# Decision for dispute CAC-UDRP-101525

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| Case number | CAC-UDRP-101525 |
| Time of filing | 2017-05-03 08:56:48 |
| Domain names | rueducommerce.xyz |

## Case administrator

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

## Complainant

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| Organization | RueDuCommerce |

## Complainant representative

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| Organization | CHAIN AVOCATS |

## Respondent

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| Name | Michael Mayer |

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has not provided the corresponding evidence regarding its trade mark rights as referred to in the Complaint (annex to the Complaint contains trade marks irrelevant to this dispute). The Panel therefore conducted its own brief factual research based on the French Trade Mark Database available at https://bases-marques.inpi.fr/ and confirms that the Complainant is indeed the owner of the following trade mark rights in France and in the European Union:

French Trade Mark Registration No. 3374566 issued on 29 July 2005
WWW.RUE DU COMMERCE.COM, for goods and services class 9, 16, 28, 35, 38, 41, 42;

French Trade Mark Registration No. 3036950 issued on 27 June 2000
RUE DU COMMERCE, for goods and services class 9, 16, 28, 35, 38, 41 et 42;

French Trade Mark Registration No. 99805150 issued on 28 July 1999
RDC.fr Rue du Commerce, for goods and services class 35, 38, 42;

European Trade Mark Registration No. 8299381 issued on 14 May 2009
RUE DU COMMERCE.COM, for goods and services class 16, 35, 36, 37, 38, 41, 42;

European Trade Mark Registration No. 8299356 issued on 14 May 2009
RUE DU COMMERCE, for goods and services class 16, 35, 36, 37, 38, 41, 42;

European Trade Mark Registration No. 12014833 issued on 25 July 2013
RUE DU COMMERCE, for goods and services class 9, 16, 35, 36, 37, 38, 41, 42.

Furthermore, the Complainant has supplied various evidence establishing that its trade marks fulfil the criteria of well-known trade marks:

- its active business has been reported by the media (press, internet and television);
- its notoriety results from communication through various means, notably including the use of its internet website and social networks, and from numerous advertising campaigns (e.g. metro, bus, national television channels, radio and Youtube);
- its website is becoming one of the principal e-commerce websites among the top 15 most visited websites in France and has won several awards in 2009 and 2011; and
- the notoriety of its trade marks has been recognized in previous decisions under the Policy.

FACTUAL BACKGROUND

The Complainant was founded in 1999 and sells goods online, focusing mainly on the French market. Its main website is available at www.rueducommerce.com and www.rueducommerce.fr.

The Respondent is an individual based in France. Nothing is known about the Respondent except his contact details revealed by the registrar.

The disputed domain name was registered on 14 March 2017 and is currently not resolving.

Parties' Contentions

Complainant

Procedural Factors

The Complainant requests that the language of the proceedings be English for the following reasons:

- the Respondent never answered the Complainant's emails; and
- this is the only way for the Complainant to protect its rights and fight against illegitimate use of a confusingly similar domain name.

Identical or confusingly similar

The Complainant contends that the disputed domain name is visually, conceptually and phonetically similar to its registered RUEDUCOMMERCE trade mark to the extent that its trade mark is entirely reproduced in the disputed domain name.

According to the Complainant, internet users are legitimately entitled to believe that the disputed domain name is related to or authorized by the Complainant.

The Complainant thus argues that it would be difficult for the Respondent to deny the likelihood of confusion.

No rights or legitimate interests

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

The Complainant points out that 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 further states that, after having obtained the Respondent's contact details revealed by the registrar, it tried to reach the Respondent by sending two registered letters on 21 March 2017 and 7 April 2017. The Respondent never responded to these letters.

Based on the fact that the disputed domain name was pointing to an inactive website that has now been suspended by the registrar, the Complainant argues that the Respondent has not demonstrated any intention to use the disputed domain name in connection with a bona fide offering of goods or services.

The Complainant therefore contends that the Respondent lacks rights and legitimate interests in respect of the disputed domain name.

Registered and used in bad faith

With regard to registration 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 trade mark and the infringement to intellectual property rights he was committing by registering this domain name".

According to the Complainant, the choice of a domain name identical to its trade marks, which may lead internet users to believe that the disputed domain name is somehow related to or authorized by the Complainant, further demonstrates the Respondent's bad faith.

In terms of use in bad faith, the Complainant underlines that nothing suggests that the Respondent is conducting a legitimate commercial or non-commercial business activity using the disputed domain name as the Respondent has never used or prepared to use it.

In the Complainant's opinion, the Respondent is deliberately using the disputed domain name to prevent the Complainant, as the legitimate owner of the RUEDUCOMMERCE trade mark, from reflecting its brand in a corresponding domain name.

The Complainant points out that the fact that the disputed domain name was pointing to an inactive website can be perceived as an act of "passive holding" preventing the Complainant from exercising the rights conferred by its trade marks.

The Complainant argues that the Respondent's holding of the disputed domain name without any legal right to use the Complainant's trade marks constitutes bad faith.

Finally, the Complainant contends that the suspension by the registrar of the website associated with the disputed domain name constitutes further evidence of the Respondent's bad faith and lack of any legitimate rights.

Based on the above, the Complainant asserts that the Respondent registered and has been using the disputed domain name in bad faith.

PARTIES CONTENTIONS

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trade mark 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 disputed 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 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

As far as the language of the proceedings is concerned, Rule 11 states as follows:

"Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

The Complainant requests that the language of the proceedings should be English, even though it differs from the language of the Registration Agreement which is French.

The fact that the Respondent never replied to the Complainant's three emails and two registered letters to his physical address, nor submitted any response to the Complaint sent by the CAC both by email (delivery confirmed) and by hard copy (delivery confirmed) indicates that the Respondent deliberately opted to not take part in the proceedings and chose not to use his right to defend himself. It should be noted that the Complainant's communications were all in French. In such circumstances, the Panel finds that it would put the Complainant to unnecessary expense to translate the Complaint and cause unnecessary delay. As the Respondent had ample chance to defend himself, but elected not to do so, the Panel, having regard to these circumstances, considers that it would be disproportionate to require the Complainant to submit the Complaint in French and therefore accepts the Complaint filed in English.

The Panel is satisfied that all procedural requirements under the Policy have been met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules states that the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In this case the Respondent has not submitted any response and consequently has not contested any of the contentions made by the Complainant. The Panel is therefore obliged to make its decision on the basis of the factual statements contained in the Complaint and the documents made available by the Complainant to support its contentions.

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(s) at issue:

i. the domain name registered by the respondent is identical or confusingly similar to a trade mark 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 Panel's supplemental factual research due to the Complainant's omission to provide appropriate evidence to prove its factual allegation, the Panel finds that the Complainant has trade mark rights in the term RUE DU COMMERCE.

The Panel notes that the disputed domain name incorporates the Complainant's RUE DU COMMERCE trade mark in its entirety. It is widely accepted that the generic Top Level Domain suffix is generally irrelevant for the purpose of assessing identity or confusing similarity between a trade mark and a domain name as it is a functional element.

On the basis of these considerations, the Panel finds that the disputed domain name is identical to the 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(s) 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 trade mark 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 trade mark or service mark at issue".

Based on the evidence put forward by the Complainant, the Panel finds that the Complainant has established a clear prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name. The Respondent did not submit any response to rebut this showing.

The Respondent is unlikely to have used the disputed domain name in connection with a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy above as the disputed domain name is currently not resolving. The use of a domain name that is identical to the Complainant's trade marks cannot be considered as "fair" within the meaning of paragraph 4(c)(iii) above as it falsely suggests affiliation with the trade mark owner. Furthermore, there is no evidence to suggest that the Respondent is commonly known by the disputed domain name, as required by paragraph 4(c)(ii) above.

Given the above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The third element that the Complainant must prove is that the disputed domain name was 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 considered 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 trade mark 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 trade mark 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".

Based on various evidence submitted by the Complainant, the Panel is satisfied that the Complainant's trade mark in the term RUEDUCOMMERCE is very well-known in France.

On this basis, as the Respondent registered the disputed domain name long after the Complainant's trade mark registrations and the creation of its reputation, it is reasonable to believe that the Respondent registered the disputed domain name in full knowledge of the Complainant's rights. Furthermore, as asserted by the Complainant, the Respondent's bad faith at the time of registration is further strengthened by the deliberate choice of a domain name which is identical to the Complainant's trade mark.

With regard to use in bad faith, the Complainant relies on "passive holding" as the disputed domain name has never been actively used by the Respondent since its registration. In particular, the Complainant, relying on the landmark decision Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, contends that such passive holding may amount to bad faith use as long as the Complainant's trade mark has a strong reputation and the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name. The Panel agrees and also notes that the Respondent took active steps to conceal his real identity by using a privacy protection service, which is also cited in the Telstra decision as an example of bad faith under certain circumstances. In this particular case, the Panel therefore finds that such passive holding should lead to a finding of bad faith use.

The Panel therefore finds that the disputed domain name was registered and is being used in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **RUEDUCOMMERCE.XYZ**: Transferred

## PANELLISTS

| Name | **Jane Seager** |
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DATE OF PANEL DECISION 2017-07-03

Publish the Decision