Decision for dispute CAC-UDRP-100824

Case number	CAC-UDRP-100824
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Domain names	rdcommerce.net

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	RueDuCommerce

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Organization	ELECTRONIQUE-MARKET.COM

IDENTIFICATION OF RIGHTS

The Complainant is the owner of a number of proved French trade marks, European Community trade marks and International trade marks, including the following:

- French trade mark No.99805150 RDC.FR RUE DU COMMERCE, registered on 28 July 1999;

- French trade mark No.3036950 RUE DU COMMERCE registered on 27 June 2000;

- French trade mark No.3374566 WWW.RUE DU COMMERCE.COM registered on 29 July 2005;

- European Community trade mark No.8299381 RUE DU COMMERCE.COM registered on 14 May 2009;

- International trade mark No.754897 RUE DU COMMERCE registered on 15 November 2000;

- International trade mark No.882818 WWW.RUEDUCOMMERCE.COM registered on 13 January 2006.

In addition, the Complainant uses the domain names <rueducommerce.com> and <rueducommerce.fr> which resolve to the official website of the Complainant, namely www.rueducommerce.fr.

FACTUAL BACKGROUND

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

The Complainant claims it has registered the following trademarks in France:

• « http ://www.rue du commerce.fr », registered on 26 January 1999 under number 99771021, goods and services class 35, 38 and 42.

• « RDC.fr RUE DU COMMERCE », registered on 28 july 1999 undr number 99805150, for goods and services class 35,38 and 42.

• « WWW.RUE DU COMMERCE.FR », registered on 17 April 2000 under number 3022048, for goods and services class 9, 16, 25, 38 and 41.

• "RUE DU COMMERCE", registered on 27 June 2000 under number 3036950, for goods and services class 9, 16, 28, 35, 38, 41 et 42.

• WWW.RUE DU COMMERCE.COM, registered on 29 July 2005 under number 3374566 for goods and services class 9, 16, 28, 35, 38, 41 and 42.

Moreover, the Complainant contends it has registered the following CTM:

• « RUE DU COMMERCE.COM », registered on 14 May 2009 under number 8299381 for goods and services class 16, 35, 36, 37, 38, 41, 42

• « RUE DU COMMERCE », registered on 14 May 2009 under number 8299356 for goods and services class 16, 35, 36, 37, 38, 41, 42.

• « RUE DU COMMERCE », registered on 25 July 2013 under number 12014833 for goods and services class 9, 16, 35, 36, 37, 38, 41, 42.

Furthermore, the Complainant states it has registered the following international trademarks:

• WWW.RUEDUCOMMERCE.FR registered on 17 October 2000 under number 746334, for goods and services class 9, 16, 28, 35, 38, and 41.

• "RUE DU COMMERCE" registered on 15 November 2000 under number 754897, for goods and services class 9, 16, 28, 35, 38, 41, and 42.

• "WWW.RUEDUCOMMERE.COM" registered on 13 January 2006 under number 882818, for goods and services class 9, 16, 8, 35, 38, 41 and 42.

According to the Complainant, the RueDuCommerce Company has been registered on 27 April 1999 under the number B 422 797 720 R.C.S. BOBIGNY. Its head office is situated 44 Avenue du Capitaine Glarner, 93400 ST OUEN – FRANCE.

The Complainant claims that RueDuCommerce is the owner of a portfolio of Trademarks for the course of its internet-order selling business activities on web sites accessible in particular at the addresses www.rueducommerce.com and www.rueducommerce.fr.

Furthermore, during more than eleven years RueDuCommerce has gained an important notoriety among the French net surfers and consumers. It is now a major e-merchant in France whose honorability and reliability are well known from the Internet users.

The Complainant claims that the disputed domain names are confusingly similar to trademarks in which the Complainant has rights. According to the Complainant, the litigious domain names www.rdcommerce.net and www.rdcomerce.com are almost identical to the mark “Rue Du Commerce”.

This similarity is illustrated, in particular, on three levels:

1) Visually, the domain names contain the same contraction naming just emphasize the symbol "RDC" which corresponds to the historic signing of the company RueDuCommerce (as shown by the mark referred above).

2) Conceptually, only three mute letters distinguish the name "RDCommerce" of "RueDuCommerce." The recovery is almost identical and the spirit of the text is unaffected by the absence of these three letters. Indeed, the disputed domain names each contain dominant and distinctive parts that form the trademark of RueDuCommerce.

3) Phonetically, the sound of the name "RDCommerce" is equivalent to that of "RueDuCommerce":
- The sounds are the same as the vowels were not included,
- The suffix "commerce" remains intact,
- The disputed domain name "www.rdcommerce.com" uses the same extension (“.com”) as RueDuCommerce.com.

This similarity between the disputed domain names and trademarks of the company RueDuCommerce is likely to create confusion in the public mind.

Given the number of similarities, users are legitimately entitled to believe that the website "www.rdcommerce.com" and the domain name "www.rdcommerce.net" belong to RueDuCommerce company or, at least, that they are economically linked.

Some consumers visiting the site www.rdcommerce.com believed they were on RueDuCommerce’s website.

Thus, on May 15 2014, the RueDuCommerce Company received a letter complaint from a consumer requesting a refund of his order.

It turns out that this order has been done on the website www.rdccommerce.com. But the consumer thought that the order has been registered on the RueDuCommerce’s website and due to encountered inconveniences, he went to the customer service of RueDuCommerce.

The Complainant contends that the confusion caused by the similarity of disputed domain names with the trademark of the RueDuCommerce company is real.

Moreover, the Complainant claims that the confusion has even been raised by consumer groups, including in an article of 31 July 2014.

The Complainant states that the disputed domain names have been registered by the Respondent without rights or legitimate interest.

First of all, the Complainant claims it has not licensed or otherwise permitted the Respondent to use his brand or to apply for or use any domain name incorporating it.

Internet inquiries as well as trademark database searches have not revealed any use or registrations by the Respondent that could be considered relevant.

The Complainant asserts that on 14 April 2014

RueDuCommerce sent a recorded delivery mail and an e-mail to the following address: contact@rdcommerce.com.

The same day, the owner of the disputed domain names answered by email and offered to sell domain names.

In response to this unacceptable sale proposal, RueDuCommerce's Counsel sent a formal notice to the domain names holder in order to obtain the immediate cessation of the use of the site and the transfer of disputed domain names.

This formal notice remains unanswered.

On 19 May 2014 a recorded delivery mail was sent to the recording unit and the technical and administrative contact of the disputed domain names.

On 4 June 2014 the Counsel of the MAGIC ONLINE company, technical and administrative contact of the domain names, responded to this notice. In this response, it disclaims any responsibility for the registration and use of the disputed domain names.

A second notice was sent to the owner by letter and by email at: contact@rdcommerce.com and contact@electronique-market.com.

On 20 May 2014, the Respondent replied to this letter by email and proposed again to sell domain names to RueDuCommerce.

According to the Complainant the domain name "www.rdcommerce.net" refers to any active website.

This lack of exploitation is considered like an act of passive-holding of detention when it is intended to prevent third parties, such as the holder of the protected trademark, from registering the domain name and use it.

The Complainant asserts that in this case the domain name "www.rdcommerce.net" made no bona fide offering of goods or services or any serious preparations in this regard. Since its registration (December 2013) no action has been implemented by the owner to start any activity.

Otherwise, the holder of the domain name was in no way authorized or licensed by the RueDuCommerce society to use this domain name.

In view of its elements - at least as per the Complaint - the holder can't claim to have rights to the domain name or have a legitimate interest related to it.

As far as the disputed domain name "www.rdcommerce.com" is concerned the Complainant claims it refers to an active website which sells products in the world of home furnishings and person.

The Complainant states that an affidavit has been made by Mr. Fradin, bailiff, on 21 May 2014 confirming the site's activity.

Firstly, the site presentation www.rdcommerce.com takes a large part of the Rue Du Commerce site presentation. Anymore, the site offers to the public the same products.

Thus, the owner of the domain name creates the confusion with the RueDuCommerce company, to appropriate its clients and draw undue benefits. This evidence shows indeed the will of the owner to divert the notoriety of the company in order to capture RueDuCommerce customers.

Consequently, the owner of the disputed domain names should be considered as having no interest therein, nor any legitimate interest, since it interferes in the wake of the RueDuCommerce company to draw undue advantages and divert its customers.

The Complainant claims that the registration of the disputed domain names occurred in 2013, almost fourteen years after

the creation of RueDuCommerce company. The historic settlement of this company and its serious enabled it to rise to the leading position on e-commerce.

Thus, the holder could not validly be ignored during the registration of these domain names, first the existence of the RueDuCommerce compagny, and secondly violation of its intellectual property that was being committed in carrying out this recording.

Therefore, at the time of registration, the owner having full knowledge of RueDuCommerce's trademarks has « intentionally attempted to attract, for commercial gain, Internet users to its web site [...] by creating a likelihood of confusion with the complainant's mark ».

This behavior covered by the Guiding Principles UDRP (4b) characterizes the bad faith of the licensee at the registration of the domain names.

The website www.rdcommerce.com is comparable to RueDuCommerce company activity, reflecting its particular bad faith in the registration and operation of the domain name.

Otherwise, the owner proposed to RueDuCommerce company in his email on 14 April 2014, to sell the disputed domain names.

This proposal demonstrates bad faith and establishes that the domain name was registered primarily for the purpose of harming the company RueDuCommerce and make a profit.

Indeed, on the one hand, the domain www.rdcommerce.com captures customer RueDuCommerce society by creating confusion and having the same activity.

On the other hand, the registration of www.rdcommerce.net is only a mean to offer for sale the domain names to the RueDuCommerce company in order to obtain undue benefits and prevent RueDuCommerce from registering it.

According to all circumstances of this situation, according to the Complaint the Respondent is acting in bad faith.

The Complainant concludes that the domain names are both infringing Complainant's intellectual property rights, violating the UDRP rules registering and being used in bad faith.

Despite good faith attempts, the Complainant has not managed to find anything that would suggest that the Respondent has rights or legitimate interest in holding the domain names.

Accordingly, the Complainant respectfully submits that the disputed domain names are transferred to the Complainant, the RueDuCommerce Company.

Finally, the Complainant contends that English is the language of the registration agreement for one of the domain names (rdcommerce.net). Based on this assertion the Complainant claims that the Respondent speaks and understands this language and therefore the proceedings shall be – at least according to the Complainant – conducted in English.

PARTIES CONTENTIONS

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

Paragraph 11(a) of the Rules provides that “Unless otherwise agreed by the Parties, or specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”. According to the information received by the CAC from the respective Registrars, it appears that the language of the Registration Agreement for one of the disputed domain names is English while the language of the Registration Agreement for the other disputed domain name is French. The Complainant requested the proceedings to be conducted in English. Although the Complainant failed to provide any relevant arguments supporting its request, in the absence of any objection to such request by the Respondent, the Panel accepted the Complainant's request and the language of the proceedings is therefore English.

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

As a preliminary comment, the Panel notes the various typographical errors contained in its Complaint, in particular regarding the disputed domain names and the trade marks upon which the Complainant bases its Complaint (trade mark WWW.RUEDUCOMMERE.COM instead of WWW.RUEDUCOMMERCE.COM, domain name <www.redcommerce.com> instead of <rdcommerce.com>, etc.). The Panel wishes to simply comment on the confusion this lack of care can cause.

A. Identical or Confusingly Similar

The Complainant satisfactorily proved that it holds trade mark rights and that the disputed domain names (the "Domain Names") are confusingly similar to those trade marks. The Domain Names indeed consist of misspellings of the terms RDC and RUE DU COMMERCE.

B. Rights or Legitimate Interests

The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has no rights or legitimate interests in the Domain Names.

Indeed, the Respondent has made no use of the Domain Name <rdcommerce.net>.

In addition, the Panel notes that the Domain Name <rdcommerce.com> resolves to an active commercial website selling the same categories of products as the Complainant offers on its website at www.rueducommerce.fr. The Complainant has provided evidence showing that consumers have been confused by the content of the website at the Domain Name <rdcommerce.com> and thought that it was operated by the Complainant.

The prima facie evidence brought by the Complainant was not challenged by the Respondent since no response has been filed in the present case.

The Panel thus finds that the Respondent is not making a fair and legitimate use of the Domain Name <rdcommerce.com>.

C. Registered and Used in Bad Faith

The Complainant's rights were acquired well before the Respondent registered the Domain Names. In the absence of a Response, the Panel finds that the Respondent registered the Domain Names with full knowledge of the Complainant's trade marks and business.

In addition, the fact that the Respondent offered the Domain Names for sale to the Complainant upon receipt of the Complainant's cease and desist letter is an indication of the Respondent's bad faith.

Finally, the Panel finds that the Complainant has proved that the Respondent has used the Domain Names in bad faith. The Domain Name <rdcommerce.net> has never been used while the Domain Name <rdcommerce.com> has been used in order to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trade mark and the Respondent actually succeeded in doing so, given the actual consumer confusion, as evidenced by the Complainant.

The Complainant has, to the satisfaction of the Panel, shown that the Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **RDCOMMERCE.NET**: Transferred
2. **RDCOMMERCE.COM**: Transferred

PANELLISTS

Name	**David Taylor**

DATE OF PANEL DECISION 2014-10-09

Publish the Decision