Decision for dispute CAC-UDRP-100838

Case number	CAC-UDRP-100838
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Domain names	Grand-prix-monaco.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	AUTOMOBILE CLUB DE MONACO

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Organization	Hotels Web Service

Respondent representative

Organization	CASALONGA AVOCATS

OTHER LEGAL PROCEEDINGS

The Panel is not aware of the existence of other legal proceedings concerning the <www.grand-prix-monaco.com> domain name (the “Disputed Domain Name”).

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of the following Community Trade Marks and also Madrid Protocol trade marks designating, amongst other countries, France:

Registration No. 629519 GRAND PRIX DE MONACO (word) in classes 3,12,16,18,24,25,28,34,35,42, registered on 6 January 1995 under the Madrid Protocol.

Registration No. 487220 GRAND PRIX DE MONACO (device) in classes 24,34,42, registered on 10 September 1984 under the

Madrid Protocol.

Registration No. 485820 GRAND PRIX DE MONACO (device) in classes 3,12,16,18,25,28,35, registered on 27 June 1984 under the Madrid Protocol.

Registration No. 2046472 MONACO GRAND PRIX (device) in classes 3,4,5,8,9,11,14,18,20,21,22,26,32,33,34,35,36,41,42, registered on 20 June 2002 as a CTM.

Registration No. 1725449 MONACO GRAND PRIX (device) in classes 9,12,16,24,25,28,38,41,42, registered on 28 August 2001 as a CTM.

Registration No. 4258877 MONACO GRAND PRIX (device) in classes 9,14,16,18,21,25,41 registered on 1 August 2001 as a CTM.

Registration No. 12012597 GRAND PRIX DE MONACO HISTORIQUE (word) in classes 14,18,21,34, registered on 24 January 2014 as a CTM.

Registration No. 516077 GRAND PRIX AUTOMOBILE DE MONACO (word) in classes 9,16,25,28 registered on 22 September 1987 as a CTM.

The Complainant is also the registered owner of the domain name <grandprixmonaco.com>. This was registered on 15 May 2002.

FACTUAL BACKGROUND

The Complainant is a Monaco based car club that was founded in 1890 and, in particular, organises the annual Formula 1 Grand Prix of Monaco. The Complainant owns registered trade marks as set out above for the word marks GRAND PRIX DE MONACO, GRAND PRIX AUTOMOBILE DE MONACO and GRAND PRIX DE MONACO HISTORIQUE and for the combined word / device marks GRAND PRIX DE MONACO and MONACO GRAND PRIX. The registration dates for these trade marks range from 1984 to 2013. The Complainant also owns the <grandprixmonaco.com> domain name, which it registered in 2002.

The Respondent registered the Disputed Domain Name on 10 January 2006 after a third party owner had let it lapse and it became available for new registration. However, the Respondent provided evidence from https://web.archive.org that the Disputed Domain name was in use by a third party in 2001.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the Disputed Domain Name is confusingly similar to the Complainant’s trade marks.

The Complainant further claims that the Respondent registered the Disputed Domain Name without any rights or legitimate interest in the name. It claims that the Respondent is not commonly known as <grand-prix-monaco.com>, that the Respondent’s name and contact details contain no reference to “grand-prix-monaco” or to similar words or names and that the Respondent is not affiliated with the Complainant or authorised by it in any way.

The Complainant further asserts that the Disputed Domain Name has been used in bad faith as, amongst other things, the Disputed Domain Name has been intentionally registered and used in an attempt to attract, for commercial gain, internet users to the Respondent’s website or other online location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the Respondent’s website or location.

The Complainant asserts that the Disputed Domain Name was knowingly registered by the Respondent with full knowledge of the Complainant's trade marks.

RESPONDENT:

The Respondent contends that the Disputed Domain Name was registered in 2001, before the registration of the Complainant's domain name, and was legally acquired by it in 2006.

The Respondent further claims that the Disputed Domain Name does not create any risk of confusion with the Complainant's trade marks because the terms used and their composition are different and the signs at issue are composed of common words that are at least descriptive.

The Respondent submits that it has rights and / or legitimate interests in the Disputed Domain Name since it provides services to customers attending the Formula 1 Grand Prix of Monaco organised annually by the Complainant, in relation to hotel reservations, transfer facilities and event tickets. It notes that all pages of its website contain a disclosure, which it says also removes any risk of confusion for the relevant public.

The Respondent states it has legitimate interests in the Disputed Domain Name and does not need to be authorised by the Complainant as the words used in the domain name are descriptive of the services provided by the website. In particular, it relies on the decision in Tourism Tasmania v Gordon James Craven, WIPO case No. DAU2003-0001.

In respect of the Complainant's submission on bad faith, the Respondent states that:

1. the Complainant failed to demonstrate that the Respondent had knowledge of its trade marks when registering the Disputed Domain Name;

2. the Respondent could legitimately consider the words "grand prix Monaco" were not protected by a trade mark as they constitute common words;

3. the Respondent could not have diverted the Complainant's customers since it does not directly sell tickets but offers the services of official distributors or authorised agents that have been authorised by the Complainant;

4. where the Respondent's website displays content in respect of the race or the Complainant, it does so with a disclaimer, demonstrating that the Respondent is acting in good faith. The Respondent relies on the decision in Dr. Ing. H.c. F. Porsche AG v Del Fabbro Laurent, Wipo Case no D2004-0481 in respect of this; and

5. the Respondent has no alternative but to use the terms "grand prix Monaco" to describe its own activity, and relies on the decisions in Comexpo Paris v Visiotex S, WIPO case no. D2000-0792 and Tourism Tasmania, above.

The Respondent submits that the above demonstrates that it has not acted in bad faith.

RIGHTS

The Complainant has established that it owns the registered word mark GRAND PRIX DE MONACO under WIPO registration number 629519 dating from 6 January 1995, which has been registered in France under registration number 629519. The Panel finds that the Complainant therefore owns trade mark rights for the purposes of the Policy.

The Panel accepts the Complainant's claim that the Disputed Domain Name is confusingly similar to this word mark, the only differences being the addition of the word "DE" and the lack of dashes between the words. These differences do not distinguish the Disputed Domain Name from the Complainant's registered word marks and the Panel therefore finds that the

Disputed Domain name is confusingly similar to the Complainant's registered word mark and that the complaint succeeds under this element of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has submitted that the Respondent is not commonly known by the Disputed Domain Name and is not connected in any way with the Complainant's business in organising the Monaco Grand Prix races. It further submits that the Complainant has not authorised the Respondent's use of the Disputed Domain Name. The Complainant has therefore made out a prima facie case that the Respondent has no right or legitimate interest in the Disputed Domain Name.

The Respondent argues that it is entitled to use the Disputed Domain Name because it is descriptive and constitutes commonly used words, that it does not directly sell tickets but rather offers the services of distributors or agents authorised by the Complainant and that it uses a disclaimer on each webpage.

As far as descriptiveness is concerned, the Panel notes that, although the words individually may be descriptive, the Complainant owns registered trade mark rights for the GRAND PRIX DE MONACO word mark as a whole and by virtue of very considerable use has developed a substantial reputation and secondary meaning in relation to the Complainant's motor racing competition. As noted above the Disputed Domain Name is confusingly similar to this mark for the purposes of the Policy. The Respondent could have chosen a number of combinations of words for its domain name which would have distinguished it from the Complainant's trade marks, but apparently chose not to do so. Further, the fact that the Disputed Domain Name became available in 2006 for registration is irrelevant and does not mean that the Respondent could register it with impunity. The Respondent's disclaimer, which is in very small font at the bottom of each webpage and is barely discernible to users of its site, does not in these circumstances assist.

Considering the Panel's findings below in relation to bad faith, the overriding inference is that the Respondent chose the Disputed Domain Name in order to attract traffic to its website, without the Complainant's authority and in order to sell services related to the Complainant's Monaco Grand Prix race. This is not legitimate conduct and accordingly the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and that the claim succeeds under the second element of the Policy.

BAD FAITH

For Paragraph 4(a)(iii) of the Policy to apply, the onus is on the Complainant to prove that the Respondent both registered the Disputed Domain Name in bad faith and uses it in bad faith.

The Respondent acquired the Disputed Domain Name after it became available in 2006. This is therefore the relevant date for consideration of registration in bad faith, not the original date of registration of the Disputed Domain Name in 2001 by a third party.

The Panel accepts the Complainant's claim that the Disputed Domain Name was registered in bad faith. The Complainant has owned the GRAND PRIX MONACO word mark for 19 years and has been operating the race for considerably longer. It is reasonable to infer from all the circumstances that the Respondent was aware of the race or the Complainant's trade mark rights or, in the Panel's view, should have been so aware. The Panel considers that on the balance of probabilities the inference can be drawn that the Respondent registered the Disputed Domain Name with knowledge of the Complainant's rights.

The Panel further accepts the Complainant's claim that the Disputed Domain Name is currently being used in bad faith to intentionally attempt to attract, for commercial gain, internet users to its website and other on line locations by creating a likelihood of confusion with the complainant's market as to the source, sponsorship, affiliation and endorsement of the website and the services of the website. As noted above under "Rights", the Disputed Domain Name is confusingly similar to the Complainant's trade marks. That confusing similarity is such that internet users, in searching for the Complainant's website, may be diverted to the Respondent's website, which then further links to hotels and other service not connected with the Complainant. For instance, the Panel notes that a search on Google for "Grand Prix Monaco", delivers the Disputed

Domain Name as the first result.

As noted in the section above, the Panel does not accept the Respondent's arguments concerning descriptiveness or genericism.

The Panel further rejects the submissions by the Respondent that it has no alternative but to use the words "grand prix Monaco" in its domain name and website pages, to describe its own activity. It would be possible to describe its activities using other formulas of words, or to distinguish its operation by using them in conjunction with other distinguishing terms. Neither does the Panel find that the Comexpo and Discover Tasmania decisions are relevant. In Comexpo, the panel found on the facts that the respondent was not aware of the complainant's ownership of trade marks, which is not the case here. In Discover Tasmania, the panel found that the respondent took all reasonable steps to assure himself that the words contained in the domain name were not registered or used as a trade mark. Similarly, there is nothing to justify this in the instant case.

Accordingly, the Panel finds that the Respondent's registration and use of the Disputed Domain Name were in bad faith, and the Complainant's claim succeeds under this element 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

For all the foregoing reasons, the Panel accepts the Complaint of the Complainant and orders that the Disputed Domain Name be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GRAND-PRIX-MONACO.COM**: Transferred

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2014-09-23

Publish the Decision