Decision for dispute CAC-UDRP-101183

Case number	CAC-UDRP-101183
Time of filing	2016-03-08 10:16:46
Domain names	siruecommerce.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	RueDuCommerce

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Organization	Siru

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

French trademark « WWW.RUE DU COMMERCE.COM », registered on 29 July 2005 under number 3374566 for goods and services in classes 9, 16, 28, 35, 38, 41, and 42.

French trademark « RUE DU COMMERCE », registered on 27 June 2000 under number 3036950 for goods and services in classes 9, 16, 28, 35, 38, 41 and 42.

French trademark « RDC.fr Rue du Commerce », registered on 28 July 1999 under number 99805150 for goods and services in classes 35, 38, and 42.

Community Trade Mark (now European Union Trade Mark) « RUE DU COMMERCE.COM », registered on 14 May 2009 under number 8299381 for goods and services in classes 16, 35, 36, 37, 38, 41, and 42.

Community Trade Mark (now European Union Trade Mark) « RUE DU COMMERCE », registered on 14 May 2009 under number 8299356 for goods and services in classes 16, 35, 36, 37, 38, 41, and 42.

Community Trade Mark (now European Union Trade Mark) « RUE DU COMMERCE », registered on 25 July 2013 under number 12014833 for goods and services in classes 9, 16, 35, 36, 37, 38, 41, and 42.

FACTUAL BACKGROUND

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

The Complainant RueDuCommerce is the owner of a portfolio of trademarks for the course of its online business activities on web sites accessible under the addresses www.rueducommerce.com and www.rueducommerce.fr.

RueDuCommerce is a major e-merchant in France whose honourability and reliability are well known by internet users. Since its creation in 1999, RueDuCommerce has identified its products under the trademark “Rue du Commerce”. During the more than fifteen years since then, RueDuCommerce has gained an important notoriety among the net surfers and consumers. Its business activities have been the subject of various media reports (paper, internet and television), its internet web site has more than 5 million pages, and it has distributed a large number of products bearing its name (e.g. USB key, pencil tray, pen, mobile phone, MP3 player, notebooks, and keyrings). RueDuCommerce has also placed advertising campaigns in the subway, on busses, on national TV and radio stations and on its YouTube video channel. For example, between November 24th and December 14th 2014, RueDuCommerce has broadcast:

• 107 commercial spots on M6 channel for an amount of 830.556,00 Euros;
• 53 commercial spots on Canal + Temporis channel for an amount of 170.078,00 Euros;
• 64 commercial spots on D8 channel;
• 65 commercial spots on W96ter Puissance TNT channel;
• 46 commercial spots on TMC channel;
• 67 commercial spots on NT1 channel;
• 62 commercial spots on NRJ12 channel;
• 106 commercial spots on D17 channel;
• 144 commercial spots on Numéro 23 channel;
• 87 commercial spots on RMC Découverte channel;
• 196 commercial spots on BeIn Sports 1 channel;
• 16 commercial spots on Canal + Décalé channel;
• 101 commercial spots on Comédie + channel;
• 79 commercial spots on Discovery Channel;
• 132 commercial spots on Game one channel;
• 23 commercial spots on I>Télé channel;
• 120 commercial spots on Infosport + channel;
• 47 commercial spots on J-One channel;
• 75 commercial spots on Jimmy channel;
• 170 commercial spots on L’Equipe 21 channel;
• 124 commercial spots on MTV Base channel;
• 221 commercial spots on MTV Francophone channel;
• 109 commercial spots on NRJ Hits channel;
• 23 commercial spots on Planète No Limit + channel;
• 201 commercial spots on Serie Club channel;
• 20 commercial spots on Sport + channel; and
• 54 commercial spots on Téva channel.

This gives a total of 2.512 commercial spots broadcast on 27 various TV channels on a 20 days period.

The notoriety of RueDuCommerce has been reinforced by intensive use of social networks. The Complainant has an active account on Twitter with 44.000 published tweets from RueDuCommerce.

The website www.rueducommerce.com is among the Top 15 of the most visited e-commerce websites in France, with more than 4.2 million of visits by month. It has been awarded the title of best website for technical products in 2009 and 2011 within the “Favori’s night” organized by the Federation of distance contracts for the sale of goods (“FEVAD”).

The notoriety of RueDuCommerce has been recognized in prior decisions of the Czech Arbitration Court (CAC), namely in Panel decisions regarding the disputed domain names

• “wwwrueducommerce.com” (case no. 101028) of 22 September 2015;
• “rueducommerces.com” (case no. 101030) of 24 September 2015;
• “rue-ducommerce.com” (case no.100861) of 12 November 2014;
• “rueducommercerd.biz” (case no. 100873) of 1 January 2015; and
• “rueducommerce.vote” (case no.101143) of 2 February 2016.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is identical to a trademark in which the Complainant has rights. According to the Complainant this identity is illustrated on three levels:

1) Visually, the disputed domain name copies the “rueducommerce” trademark. The domain name “siruecommerce” remains almost identical. The Complainant believes that the addition of the word “si” is only a way to create confusion in consumers’ mind and is not sufficient to create a distinction between the two names.

2) Conceptually, the only difference between the two domain names is the withdrawal of the term “du”, which according to the Complainant is entirely insufficient to conceptually distinguish both domain names because the two words characterizing the Complainant’s trademark are “rue” and “commerce”. “Du” is only an article linking these two essential trademark terms.

3) Phonetically, the Complainant considers it obvious that both domain names sound identical.

The Complainant concludes that the minor difference in spelling is insignificant and does not preclude a finding of confusing similarity with the Complainant’s trademark.

The Complainant further contends that the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name because of the following facts.

First of all, the Complainant has not licensed or otherwise permitted the Respondent to use its 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 disputed domain name siruecommerce.com has been registered on 17 August 2014. The Complainant has tried to reach the Respondent with regard to the disputed domain name by postal mail and by email, but it seems that these messages have never reached the Respondent.

Secondly, the Complainant argues that the disputed domain name is used for an “artificial activity”. In fact, the website for which the disputed domain name is used displays advertisements which are served by a standard “sponsored link” service operated by the disputed domain name’s registrar, GoDaddy.

The Complainant also argues that the Respondent has not demonstrated any preparations to use the disputed domain name in connection with a bona fide offering of goods or services.

As to the aspect of bad faith registration and use, the Complainant argues as follows.

First, the Complainant contends, nothing on the website suggests that the Respondent is making a legitimate commercial or non-commercial business activity with the domain name because it has never been used and it is not currently being used.

The Complainant further points to the fact that the Respondent has registered the disputed domain name on 17 August 2014, i.e. subsequent to the Complainant's trademark registrations. The Respondent was therefore, at the time of the registration, able to be aware of the existence of the Complainant's trademark.

The Complainant also contends that the choice of a name and an address very close to the real ones demonstrates the bad faith of the Respondent.

The Complainant further contends that the absence of proper use by the Respondent of the disputed domain name also constitutes bad faith.

The Complainant further contends that the main purpose of the disputed domain name registration has been to prevent the Complainant, legitimate owner of the "Rueducommerce" trademark, from reflecting the brand in a corresponding domain name.

The Complainant finally contends that the Respondent, by registering the disputed domain name, has engaged in "typo squatting", because the Respondent has purposefully included typographical errors in the mark portion of a disputed domain name to divert Internet users who make those typographical errors to competitors of the Complainant.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The disputed domain name is not identical to the Complainant's "rueducommerce" trademark. The disputed domain names starts with the letters "si", which are not present in the trademark; and the letters "du", which are present in the trademark, are missing in the disputed domain name.

This Panel is also convinced that the disputed domain name is not confusingly similar to the Complainant's "rueducommerce" trademark. The disputed domain name is evidently a combination of "siru" (which appears to be a part of the Respondent's name) and the word "ecommerce", which is purely descriptive for online business. Theoretically the combination of "siru" and "ecommerce" can also be read as a combination of "si" and "rue" and "commerce", but this latter combination does not make much sense and appears to be a purely accidental coincidence.

It is also evident that the domain name "siruecommerce" is by no means a "typo squatting" variation of "rueducommerce", because the additional letters "si" and the omitted letters "du" are far too significant.

NO RIGHTS OR LEGITIMATE INTERESTS

Similarly, the Complainant has not demonstrated that the Respondent has no rights or legitimate interests in respect of the disputed domain name. As explained above, the whois record for the disputed domain name indicates that "siru" is part of the Respondent's name, so that the disputed domain name appears to be a combination of the Respondent's name and the descriptive word "ecommerce". Even though this does not exactly match the case described in paragraph 4(c)(ii) of the Policy, this Panel is nevertheless not convinced that the Respondent has no rights or legitimate interests in respect of the domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

And finally, the Complainant has not demonstrated that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy). The Complainant's contentions (on which the Respondent's alleged bad faith is based) are entirely unconvincing. The Panel accepts that the Complainant's brand is very well known in France, and potentially also in other countries using the French language. There is no indication, however, that the Complainant's brand has any particular reputation in the Respondent's country Mexico. Given this fact, the significant differences between the disputed domain name and the Complainant's trademark (cf. the discussion of "confusing similarity" above), and the Respondent's apparent name "siru" as the dominant part of the disputed domain name, the Complainant's allegations of a registration and use in bad faith are not convincing.

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. In particular, the Respondent's failure to submit a response does not imply that the Complaint should automatically be successful.

PRINCIPAL REASONS FOR THE DECISION

As discussed above the Panel does not consider the disputed domain name to be identical or confusingly similar to the Complainant's trademark. This finding alone would be sufficient to reject the Complaint. It is supported, however, by this Panel's views (as discussed above) that the Respondent may well have rights or legitimate interests in the disputed domain name, and that there is no convincing evidence of bad faith registration and/or use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2016-04-14

Publish the Decision