Decision for dispute CAC-UDRP-101108

Case number	CAC-UDRP-101108
Time of filing	2015-11-10 13:00:22
Domain names	ruedecommerce.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	RUEDUCOMMERCE

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Name	FILALI AFIFA

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

RDC.fr Rue du Commerce (logo) registered in France under No. 99805150 in classes 35, 38 and 42, on 28 July 1999

RUE DU COMMERCE (logo) registered in France under No. 3036950 in classes 9, 16, 28, 35, 38, 41 and 42, on 27 June 2000

WWW.RUE DU COMMERCE.COM (logo) registered in France under No. 3374566 in classes 9, 16, 28, 35, 38, 41 and 42, on 29 July 2005

RUE DU COMMERCE (word mark) registered in the EU under No.8299356 in classes 16, 35, 36, 37, 38, 41 and 42, on 14 May 2009

RUE DU COMMERCE.COM (word mark) registered in the EU under No.8299381 in classes 16, 35, 36, 37, 38, 41 and 42, on 14 May 2009

RUE DU COMMERCE (logo) registered in the EU under No.12014833 in classes 9, 16, 35, 36, 37, 38, 41 and 42, on 25 July 2013

FACTUAL BACKGROUND

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The Complainant is a major internet retailer. Its website now has more than 5 million pages. It advertises extensively on Francophone television channels as well as other media, and operates an active Twitter account. In 2015 it was the twelfth most visited e-commerce website in France, ahead of the websites of the Leclerc and Darty chains.

The Complainant was formed on 27 April 1999. In its year ended 31 March 2005 it had a turnover of over 178 million euros. It was floated as a public company on the Euronext exchange in September 2005. It launched a Spanish website in June 2006. According to market research by tns sofres in September 2006, 92% of the sample knew of the Complainant's website, 72% had visited it, and 25% had purchased from it in the last 6 months.

The disputed domain name was originally registered in the name Christy Filali with a street address in Dorset, UK on 13 October 2002. By 8 December 2006 it was registered in the name of the Respondent with a street address in Casablanca, Morocco, and it has remained so registered since that date. The contact email address has been filali1@gmail.com at all times. According to a record of DomainTools, this email address is associated with about 551 domains.

The Respondent also registered the domain name ruedecommerce.ma in 2006 and registered the trademark www.RueDeCommerce.com in classes 16, 35, 38 and 42 in Morocco on 14 June 2006.

The Complainant sent letters objecting to the registration of the disputed domain name to the Registrar on 12 March 2015 and to the Respondent on 19 March and 25 June 2015. The Complainant did not receive any response and filed a Complaint (Case No. 101029, "the First Complaint") with the ADR Center of the Czech Arbitration Court ("the Center").

Prior to the First Complaint, the disputed domain name was directed to a parking page which presented several links, including to "Rue du commerce", and stated under the heading "ACQUÉRIR LE DOMAINE" (to acquire the domain) that "Le nom de domaine ruedecommerce.com est mis en vente par son propriétaire" (the domain name ruedecommerce.com has been put on sale by its owner). Following the First Complaint, the disputed domain name was redirected to a web page at www.ruedecommerce.ma which referred to a site under construction. However, the DomainTools record continued to indicate "RuedeCommerce.com is for sale! / The owner of the domain you are researching has it listed for sale. / Buy RuedeCommerce.com".

The Respondent disputed the First Complaint, referring to her registration of the trademark www.RueDeCommerce.com in Morocco. The Complainant withdrew the First Complaint and brought this Complaint. The Respondent disputed this Complaint and requested a 3-member Panel, which was duly appointed following payment by the parties of the requisite fees.

The Panel made a Procedural Order under Rule 12 of the Rules for Uniform Domain Name Dispute Resolution Policy ("UDRP Rules") requesting the Complainant to file (i) a statement clarifying whether it accepted that the Respondent had registered the disputed domain name on 13 October 2002, or whether it contended that the Respondent acquired the domain name on some other date; and if the latter stating the alleged date or date range of the Respondent's acquisition of the domain name and the evidence on which it relied; and (ii) evidence as to the Complainant's reputation (if any) under the mark RUE DU COMMERCE as at 13 October 2002 and as at any other date of the Respondent's acquisition of the disputed domain name alleged by the Complainant. The Procedural Order further requested the Respondent to file any comments and evidence in response to any material filed by the Complainant pursuant to the Order.

The Procedural Order contained a timetable affording the Complainant time to submit the information requested and the Respondent time thereafter to submit any comments and evidence in response, and deferring the projected Decision Date accordingly. The Order was notified automatically to the Parties by the Center's IT Platform and by separate email from the Center. The Complainant submitted a statement and evidence pursuant to the Order, which was notified automatically to the Respondent by the Center's IT Platform. The Respondent did not submit any comments or evidence in response.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that it has registered rights in the trademarks identified above and that these trademarks are well known as a result of the Complainant's extensive advertising under them and large sales through its website at www.rueducommerce.com. The Complainant also draws attention to several previous decisions of the Center's Panels that have recognised these rights.

The Complainant submits that the disputed domain name is confusingly similar to these trademarks. The Complainant points out that the change from "du" to "de" does not provide any significant visual, conceptual or phonetic difference.

The Complainant denies that the Respondent has any right or legitimate interest in respect of the disputed domain name. The Complainant points out that its registered trademarks predate the registration of the disputed domain name or the trademark registered in Morocco by the Respondent. The Complainant alleges that the Respondent registered her trademark and the disputed domain name in order to profit from the Complainant's reputation.

The Complainant states that the Respondent has not exploited the disputed domain name in any way and only redirected it to the page at www.rueducommerce.ma after the Complainant submitted the First Complaint to create an illusion of real exploitation. The Complainant notes that prior to this redirection, the disputed domain name was directed to a web page which offered it for sale and presented links related to the Complainant's activities.

The Complainant observes that the website www.ruedecommerce.com is still not active, despite the Respondent's assertion that she registered it in good faith as she wanted to launch a website enabling merchants in Morocco to promote their merchandise; and that the website at www.ruedecommerce.ma is still under construction.

The Complainant regards the Respondent's failure to answer its letters, whereas she immediately answered the First Complaint, as evidence of her bad faith. The Complainant also emphasises that the domain name was registered after the Complainant registered its trademarks.

The Complainant submits that the main purpose of the registration of the disputed domain name has been to prevent the Complainant from reflecting its brand in a corresponding domain name; and that it was registered primarily for the purpose of harming the Complainant and making a profit from selling the domain name.

In response to the Panel's Procedural Order, the Complainant inferred from the available information that the Respondent acquired the disputed domain name in 2006. The Complainant provided evidence as to its reputation in 2006.

RESPONDENT:

The Respondent draws attention to the essentially descriptive character of the terms used in the Complainant's trademarks and that the Complainant did not present evidence that these trademarks had acquired the requisite level of distinctiveness outside France. The Respondent also disputes the Complainant's assertion that the disputed domain name is confusingly similar to its trademarks.

The Respondent submits that she has rights and legitimate interests in the disputed domain name. She refers to her registered trademark in Morocco and points out that the Moroccan Intellectual Property Office searched the national database prior to registering it to make sure that no other party held the same trademark in the same classes in Morocco. The Respondent states that the disputed domain name is currently used to route traffic to ruedecommerce.ma, a site under development for independent businesses to establish a web presence. She invites the Panel to view a "beta version" of the proposed website. She denies that the disputed domain name is currently for sale.

The Respondent observes that the Complaint acknowledges the registration of the disputed domain name containing

relatively generic terms on 13 October 2002, but provides no evidence that any degree of notoriety was achieved by the Complainant before this date. According to the Respondent, she could not possibly have registered her trademark with the Complainant's trademark in mind and her registration predates the Complainant's notoriety. She states that she registered the disputed domain name because she believed it contained a generic term. The Respondent submits that any notoriety of the Complainant was gained by its heavy marketing expenditure in the last 3-4 years, long after the registration of the disputed domain name in 2002 or the Respondent's trademark in 2006.

With regard to the correspondence mentioned by the Complainant, the Respondent states that the address in Casablanca in the domain name record is her second residence and that recorded delivery mail sent to this address was undelivered because there was no one present to sign for it. She criticises the Complainant for not attempting to contact her by email and for repeating the allegation that she ignored its letters after she explained the position in her response to the First Complaint.

The Respondent accuses the Complainant of impermissible reverse domain name hijacking. The Respondent notes that the Uniform Domain Name Dispute Resolution Policy ("UDRP" or "Policy") exists to provide a mechanism for efficient transfer of domain names from obvious cybersquatters to trademark owners, and was not enacted to assist licensee-distributors to corner the market on descriptive domain names, or to circumvent contract law or trademark principles such as fair use.

The Respondent alleges that the Complainant was well aware of the weakness of its position and brought this Complaint in bad faith, hoping that the Respondent would default and that a sympathetic Panel would draw inferences in the Complainant's favour. The Respondent also refers to inaccurate statements in the First Complaint and claims that the Complainant falsified a screenshot of the Respondent's web page at www.ruedecommerce.ma by omitting the background picture.

As stated above, the Respondent did not respond to the further information and evidence provided by the Complainant in response to the Procedural Order.

RIGHTS

The Panel finds that the Complainant has rights in the registered trademarks mentioned above, including the RUE DU COMMERCE logo registered in France in 2000, the WWW.RUE DU COMMERCE.COM logo registered in France in 2005, and the RUE DU COMMERCE and RUE DU COMMERCE.COM word marks registered in the EU in 2009.

The Panel further finds that the disputed domain name is confusingly similar to each of these marks. The words RUE DU COMMERCE are the predominant element of the logos and the difference between "du" and "de" is quite insufficient to distinguish, especially as this change of only one letter does not convey any different concept.

While small differences can suffice to distinguish descriptive trademarks, the Panel considers that the trademark "Rue du Commerce" is not altogether descriptive in relation to retailing on the internet and that the trademark has acquired a substantial degree of distinctiveness as a result of its extensive use and promotion by the Complainant.

The likelihood of confusion is corroborated by the fact that the Respondent's web page presented a link under the words "Rue du commerce".

Although the Complainant's EU word marks were registered after the disputed domain was acquired by the Respondent, this is not a relevant consideration under the first requirement of the UDRP, which serves the function of establishing a Complainant's interest in relation to the disputed domain name, rather than determining whether the latter is an abusive registration, which is covered by the second and third requirements: see, for example, the decisions of Panels under the UDRP in WIPO Cases Nos. D2007-0856 Esquire Innovations, Inc. v. Iscrub.com c/o Whois Identity Shield and Vertical Axis, Inc, Domain Administrator and D2006-0916 Stoneygate 48 Limited and Wayne Mark Rooney v. Huw Marshall.

Accordingly, the Complainant has, to the satisfaction of the Panel, shown that 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 Panel finds on the evidence that the Respondent did not use or make demonstrable preparations to use the disputed domain name or a name corresponding to it for a bona fide offering of goods or services before notice of the dispute. Despite being registered in the name of the Respondent since 2006, the disputed domain name was still directed to a parking page when the Complainant initiated the First Complaint in 2015 and was only later redirected to another parking page at www.ruedecommerce.ma. The rudimentary character of the draft web pages which the Panel was invited to view by the Response only reinforces the indications that the Respondent had not prepared to use the domain for any bona fide offering of goods or services before notice of the dispute.

It is also clear that the Respondent is not commonly known by the disputed domain name and is not making any legitimate non-commercial or fair use of it.

In all the circumstances, the Panel finds that the Respondent's registration of the trademark in Morocco in 2006 was not made for the purposes of any genuine business or intended business, but rather was made in an attempt to justify the registration of the disputed domain name in the name of the Respondent and to circumvent the operation of the UDRP. If there had been a genuine intention to trade under this trademark there would have been evidence of the Respondent's preparations to do so and as to why they did not come to fruition in the nine years that elapsed prior to the Respondent receiving notice of the dispute in 2015.

In line with previous decisions under the UDRP such as WIPO Cases Nos. D2000-0847 Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com", D2008-1379 Chemical Works of Gedeon Richter Plc v. Covex Farma S.L. and D2009-0817 British Sky Broadcasting Group Plc. and British Sky Broadcasting Limited v. Global Access, the Panel considers that the Respondent's registration of the trademark in these circumstances does not qualify as a right or legitimate interest within the meaning of paragraph 4(a)(ii) of the UDRP.

In the circumstances, 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

It is clear from the terms of paragraph 4(a)(iii) of the UDRP that its two elements are cumulative conditions: a complainant must show that the disputed domain name both was registered and is being used in bad faith.

On the other hand, the registration of a domain name on its acquisition by a new owner is treated as a registration for this purpose. This is evident from paragraph 4(b)(i) of the UDRP and has been confirmed by numerous decisions of Panels under the UDRP: see, for example, WIPO Cases Nos. D2005-1270 MC Enterprises v. Mark Segal (Namegiant.com), D2004-0887 Video Images, LLC v. Stoebner, Jeff and D2004-0016 Ideenhaus Kommunikationsagentur GmbH v. Ideenhaus GmbH. Accordingly, the acquisition of an existing domain name in bad faith satisfies the first element of paragraph 4(a)(iii).

The Respondent has not disputed the inference drawn by the Complainant that she acquired the disputed domain name in 2006, despite having the opportunity to respond to the Complainant's submission in this regard. In these circumstances, the Panel accepts the Complainant's inference and must therefore consider whether the registration of the disputed domain name by the Respondent on acquiring it in 2006 was in bad faith.

The Panel is satisfied on the evidence that by 2006 the Complainant was well known at least in the Francophone world under its RUE DU COMMERCE trademark and for its website at www.rueducommerce.com. Furthermore, this website was readily accessible and would be found by anyone genuinely considering establishing a business using the domain name ruedecommerce.com. In these circumstances, the Panel considers that the Respondent must have known of the Complainant's operations through its website at www.rueducommerce.com and using the mark RUE DU COMMERCE when she acquired the very similar domain name ruedecommerce.com.

The Panel also notes that the Respondent did not use the disputed domain name for any bona fide business or any other bona fide activity prior to notice of the dispute, but instead offered it for sale.

In all the circumstances, the Panel finds on the balance of probabilities that the Respondent acquired the disputed domain name primarily for the purpose of selling it to the Complainant or to a competitor of the Complainant for valuable consideration. In accordance with paragraph 4(b)(i) of the UDRP this constitutes evidence of both registration and use of the disputed domain name in bad faith.

This presumption is not displaced by any other evidence before the Panel. On the contrary, it is entirely consistent with all the available evidence.

Accordingly, the Complainant has, to the satisfaction of the Panel, shown that 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

As stated above, the Panel issued a Procedural Order requesting further statements and documents from the parties under UDRP Rule 12.

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

The disputed domain name is confusingly similar to the Complainant's trademark RUE DU COMMERCE and RUE DU COMMERCE.COM, from which it differs only by one letter.

The Respondent has no rights or legitimate interests in the disputed domain name. She did not use or make preparation to use it for a bona fide offering of goods or services or any other legitimate purpose despite owning it for some 9 years prior to notice of the dispute. Her registration of a corresponding trademark in Morocco was not made to support any bona fide business; it was made in an attempt to justify the registration of the disputed domain name and to circumvent the Policy.

The Respondent acquired the disputed domain name knowing that it was almost identical to the Complainant's well known mark and domain name, primarily for the purpose of offering it for sale at a profit, and has offered it for sale. The Respondent thereby registered and has been using the disputed domain name bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **RUEDECOMMERCE.COM**: Transferred

PANELLISTS

Name	**Jonathan Turner, Alistair Payne, Mr. Etienne Wéry**

DATE OF PANEL DECISION 2016-03-29

Publish the Decision