Decision for dispute CAC-UDRP-102674

Case number	**CAC-UDRP-102674**
Time of filing	**2019-09-13 11:39:34**
Domain names	**bitcointreau.club, bitcointreau.party**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**COINTREAU**

Complainant representative

Organization	**Nameshield (Enora Millocheau)**

Respondent

Organization	**Tucows Inc.**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademark registrations consisting of the term “COINTREAU”, in particular International trademark no. 321517 registered on 23/09/1966.

FACTUAL BACKGROUND

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

The Complainant produces a liqueur made of orange peels. It results from the Complainant’s undisputed allegations that it was founded in 1849 in Angers by Adolphe and his brother Edouard-Jean Cointreau and nowadays is a branch of the company REMY COINTREAU. The Complainant contends that its distinctive trademark “COINTREAU” is well-known worldwide.

The Complainant is also the owner of the domain name <www.cointreau.com> (registered on 11/10/1995).

The disputed domain name <bitcointreau.club> was registered on 26/10/2017 and resolved to a parking page.

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.

According to the information provided by the Registrar upon the Request for Registrar Verification sent by Online- ADR Center of the Czech Arbitration Court, the domain names <bitcointreau.club> and <bitcointreau.party> - both originally disputed in the complaint – were registered by different Respondents, i.e. Support Team, Tucows Inc., Toronto/CANADA and Private User, Domain Privacy Protector Ltd, London/ Great Britain.

In the Amended Complaint the Complainant contends that “the domain names have been registered with different Registrant (Proxy service)” but “it is the same Registrant for both domain names”. In fact, the domain names “are registered at the same day and at the same time and use the same IP address”; the disputed domain names redirected to a parking page. For these reasons, the Complainant “confirms that the domain names have been registered by the same Registrant”.

With a Non-Standard Communication dated 11/11/2019 the Panel considered that the Respondents are different and in the Panel’s view, the Complainant did not submit sufficient evidence to justify the consolidation. Therefore, the proceedings regarding domain name <bitcointreau.party> terminated with effect from 11/11/2019.

Following this, the Complainant filed on 12/11/2019 a Non-Standard Communication stating that, since “the term for both domain name” is the same for both domain names, the domain names were registered with the same Registrar and the same time, “it is impossible for two different owners to register the similar domain names, with the same registrar at the same time”. The Complainant contended that the Registrant used different information to register the domain names. It therefore requested the Panel to request the Registrar to verify that the domain names are registered in the same account.

With a Non-Standard Communication dated 12/11/2019, the Panel decided to proceed to further investigations with the Registrar and postponed the deadline term for its decision also determining appropriate for the Complainant to pay the Additional UDRP Fees, having regard to the complexity of the proceedings.

The Online ADR Center of the Czech Arbitration Court on 13/11/2019 requested Tucows Domains Inc. (the Registrar of both domain names) to provide further information on the Registrants of the domain names at issue: in particular, if the domain names were registered from the same user account. Furthermore, the Center asked for information about the actual Registrant of the domain name <bitcointreau.party>, provided that the Registrant of this domain name is using a privacy protection.

The Registrar specified that the only information at its disposal are the information provided with the answer to the Registrar Verifications and that Tucows “doesn't have user accounts, if by 'user' you mean the same registrant”. The Registrar also added “from what I can see in Whois, they are not the same Registrant, anything else would be speculation on my part”. The Center insisted on 15/11/2019 in requesting the Registrar to “enable the privacy protection service and provide CAC with nonprotected data”. The Registrar affirmed that “as previously indicated, the whois sent is the whois we have in our internal database, that is, the 'privacy' that is shown is NOT Tucows' privacy, what you see is the ONLY whois we have for the domain”.

Under Paragraph 10(e) of the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) “A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules”.

In the light of the above, the Panel still considers the consolidation as not appropriate. In the Panel’s view the Complainant failed to submit sufficient evidence to justify the consolidation in terms of 1) common control of the domain names or corresponding websites and 2) fairness and equitableness of the consolidation to all parties. As specified in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) at point 4.11.2 “Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants’ identity(ies) including pseudonyms, (ii) the registrants’ contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).

In the present case, it is true that the domain names are connected to the same IP address and consist of the same second level domain. However, the Panel considers these elements not sufficient for the following reasons: the Registrants’ identity and Registrants’ contact information (one located in Canada and the other in Great Britain) are different; both domain names resolved to a parking page and therefore the content of the websites corresponding to the disputed domain names cannot give evidence of a common control of the two domain names at issue (see on this aspect WIPO Case No. D2013-1312 Apple, Inc. v. WhoIs Privacy Services Pty Ltd. / Stanley Pace / Shahamat / Kent Mansley / Phoebe Aoe / Tammy Caffey / Staci Michele / Layne Fletcher / Hiroko Tadano / Keith Besterson / Andrew Devon, in this decision the Panel states that: “In the instant case, the majority of the disputed domain names point to webpages generated by Sedo’s free domain name parking service. With this service, Sedo provides a domain name with a generic “landing page.” The use of such a landing page, however, is insufficient to demonstrate common control”. Finally, the Panel could not infer elements in favour of a possible common control neither from the additional answer provided by the Registrar in reply to the Center’s supplementary request.

Since the Complainant has ultimately failed to satisfy its burden of proof as to a common control and the fairness and equitableness of the consolidation to all parties, this decision will only determine rights concerning the disputed domain name registered by Respondent Support Team Tucows Inc. <bitcointreau.club>.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark. Many Panels have found that a disputed domain name is confusingly similar to a Complainant’s trademark where the disputed domain name incorporates the Complainant’s trademark in its entirety. This is the case in the case at issue where the Complainant’s trademark “COINTREAU” is fully included in the disputed domain name <bitcointreau.club> preceded by the generic term “bit” in the sense of “a small quantity”, that is however not able to prevent the possibility of confusion amongst consumers. In fact, the trademark “COINTREAU” is clearly recognizable within the disputed domain name.

In addition, the Top Level Domain in the disputed domain name - i.e. ".club" - represents a standard registration requirement and has to be disregarded in determining the confusing similarity, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0") at point 1.11.1.

2. In the absence of any Response, or any other information from the Respondent indicating the contrary, the Panel further holds that the Complainant successfully presented its prima facie case and that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not affiliated with nor authorized by the Complainant in any way, and he is not related in any way to the Complainant's business. In addition, the Respondent is not commonly known by the disputed domain name.

In addition, the websites to which the disputed domain name resolved was a parking page. This Panel finds that such use can neither be considered as bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Furthermore, the Top Level Domain in the disputed domain name - i.e. ".club" – relates to goods or services (including their natural zone of expansion) associated with the Complainant, therefore this panel shares the view expressed in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0") at point 2.14.1: "the respondent's selection of such TLD would tend to support a finding that the respondent obtained the domain name to take advantages of the complainant's mark and as such that the respondent lacks rights or legitimate interests in the domain name".

3. Finally, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

The Complainant has been established more than a century ago and has a worldwide reputation for the production and commercialization of a liqueur and its trademarks have existed for a long time. Therefore, it is the view of this Panel that the Respondent has intentionally registered the disputed domain name which totally reproduces the Complainant's trademark "COINTREAU". By the time the disputed domain name was registered, it is unlikely that the Respondent did not have knowledge of the Complainant's rights on its trademarks. The Complainant also proved that the Respondent is using the disputed domain name to lead to a parking page. These facts, including the failure to submit a response, the Respondent's initial concealing its identity, the chosen top-level domain (corresponding to the Complainant's area of business activity or natural zone of expansion) also confirm that the disputed domain name is used to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's 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 the Respondent's web site or location, or of a product or service on the Respondent's web site or location.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **BITCOINTREAU.CLUB**: Transferred
2. **BITCOINTREAU.PARTY**: Remaining with the Respondent

PANELLISTS

Name	**Dr. Federica Togo**

DATE OF PANEL DECISION 2019-11-23