Decision for dispute CAC-UDRP-100762

Case number	CAC-UDRP-100762
Time of filing	2014-02-28 11:23:55
Domain names	rueducommerce-rdc.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	RueDuCommerce

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Organization	Wave Connections

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 the owner of trademark registrations for RUE DU COMMERCE, RDC.FR RUE DU COMMERCE and RUE DU COMMERCE.COM.

FACTUAL BACKGROUND

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

The Complainant was established in 1999 and is the owner of the following registered trademarks:

French trademark No. 3374566 for WWW.RUE DU COMMERCE.COM (figurative mark), registered on July 29, 2005, in classes 9, 16, 28, 35, 38, 41 and 42;

French trademark No. 3036950 for RUE DU COMMERCE (word mark), registered on June 27, 2000, in classes 9, 16, 28, 35, 38, 41 and 42;

French trademark No. 99805150 for RDC.FR RUE DU COMMERCE (word mark), registered on July 28, 1999, in classes 35, 38 and 42;

Community trademark No. 8299381 for RUE DU COMMERCE.COM (word mark), registered on May14, 2009, in classes 16, 35, 36, 37, 38, 41 and 42;
Community trademark No. 8299356 for RUE DU COMMERCE (word mark), registered on May 14, 2009, in classes 16, 35, 36, 37, 38, 41 and 42;

Community trademark No. 12014833 for RUE DU COMMERCE (figurative mark), registered on July 25, 2013, in classes 9, 16, 35, 36, 37, 38, 41 and 42.

The Complainant operates an e-commerce web site at www.rueducommerce.fr and is also the owner of the domain name <rueducommerce.com>.

The disputed domain name <rueducommerce-rdc.com> was registered on August 22, 2013.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT

The Complainant asserts that, during more than eleven years, RueDuCommerce has gained an important notoriety among the French net surfers and consumers, being nowadays a major e-merchant in France whose honorability and reliability are well known among Internet users.

The Complainant contends that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights, as it fully incorporates the trademark RUEDUCOMMERCE, with the minor addition of a dash and the “Rue du Commerce” acronym “rdc”. The Complainant concludes that, in view of the above, Internet users who search for the Complainant on the Internet may mistakenly believe that the disputed domain name be somehow related to or authorized by the Complainant.

With reference to the Respondent’s rights or legitimate interest in the disputed domain name, the Complainant states that it has not licensed or otherwise permitted the Respondent to use its trademark or to apply for or use any domain name incorporating it.

The Complainant indicates that its Internet inquiries and trademark database searches have not revealed any use or registrations by the Respondent that could be considered relevant.

The Complainant informs the Panel that it has tried to reach the Respondent, by email and registered mail, on August 27, 2013 and that the Respondent answered explaining that the disputed domain name was registered on behalf of a D.R. Congo organization business related to an avenue in Kinshasa called “Avenue du Commerce”. The Complainant therefore followed up requesting additional information about the referenced D.R Congo organization business but received no additional replies from the Respondent. In addition, the Complainant also addressed a letter to the concerned registrar by email and registered mail, after which the disputed domain name was suspended.

The Complainant underlines that the disputed domain name is not actively used by the Respondent and states that it has never been used in connection with a bona fide offering goods or services or with a legitimate commercial or non-commercial business activity. Therefore, the Complainant concludes that the disputed domain name has been registered by the Respondent without any rights or legitimate interest.

As to the bad faith requirement, the Complainant highlights that the Respondent registered the disputed domain name on August 22, 2013, after the registration of the Complainant’s trademarks. The Complainant submits that the Respondent

could be aware, at the time of the registration, of the Complainant's trademark and of the infringement of the Complainant's intellectual property rights it was committing by registering the disputed domain name.

The Complainant contends that the main purpose of the Respondent's registration of the disputed domain name was to prevent the Complainant from reflecting its trademark in a corresponding domain name and states that the Respondent's non-use of the disputed domain name is perceived as an act of "passive holding" which prevents the Complainant from registering the disputed domain name under its rightfully owned trademark.

The Complainant further states that, as the Respondent has no legal right to use the Complainant's trademark, it is clearly maintaining the disputed domain name in bad faith for its own benefit.

RESPONDENT

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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

1. The disputed domain name includes the registered trademark RUE DU COMMERCE of the Complainant, with the addition of the hyphen and of the acronym of the Complainant's trademark and company name "rdc". In line with a number of prior decisions rendered under the UDRP, the Panel finds that the addition of the dash and of these three letters to the Complainant's trademark is not sufficient to exclude the confusing similarity.

2. The Complainant has stated that the Respondent is not affiliated with or authorized by the Complainant in any way. There is no evidence of the fact that the Respondent might have been commonly known by the disputed domain name or by a name corresponding to the disputed domain name. According to the evidence on records, the Respondent has passively held the disputed domain name and has not submitted any evidence showing that it made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, or that it has made a legitimate non-commercial or fair use of the disputed domain name. The Respondent replied to the cease and desist letter of the Complainant stating that it had registered the disputed domain name for a D.R. Congo organization business related to an avenue in Kinshasa called "Avenue du Commerce", but has failed to provide any evidence to substantiate its statement as well as additional details about its alleged client. In view of the above, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name.

3. As to bad faith at the time of registration, in light of the prior registration and use of the Complainant's trademark RUE DU COMMERCE since 1999 in connection with the e-commerce services provided by the Complainant through its web sites

<rueducommerce.fr> and <rueducommerce.com>, considering that the disputed domain name differs from the Complainant's trademark only for the addition of an hyphen and of the three letters "rdc" and in view of the fact that the disputed domain name has not been actively used and that there is no evidence showing that the Respondent might have any right or legitimate interest in the disputed domain name, the Panel finds that the Respondent was more likely than not aware of the Complainant's trademark and that the registration of the disputed domain name cannot be ascribed to a mere coincidence. The disputed domain name is not used in connection with an active web site, i.e. is passively held. As established in a number of prior cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding; see the landmark case Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. Therefore, the Panel concludes that the Respondent has registered and used 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. **RUEDUCOMMERCE-RDC.COM**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2014-04-09

Publish the Decision