Decision for dispute CAC-UDRP-102901

Case number	CAC-UDRP-102901
Time of filing	2020-02-13 11:47:02
Domain names	premiererueducommerce.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	RueDuCommerce

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Name	Ahmadou Nsangou Ngapout

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has evidenced to be the owner of the following trademark registrations with protection, inter alia, for the territory of France where the Respondent apparently is domiciled:
- Word mark RUE DU COMMERCE, Institut National de la Propriété Industrielle (INPI) Paris, Registration No.: 3036950, Registration Date: June 27, 2000, status: active;
- Word mark RUE DU COMMERCE, European Intellectual Property Office (EUIPO), Registration No.: 008299356, Registration Date: February 20, 2011; status: active;
- Word mark RUE DU COMMERCE, EUIPO, Registration No.: 008299381, Registration Date: February 24, 2011; status: active.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:
Complaint is based on the following grounds:
The Complainant has an important trademarks and domain names portfolio:

The complainant has registered the following trademarks in France:
« WWW.RUE DU COMMERCE.COM », registered on 29 July 2005 under number 3374566 goods and services class 9, 16, 28,

35, 38, 41, 42.

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

“RDC.fr Rue du Commerce”, registered on 28 July 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 14 May 2009 under number 8299381 for goods and services class 16, 35, 36, 37, 38, 41, 42
« RUE DU COMMERCE », registered on 14 May 2009 under number 8299356 for goods and services class 16, 35, 36, 37, 38, 41, 42
« RUE DU COMMERCE », registered on 25 July 2013 under number 12014833 for goods and services class 9, 16, 35, 36, 37, 38, 41, 42.

The RueDuCommerce Company has been registered on April 27th, 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 the course of its internet-order selling business activities on web sites accessible in particular at the addresses www.rueducommerce.com and www.rueducommerce.fr.

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 honorability and reliability are well known from the Internet users.

The Complainant fulfils criteria of well-known marks

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

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

This active business is relayed by media (paper, internet and television).

The notoriety results also of an intense communication on classic supports

Its internet website has more than 5 million of pages;

RueDuCommerce has distributed goodies at its name to a large public (USB key, pencil tray, pen, mobile phone, MP3 player, notebooks, key-rings…);

Advertising campaigns in the subway and on buses (Annex 13).

The Company RueDuCommerce has also broadcasted a lot of advertising campaigns on national channels, on radio and on its youtube video channel.

Total of 2.512 commercial spots broadcast on 27 various TV channels on a 20 days period.

The notoriety of RueDuCommerce has been reinforced by intensive use of social networks

For example, the Complainant has an active account on Twitter: until now there are 44.000 tweets from RueDuCommerce on Twitter and more than 172.000 followers.

RueDuCommerce is becoming one of the principal e-commerce website.

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 consecrated 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 notoriety 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 22th, 2015, the Panelist 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 24th, 2015, the Panelist 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 12th, 2014, and January 1st, 2015, Panelists 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 honorability and reliability are well known from the Internet users".

Under Panel decision of disputed domain name "rueducommercerd.biz" (case no.100873) dated January 1st, 2015, JUDr. Jin Cermak 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 2nd 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".

And a new time on the decision dated June 20th 2019 (Case n°102434).

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

2. The disputed domain name is identical to trademark in which the Complainant has rights

(Policy, para. 4(a)(i), Rules, paras. 3(b)(viii), (b)(ix)(1)).

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

1) Visually, the litigious domain name copies “rueducommerce” trademark. The RueDuCommerce trademark is reproduced identically. The adding of “premiere” is only a way to create confusion in consumers mind and is not sufficient to create a distinction between the two names.

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

The perfect copying of the domain name is undeniably a way to attract customers and take advantage of the notoriety of RueDuCommerce. This difference in the name of the domain name 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 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.

3. 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 his brand or to apply for or use any domain name incorporating it.

Internet inquiries 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 www.premiereruedu commerce.com has been registered on April 29th 2019.

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

On 30th April 2019 a recorded delivery mail has been addressed to the registrar,

On 30th April 2019 the Complainant has addressed a recorded delivery mail and email to the Respondent.

The Respondent did not answer either of these mails.

On 22th July 2019, the Complainant sent a second recorded delivery mail and email to the Registrant.

The Complainant never received any answer from the Respondent.

Secondly, the disputed domain name reroutes the internet users having misspelled the Complainant’s address to an active website selling the same types of goods as the RueDuCommerce Company such as home items, electronic and computing devices.
The domain name www.premiereruedu commerce.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 www.premiereruedu commerce.com has been registered by the Respondent, without rights and legitimate interest.

4. The 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 suggests that the Respondent is making a legitimate commercial or non-commercial business activity with the domain name because it has not been used since April 29th 2019 and it is not currently being used.

Besides, the Respondent has registered the litigious domain name on 29th April 2019, 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 he was committing by registering this domain name.

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

As the registrant of "premiereruedu commerce" has no legal right to use the complainant trademarks', there is clearly bad faith in maintaining the domain name to the benefit of the respondent.

UDRP rules provide several ways of establishing bad faith. One is 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)).

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.

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 to its own commercial interest.

It should be noted that the website seems to be operated illegally as it does not contain any legal notices, general terms and conditions of sale or privacy policy.
It is thus all the more prejudicial for the RueDuCommerce company to be assimilated to this site whereas this one does not obviously respect the rights of the consumers.

Finally, this demonstrates a pattern of conduct for the sole purpose of attracting users for commercial gain to its 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.

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

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 is a company organized under the laws of France that is active in the e-merchant business with its website at “www.rueducommerce” showing more than 5 million pages and an important notoriety of the Complainant’s RUEDUCOMMERCE trademark established since its creation in 1999 through significant advertising efforts. The Respondent, according to the disclosed WhoIs information for the disputed domain name, is a resident of France who registered the disputed domain name on April 29, 2019, redirecting it to a website at “www.premiererueducommerce” offering a large variety of products for online sale.

The Panel finds that the disputed domain name <premiererueducommerce> is confusingly similar to the Complainant’s RUEDUCOMMERCE trademark, since the disputed domain name incorporates the latter in its entirety and the mere addition of the descriptive term “premiere” is not capable to dispel the confusing similarity arising from the Complainant’s trademark’s incorporation in the disputed domain name.

Moreover, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent has neither made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent commonly known under the disputed domain name, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain. The Complainant has provided evidence that the disputed domain name redirects to an active website at “www.premiererueducommerce.com” offering a large variety of products for online sale - which is the very core of Complainant’s own business, but without any authorization granted by the Complainant to the Respondent to do so; also, the case file does not indicate as to why the Respondent needed to rely on the Complainant’s RUEDUCOMMERCE trademark as part of the disputed domain name unless in an attempt to somehow profit from the trademark’s undisputed reputation. Such doing business by the Respondent obviously neither qualifies as a bona fide nor as a legitimate non-commercial or fair use of the disputed domain name under the UDRP.

Finally, the Respondent’s making use of the disputed domain Name, which is confusingly similar to the Complainant’s RUEDUCOMMERCE trademark, to redirect to a website that is in direct competition with the Complainant’s e-merchant business, not only is a clear indication that the Respondent has registered the disputed domain name with full knowledge of the Complainant’s RUEDUCOMMERCE trademark, but also shows that the Respondent obviously registered and is using the disputed domain name intending to attract, for commercial gain, Internet users to the Respondent’s own website, by creating a likelihood of confusion with the Complainant’s RUEDUCOMMERCE trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website. Such circumstances shall be evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. In connection with this finding, it also carries weight in the eyes of the Panel that the Respondent not only kept silent on any of the Complainant's pre-procedural correspondence, but also made use of a WhoIs Privacy Shield, apparently in an attempt to conceal its true identity. These facts at least throw a light on the Respondent’s behavior which supports the conclusion of registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PREMIERERUEDUCOMMERCE.COM**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2020-03-23

Publish the Decision