Decision for dispute CAC-UDRP-100873

Case number	CAC-UDRP-100873
Time of filing	2014-11-12 11:44:55
Domain names	rueducommercerd.biz

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	RUEDUCOMMERCE

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Organization	SHELDON WILDER

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant company name consists of the denomination “RueDuCommerce” which forms the distinctive part thereof.

In addition the Complainant is the registered holder of, inter alia, the following trademarks:

(i) WWW.RUE DU COMMERCE.COM (combined), French national trademark, application and registration date 29 July 2005, application no. 3374566, registered for goods and services in classes 9, 16, 28, 35, 38, 41, 42;

(ii) RUE DU COMMERCE (combined), French national trademark, application and registration date 27 June 2000, application no. 3036950, registered for goods and services class 9, 16, 28, 35, 38, 41 et 42;

(iii) RUE DU COMMERCE.COM (word), Community trademark (CTM), application date 14 May 2009, registration date 24 February 2011, application and registration no. 8299381, registered for goods and services in classes 16, 35, 36, 37, 38, 41, 42;

(iv) RUE DU COMMERCE (word), Community trademark (CTM), application date 14 May 2009, registration date 24 February

2011, application and registration no. 8299356, registered for goods and services in classes 16, 35, 36, 37, 38, 41, 42.

Moreover, the Complainant operates an electronic marketplace and e-shop under the domain names RUEDUCOMMERCE.FR and RUEDUCOMMERCE.COM; both these domain names are also owned by the Complainant.

FACTUAL BACKGROUND

The Complainant was registered as a company on 27 April 1999 under the number B 422 797 720 R.C.S. BOBIGNY. Its head office is situated 44 Avenue du Capitaine Glarner, 93400 ST OUEN – FRANCE.

The Complainant 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 addresses www.rueducommerce.com and www.rueducommerce.fr.

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

The Complainant is a holder of various registered national, international (WIPO) as well as community trademarks (CTMs) that consist of the denomination RUE DU COMMERCE or RUE DU COMMERCE.COM, as described in more detail above.
The disputed domain name was registered on 26 July 2014.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims that the disputed domain name is confusingly similar to its trademarks (as listed above), since it incorporates RUE DU COMMERCE denomination which forms the dominant parts of the said trademarks. The Complainant namely asserts that inclusion of the non-distinctive letters “rd” into the disputed domain name (after the distinct element “rue du commerce”) cannot prevent confusing similarity between the disputed domain name and the said trademarks.

The Complainant contends that, as a result, the disputed domain name alone as well as any website which may be under it creates an overall impression that they are connected to the Complainant’s trademarks and its business.

The Complainant also presents facts and evidence to show that the disputed domain name has been registered and used in bad faith and that the Respondent has no rights or legitimate interest to the disputed domain name, in particular because it does not use the disputed name in in any manner and failed to respond to various requests and correspondence addressed to it in relation to the disputed domain name.
In this respect, the Complainant has presented to the Panel the following evidence, which has been assessed by the Panel:

- Printout of the registered trademarks “RUE DU COMMERCE”

- Recorded delivery mail and email from Cyril CHABERT (counsel to Complainant) to SHELDON WILDER (Respondent) dated on 29 July 2014

- Emails from Cyril CHABERT to CONFLUENCE NETWORKS and PUBLIC DOMAIN REGISTRY PTY LTD dated on 31 July 2014

- Recorded delivery mail and email from Cyril CHABERT to SHELDON WILDER dated on 22 August 2014

- Emails from Cyril CHABERT to CONFLUENCE NETWORKS and PUBLIC DOMAIN REGISTRY PTY LTD dated on 22 August 2014

- Recorded delivery mail and email from Cyril CHABERT to PUBLIC DOMAIN REGISTRY PTY LTD dated on 18 September 2014

- Printout of the screenshot of the website www.rueducommercerd.biz dated 4 August 2014 and 18 September 2014.

RESPONDENT:

The Respondent has not provided any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("UDRP" or "Policy").

For details, see "Principal Reasons for the Decision".

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).

For details, see "Principal Reasons for the Decision".

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).

For details, see "Principal Reasons for the Decision".

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

CONFUSING SIMILARITY WITH COMPLAINANT'S RIGHTS

Since the domain name and the Complainant's trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of to a certain level generic term "RUE DU COMMERCE" accompanied by a suffix "RD" is confusingly similar to the Complainant's trademarks "RUE DU COMMERCE" or "RUE DU COMMERCE.COM".

Having in mind the complexity of this issue, the Panel below reveals in detail its considerations and findings:

(i) Existing Case Law
In decisions by various panels constituted under the UDRP process to resolve domain name disputes, there has been discussion of what constitutes confusion for the purposes of paragraph 4(a)(i) where registered trademarks and domain names already in use had been joined together with generic prefixes or suffixes to form a new domain name (sometimes

referred to as a derivative).

Although the panel is well aware that the principle of stare decisis does not apply in these proceedings and that it is not bound by decisions reached by earlier panels, it is of the opinion that a review of some the cases provides some support for the conclusions of this decision.

(i) (a) Prefix or Suffix Case Law

There are a number of other decisions within the UDRP process which have addressed the issue of whether a domain name, which comprises the Complainant's mark together with a prefix or suffix, gives rise to confusing similarity.
The decisions fall mainly into two categories: 1) addition of a geographical suffix to a well-known domain name (see, for example, Wal-Mart Stores, Inc. v Walmarket Canada, WIPO D2000-0150; Wal-Mart Stores, Inc. v Walsucks and Walmarket Puerto Rico, WIPO D2000-0477; AltaVista Company v S.M.A. Inc., WIPO D2000-0927), or 2) addition of "sucks" to a similarly well known name (see, for example, Dixons Group Plc v Purge I.T. and Purge I.T. Ltd., WIPO D2000-0584; Cabela's Inc. v Cupcake Patrol, NAF FA0006000095080; Wal-Mart Stores, Inc. v Walsucks and Walmarket Puerto Rico, WIPO D2000-0477).

The Complainant has typically prevailed in both types of categories.

Decisions in the former category have been disposed of generally on the clearly correct basis that the addition of a place name is not likely to alter the underlying mark (Wal-Mart Stores, Inc v Walsucks and Walmarket Puerto Rico, WIPO D2000-0477) and not likely to change the fact that consumers will be confused.

Decisions in the second category have been decided for on the basis of similar reasoning, though this seems more open to dispute. There are a number of other decisions where there is neither a geographical, nor derogatory addition (see, for example, Yahoo!, Inc. and Geocities v Cupcakes et al., WIPO D2000-0777; Yahoo!, Inc. v Cupcake Patrol et al., WIPO D2000-0928). These too have followed similar reasoning, though the finding of confusing similarity is largely based in these cases on evidence of demonstrated confusion amongst consumers.

The disputed domain name which is the subject of this administrative decision does not fall into either the geographical or "sucks" category, but at first blush the same principle would appear to apply: the addition of a suffix does not alter the underlying mark and confusion will inevitably result.

It is here that the Complainant's idea of 'genericness' comes into play. The other decisions dealt with either extremely well known marks, which had a high degree of inherent or acquired distinctiveness: for example, Walmart, Standard Chartered, Dixons, Altavista and Yahoo, or at least concerned trademarks which have no meaning in common language (i.e. they are fantasy or imaginary trademarks "invented" by their holders).

They did not deal, as here, with marks which are the concatenation of two words that are (in French language) to certain degree generic (the term "rue du commerce" can be approximately translated into English as a shopping street, shopping avenue, shopping mall or alike). This has been dealt in other case law.

(i) (b) Generic mark and generic word case law

On the other hand, decisions dealing with an issue of descriptiveness of the trademark or a trademark and a generic word, showing more mixed decisions, often resulted in rejection of a complaint (see, for example, Hotels unis de France vs. Christopher Dent / Exclusivehotel.com, WIPO D2005-1194, Pinnacle Intellectual Property vs. World Wide Exports. WIPO D2005-1211, City Utilities of Springfield vs. Ed Davidson, WIPO D2000-0407 and similar).

(ii) Legal Analysis

The effect of strictly and automatically adopting the principle from the prefix or suffix cases would be to stop any other registrations of domain names which add either a prefix or suffix to registered trademarks, even though such trademarks are

quite generic.

The Panel declines, therefore, to adopt the broadest interpretation of the principle from the suffix or prefix cases, and instead believes that it is necessary to apply a more case specific approach as established by “mark with generic word” and “generic / distinctive” case law.

As a result, the following test should be followed:

A domain name comprising from a trademark and a suffix (or prefix) should not be held confusingly similar to such trademark:

(1) Where that trademark is essentially generic within the online world and has not acquired such distinctiveness as to merit broader protection (i.e. in particular, where such originally generic trademark has not yet - through its use, advertising good name, etc. - acquired such distinctiveness that it is exclusively attributable to its trademark holder – Complainant); and

(2) Where the suffix or prefix (or the domain name as a whole) does not relate specifically and exclusively to the business of the Complainant.

In the Panel’s view, the Complainant’s trademarks consisting of the “RUE DU COMMERCE” denomination are prima facie rather non-distinctive. However, the Complainant has shown that through extended use, promotion and advertising spent by the Complainant, its trademarks have become so well known as to acquire the requisite degree of distinctiveness taking them out of their original generic nature. Addition of non-distinctive element - suffix “RD” - to the “RUE DU COMMERCE” denomination cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant’s trademarks and thus the likelihood of confusion still exists.

Therefore, the Panel has decided that there is confusing similarity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the UDRP.

BAD FAITH

Since there is only a remote chance that the Respondent has registered such complex domain name just by a chance and without having a knowledge about the existence of the Complainant’s rights and business, the Panel contends, on the balance of probabilities, that the above discussed similarity has been established by the Respondent on purpose and in a bad faith. Thus, the Panel has taken a view 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).

NO RIGHTS OR LEGITIMATE INTEREST

The Complainant’s assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. The Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

For the reasons as set out above, the Complaint is Accepted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **RUEDUCOMMERCERD.BIZ**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2015-01-01

Publish the Decision