

Decision for dispute CAC-UDRP-100820

Case number	CAC-UDRP-100820
Time of filing	2014-06-26 11:00:46
Domain names	TOPPROMOVACANCES.COM

Case administrator

Name	Lada Válková (Case admin)
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Complainant

Organization	KARAVEL S.A.S.
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Complainant representative

Organization	Nameshield (Laurent Becker)
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Respondent

Organization	TRAVEL BOOKING TRAVEL BOOKING
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OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered holder of, inter alia, the following trademarks:

(i) PROMOVACANCES (word), national French trademark, application no. 3044756, registered for goods and services in classes 38, 39, 41, 43 and 44, priority date: 2 August 2000;

(ii) PROMOVACANCES.COM (combined), national French trademark, application no. 3277198, registered for goods and services in classes 38, 39 and 41, priority date: 26 February 2004;

(iii) PROMOVACANCES.COM (combined), national French trademark, application no. 3024472, registered for goods and services in classes 38,41 and 42, priority date: 27 April 2000; and

(iv) PROMOVACANCES.COM (combined), community trademark, application no. 8982134, registered for goods and services in classes 16,38, 39, 41 and 43, priority date: 5 March 2010.

In addition, the Complainant operates an online travel agency under the domain name: PROMOVACANCES.COM. This domain

name is also owned by the Complainant.

FACTUAL BACKGROUND

FACTS ASSERTED BY COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The Complainant was established in 1998 and, since then, has been operating an online travel agency under the domain name: PROMOVACANCES.COM.

The Complainant's travel agency operates under the domain name and brand PROMOVACANCES.COM, offering more than 10,000 trips - daily updated and including holidays, tours, weekends, cruises, spas, diving, golfing, flights, car hires, etc.

The Complainant also has provided figures about a number of its customers of the online travel agency and visitors to the website operated under PROMOVACANCES.COM as well as some other data concerning its business.

The Complainant is a holder of various registered national as well as community trademarks that consist of the denomination PROMOVACANCES or PROMOVACANCES.COM, as described in more detail above.

The disputed domain name was registered on 13 December 2013.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims that the disputed domain name is confusingly similar to its trademarks (as listed above), since it incorporates PROMOVACANCES and PROMOVACANCES.COM denominations, which are dominant parts of the said trademarks. The Complainant contends that, as a result, the disputed domain name alone as well as any website operated under it creates an overall impression that they are connected to the Complainant's trademarks and its business.

Further, the Complainant alleges that the expression "PROMOVACANCES" is exclusively known in relation with the Complainant. In this respect, the Complainant has presented to the Panel the following evidence, which has been assessed by the Panel:

- Information regarding the Complainant;
- List of the Complainant's trademarks;
- List of the Complainant's domain names;
- Copy of Results of Google search for a term "PROMOVACANCES."

The Complainant also presents other facts and evidence to show that the domain name has been registered and used in bad faith - and that the Respondent has no rights or legitimate interest to the disputed domain name. However, for the reasons described below, such statements and evidence were not assessed by the Panel, because it was not necessary to do so in order for the Panel to issue a decision in this case.

RESPONDENT:

The Respondent has not provided any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain name is not 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 Uniform Dispute Resolution Policy (“UDRP” or “Policy”).

As a result, the Panel rejects the complaint.

For reasons and substantiation of such finding, please see below.

NO RIGHTS OR LEGITIMATE INTERESTS

This element was not envisaged by the Panel.

Since the three elements of paragraph 4(a) of the Policy are conjunctive and because the Complainant did not satisfy the requirement of paragraph 4(a)(i) and 4 (a) (iii) of the Policy, the Panel did not further investigate whether the remaining element is present or not.

BAD FAITH

The Panel concluded that the disputed domain name has not been registered and is being used in bad faith within meaning of paragraph 4(a)(iii) of the UDRP.

As a result, the Panel rejects the complaint.

For reasons and substantiation of such finding, please see below.

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

Since the domain name and the Complainant’s trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a rather generic term “TOPPROMOVACANCES.COM” is confusingly similar to the Complainant’s trademarks “PROMOVACANCES” or “PROMOVACANCES.COM”.

Having in mind the complexity of this issue, the Panel below reveals in detail its considerations and findings:

(i) Existing Case Law

In decisions by various panels constituted under the UDRP process to resolve domain name disputes, there has been discussion of what constitutes confusion for the purposes of paragraph 4(a)(i) where registered trademarks and domain names already in use had been joined together with generic prefixes or suffixes to form a new domain name (sometimes referred to as a derivative).

Although the panel is well aware that the principle of stare decisis does not apply in these proceedings and that it is not bound by decisions reached by earlier panels, it is of the opinion that a review of some the cases provides some support for the conclusions of this decision.

(i) (a) Prefix or Suffix Case Law

There are a number of other decisions within the UDRP process which have addressed the issue of whether a domain name, which comprises the Complainant’s mark together with a prefix or suffix, gives rise to confusing similarity.

The decisions fall mainly into two categories: 1) addition of a geographical suffix to a well-known domain name (see, for example, Wal-Mart Stores, Inc. v Walmarket Canada, WIPO D2000-0150; Wal-Mart Stores, Inc. v Walsucks and Walmarket Puerto Rico, WIPO D2000-0477; AltaVista Company v S.M.A. Inc., WIPO D2000-0927), or 2) addition of “sucks” to a similarly well known name (see, for example, Dixons Group Plc v Purge I.T. and Purge I.T. Ltd., WIPO D2000-0584; Cabela’s Inc. v Cupcake Patrol, NAF FA0006000095080; Wal-Mart Stores, Inc. v Walsucks and Walmarket Puerto Rico, WIPO D2000-0477).

The Complainant has typically prevailed in both types of categories.

Decisions in the former category have been disposed of generally on the clearly correct basis that the addition of a place name is not likely to alter the underlying mark (Wal-Mart Stores, Inc v Walsucks and Walmarket Puerto Rico, WIPO D2000-0477) and not likely to change the fact that consumers will be confused.

Decisions in the second category have been decided for on the basis of similar reasoning, though this seems more open to dispute. There are a number of other decisions where there is neither a geographical, nor derogatory addition (see, for example, Yahoo!, Inc. and Geocities v Cupcakes et al., WIPO D2000-0777; Yahoo!, Inc. v Cupcake Patrol et al., WIPO D2000-0928). These too have followed similar reasoning, though the finding of confusing similarity is largely based in these cases on evidence of demonstrated confusion amongst consumers.

The disputed domain name which is the subject of this administrative decision does not fall into either the geographical or “sucks” category, but at first blush the same principle would appear to apply: the addition of a prefix does not alter the underlying mark and confusion will inevitably result.

It is here that the Complainant’s idea of ‘genericness’ comes into play. The other decisions dealt with either extremely well known marks, which had a high degree of inherent or acquired distinctiveness: for example, Walmart, Standard Chartered, Dixons, Altavista and Yahoo, or at least concerned trademarks which have no meaning in common language (i.e. they are fantasy or imaginary trademarks “invented” by their holders).

They did not deal, as here, with marks which are the concatenation of two words that are fairly generic. This has been dealt in other case law.

(i) (b) Generic mark and generic word case law

On the other hand, decisions dealing with an issue of descriptiveness of the trademark or a trademark and a generic word, showing a more mixed decision, often resulted in rejection of the complaint (see, for example, Hotels unis de France vs. Christopher Dent / Exclusivehotel.com, WIPO D2005-1194, Pinnacle Intellectual Property vs. World Wide Exports. WIPO D2005-1211, City Utilities of Springfield vs. Ed Davidson, WIPO D2000-0407 and similar).

(ii) Legal Analysis

The effect of strictly and automatically adopting the principle from the prefix or suffix cases would be to stop any other registrations of domain names which add either a prefix or suffix to registered trademarks, even though such trademarks are quite generic.

In the Panel’s view, the scope of the concept of “confusing similarity” must be taken into account.

The Panel declines, therefore, to adopt the broadest interpretation of the principle from the suffix or prefix cases, and instead believes that it is necessary to apply a more case specific approach as established by “mark with generic word” and “generic / distinctive” case law.

As a result, the Panel believes that as a basic guideline, following test should be followed:

A domain name comprising from a trademark and a prefix should not be in general held confusingly similar to such trademark:

(1) Where that trademark is essentially generic within the online world and has not acquired such distinctiveness as to merit

broader protection (i.e. in particular, where such originally generic trademark has not yet - through its use, advertising good name, etc. - acquired such distinctiveness that it is exclusively attributable to its trademark holder – Complainant); and

(2) Where the prefix (or the domain name as a whole) does not relate specifically and exclusively to the business of the Complainant.

Ad 1) Generic Nature of the Trademarks

In the Panel's view, the Complainant's trademarks consisting of the "PROMOVACANCES" denomination are rather non-distinctive. It is apparent that the words "PROMO VACANCES" are words that are descriptive or laudatory of the services in respect of which the trademark and the domain names are used. i.e. travelling and travel agency services. They have the similar meaning as "promo séjours" - and they are frequently used in French language. Even though the meaning is not exactly the same, it has a similar meaning as the English term "special offer" and similarly as "last minute" or "early bird" terms (which have, of course, a different connotation), they all describe specific types of offers provided by travel agencies to their prospective clients.

The Complainant is trying to show by the results of the Google online search that the term "PROMOVACANCES" is specifically and solely connected with the Complainant. However, such an approach is misleading. Insofar as elimination of the spacing between words in domain names is dictated by technological factors and is a common practice among domain name registrants, the Panel concludes that since in normal language the term consists of two words PROMO and VACANCES, it is necessary to perform the search for these two words separately (divided by a space), not as a single word.

In such a case, the results of the search clearly show that the words PROMO VACANCES are commonly used by many travel agencies and tourists in the French-spoken world - and it is not, by far, attributable or connected solely to the business of the Complainant.

As a result, despite all the promotion and advertising spent by the Complainant, its trademarks have not become so well known as to acquire the requisite degree of distinctiveness taking them out of their original generic nature.

This implies that Internet user's are aware of the fact that the term "PROMO VACANCES" is legitimately and commonly used by various subjects on the Internet, both as a part of domain names or within Internet content (e.g. on websites, etc.) and, therefore, that they do not associate this term solely with the Complainant or its business. In the Panel's view, the Internet public understands and anticipates that various modifications of such generic and common terms will exist, that they will be used by different subjects, and that they do not reasonably expect all of them will be associated with the Complainant.

Ad 2) Generic Nature of the Prefix

It is apparent that the prefix "TOP" is laudatory and cannot alone or by inclusion to the disputed domain name change the generic nature thereof or make the domain name specially attributable to the Complainant, or be exclusively connected with its services or business.

In addition to the test above, the Panel believes that for a domain name to be regarded as confusingly similar to the Complainant's trademark, there must be a risk that Internet users may actually believe there to be a real connection between the domain name and the Complainant and/or its goods and services. As it follows from the above, this is not the case.

Thus, by failing the above test, the Panel concludes that even though the domain name "toppromovacances.com" is similar to the PROMOVACANCES trademarks, it is not confusingly similar to such Complainant's trademarks.

Since the Panel has decided that there is no confusing similarity in this case, it also concludes that the Complainant has not satisfied paragraph 4(a)(i) of the UDRP.

Moreover, in the opinion of the Panel, the Complainant has not managed to prove bad faith on the part of the Respondent in

registering and using the domain name.

It is clear from the terms of paragraph 4(a)(iii) of the UDRP as well as confirmed by numerous decisions under it that the two elements of this third requirement are cumulative; both registration and use in bad faith must be proved for a complaint to succeed. See, for example, World Wrestling Federation Entertainment, Inc. v. Michael Bosman, WIPO D1999-0001, Telstra Computers Ltd v. Nuclear Marshmallows, WIPO D2000-0003 and A. Nattermann & Cie. GmbH and Sanofi-aventis v. Watson Pharmaceuticals, Inc., WIPO D2010-0800.

The Complainant asserts that "... given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks" and that "... by using the disputed domain name, the Respondent has attempted to create a likelihood of confusion in order to contact the Complainant's customers."

The Panel contends that the bad faith element in this particular case is closely connected with the "confusing similarity" and "false association" concepts as described above. Since the Panel has asserted that the term "PROMO VACANCES" is still generic and commonly used, it has concluded that there is no likelihood of confusion or false association between the disputed domain name and the Complainant's trademark and its business, unless the Complainant proves otherwise in this specific case.

It is possible that the Respondent has been aware of Complainant's trademarks, domain names and business in general; however, this does not automatically mean that it has registered its domain name in bad faith in order to "free ride" on the Complainant's or its trademarks' reputation, since the domain name is descriptive of the services that the Complainant has been offering.

In addition, the Complainant claims that the Respondent has attempted to create a likelihood of confusion in order to contact the Complainant's customers - and it provides the Panel with evidence of such Respondent's alleged intent. However, such evidence (Annex 9 to the Complaint) does not prove such Claimant's contention. First, it was provided in French language only, without any translation into the language of the dispute (i.e. English) and, thus, can be disregarded by the Panel. Second, and more importantly, the evidence is a copy from a traveller's blog, which merely shows that various people have complained about the services of the Respondent or its affiliates. Still, these travellers neither state that they were in any way misled about the origin of such unsatisfactory services, nor do they warn others not to confuse the services of the Respondent (offered through the "TOPPROMOVACANCES" website) with the services of the Complainant. On the contrary, it is apparent that they know that such website is operated by a provider of services different from the Complainant.

As a result, the Panel concludes that the Complainant has failed to prove that the disputed domain name has been registered and is being used in bad faith within meaning of paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **TOPPROMOVACANCES.COM**: Remaining with the Respondent

PANELLISTS

Name	JUDr. Jiří Čermák
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DATE OF PANEL DECISION 2014-08-08

Publish the Decision
