Decision for dispute CAC-UDRP-102435

Case number	CAC-UDRP-102435
Time of filing	2019-04-12 12:32:34
Domain names	supertopachat.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	RueDuCommerce

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Organization	Bepanda omnisport

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following registered trademarks (among others):

French registered trademark:

TOP ACHAT, word mark, registered May 4, 2004 under number 3289599, for goods and services in Nice classes 11, 20 and 21.

European Union registered trademarks:

TOP ACHAT, word mark, filed September 19, 2002 and registered March 30, 2004 under number 2872976, for goods and services in Nice classes 9, 35, 36, 38, 41, 42 and 43.

TOP ACHAT, word mark, filed August 9, 2004 and registered December 23, 2005 under number 4034211, for goods and services in Nice classes 11, 20 and 21.

TOPACHAT.COM, figurative mark, filed July 6, 2011 and registered December 22, 2011 under number 10103067, for goods and services in Nice classes 9, 35, 38, 41 and 42.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant was incorporated on April 27th, 1999. It is the owner of a portfolio of TOP ACHAT trademarks for the course of its internet-order selling business activities on websites accessible in particular at <topachat.com>.

Over more than eleven years the Complainant has become famous among French net surfers and consumers. It is now a major e-merchant in France whose integrity and reliability are known by Internet users. The Complainant's notoriety has been reinforced by intensive use of social networks. Its twitter account has more than 418,000 followers and its Facebook account has more than 279,183 followers.

The Complainant's TopAchat brand was the most popular brand on social media, ahead of Ebay, Decathlon and Sephora in 2011. Notoriety also results from the Complainant's intense marketing and communications activity in the press.

The disputed domain name is identical or confusingly similar to the Complainant's trademark. The disputed domain name contains the two same joined words as the Complainant's trademark, with an addition of the neutral word "super", which does not bring any original character to the disputed domain name as it is a neutral term without any meaning on its own. The disputed domain name is almost identical to the registered trademark of the Complainant, which contributes to create a confusion in the mind of the consumer.

The disputed domain name has been registered by the Respondent without rights or legitimate interests. 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 inquiries and trademark database searches have not revealed any use or registrations by the Respondent that could be considered relevant. The Respondent is not a partner of the Complainant and thus is by no means allowed to use its registered trademark. The Respondent has not demonstrated, as the Policy requires, that it has made preparations to use the disputed domain name in connection with a bona fide offering goods or services.

The disputed domain name was registered on October 22, 2018. The Complainant corresponded with the then named registrant of the disputed domain name by recorded delivery letter dated October 24, 2018. The registrant of the disputed domain name did not reply to this letter. The Complainant wrote again to the registrant on January 11, 2019 without response. The registrant only stopped exploiting the website associated with the disputed domain name after receiving this letter. The Respondent remains the registrant of the disputed domain name.

Until January 2019, the disputed domain name rerouted Internet users to an active website selling similar goods to those sold at the Complainant's "topachat.com" site and thus benefitted from the Complainant's notoriety.

The disputed domain name is registered and being used in bad faith. The Respondent registered the disputed domain name subsequent to the Complainant's trademark registration. The Respondent was therefore able, at the time of the registration, to know the existence of the Complainant's trademark and the infringement to intellectual property rights which it would commit by such registration. As the Respondent has no legal right to use the Complainant's trademark, there is clearly bad faith in maintaining the disputed domain name to its benefit.

The disputed domain name was obviously chosen to take advantage of the Complainant's notoriety by creating a concurrent website selling the same types of goods. Considering that the website associated with the disputed domain name sold similar goods to those of the Complainant and carries nearly the same domain name, it is certain that it contributed to create a likelihood of confusion with the Complainant's mark, demonstrating bad faith of the Respondent in terms of paragraph 4(b)(iv) of the Policy.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

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

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 Complainant has demonstrated that the disputed domain name contains the Complainant's TOP ACHAT mark in its entirety, prefixed by the generic or descriptive word "super". It is well accepted in cases under the Policy that the addition of one or more generic or descriptive terms to a trademark does not avoid a finding of confusing similarity. Such terms do not remove the overall impression made upon the public by the presence of a trademark which is the dominant part of the domain name (see, for example, Sony Kabushiki Kaisha (also trading as Sony Corporation) v. Inja, Kil, WIPO Case No. D2000-1409).

The Complainant established a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name by reference to its averments that it has not licensed or otherwise permitted the Respondent to use its brand or to apply for or use any domain name incorporating it, that the Complainant was unable to identify relevant use of trademarks by the Respondent, and that the Respondent did not demonstrate, as the Policy requires, that it has used or made demonstrable preparations to use the disputed domain name in connection with a bona fide offering goods or services. The Respondent failed to rebut the Complainant's prima facie case in that it did not file any Response. There are no surrounding facts or circumstances tending to show that the Respondent may otherwise have rights or legitimate interests in the disputed domain name. It is therefore reasonable in the circumstances for the Panel to find that that the Respondent has no such rights or legitimate interests therein.

The Complainant established to the satisfaction of the Panel that the Respondent registered the disputed domain name some 14 years after the Complainant's TOP ACHAT mark was first registered and long after it had become well-known and popular in connection with the Complainant's online retail website. The Complainant also established that the Respondent proceeded to use the disputed domain name, which was confusingly similar to the Complainant's TOP ACHAT mark, in connection with a website making a similar offering of goods and services to that of the Complainant's website at <topachat.com>.

In the Panel's opinion, the Complainant successfully made out a case of registration and use in bad faith in accordance with paragraph 4(b)(iv) of the Policy, namely that by using the disputed domain name, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such website. The fact that the Respondent's website has recently been suspended by its registrar or hosting company does not alter this conclusion. The Respondent failed to address the Complainant's contentions by way of any Response and did not advance any alternative motivation for the registration and use of the disputed domain name which might have indicated that its actions were in good faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SUPERTOPACHAT.COM**: Transferred

PANELLISTS

Name	**Andrew Lothian**

DATE OF PANEL DECISION 2019-05-22

Publish the Decision