

Decision for dispute CAC-UDRP-104499

Case number	CAC-UDRP-104499
Time of filing	2022-04-19 09:37:00
Domain names	stadetoulousain.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	S.A.S.P STADE TOULOUSAIN RUGBY
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Park HyungJin
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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, with the company name "STADE TOULOUSAIN RUGBY" since April 17th, 1998, is the owner of (1) the French trademark ST STADE TOULOUSAIN® n° 98747455, registered since August 26th, 1998 and (2) the European trademark ST STADE TOULOUSAIN® n° 002345502 registered since August 7th, 2001.

The Complainant also owns domain name <stadetoulousain.fr> registered and used since March 12th, 2000, comprising the wording "STADE TOULOUSAIN".

The disputed domain name <stadetoulousain.com> was registered on March 7th, 2012.

FACTUAL BACKGROUND

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

The disputed domain resolves to a parking page with commercial links related to the Complainant's activities. Besides, the domain name is offered for sale for 5 600 EUR.

The Complainant states that the disputed domain name is confusingly similar to its trademark ST STADE TOULOUSAIN. Indeed, the deletion of acronym "ST", which is a part of the Complainant's logo, is not sufficient to escape the finding that the domain name is confusingly similar to the trademark. Deleting non-distinctive terms does not sufficiently distinguish a domain name from a mark to prevent a finding of confusingly similarity under a Policy paragraph 4(a)(i) analysis. Indeed, it is well established that, where a dominant feature of the relevant trademark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (WIPO Case No. D2020-0415). Furthermore, Complainant contends that the addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and Complainant, its trademark and its domain names associated.

The Respondent does not have any rights or legitimate interest in the disputed domain name. The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name, but as "Park HyungJin". Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name (Forum Case No. FA 1781783). The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks, or apply for registration of the disputed domain name by the Complainant. The disputed domain name points to a parking page with commercial links. Past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use (Forum Case No. FA 970871 or WIPO Case No. D2007-1695). Besides, the disputed domain name is offered for sale for 5 600 USD. The Complainant contends this general offer to sell the disputed domain name evidences the Respondent's lack of rights or legitimate interest (Forum Case No. 1562569).

The Complainant contends that the disputed domain name is confusingly similar to its distinctive trademark ST STADE TOULOUSAIN. The Complainant asserts that, in light of the prior use of the Complainant's trademark ST STADE TOULOUSAIN since 1908 and the notoriety acquired by the trademark since 1998, it is unlikely that the Respondent was not aware of the Complainant and its trademarks when it registered the disputed domain name. Besides, all the Google results of a search of the terms "STADE TOULOUSAIN" refers to the rugby club managed by the Complainant. On those facts, the Complainant claims that the use of the Complainant's trademark in the disputed domain name gives rise to the inference that the Respondent ought to have registered the disputed domain name for its trademark value. Moreover, the disputed domain name resolves to a parking page with commercial links related to the Complainant's activities where it is offered for sale for 5 600 EUR.

The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith (WIPO Case No. D2018-0497).

Furthermore, the Complainant contends that the Respondent has registered the disputed domain name only in order to sell it back for out-of-pockets costs, which evinces bad faith registration and use (Forum Case No. FA 1623939).

Finally, the Respondent has already been involved in several UDRP cases, which evidences a pattern of registration of third-parties' trademarks. Please see for instance WIPO Case No. D2021-3459, Singular Bank, S.A.U. v. Park HyungJin; WIPO Case No. D2021-1324, RatioPharm GmbH v. Park HyungJin; WIPO Case No. D2020-0657, PLIVA Hravtska D.o.o v. Park HyungJin.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) The respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the French combined trademark ST STADE TOULOUSAIN n° 98747455, registered since August 26th, 1998, and the European figurative trademark ST STADE TOULOUSAIN n° 002345502 registered since August 7th, 2001, and that it owns domain name <stadetoulousain.fr> comprising the same distinctive wording "STADE TOULOUSAIN" registered and used since March 12th, 2000.

The disputed domain name has been registered on March 7th, 2012, i.e. almost 14 years after the French trademark registration, and incorporates two words of the Complainant's trademarks - STADE TOULOUSAIN.

Two words of the trademark (STADE and TOULOUSAIN) are divided by the space which is deleted in the disputed domain name, but the replacement of the space is usually made by the deletion or by the hyphen as the space is not supported character to be used in the domain names. Therefore, the deletion of the space between two parts of the trademark does not distinguish the disputed domain name from the Complainant's trademark.

The missing acronym "ST", which in a graphic form is a part of the Complainant's trademarks, is not sufficient to escape the finding that the domain name is confusingly similar to the Complainant's trademarks ST STADE TOULOUSAIN. Deleting non-distinctive terms does not sufficiently distinguish a domain name from a mark to prevent a finding of confusing similarity under a Policy paragraph 4(a)(i) analysis. Moreover, the dominant part of the trademarks (STADE TOULOUSAIN) is recognizable in the domain name.

The generic top-level domain "COM" should be disregarded in the assessment under the Policy when comparing disputed domain name and trademark and does not change the overall impression of the designation as being connected to Complainant's trademarks.

The Panel therefore considers the disputed domain name to be confusingly similar to the Complainant's trademarks ST STADE TOULOUSAIN which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not affiliated with nor authorized by the Complainant in any way, is not identified in the WHOIS database as the disputed domain name, does not carry out any activity for, nor has any business with the Complainant and neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks, or apply for registration of the disputed domain name by the Complainant.

There is also no indication nor evidence that the Respondent is commonly known by the term "STADE TOULOUSAIN" or its variations or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. Moreover, the disputed domain name points to a parking page with commercial links and is offered to be sold for 5 600 EUR. Such use of the disputed domain name is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

Considering the distinctiveness of the Complainant's trademarks it is unlikely that the Respondent was not aware of the Complainant and its trademarks when it registered the disputed domain name. Furthermore, the disputed domain name has been offered for the sale only and there is no evidence that it has been really used. The incorporation of a trademark into a domain name, coupled with an offer to sale of the disputed domain may be the evidence of bad faith use as well.

The Panel therefore considers 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 Panel finally considers that the Complainant has shown that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. STADETOULOUSAIN.COM: Transferred

PANELLISTS

Name	JUDr. Petr Hostaš
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DATE OF PANEL DECISION 2022-05-22

Publish the Decision
