, the Respondent claims not to use the disputed domain name in order to maximize the chances of visits of its website but to use the disputed domain name merely in its generic meaning to describe its own activity, which differs from the Complainant's. Additionally, the Respondent claims not to present itself as being the trademark owner but to act under its trade names. Indeed, any correspondence with consumers is made under the name of GOOTICKETS.COM / PLATINIUM GROUP.

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).

1. The Panel agrees with the Respondent that there are noticeable differences between the disputed domain name < MONACO-GRAND-PRIX.COM > and the trademarks < GRAND PRIX AUTOMOBILE DE MONACO > and < GRAND PRIX DE MONACO HISTORIQUE > invoked by the Complainant. However, it is not necessary to come to a final conclusion on whether or not there is actually lack of confusing similarity between those marks and the disputed domain name due to these differences because the Panel concludes that the disputed domain name is confusingly similar to the Complainant's further trademarks < MONACO GRAND PRIX (fig.) >:

2. In fact, the Complainant has been able to demonstrate that it owns – amongst others – rights to several registered figurative trademarks consisting respectively of the verbal elements < MONACO GRAND PRIX > (in French language) that are clearly separated from the respective device element of stylized racing cars (i.e. CTMs 001725449, 002046472, 004258877). These figurative marks are collectively registered for a variety of goods and services in many classes. Furthermore, the Complainant is the registered owner of a word mark < GRAND PRIX DE MONACO > registered as international trademark no. 629519 in different countries including French speaking countries for goods and services in different classes.

a) The disputed domain name consists of the term < MONACO-GRAND-PRIX.COM >. Firstly, this Panel notes that according to settled case law the hyphenation of a trademark in a domain name does not eliminate the identity or confusing similarity with the mentioned trademark. The same applies to the top-level suffix <.com> which is to be disregarded under the confusing similarity test as it is a technical requirement of registration.

b) Furthermore, this Panel considers itself, as a rule, bound by the registration of the above trademarks < MONACO GRAND PRIX (fig.) > that have respectively been the result of ex officio examinations on absolute grounds for refusal in different countries, including French speaking countries. Therefore, these registered trademarks generally satisfy the threshold requirement of the Complainant having trademark rights.

However, it is true that some Panels have opted to examine the circumstances of trademark registration in considering whether the registration satisfies UDRP requirements. In certain cases, where the trademark consists of a word plus device

element in which the design element is found to be the sole source of distinctiveness due to the merely descriptive character of its verbal elements, such registration alone may be insufficient to enable the Complainant to establish relevant rights for standing purposes under the UDRP.

However, with regard to the figurative trademarks < MONACO GRAND PRIX (fig.) > this Panel does not consider - in consideration of the registered variety of goods and services - that their only distinctive element is the device element consisting of respectively different stylized racing cars. While alleging a clearly descriptive character of the marks invoked by the Complainant for the Formula One race taking place in Monaco once a year, the Respondent did not bring forward any argument to support that these marks < MONACO GRAND PRIX (fig.) > lack distinctive character for all other registered goods and services.

This Panel further takes note of the fact that also the word mark < GRAND PRIX DE MONACO > has been registered in French speaking and other countries through the Madrid system for a variety of goods and services. At least from a conceptual point of view this mark is (almost) identical to the verbal elements < MONACO GRAND PRIX > contained in the three device marks < MONACO GRAND PRIX (fig.) >.

Therefore, if the word mark < GRAND PRIX DE MONACO > has not even been considered as merely descriptive for a variety of goods and services in French speaking countries, this Panel has no reason to state that the verbal elements < MONACO GRAND PRIX > are merely descriptive for identical/similar goods and services either.

Consequently, the condition of paragraph 4(a)(i) of the Policy is fulfilled.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, not 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).

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the disputed domain names by demonstrating any of the following:

(i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

1. The dispute settlement procedure established by the UDRP-Policy is summary in nature; yet it can only lead to the Respondent's domain name being transferred to the Complainant when there has been a finding of lack of rights or legitimate interest on the Respondent's part within the meaning given to that term in Paragraph 4(a)(ii), 4(c) of the Policy. It follows that the Complaint should be found substantiated only when a case is sufficiently made out against a Respondent.

This is not the case in the case at hand, since the Complainant has not to the satisfaction of this Panel demonstrated the lack of Respondent’s rights or legitimate interest. The Panel makes this finding for the following reasons:

2. The Complainant alleges amongst others that the Respondent is not affiliated with the Complainant who did – allegedly – not authorize the Respondent in any way to register and use the disputed domain name. This Panel notes that the Complainant did not support this allegation by any substantial evidence. In particular the Complainant did not mention any correspondence between the parties regarding the disputed domain name and its use and provided no explanation as to why it did only now tray to challenge the disputed domain name that has been registered nine years ago (in 2005).

This Panel further notes, that while the Complainant brings forward arguments with regard to paragraph 4(c)(ii) and (iii) of the Policy, it did not explicitly discuss paragraph 4(c)(i) of the Policy. Yet the Respondent - for its part - provided several documents showing that Respondent's activity consists amongst others in reselling official tickets for the Grand Prix de Monaco Formula 1 Race that it has previously and officially purchased directly from the Complainant. In support of its allegations the Respondent provides different documents, such as (1) a Booking confirmation dated 10 December 2013 issued by the Complainant to the Respondent for the GRAND PRIX D'AUTOMOBILE MONACO 2014 amounting to 196.120 EUR and (2) the Complainant's General Terms and Conditions duly countersigned and accepted by the Respondent for the GRAND PRIX D'AUTOMOBILE MONACO in the years 2009, 2010 and 2011. Finally, the Respondent provided an additional document that contains information that this Panel considers equally important, i.e. a letter dated 21 October 2009 sent by the Respondent to the Complainant seeking its approval to use specific supporting material (such as a circuit graphic, official posters, photographs of the race etc.) on the website available under the disputed domain name. The Panel finds these documents to be credible and consistent with the limited record available in this UDRP proceeding.

3. Taking into account these documents provided by the Respondent this Panel is satisfied that the parties have actually been conducting business together at least in the years 2009, 2010, 2011 and 2013. It is furthermore satisfied that the Complainant has positively been aware - at least since 2009 - of the disputed domain name (that has been registered already in 2005) and its use by the Respondent in line with this established business relationship between the parties.

In the light of the above and in the absence of any evidence to the contrary, this Panel holds that the Complainant did not prove a lack of rights or legitimate interests of the Respondent. In particular the Complainant did not provide the Panel with any evidence as to its view on the contractual or factual relationship between the parties. It rather limited itself to the mere and unproved allegation – amongst others – that it did not authorize the Respondent in any way to use the disputed domain name. In particular, the Panel would have been interested in evidence on the Complainant's (eventual) reaction to the above mentioned letter dated 21 October 2009 in which the Respondent contacted the Complainant with regard to the disputed domain name, since the absence of any reaction could be interpreted as an implicit approval to provide the supporting material on the website and therefore a fortiori an implicit authorization to also use the domain name.

4. This Panel does not ignore that Paragraph 4(a)(ii) of the Policy requires the Complainant to prove a negative, namely that the Respondent has no rights or legitimate interests in respect of the Domain Name and that this proof can often be a difficult matter for a Complainant to establish. Therefore, while the overall burden of proof rests with the Complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the Respondent. As a consequence, a Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, a Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interest, the Panel then weighs all the evidence, with the burden of proof always remaining on the Complainant (see Paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition - WIPO Overview 2.0).

Weighting all the evidence before it, this Panel concludes that the Complainant failed to meet its burden of proof and failed to make out a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name under paragraph 4(c)(i) of the Policy. The Complainant did rather not provide any evidence as to paragraph 4(c)(i) while the evidence provided by the Respondent gives well founded indications that it actually used the disputed domain name < MONACO-GRAND-PRIX.COM > in connection with a bona fide offering of goods or services and with the Complainant's knowledge at least since 2009.

BAD FAITH

Since the Complainant has, to the satisfaction of the Panel, not shown the Respondent to have no rights or legitimate interests in respect of the Domain Name there is no need for the Panel to examine the third UDRP-element (bad faith).

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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **MONACO-GRAND-PRIX.COM**: Remaining with the Respondent

PANELLISTS

Name	**Dr. Tobias Malte Müller**

DATE OF PANEL DECISION 2014-09-24

Publish the Decision