

Decision for dispute CAC-UDRP-100309

Case number CAC-UDRP-100309

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Domain names tarjetaroadirecta.net

Case administrator

Name Tereza Bartošková (Case admin)

Complainant

Organization Puerto 80 Projects, SLU

Respondent

Organization PUBLISTYLE

IDENTIFICATION OF RIGHTS

Rojadirecta is a combined trademark registered under number 2938949 and Nice classification: 38 in the OEPM (Spanish Patents and Trademark Office)

FACTUAL BACKGROUND

The parties are disputing whether the domain names in question violate the trademark right of the complainant.

PARTIES CONTENTIONS

COMPLAINANT:

Apparently, the complainant holds the view that with his combined trademark he is as well rightholder in the term "Rojadirecta". He states: "Tarjeta roja" is the most common confusion when someone refers to Rojadirecta (roja directa), they have the same meaning in Spanish. In football when a player receives a red card ("tarjeta roja" in Spain) without previously receiving two yellow cards that is called Roja directa ("direct red"). A proof of this confusion is the fact that our domain rojadirecta.es appears as the top hit (although it is filtered by Google due to a complaint related to the DMCA and our address 209.44.113.146/ appears in its place as the second hit). There are also a whole host of comments in Spanish on the Internet in which the users confuse tarjeta roja when trying to access Rojadirecta, for example the page dating from 2007 in which a user has problems accessing Rojadirecta because he confuses it with "Tarjeta roja": <http://es.answers.yahoo.com/> . This problem can also be seen in many of the comments from users available in one of the blogs from those domains which the registrar uses for "link farming" <http://tecnologia7.net/> One more sign of evidence of this is that the following Google search ("tarjeta roja "rojadirecta") shows 60500 results.<http://www.google.com/>"

RESPONDENT:

The respondent claims that there is no violation of trademark rights. He states: "The recently trademarked by the plaintiff is "Rojadirecta" a word of 11 characters and no spaces, where today not even have ownership of the TLDs with that exact term.

The term is commonly used Red Direct popular and refers to the card displays the referee in a football match to mark the expulsion of a player, like the terms or Red Card, Red Card Direct is the one we use on our behalf domain. Sounds illogical to pretend that it is blocking domains that contain those words of general use in the world of football. It's like registering the term "Free Games" and began to notify all who take the term in its domain, it would be unconscionable. It also calls for the content of tarjetarodirecta.net other error of the plaintiff, as they are totally different content. The site "Rojadirecta" focuses exclusively on providing links to display any kind of sports activity on the Internet, football, baseball, basketball, cricket, hockey, tennis, handball or Internet relay event. Instead the issue of "tarjetarodirecta.net" focuses on the world of football, show information relevant parties, whether comments, alignments, stadiums, referees, dates, hours of gameplay and options to view additional matches streaming reference to "Rojadirecta" as one of several alternatives, focusing on something that has always defended the plaintiff "link is not a crime." Therefore, "tarjetarodirecta.net" is totally alien to the page content "Rojadirecta". Anyway to avoid discomfort we have eliminated any mention or link that would lead to "Rojadirecta" from "tarjetarodirecta.net" although they allowed in your CC licens."

RIGHTS

The Complainant has definitively not shown the domain names in question are 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).

As the annex to his complaint shows, the Complainant is the owner of a combined word and device trademark which links the wording rojadirecta with the image of a man/referee holding a red card in his left hand. The referee is obviously similar to the famous referee Pierluigi Collina. The Spanish term "roja directa" is only a descriptive term for the red card used especially in football. This generic use of the term "roja directa" is important in the light of the fact that both parties have a common background in the Spanish language and direct their activities to a Spanish-speaking audience. At least in this Spanish context the complainant would have never been granted a word trademark "rojadirecta". The distinctiveness of his trademark is based upon the combination of words "rojadirecta" with a highly decorative and creative image of a referee holding up as red card.

Here the combined trademark features a prominent design with a commonly used or generic word beside it. In this situation, it is inappropriate to disregard the device element and to limit the comparison to one between the textual component of the relevant mark and the alphanumeric string in the disputed domain name (see e.g. RUGGEDCOM, Inc. v. James Krachefels, WIPO Case No. D2009-0130; Meat & Livestock Commission v David Pearce aka OTC / The Recipe for BSE, WIPO Case No. D2003-0645 with further references). In fact, in cases where the word element is a dictionary or common term and has no inherent distinctiveness, there should be an onus on the complainant to present compelling evidence of secondary meaning or distinctiveness through extensive use (see e.g. Dreamstar Cash S.L. v. Brad Klarkson, WIPO Case No. D2007-1943; Limited Liability Company Infomedia v. c/o Office-Mail processing center, WIPO Case No. D2010-1239).

As this evidence is missing here, there is no likelihood of confusion comparing the domain names in question with this combined trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

Considering the fact that there is no likelihood of confusion between the domainnames in question and the trademark, there is no need to consider rights or legitimate interests of the respondent.

BAD FAITH

Considering the fact that there is no likelihood of confusion between the domainnames in question and the trademark, there is no need to consider bad faith questions.

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 trademark of the complainant combines a prominent design with a commonly used or generic word. In this situation there is no evidence for a likelihood of confusion between the trademark and the domain name in question.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **TARJETAROJADIRECTA.NET**: Remaining with the Respondent
 2. **TARJETAROJA.INFO**: Remaining with the Respondent
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PANELLISTS

Name	Thomas Hoeren
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DATE OF PANEL DECISION **2011-10-03**

Publish the Decision
