Decision for dispute CAC-UDRP-100856

Case number	CAC-UDRP-100856
Time of filing	2014-09-18 15:54:52
Domain names	code-promo-rueducommerce.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	RueDuCommerce

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Organization	FUNDATION PRIVATE WHOIS

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of different trademark registrations for "RUE DE COMMERCE". In particular RueDuCommerce owns:

French Registration for "RUE DU COMMERCE" no. 3036950 registered on June 27, 2000 and duly renewed for classes 09, 16, 28, 35, 38, 41 and 42;

CTM Registration for "RUE DU COMMERCE" no. 8299356 registered on February 23, 2011 for classes 09, 16, 35, 36, 37, 38, 41 and 42;

International Registration for "RUE DU COMMERCE" no. 754897 registered on November 15, 2000 and duly renewed for classes 09, 16, 28, 35, 38, 41 and 42;

FACTUAL BACKGROUND

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

The Complainant, RueDuCommerce, is a French Company regularly registered in France since the year 1999.

The Complainant is the owner of a portfolio of trademarks consisting of or including the wording "RUE DU COMMERCE". The above mentioned trademarks are used in order to distinguish the business of RueDuCommerce consisting of internet-selling activities carried out through its web sites connected to its domain names <rueducommerce.com> and <rueducommerce.fr>.

RueDuCommerce has gained an important notoriety among the French net surfers and consumers and at present time it is a major e-merchant in France whose honorability and reliability are well known from the Internet users.

The disputed domain name <code-promo-rueducommerce.com> registered by Respondent is confusingly similar to "RUE DU COMMERCE" trademark in which the Complainant has rights since said domain name fully incorporates the Complainant's trademark, with the mere addition of the generic prefix “code-promo”.

The addition of the prefix “code-promo” is a way to attract customers and take advantage of the notoriety of the mark "RUE DU COMMERCE". Actually Internet users will believe that the domain name “code-promo-rueducommerce.com” is linked to or authorized by RueDuCommerce.

Moreover, according to the Complainant's statement, the domain name in dispute for a certain period redirected automatically to the website of RueDuCommerce (even if no evidences of such a use have been submitted) in order to create visits and take advantage from it. Currently the domain name in dispute is linked to an inactive web site.

The Complainant has never licensed or otherwise permitted the Respondent to use his brand or to apply for domain name incorporating it. Furthermore, Respondent has no right on the wording RUE DU COMMERCE and it is not known with a name corresponding to the above wording.

The Complainant tried to reach the owner of the domain name in dispute both by a recorded delivery and by email. The recorded delivery (sent twice) was sent back to the Complainant and the email was never answered.

It must be noted that the Respondent has registered the litigious domain name on February 19, 2014 and, therefore after the registration of the trademarks by the Complainant. The Respondent was therefore able, at the time of the domain name registration, to know the Complainant’s trademark and the infringement to intellectual property rights he was committing by registering this domain name.

According to Respondent's view, it cannot be disputed that the Complainant has well-recognized rights and goodwill in its "RUE DE COMMERCE" mark in connection with Internet selling. The <code-promo-rueducommerce.com> domain name is confusingly similar to the Complainant’s "RUE DE COMMERCE" mark. The Respondent has no legitimate rights in the <code-promo-rueducommerce.com> domain name.

Finally, at present time the domain name in dispute results inactive. According to UDRP rules the circumstance that the domain name is inactive ("passive holding") may be considered as a clear evidence of bad faith.

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

A) The disputed domain name <code-promo-ruedecommerce.com> combines three elements: (1) the wording "rueducommerce" preceded by (2) the wording "code-promo-" and (3) the top level domain name .com. The relevant comparison to be made is with the portion of the domain name "rueducommerce". Actually, it is well established that the top-level domain name (i.e., ".com") should be disregarded for this purpose (see, between many others, Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006 0561). Furthermore, the prefix "code-promo-" does not distinguish the disputed domain name from Complainant's RUE DE COMMERCE mark. (see Samsung Electronics Co.; Ltd v. Albert Daniel Carter, WIPO Case. No. D2010-1367 in which it was stated that "promo" is a descriptive element consisting of an abbreviation for "promotion" or "promotional items" and therefore it is not sufficient to distinguish the domain name in dispute from the Complainant's mark). Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks "RUE DU COMMERCE".

B) The Complainant has long standing rights in the mark "RUE DU COMMERCE". The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized to use the domain name by the Complainant. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant has not licenced or otherwise permitted the Respondent to use the Complainant's marks in the disputed domain name. On the basis of the evidences submitted and in the absence of a response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C) The Respondent was or must have been perfectly aware of the existence of "RUE DU COMMERCE" trademark, which is distinctive and unique for the registered goods and services, when it registered the domain name <code-promo-ruedecommerce.com>. Therefore, when considering this, in conjunction with the fact that the Respondent has been passively holding the disputed domain name and has not submitted any evidence suggesting that the disputed domain name was selected for a legitimate use or purpose, an inference of bad faith registration and use is made by the Panel (see, between many others, Incipio Technologies, Inc. v.Starfield Services Ltd, WIPO Case No. D2011-0418).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CODE-PROMO-RUEDUCOMMERCE.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2014-10-28

Publish the Decision