Decision for dispute CAC-UDRP-103357

Case number	CAC-UDRP-103357
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Domain names	rueducommerce.net

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	RueDuCommerce

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Name	Michael Nava - Domain Nerdz LLC

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following national French trademark registrations:

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

“RDC.fr Rue du Commerce”, registered on July 28, 1999 under number 99805150, for goods and services class 35, 38, 42.

The Complainant has also registered the following CTM:

"RUE DU COMMERCE.COM", registered on May 14, 2009 under number 8299381 for goods and services class 16, 35, 36, 37, 38, 41, 42;

"RUE DU COMMERCE", registered on May 14, 2009 under number 8299356 for goods and services class 16, 35, 36, 37, 38, 41, 42; and

"RUE DU COMMERCE", registered on July 25, 2013 under number 12014833 for goods and services class 9, 16, 35, 36, 37, 38, 41, 42.

FACTUAL BACKGROUND

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

Factual and Legal Grounds
(Policy, paras. 4(a), (b), (c); Rules, para. 3)

1. Background

The Complainant has an important trademarks and domain names portfolio.

The RueDuCommerce Company has been registered on April 27, 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.

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

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 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, on buses).

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

Giving a 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 169.000 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”).

Finally, in March 2020 this website has been consecrated by the French Magazine Capital the champion, ranked 1st place, of

the generalist sites. In order to provide that information, Capital has joined forces with the research institute Statista to establish an original list of achievements. The research institute relied on a rich database of more than 10,000 merchant sites operating in France and www.rueducommerce.com has appeared a champion in its category.

The notoriety of RueDuCommerce has been recognized in prior decisions of the Czech Arbitration Court (CAC), which the Complainant presented in its complaint (e.g. cases no. 101028; no. 101030, no.101143, no.102434, no. 102594, no.100861 and no.100873).

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.

2) Conceptually, the three words characterizing the Complainant’s trademark are “rue”, “du” and “commerce” and remain strictly the same in the litigious 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 Respondent.

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 <rueducommerce.net> has been registered on August 19 2020.

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

- On August 21, 2020 a recorded delivery mail and email has been addressed to the registrar, see attached:

Sav.com, LLC
2229 South Michigan Ave suite 3030
Chicago
IL, 60616
UNITED STATES
Email: abuse@nameking.com

- On August 21, 2020 the Complainant has addressed a recorded delivery mail and email to the Registrant, that appeared to be Privacy Protect, LLC, 10 Corporate Drive, Burlington, Massachusetts, MA, 01803 United States.
Email: contact@privacyprotect.org.

The Respondent did not answer either of these mails.

- On September 4, 2020, the Complainant sent a second recorded delivery mail and email to the Registrant, Privacy Protect, LLC, 10 Corporate Drive, Burlington, Massachusetts, MA, 01803 United States.
Email: contact@privacyprotect.org.

The Complainant then received an email from the Registrar, sent by the email address “nick@sav.com”, in which the Registrar informed that he received the Complainant’s letter about rueducommerce.net, but that it didn’t follow their policy regarding complaints like this.

Therefore, and considering the Respondent reluctance to respect the Complainant’s intellectual property rights, RueDuCommerce is forced to go to before the Court to enforce these rights.

Secondly, the disputed domain name reroutes the internet users to a website offering to sell the domain name.
This characterizes a speculation of domain name, which is totally illegal and RueDuCommerce refuses such a misappropriation of the fruit of its investments made.

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.rueducommerce.net 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 since August 19, 2020.

Besides, the Respondent has registered the disputed domain name on August 19, 2020, 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 strictly identical to the real ones demonstrates the bad faith of the registrant.

As the registrant of <rueducommerce.net> has no legal right to use the Complainant's 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 the domain name in order to appropriate the investments made by RueDuCommerce.

Therefore, the Respondent clearly tried to use the Complainant's fame to its own commercial interest.

According to all circumstances of this situation, the Respondent has registered the disputed domain name and is acting in bad faith.

5. Conclusion

The Respondent has registered a domain name that is identical to the trademarks registered and used by the Complainant.

The disputed domain name confusingly reproduces the "rueducommerce" trademark.

The domain name is infringing Complainant's intellectual property rights, violating the UDRP rules registering and being used in bad faith.

Despite good faith attempts, the Complainant has not managed to find anything that would suggest that the Respondent has rights or legitimate interest in holding the domain name.

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 disputed domain name incorporates in full the Complainant's well-known trademarks, which is one of the most famous French e-commerce sites and this is also confirmed by a number of previous UDRP CAC disputes, namely: <wwwrueducommerce.com> (case no. 101028) dated September 22, 2015; <rueducommerces.com> (case no. 101030) dated September 24, 2015; <rue-ducommerce.com> and <ruedu-commercerd.biz> (cases no. 100861 and no. 100873) dated November 12, 2014, and January 1, 2015; <rueducommercerd.biz> (case no. 100873) dated January 1, 2015; <rueducommerce.vote> (case no. 101143) dated February 2, 2016; <rudecommerce.com> (case no. 101488) dated May 3,

2017; <rueducommerce.store> (case no. 102217) dated December 21, 2018, and others.

The present case is fully consistent with the previous cases of this Court in which the disputed domain name is in a passive holding and offered for sale without any legitimate interest and in bad faith by the respondent, who failed to provide any explanation or to respond to any of the Complainant's insisted enquiries.

As a result, the Panel is certainly persuaded this is clear-cut case of cybersquatting.

A. THE DOMAIN NAME IS CONFUSINGLY SIMILAR

The domain name <rueducommerce.net> (hereinafter referred to as the "Disputed Domain Name"), incorporates entirely the Complainant's well-known, trademark RUEDUCOMMERCE, and therefore is closely related to the Complainant and its business activities. The addition of the gTLD ".net" does not add any distinctiveness to the disputed domain name. See as an example the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581).

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Complainant has never granted the Respondent any right to use the trademark in re nor is the Respondent affiliated to the Complainant in any form.

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has interest over the disputed domain name.

The Respondent could have easily performed a search before registering the disputed domain name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks not only in France.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the disputed domain name.

C. THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

The Complainant has tried to reach the Respondent by a cease-and-desist notice sent twice and as the registrant was under privacy shield, its letters were sent via the Registrar's email However, it has not received any response from the Respondent.

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 the domain name in order to appropriate the investments made by RueDuCommerce

In terms of paragraph 4(b)(iv) of the Policy, the above facts demonstrate the Respondent's use of the disputed domain name in bad faith. See "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246:

"The Domain Name was not resolving to an active website."

Now a notice is shown in the connected web site and it states the following: "the domain name has been deleted" which is of course false until this Decision will be issued.
Doing this, showing the same lack of respect of the proceeding and of the Complainant's customers, the Respondent provides advance information to present this fact as it was its decision. This also shows an unfair attitude of the Respondent.

In conclusion to summarize the findings we have the following elements:

• Respondent has no rights in the mark RUEDUCOMMERCE, bears no relationship with the Complainant; and
The Respondent is not commonly known by the disputed domain name - accordingly it has no legitimate interest in the disputed domain name.
• It is highly unlikely that Respondent was not aware of Complainant’s prior rights in the trademark at issue at the time of registering the disputed domain name, given the Complainant’s renown and presence on the internet.
• Respondent has been passively holding the disputed domain name.
• Respondent has not responded to Complainant’s cease-and-desist letter.
• Respondent has been using privacy shield to conceal its identity.
- Respondent has registered the disputed domain name identical to the Complainant’s well-known trademark.

The Respondent's behaviour in the proceeding and outside the proceeding confirms the above findings of bad faith and lack of interest.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **RUEDUCOMMERCE.NET**: Transferred

PANELLISTS

Name	**Massimo Cimoli**

DATE OF PANEL DECISION 2020-11-18

Publish the Decision