Decision for dispute CAC-UDRP-101488

Case number	CAC-UDRP-101488
Time of filing	2017-03-31 12:07:08
Domain names	rudecommerce.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	RueDuCommerce

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Organization	Teo Group

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name

IDENTIFICATION OF RIGHTS

The Complainant has registered the following trademarks in France:

• « WWW.RUE DU COMMERCE.COM », registered on July 29, 2005 under number 3374566 goods and services class 9, 16, 28, 35, 38, 41, 42.

• « RUE DU COMMERCE », registered on June 27, 2000 under number 3036950, for goods and services class 9, 16, 28, 35, 38, 41 et 42,

• “RDC.fr Rue du Commerce”, registered on July 28, 1999 under number 99805150, for goods and services class 35, 38, 42.

The Complainant has registered the following CTM:

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

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

FACTUAL BACKGROUND

The Complainant's contentions which are not disputed by the Respondent can be summarised as follows:

The RueDuCommerce Company has been registered on April 27, 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.

RueDuCommerce is the owner of a portfolio of Trademarks for its internet-order selling business activities on websites accessible in particular at the addresses www.rueducommerce.com and www.rueducommerce.fr.

Since its creation in 1999, RueDuCommerce has identified its products under the trademark “Rue du Commerce”.

For more than fifteen years, RueDuCommerce has created a considerable reputation among net surfers and consumer through media advertising, social media and use on the Internet. It is now a major e-merchant in France well-known with Internet users for reliability.

RueDuCommerce has distributed merchandise with its name to a large number of consumers (USB keys, pencil trays, pens, mobile phones, MP3 players, notebooks, key-rings…);

The website www.rueducommerce.com is part of the Top 15 of the most visited e-commerce websites in France. This website is classified 12th before Darty or Leclerc with more than 4.2 million of visits by month.

This website has been awarded the title of best website of technical products in 2009 and 2011 within the framework of the “Favori’s night” organized by the Federation of distance contracts for the sale of goods (“FEVAD”).

The reputation of RueDuCommerce has been recognized in prior decisions of the Czech Arbitration Court (CAC).

Under the Panel decision of the disputed domain name “wwwrueducommerce.com” (case no. 101028) dated September 22, 2015, the Panellist Alfred MEIJBOOM has reckoned that:

“The Complainant has been in business for eleven years and its trademarks gained an important notoriety among the French Internet public and consumers”.

Under the Panel decision of the disputed domain name “rueducommerces.com” (case no. 101030) dated September 24, 2015, the Panellist Angelica LODIGIANI has held that:

“During more than eleven years, the Complainant has gained an important notoriety among French net surfers and consumers. It is now a major e-merchant in France that Internet users consider reliable and honorable”.

Under Panel decisions of disputed domain names “rue-ducommerce.com” and “rueducommercerd.biz” (cases no. 100861 and no. 100873) dated November 12, 2014, and January 1, 2015, Panellists have insisted on the fact that:

“During more than eleven years RueDuCommerce has gained an important notoriety among the French net surfers and consumers. It is now a major e-merchant in France whose honourability and reliability are well-known from the Internet users”.

Under the Panel decision of disputed domain name “rueducommercerd.biz” (case no.100873) dated January 1, 2015, JUDr. Jiří Čermák said that:

“(…) the Complainant has shown that through extended use, promotion and advertising spent by the Complainant, its trademark 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”.

Under Panel decision of disputed domain name “rueducommerce.vote” (case no. 101143) dated February 2, 2016, it was held that:

“During more than eleven years the Complainant has gained an important notoriety among the French internet users. It is now a major e-merchant in France whose honourability and reliability are well-known”.

Consequently, the trademark RueDuCommerce constitutes a well-known trademark and this notoriety goes beyond the French framework.

The Complainant makes the following legal arguments:

The disputed domain name is identical to trademark in which the Complainant have rights
[Policy, para. 4(a)(i), Rules, paras. 3(b)(viii), (b)(ix)(1)].

This identity is illustrated, in particular, on three levels:

1) Visually, the disputed domain name copies the “rueducommerce” trademark and the domain name “rudecommerce” remains almost identical. The removal of the letter “e” and the replacement of the word “du” by “de” is the only a way to create confusion in consumer's minds and is not sufficient to create a distinction between the two names.

2) Conceptually, the only difference between the two domain names is the removal of the letter “e” and the replacement of the word “du” by “de”, which is entirely insufficient to conceptually distinguish both domain names. Indeed, the two words characterizing the Complainant’s trademark are “rue” and “commerce” and remain the same in the disputed domain name.

3) Phonetically, it is obvious that both domain names sound identical as the letter “e” is not pronounced.

The copying of the Complainant's trade mark by the disputed domain name is undeniably a way to attract customers and take advantage of the peputation of RueDuCommerce. This minor difference in spelling is insignificant and does not preclude a finding of confusing similarity with the Complainant’s trademark and domain name.

There is no doubt that internet users seeing the disputed domain name may believe that it is somehow related to or authorized by RueDuCommerce Company.

In these conditions, it will be very hard, if not impossible for the Respondent to deny the likelihood of confusion. This choice also demonstrates the bad faith of the Registrant.

The disputed domain name has been registered by the Respondent without rights or legitimate interest in the name [Policy, paras. 4(a)(ii), 4(c), Rules, para. 3(b)(ix)(2)].

First of all, the Complainant has not licensed or otherwise permitted the Respondent to use its brand or to apply for or use any domain name incorporating it.

Internet enquiries as well as trademark database searches have not revealed any use or registrations by the Respondent that could be considered relevant.

The disputed domain name "ruducommerce.com" has been registered on April 19, 2016.

The RueDuCommerce Company tried to reach the owner of the disputed domain name:

On December 21, 2016 a recorded delivery communication was addressed to the Registrar (NAME.COM).

On December 21, 2016 the Complainant has addressed a recorded delivery letter and e-mail to the Respondent Domain Protection Service, Inc.

The Respondent did not answer any of these communications.

On March 10, 2017, the Complainant sent a second recorded delivery letter and email to the Registrant, Domain Protection Service, Inc. The Complainant never received any answer from the Respondent.

Therefore, and considering the Respondent reluctance to respect the Complainant's intellectual property rights, RueDuCommerce is forced to go to before the Court to enforce these rights.

Secondly, the litigious domain name reroutes the internet users having misspelled the Complainant's address to an active website selling women clothes. The disputed domain name <rudecommerce.com> still leads to an active website.

Moreover, the Respondent has not demonstrated, as the Policy requires, that he made preparations to use the disputed domain name in connection with a bona fide offering goods or services.

For all these previous reasons, the disputed domain name "ruducommerce.com" has been registered by the Respondent, without rights and legitimate interest.

The disputed domain name is registered and being used in bad faith [Policy, paras. 4(a)(iii), 4(b); Rules, para. 3(b)(ix)(3)].

First, nothing on the website itself suggests that the Respondent is making a legitimate commercial or non-commercial business activity with the disputed domain name because it has never been used and it is not currently being used except to re-route consumers as set out above.

Besides, the Respondent registered the disputed domain name on April 19, 2016, subsequent to the Complainant's trademark registration. The Respondent was therefore able, at the time of the registration, to know of the Complainant's trademark and the infringement of intellectual property rights he was committing by registering this domain name.

Second, the choice of a name and an address very close to the real one demonstrates the bad faith of the Respondent.

UDRP rules provide several ways of establishing bad faith:

Where the domain name has been acquired with the main purpose of selling it the complainant who is the legitimate owner of the trademark [see paragraph4(b)(i)];

Where the domain name has been registered in order to prevent the owner of the trademark from reflecting the trademark in a corresponding domain name, provided that you have engaged in a pattern of such a conduct [see paragraph 4(b)(ii)];

Where the domain name has been registered in order to attract, for commercial gain, Internet users to the web site 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 web site or location or of a product or service on your web site or location [see paragraph 4(b)(iv)].

Thus, according to the circumstances exposed above, it will appear that the disputed domain name has been registered by the Respondent in bad faith.

• The disputed domain name is being used in bad faith

The main purpose of the disputed domain name registration has been to prevent the Complainant, legitimate owner of “Rueducommerce” trademark, from reflecting the brand in a corresponding domain name.

Not only did the Respondent buy a disputed domain name belonging to the Complainant’s trademarks portfolio, but he has engaged in typo squatting which creates a confusingly similar domain name to the Complainant’s registered trademark and domain names, and so since its registration on April 19, 2016.

According to WIPO Case No. D2010-1118:

“Typo squatting occurs when a respondent purposefully includes typographical errors in the mark portion of a disputed domain name to divert Internet users who make those typographical errors”.

In the present matter, as explained above, the Respondent only made minor changes keeping the essence of the Complainant’s trademark and domain names. This constitutes typo squatting under WIPO case law.

Another case needs to be quoted:

“The use of misspellings alone is sufficient to prove bad faith under paragraph 4(b)(iv) of Policy because Respondent used these names intentionally to attract, for commercial gain, Internet users to his website by making a likelihood of confusion with the Complainant’s mark” (WIPO Case No. D2000-0937).

The misspelling’s goal was precisely to attract the Complainant’s clients by causing a likelihood of confusion with the Complainant's mark.

Indeed, the Respondent used its website to sell some goods that might also be sold by RueDuCommerce. The Respondent’s website sold clothes, which constitutes one of RueDuCommerce’s activities.

Therefore, the Respondent clearly tried to use the Complainant’s fame for its own commercial interest. Customers which make a typographical mistake will find a website selling products similar or apparently similar items to those sold by RueDuCommerce.

Finally, this demonstrates a pattern of conduct for the sole purpose of attracting users for commercial gain to the Respondent's website by creating a likelihood of confusion with the Complainant’s trademark and domain names.

According to all circumstances of this situation, the Respondent has registered the disputed domain name and is acting in bad faith.

The Respondent has registered a domain name that is similar to the trademarks registered and used by the Complainant.

The disputed domain name confusingly reproduces the “rueducommerce” trademark.

The disputed domain name is infringing Complainant’s intellectual property rights and violates the UDRP rules due to registration and use in bad faith.

Despite good faith attempts, the Complainant has not managed to find anything that would suggest that the Respondent has any rights or legitimate interest in holding the disputed domain name.

Accordingly, the Complainant submits that the disputed domain name should be transferred to the Complainant, RueDuCommerce Company.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, in the opinion of the Panel, not shown that the disputed 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).

The Registrant of the disputed domain name is American, an English speaking nation. The ordinary reaction of an English speaker or a European Citizen that speaks English would in the opinion of the Panel be that the disputed domain name would read as the two English words 'Rude Commerce' plus the gTLD. The Complainant has not shown any evidence that this would be mistaken for the French expression 'Rue du Commerce' even in France or other French speaking nations and in the opinion of the Panellist this is unlikely. This does not appear to be a case of typosquatting, but a case of a selection of two English words 'rude commerce' with their own distinct meaning. While there is a small degree of visual and phonetic similarity, this is not overriding and the strong conceptual difference and identifiable meaning of the words 'rude' and 'commerce' means that in the opinion of the Panel the disputed domain name is not identical or confusingly similar to the Complainant's RUE DU COMMERCE mark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). Since the disputed domain name is not confusingly similar to the Complainant's RUE DU COMMERCE mark the Respondent appears to have a legitimate right to use the name at least as far as being considered in these proceedings for clothing.

BAD FAITH

The Complainant has not, to the satisfaction of the Panel, shown 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). Due to the findings above and no evidence that the Respondent is targeting the Complainant it would not be appropriate to find any bad faith on the part of the Respondent.

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

The Panel is of the view that there is strong conceptual dissimilarity between the disputed domain name and the Complainant's trade mark and overall the disputed domain name and the Complainant's trademark are not confusingly similar.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2017-05-03

Publish the Decision