Decision for dispute CAC-UDRP-102059

Case number	CAC-UDRP-102059
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Domain names	beau-cointreau.com

Case administrator

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

Complainant

Organization	COINTREAU

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Robert Brownsword

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

International trademark COINTREAU n°224329 registered and renewed since October 2, 1959 and the trademark COINTREAU n°143704 registered and renewed since October 31, 1949.

FACTUAL BACKGROUND

The Complainant was founded in 1849 in Angers by Adolphe Cointreau, a confectioner, and his brother Edouard-Jean Cointreau. It produces a liqueur made of orange peels. Nowadays, the Complainant is a branch of the company REMY COINTREAU, and is known worldwide.

The Complainant is the registered proprietor of the international trademark COINTREAU n°224329 registered and renewed since October 2, 1959 and the trademark COINTREAU n°143704 registered and renewed since October 31, 1949.

The Complainant is the registrant of the domain name <cointreau.com> (registered on October 11, 1995), which it uses for its main website. It has also registered other domain names similar to the trademark COINTREAU such as <cointreau.net> (registered on December 11, 2001).

The disputed domain name <beau-cointreau.com> ("the Domain Name") was registered on May 25, 2018. It resolves to a parking page with commercial links related to the Complainant and its products.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends the Domain Name is confusingly similar to its COINTREAU trademarks and that the Respondent has no rights or legitimate interests with respect to the Domain Name, which was registered and is being used in bad faith.

As to confusing similarity, the Domain Name includes the trademark COINTREAU in its entirety and the addition of the generic term “BEAU” (French for “beautiful”) is not sufficient to escape the finding that the Domain Name is confusingly similar to the trademark. On the contrary, the addition of a French word contributes to confusion as COINTREAU is a French well-known trademark and company.

As to legitimacy, the Respondent is not related in any way to the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither licence nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark COINTREAU, nor to apply for registration of the Domain Name, which, since registration, resolves to a parking page with commercial links related to the Complainant. That is not a legitimate non-commercial or fair use of the Domain Name. Thus, the Respondent has registered the Domain Name in order to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant’s trademark.

As to bad faith registration and use, the Complainant's trademark COINTREAU is distinctive and well-known worldwide. It is reasonable to infer that the Respondent registered the Domain Name with full knowledge of the Complainant's trademarks. Therefore, it seems impossible to conceive that the Respondent could use the Domain Name without infringing those trademarks because the Domain Name is too connected with them. The website in connexion with the Domain Name is on a registrar parking page with commercial links related to the Complainant and its products. The Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant’s trademark COINTREAU, which is evidence of bad faith.

RESPONDENT:

The Respondent says he purchased the Domain Name on or about 25 May 2018 while in Africa. "Beau Cointreau" is a combination of ancestral family names the Respondent uses for his own purposes. The Respondent does not know the Complainant or its industry. It isn't [sic] impossible for the Respondent to monitor what others do in the EU. He is in the United States. It seems to him that the issue should lie with the Registrar.

The Respondent is however willing to modify the naming convention to deconflict it with all possible variations the Complainant has already purchased, so long as it does not negate his use of "Beau Cointreau," a thematically distinctive and completely different field.

"Beau Cointreau" is the Respondent's literary pen name. There will be no conflict with the use of this name and the Complainant.

The Domain Name is neither identical nor confusingly similar to the protected mark because of the Complainant’s failure to meet the required standard of proof. The Respondent has rights and/or legitimate interest in the Domain Name by reason of legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain. Further, there can be more than one Cointreau on planet earth as long as naming convention, logo and business are thematically and distinctively different. The Complainant does not appear to own the specific name "Beau Cointreau", or "Beau-Cointreau.com", as of 25 May 2018.

The Respondent says he is willing to work with the Complainant, is not trying to be belligerent and is a good neighbor with no ill intent. There is no theft of intellectual property on either side of the argument.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown 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 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

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).

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

In accordance with paragraph 4(a) of the Policy, to obtain transfer of the Domain Name, the Complainant must prove the following three elements: (i) the Respondent's Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in the Domain Name; and (iii) the Respondent has registered the Domain Name and is using it in bad faith.

Under paragraph 15(a) of the Rules, "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Rights: the Complainant has provided copies of the registration certificates for its International trademark COINTREAU n°224329 and its trademark COINTREAU n°143704. The Panel is satisfied that the Complainant has rights in the COINTREAU mark.

Confusing similarity: in determining confusing similarity, evidence of actual confusion is not required. The test is an objective one, confined to a comparison of the Domain Name and the trademark alone, independent of the products or services for which the Domain Name may be used, or other marketing and use factors usually considered in trademark infringement (see Arthur Guinness Son & Co. (Dublin) Limited v. Dejan Macesic, WIPO Case No. D2000 1698; AT&T Corp. v. Amjad Kausar, WIPO Case No. D2003-0327). Confusion in this context, in the sense of bewilderment or failing to distinguish between things, may be regarded as a state of wondering whether there is an association, rather than a state of erroneously believing that there is one. An appropriate formulation might be: "Is it likely that, because of the similarity between the domain name on the one hand and the Complainant's trademark on the other hand, people will wonder whether the domain name is associated in some way with the Complainant?": SANOFI-AVENTIS v. Jason Trevenio, WIPO Case No. D2007 0648.

Many panels have found that the mere addition of descriptive terms to a complainant's mark does not adequately distinguish the disputed domain name from the mark pursuant to the Policy, paragraph 4(a)(i). See Wal-Mart Stores, Inc. v. Gerry Senker, WIPO Case No. D2006 0211; The American Automobile Association, Inc. v. Cameron Jackson / PrivacyDotLink Customer 2440314, WIPO Case No. D2016-1671; and see the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.8: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element." The specific top-level of the Domain Name, ".com", is generally regarded as irrelevant for the purpose of determining whether the Domain Name is identical or confusingly similar. See Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525;

Rollerblade, Inc. v. Chris McCrady, WIPO Case No. D2000-0429.

Here the Domain Name wholly incorporates the Complainant's COINTREAU mark, preceded by the French descriptive word "beau", which does nothing to detract from the distinctiveness of the mark. The hyphen and the inconsequential gTLD ".com" may be disregarded.

Accordingly I find that the Domain Name is confusingly similar to the Complainant's COINTREAU mark.

Legitimacy: paragraph 4(c) of the Policy sets out three illustrative circumstances as examples which, if established by the Respondent, shall demonstrate rights to or legitimate interests in the Domain Name for purposes of paragraph 4(a)(ii) of the Policy, i.e.

(i) before any notice to the Respondent of the dispute, the use by the Respondent 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) the Respondent (as an individual, business or other organization) has been commonly known by the Domain Name, even if the Respondent has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

The Panel finds that the COINTREAU mark is distinctive and widely known. The Complainant’s assertions are sufficient to constitute a prima facie showing of absence of rights or legitimate interests in respect of the Domain Name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show that he does have rights or legitimate interests in the Domain Name. See Cassava Enterprises Limited, Cassava Enterprises (Gibraltar) Limited v. Victor Chandler International Limited, WIPO Case No. D2004-0753.

The Respondent has provided no evidence to support his assertions that "Beau Cointreau" is a combination of ancestral family names the Respondent uses for his own purposes and that "Beau Cointreau" is the Respondent's literary pen name. His assertion that he does not know the Complainant or its industry is rejected, having regard to the strong and widespread reputation of the COINTREAU mark and the content of the website to which the Domain Name resolves. This is a parking page with commercial links related to the Complainant. Use of the Domain Name for this purpose is not use in connection with a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the Domain Name.

Accordingly I find that the Complainant has established that the Respondent has no rights or legitimate interests in respect of the Domain Name.

As to bad faith, Paragraph 4(b) of the Policy sets out four illustrative circumstances, which, though not exclusive, shall be evidence of the registration and use of the domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy, i.e.

"(i) circumstances indicating that the respondent has registered or 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 the respondent’s documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on its website or location."

As in CAC Case No. 100552, COINTREAU v. Cointreau <sing-cointreau.com> and CAC Case No. 100708, COINTREAU v. Telnet Marketing <bitercointreau.info> <cointreaudrogues.info> <cointreaupyroxene.info>, I find that the COINTREAU trademark is widely known and, particularly having regard to the content of the Respondent's website, that Respondent must have been aware of the Complainants' rights in the trademark when he registered the Domain Name.

The Respondent contends that the issue should lie with the Registrar. However, as noted in paragraph 3.5 of WIPO Overview 3.0: "Particularly with respect to "automatically" generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests)."

I find that by using the Domain Name for a website promoting the Complainant's products, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Pursuant to paragraph 4(b)(iv), this is evidence of the registration and use of the Domain Name in bad faith for purposes of paragraph 4(a)(iii) of the Policy.

Accordingly I find that the Domain Name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BEAU-COINTREAU.COM**: Transferred

PANELLISTS

Name	**Alan Limbury**

DATE OF PANEL DECISION 2018-07-19

Publish the Decision