Decision for dispute CAC-UDRP-103403

Case number	CAC-UDRP-103403
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Domain names	caketailbyremycointreau.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	REMY COINTREAU

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	ali aslan

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 one of the most famous and oldest French spirits groups, whose main activity is the production and sale of spirits, cognac and liqueurs, of which 95% is sold abroad.

The Complainant was formed in 1990, following the merger of holding companies which controlled respectively the E. Remy Martin & C° Company and the Cointreau Company.

The Complainant owns trademarks comprising the terms “REMY COINTREAU”, such as the international trademark REMY COINTREAU® n°895405 registered on July 27, 2006. Complainant owns and communicate on Internet through its main domain name <remy-cointreau.com> registered on October 7, 1996.

The disputed domain name <caketailbyremycointreau.com> was registered on October 27, 2020. The domain name is offered for sale on SEDO for 988 USD.

FACTUAL BACKGROUND

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

It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”(WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin).

For instance Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).”)

Forum Case No. 1562569, Enterprise Holdings, Inc. v. Webmaster & Support (“A general solicitation to sell a disputed domain name provides further evidence of a respondent’s lack of rights and legitimate interests in a disputed domain name. […] Therefore, the Panel finds that Respondent’s willingness to sell the <wwenterprise.us> domain name is credible evidence that Respondent lacked rights and legitimate interests in the disputed domain name pursuant to Policy paragraph 4(a)(ii).”).

For instance CAC Case No. 101952, REMY COINTREAU v. Erika Slade (“As to the registration of the disputed domain name in bad faith, the distinctive character of the Complainant's trademark and its reputation is such that in the Panel's view the Respondent could not ignore the REMY COINTREAU trademark at the time of the registration of the disputed domain name. (See Remy Cointreau v. F0rbo, CAC case no.101900 “Besides, in view of the fame of Complainant’s trademark, the Panel finds that there are good reasons to believe that Respondent had actual knowledge of Complainant’s distinctive two-part REMY COINTREAU® trademark when it registered the disputed domain name.”)”).

For instance WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC (“In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve […] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.”).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Firstly, the Complainant alleges that the disputed domain name is confusingly similar to its REMY COINTREAU trademark. It argues that the addition of the terms “Caketail by” does not dismiss the likelihood of confusion since it does not change the overall impression that the disputed domain name is at least connected to the Complainant.

The Complainant also argues that the disputed domain name directly refers to the US trademark CAKETAIL BY REMY COINTREAU, filed by the Complainant’s subsidiary COINTREAU.

It also states that the addition of the gTLD “.com” does not prevent the likelihood of confusion.

Secondly, Complainant alleges that the Respondent is not known under the disputed domain name. It also argues that Respondent has no rights or legitimate interests in respect of the disputed domain name and is not related to Complainant, in any way. The Complainant did not grant any license or nor did it authorize the Respondent to use its trademarks and or to register the disputed domain name.

Complainant notes that the disputed domain name points to a parking page with commercial links and indicating that it is offered for sale for 988 USD, which shows Respondent's lack of rights and legitimate interests.

Thirdly, Complainant alleges that the disputed domain name was registered and is being used in bad faith.

Indeed, the Complainant states that the disputed domain name was registered few days after its subsidiary COINTREAU filed the trademark "CAKETAIL BY REMY COINTREAU". It shows that the Respondent knew about Complainant and its subsidiary when he registered the disputed domain name. Besides, Complainant alleged the REMY COINTREAU trademark is well known around the world.

The Complainant considers that the Respondent reproduces its trademark in the disputed domain name for its trademark value.

Since the disputed domain name is offered for sale, the Complainant states it was registered only in order to be sold back, but not to be used. It resolves to a parking page and the Complainant, therefore, concludes the Respondent has attempted to attract users to its website for commercial gain, which constitutes use in bad faith.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions and is therefore in default.

RIGHTS

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel in that:

(i) the disputed 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 respect of the disputed domain name;

(iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to the name in respect of which a right is recognized or established by the national law of a Member State and/or European Union law.

The Complainant has rights in the "REMY COINTREAU" trademark. The Panel finds the disputed domain name to be confusingly similar to this trademark, since it reproduces the trademark in its entirety. The mere addition of the terms "caketail by" does not prevent the likelihood of confusion since the term "by" directly suggests the Complainant is at the origin of the "caketail", and therefore that it is connected to the disputed domain name.

The Complainant alleges that the disputed domain name reproduces the US trademark "CAKETAIL BY REMY COINTREAU", filed by its subsidiary. However, Panel has to ignore this contention. Indeed, even if Complainant brings evidence of the said filling, it does not establish the "CAKETAIL BY REMY COINTREAU" applicant is, in fact, its subsidiary.

It is well-acknowledged that "the fact that a domain name wholly incorporates a Complainant´s registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks" (CAC Case 102373, Avast Software s.r.o. v. Pham Dinh Nhut).

Moreover, the generic Top-Level Domain ("gTLD"), in this case ".com", should be disregarded when asserting the likelihood

of confusion. See, for example, CAC Case No. 102395 Laboratoires M&L v. Lucas Verdonk: “the consensus view in previous UDRP panel decisions is that in determining confusing similarity under paragraph 4(a) of the Policy, the generic Top-Level Domain (“gTLD”) suffix (“.com” in this particular instance) should be totally disregarded”.

To the satisfaction of the Panel, Complainant has shown that the disputed domain name is confusingly similar to a trademark or service trademark in which it has rights. The requirement of Paragraph 4(a)(i) of the Policy is, therefore, met.

NO RIGHTS OR LEGITIMATE INTERESTS

B. Rights or Legitimate Interests

Pursuant Paragraph 4(a)(ii) of the Policy, the Complainant is required to prove that the disputed domain name has been registered without rights or legitimate interests in the name.

The Complainant is required to make a prima facie case demonstrating that Respondent lacks the rights and legitimate interests in the disputed domain name. If the prima facie case is successful, then the burden of proof shifts to the Respondent.

Complainant shows that Respondent is using the disputed domain name in order to offer it for sale for 988 USD. However, it only points to a parking page, which cannot be considered as a use in connection with a bona fide offering of goods or services.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s REMY COINTREAU trademark, or to apply for registration of the disputed domain name.

Moreover, the Respondent did not respond to Complainant’s contentions and therefore did not try to demonstrate any right or legitimate interests. “If the respondent fails to do so, the second element of the Policy is satisfied” (CAC Case No. 102399, Arcelormittal (SA) v. acero).

Therefore, Panel finds that Complainant has made a prima facie case and has proven that Respondent has no rights or legitimate interests in respect of the disputed domain name. The requirement of Paragraph 4(a)(ii) of the Policy is, therefore, met.

BAD FAITH

C. Registered and Used in Bad Faith

Pursuant Paragraph 4(a)(iii) of the Policy, the Complainant is required to prove that the disputed domain name has been registered or that is being used in bad faith.

Firstly, the Complainant alleges that its trademark is a famous trademark and has a worldwide reputation, which has been confirmed by previous Panels. For example, CAC Case 102321, REMY COINTREAU v. Danny Mccommick: “owing to the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademarks”.

The fact that the disputed domain name <caketailbyremycointreau.com> has been registered a few days after the filing of the “CAKETAIL BY REMY COINTREAU” trademark by Complainant’s subsidiary COINTREAU, should be disregarded by the Panel, for the same reason as for the first requirement.

Nevertheless, having the reputation of Complainant and its trademark in mind, it can be considered that the Respondent should have known about Complainant at the time he registered the disputed domain name. Furthermore, as mentioned by the Complainant, since it is offered for sale, Panel also considers the Respondent registered the disputed domain name with the intention of selling it, which constitutes a use in bad faith.

Previous Panels considered that the fact of offering the disputed domain name for sale constitutes registration and use in bad faith. See for example Forum Case No. FA 1623939, Citigroup Inc. v. Kevin Goodman ("Respondent offered the <citi.club> domain name for sale or lease at prices well above even its alleged but unverified acquisition costs. […] Therefore, the evidence shows that Respondent registered <citi.club> primarily for the purpose of transferring it for a profit and demonstrates Respondent's bad faith registration and use of the <citi.club> domain name pursuant to Policy paragraph 4(b)(i).").

Secondly, Panel finds that the Respondent targets Internet users for commercial gain, specifically Complainant's consumers. Respondent may lead them to his own website using Complainant's trademarks for its own commercial gain, which is an evidence of use bad faith.

Panel agrees with Complainant on Respondent's intention to use Complainant's well-known trademark in the disputed domain name purposes of catching users that are searching for the Complainant's website.

Use in bad faith can be established by the addition of several factors, that taken as a whole clearly show bad faith:
- the Respondent has failed to respond to Complainant's contentions;
- the Respondent is using the disputed domain name for commercial gain by creating a likelihood of confusion with Complainant's trademark;
- the Respondent does not make a fair use of the domain name since it is pointing to a parking page.

The Panel considers that the disputed domain name has been registered and is being used in bad faith.

To the satisfaction of the Panel, the Complainant has proven that the disputed domain name was registered and is being used in bad faith. The requirement of Paragraph 4(a)(iii) of the Policy is therefore met.

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

For all the foregoing reasons, the Panel orders the domain name <caketailbyremycointreau.com> to be transferred to Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CAKETAILBYREMYCOINTREAU.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2020-12-11

Publish the Decision