Decision for dispute CAC-UDRP-100866

Case number	CAC-UDRP-100866
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Domain names	rdecommerce.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	RUEDUCOMMERCE

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Organization	REUSSER DESIGN, LLC

OTHER LEGAL PROCEEDINGS

None that the Panel has been made aware of.

IDENTIFICATION OF RIGHTS

The Complainant relies on ownership of the following trade marks:

French Trade Marks:

- WWW.RUE DU COMMERCE.COM, registered on 29 July 2005 under number 3374566 for goods and services in class 9, 16, 28, 35, 38, 41, 42;
- RUE DU COMMERCE, registered on 27 June 2000 under number 3036950, for goods and services in class 9, 16, 28, 35, 38, 41 et 42; and
- RDC.fr Rue du Commerce, registered on 28 July 1999 under number 99805150, for goods and services in class 35, 38, 42.

Community Trade Marks:

- RUE DU COMMERCE.COM, registered on 14 May 2009 under number 8299381 for goods and services in class 16, 35, 36, 37, 38, 41, 42;
- RUE DU COMMERCE, registered on 14 May 2009 under number 8299356 for goods and services in class 16, 35, 36, 37, 38,

41, 42; and
- RUE DU COMMERCE, registered on 25 July 2013 under number 12014833 for goods and services in class 9, 16, 35, 36, 37, 38, 41, 42.

FACTUAL BACKGROUND

The Complainant was founded in 1999 and sells goods online, focusing mainly on the French market. The domain names <rueducommerce.fr> and <rueducommerce.com> point to its main website at www.rueducommerce.fr.

The Respondent is a web development and design agency based in Northeast Indiana, USA. It was founded by its President, Nate Reusser, in 1999.

The Respondent registered the disputed Domain Name on 15 April 2006. It is not currently pointing anywhere.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Identical or confusingly similar

According to the Complainant, the similarity between the disputed Domain Name and the Complainant's trade marks is illustrated on three levels:

(i) Visually, the disputed Domain Name partly incorporates the RUE DU COMMERCE trade mark by using the prefix "rde" instead of "ruedu". The sign "rde" is a contraction of "ruedu". The suffix "commerce" remains the same and the disputed Domain Name uses the same extension (".COM") as RueDuCommerce.com.

(ii) Conceptually, only three letters distinguish the name "rdecommerce" from "RueDuCommerce" and the spirit of the text is unaffected by the absence of these three letters.

(iii) Phonetically, the sound of the name "rdecommerce" is equivalent to that of "RueDuCommerce".

The Complainant argues that the number of similarities is likely to create confusion in the public mind. According to the Complainant, internet users are legitimately entitled to believe that the website at www.rdecommerce.com belongs to the Complainant or at least that they are economically linked.

In the Complainant's opinion, this choice demonstrates the bad faith of the Respondent and increases the likelihood of confusion.

No rights or legitimate interests

First, the Complainant states that it has not licensed or otherwise permitted the Respondent to use its brand or to apply for or use any domain name incorporating it. The Complainant's internet inquiries as well as trade mark database searches have not revealed any use or registrations by the Respondent that could be considered relevant.

The Complainant points out that it tried to reach the owner of the disputed Domain Name by sending two letters (by email and recorded delivery) to the Respondent and to the registrar on 31 July and 22 August 2014. The Respondent replied on 26 August 2014 stating its refusal to transfer the disputed Domain Name for free and suggesting that the Complainant made a formal offer.

Secondly, the Complainant states that the disputed Domain Name is not used for an active web site, and furthermore the

Respondent has not demonstrated that it has made preparations to use it in connection with a bona fide offering of goods or services, as required by the Policy.

Registered and used in bad faith

The Complainant argues that the Respondent registered the disputed Domain Name after the registration of the Complainant's trade marks. In the Complainant's opinion, the Respondent "was therefore able, at the time of the registration, to know the Complainant’s trademark and the infringement to intellectual property rights he was committing by registering this domain name."

In the Complainant's opinion, the Respondent's proposal to sell the disputed Domain Name demonstrates bad faith and establishes that it was registered primarily for the purpose of harming the Respondent and to make a profit.

According to the Complainant, nothing on the website suggests that the Respondent is making a legitimate commercial or non-commercial business use of the disputed Domain Name because it has never been used and it is not currently being used.

The Complainant argues that paragraph 4(b) of the Policy recognises that inaction in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith.

The Complainant states that the main purpose of the registration of the disputed Domain Name was to prevent the Complainant from reflecting its brand in a corresponding domain name while it was not being exploited as per paragraph 4(b)(ii) of the Policy: "you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct."

According to the Complainant, this non-use of the disputed Domain Name is perceived as an act of "passive holding" which prevents the Complainant from registering its rightfully owned trade mark as a domain name. In the Complainant's opinion, as the Respondent has no legal right to use the Complainant’s trade mark, there is clearly bad faith in maintaining the disputed Domain Name for the Respondent's benefit.

Accordingly, the Complainant requests that the disputed Domain Name be transferred to the Complainant.

RESPONDENT:

The Respondent states that the Complainant cannot prove that consumers and users would be inclined to type <rdecommerce.com> instead of <rueducommerce.com>, and asserts that the fact that the Respondent owns and uses the disputed Domain Name has no impact on the Complainant's business in any way.

The Respondent explains that in 2006 it needed a way to demonstrate eCommerce software to both prospective and existing clients. It therefore purchased the disputed Domain Name, which was short for "Reusser Design eCommerce" (some of its clients refer to it as simply "RD").

The Respondent says that it then set up its eCommerce Software powered by ProductCart using the disputed Domain Name and referred to it in its proposals and training material. The Respondent also claims to have used the website in question and the disputed Domain Name for the latest software patches to make sure that new releases were stable for its clients before migrating them to their respective websites.

The Respondent adds that recently the software in question has been replaced and it has been using two different eCommerce systems. The Respondent states that it hasn't had time to set up a new demonstration website using the disputed Domain Name, which is why the corresponding website hasn't been updated. However, the Respondent says that it does have plans to roll out both Magento and CartThrob software packages using the disputed Domain Name in the future.

The Respondent states that in the Complaint it looks as though the Respondent has just bought the disputed Domain Name and parked it to prevent the Complainant from owning it. However, the Respondent argues that this couldn't be further from the truth and assets that it has actively used the disputed Domain Name as part of its business services.

In addition the Respondent states that it was not aware of the Complainant when it purchased the disputed Domain Name and nor was it trying to infringe on any trade marks.

In conclusion, the Respondent states that it contacted the Complainant's lawyer and stated that it would be willing to sell the disputed Domain Name to the Complainant if it was interested in purchasing it, and the Respondent would then use a different domain name to demonstrate its eCommerce software to its clients. However, there was no response from the Complainant or its lawyer.

Finally the Respondent states that it believes that it has every right under ICANN policies to have purchased the disputed Domain Name and to use it for its business purposes.

COMPLAINANT'S SUPPLEMENTAL FILING

The Complainant points out that the Respondent has not produced any exhibits in support of its Response and argues that the Respondent has not proved that the disputed Domain Name has been used and will be used again.

The Complainant states that the Respondent's assertion that it had never heard of the Complainant is very surprising, given that the Complainant became a publicly listed company in 2005, a year before the purchase of the disputed Domain Name.

The Complainant asserts that the Respondent's confirmation that it would sell the disputed Domain Name to the Complainant clearly demonstrates its bad faith.

The Complainant also argues that the Respondent’s argumentation is contradictory because on the one hand the Respondent states that it is well-known by its clients under the disputed Domain Name and that it plans to use it again in the near future, but on the other hand the Respondent states that it would sell the disputed Domain Name to the Complainant, in which case it would use a different domain name to demonstrate its eCommerce software to its clients.

RIGHTS

The Complainant has shown, to the satisfaction of the Panel, that the disputed Domain Name is confusingly similar to a trade 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 not shown, to the satisfaction of the Panel, that the Respondent has no rights or legitimate interests in respect of the disputed Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has not shown, to the satisfaction of the Panel, that the disputed 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 the Policy were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following for a panel to order a transfer of the domain name at issue:

(i) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(ii) the respondent has no rights or legitimate interests in the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

Taking each of these issues in turn, the Panel decides as follows:

A. Identical or Confusingly Similar

Based on the evidence put forward by the Complainant, the Panel finds that the Complainant has trade mark rights in the term RUE DU COMMERCE.COM (Community Trade Mark number 8299381).

The disputed Domain Name does not contain the first letters "U" and "E" of the Complainant's trade mark and the second letter "U" has been substituted for an "E". Thus on a very basic level the disputed Domain Name and the Complainant's trade mark could be said to be confusingly similar, especially given the fact that it is generally accepted that the test for confusing similarity is a very low, threshold test, designed simply to assess whether a complainant has standing to bring a complaint under the Policy.

On the basis of these considerations, the Panel finds that the disputed Domain Name is confusingly similar to a trade mark in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The second element that the Complainant must prove is that the Respondent has no rights or legitimate interests in respect of the disputed Domain Name (Policy, paragraph 4(a)(ii)).

Paragraph 4(c) of the Policy sets out various ways in which a respondent may demonstrate rights or legitimate interests in the domain name at issue, as follows:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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."

The Respondent's Response is very brief and in it the Respondent argues that it fulfils both 4(c)(i) and (ii), although, as the Complainant points out in its supplemental filing, no evidence of this is supplied.

Incidentally, there is no provision in the Policy for either party to make an unsolicited supplemental filing, and such filings are usually only admitted in exceptional cases. A complainant would normally need to demonstrate why the supplemental filing is relevant and why it was unable to provide that information in the original complaint. In this case, the Complainant's supplemental filing was very short and so the Panel did consider it, but concluded that none of the information contained therein was new or indeed merited a supplemental filing. However, it did not affect the outcome of the case and so it was

unnecessary to give the Respondent an opportunity to respond.

Despite the fact that the Respondent did not supply any evidence to support its claims, the Panel finds in the Respondent's favour. The Complainant's case did not contain any concrete evidence to prove, on balance of probabilities, that the Respondent registered the disputed Domain Name with the Complainant in mind simply to profit in some way from the Complainant's fame. In other words, nothing in the Complainant's submissions was sufficient to convince the Panel that this is a case of cybersquatting.

In effect, the Panel is faced with two conflicting versions of events, neither of which is backed up by any hard evidence, and finds the Respondent's explanation to be the most plausible for the following reasons:

- The Complainant asserts that the Respondent must have heard of the Complainant when it registered the disputed Domain Name in 2006, but the Respondent denies this. It must not be forgotten that the Complainant focuses on the French market and has no presence or trade marks in the USA where the Respondent is based. Thus the Panel is convinced that the Respondent is being honest in stating that it had never heard of the Complainant when it registered the disputed Domain Name.

- The Complainant also seems to be arguing that, if the Respondent had not heard of the Complainant at the time of registration, the Complainant already had some French registered trade marks and thus the Respondent should have been aware of this. In the Panel's opinion, this would be incorrect even if the disputed Domain Name directly mirrored one of the Complainant's trade marks, as prospective domain name registrants in the USA who plan to target clients in the USA cannot be expected to check trade mark registries the world over to ensure that a proposed domain name does not match any of them. In this case, this suggestion is even more far fetched given that the string in question is not <rueducommerce> but <rdecommerce>, which isn't even a particularly obvious typo, given that two letters have been missed out entirely and one altered completely.

- Turning to the plausibility of the Respondent's assertions, in 2006 the notion of "eCommerce" was certainly very popular, and the Panel finds it entirely believable that the Respondent would have registered this term preceded by its initials for use as part of its website design business. It is generally accepted that a panel may undertake limited factual research into matters of public record if it deems this necessary to reach the right decision, and so the Panel briefly checked the information publically available at www.archive.org and noted that on 2 February 2011 the disputed Domain Name was being used to redirect to the website at www.rd-ecommerce.com. This website did indeed appear to demonstrate eCommerce software for online shops. The public Whois of the domain name <rd-ecommerce.com> indicates that it was registered by the Respondent on the same day as the disputed Domain Name and is indeed still owned by it. This information clearly confirms the Respondent's assertions, although even without it the Panel would have been convinced.

Given the above, the Panel finds that the Respondent has rights or legitimate interests in the disputed Domain Name and that paragraph 4(a)(ii) of the Policy is not satisfied.

C. Registered and Used in Bad Faith

The third element that the Complainant must prove is that the disputed Domain Name has been registered and is being used in bad faith (Policy, paragraph 4(a)(iii)).

Paragraph 4(b) of the Policy sets out various circumstances which may be treated by the Panel as evidence of the registration and use of a domain name in bad faith, as follows:

"For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark

or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The Complainant seems primarily to rely on 4(b)(ii), but the Panel cannot see how this has been made out. First, for the reasons stated in section B. above, the Panel does not believe that the Respondent registered the disputed Domain Name to prevent the Complainant from reflecting its trade mark in a corresponding domain name (mainly because it seems unlikely that the Respondent had ever heard of the Complainant, but also because the disputed Domain Name does not actually reflect the Complainant's trade mark, only a rather unobvious typo). Secondly, paragraph 4(b)(ii) requires the Respondent to have engaged in a pattern of such conduct, but the Complainant has supplied no evidence of this, and nothing would indicate to the Panel that the Respondent is a serial cybersquatter with a number of problematic domain names.

The Complainant also tries to assert that the Respondent's offer to negotiate the sale of the disputed Domain Name in some way implies bad faith. In the Panel's opinion, such an assumption would have been plausible had the Respondent made an unsolicited approach to the Complainant with an offer of sale, but in this case the offer to negotiate only came in response to the Complainant's cease and desist letter. It therefore cannot be inferred that the Respondent registered the disputed Domain Name primarily for the purpose of selling it, as per paragraph 4(b)(i) of the Policy. The Panel finds no contradiction in the Respondent's assertion that it plans to use the disputed Domain Name in the near future but yet would be prepared to sell it and use another domain name instead – it is understandable that the Respondent would sell if offered enough money and it would not be difficult for the Respondent to find another suitable domain name to demonstrate eCommerce software, indeed the Respondent already owns <rd-ecommerce.com>, as referred to above.

The Complainant also seems to argue that non use alone is enough to demonstrate the Respondent's bad faith, and that the Policy provides for this. Whilst passive holding isn't expressly referred to by the Policy, previous panels have found this to indicate bad faith, but only in particular circumstances, and notably when the trade mark at issue is so famous that it is not possible to conceive of any possible good faith use (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). This case is not comparable.

The Panel therefore finds that the disputed Domain Name has not been registered and is not being used in bad faith and that paragraph 4(a)(iii) of the Policy is not satisfied.

For all the foregoing reasons, the Panel orders that no action should be taken in respect of the disputed Domain Name and the Complaint is denied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **RDECOMMERCE.COM**: Remaining with the Respondent

PANELLISTS

Name	**Jane Seager**

2014.12.21

DATE OF PANEL DECISION 2014-12-31

Publish the Decision