# Decision for dispute CAC-UDRP-100570

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| Case number | **CAC-UDRP-100570** |
| Time of filing | **2013-03-19 18:31:08** |
| Domain names | **topachats.net** |

## Case administrator

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| Name | **Kateřina Navrátilová** |

## Complainant

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| Organization | **RueDuCommerce** |

## Complainant representative

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| Organization | **CHAIN AVOCATS** |

## Respondent

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| Organization | **Xintertop** |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceeding related to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant, the RueDuCommerce Company, 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 following address: www.topachat.com.

Complainant has proved to be the holder of several registrations for the trademark TOP ACHAT. Among them the following:

Trademarks in France:

• « TOP ACHAT », registered on May 4th, 2004 under number 3289599, for goods and services class 10, 20 and 21.

• « TOPACHAT.COM », registered on July 6th, 2011 under number 10103067, for goods and services class 9, 35, 36, 38, 41 and 42.

Community Trademarks:

• « TOP ACHAT », registered on August 9th, 2004 under number 4034211, for goods and services class 11, 20 and 21.

• « TOP ACHAT », registered on September 19th, 2002 under number 2827976, for goods and services class 9, 35, 36, 38, 41, 42 and 43.

International trademark:

• « TOP ACHAT », registered on October 8th, 2004 under number 841118, for goods and services class 11, 20 and 21.

FACTUAL BACKGROUND

The disputed domain name is 'topachats.net', registered on November 26, 2012.

Complainant's trademark registrations predate Respondent's registration of the disputed domain name.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT

Complainant contends that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which it has rights for the following reason:

The disputed domain name contains the same joined words as Complainant's trademarks, with an addition at the end of the name of the letter "s". The sole difference consists in making the disputed domain name a plural form of Complainants' trademarks.

2. As concerns Respondent's rights or legitimate interests in respect of the domain name the Complainant affirms that:

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

Complainant has unsuccessfuly tried several times to contact the owner of the disputed domain name.

The Respondent has never made any use of and has not demonstrated preparations to use the domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services.

3. Complainant then contends, that the disputed domain name has been registered and is being used in bad faith for the following reasons:

The purpose of the registration of the disputed domain name has been to prevent the Complainant, legitimate owner of TOP ACHAT and TOP ACHAT.COM trademarks from reflecting the marks in a corresponding domain name while not exploiting the disputed domain name.

As the registrant of "topachats.net" has no legal right to use the complainant trademarks, there is clearly bad faith in maintaining the domain name to the benefit of the respondent.

The fact that the Respondent does not use the domain name shows intention to prevent third parties from reflecting their trademarks in corresponding domain names.

The non-use of the domain name is perceived as an act of “passive holding”, which prevents the Complainant from registering the domain name under his rightfully owned trademarks.

The Respondent did not reply to Complainant’s cease and desist letter .

RESPONDENT

The Respondent in its extremely concise response to the complaint contends that:

a. Complainant’s international trademark registration is not extended to Respondent’s Country and therefore does not provide legal protection in the State of Delaware – USA.

b. The site being under construction does not constitute a form of cybersquatting.

c. The Complainant confuses hosting provider (Goldoweb SL) and supplier (RMI Sarl) with the owner of the disputed domain name (XINTERTOP).

RIGHTS

Discussion and findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”
Paragraph 4(a) of the Policy lists three elements that Complainant must prove to merit a finding that the domain name registered by the Respondent be transferred to the Complainant:
i) the domain name is identical or confusingly similar to a trademark or service mark (“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.

A. Identical or Confusingly Similar

Complainant has established that it has rights in several registered trademarks that are practically identical to the disputed domain name.

With regard to the Respondent’s assertion that Complainant’s trademarks are not valid in the state of Delaware – USA, this Panel notes that The Policy does not require that the Complainant should hold a valid trademark in the Country of the Respondent. In fact, the Policy makes no specific reference to the Country in which a trademark needs to be registered see Paragraph 4(a)(i) of the Policy: “the domain name is identical or confusingly similar to a trademark or service mark (“mark”) in which the Complainant has rights”. Consequently, Complainant’s lack of a valid trademark registration in the Country of the Respondent does not prevent a finding of identity or confusing similarity under the UDRP.

Therefore, the Complainant has, to the satisfaction of the Panel, shown that 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

B. Rights or Legitimate Interests

Complainant must show that Respondent has no rights or legitimate interests in respect of the disputed domain name.

Respondent in a UDRP proceeding does not assume the burden of proof, but may establish a right or legitimate interest in a disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy:
a) that before any notice to the respondent of the dispute, he or she used or made preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
b) that the respondent is commonly known by the domain name, even if he or she has not acquired any trademark rights; or
c) that the respondent is making a legitimate, non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Respondent has no connection or affiliation with Complainant, which has not licensed or otherwise authorised Respondent to use or apply for any domain name incorporating Complainant's trademark.

Respondent does not appear to make any legitimate use of the domain name for non-commercial activities, Indeed, the disputed domain name does not appear to be used.

Respondent does not appear to have been commonly known by the domain name.

Respondent has not proved, affirmed or even alleged to have legitimate rights (within the meaning of paragraph 4(a)(ii)of the Policy) to the disputed domain name.

Therefore, Respondent has not shown any facts or elements to justify prior rights and/or legitimate interests in the disputed domain name in accordance with the UDRP Policy . Respondent did not provide any elements to demonstrate, as requested by the Policy, that it used or made preparations to use the disputed domain name or a name corresponding to it in connection with a bona fide offering of goods or services.

In fact the Policy requires the Respondent to show, before any notice to him of the dispute, his use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

This Panel's view, which reflects many previous decisions, considers that the mere detention of the disputed domain name does not demonstrate any preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

Accordingly, the Panel finds that 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

C. Registered and Used in Bad Faith

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
ii) the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the

holder’s web site 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 holder’s web site or location or of a product or service on the holder’s web site or location.

Accordingly, for a Complainant to succeed, the Panel must be satisfied that the domain name has been registered and is being used in bad faith.

It is the Panel's opinion that, before establishing the existence of Respondent's bad faith registration, the following contentions of the Respondent need to be discussed:

1) Complainant’s trademark rights are not valid in the State of Delaware USA.
2) The site being under construction does not constitute cybersquatting.
3) The Complainant confuses hosting provider (Goldoweb SL) and supplier (RMI Sarl) with the owner of the disputed domain name (XINTERTOP).

As already seen, whereas it is true that Complainant’s registration of the trademark <top achat> is not protected in the US, the Policy does not require that the Complainant should hold a valid trademark in the Country of the Respondent. Therefore, this contention is not relevant within the meaning of paragraph 4(a)(iii)of the Policy.

As concerns Respondent's contention that «the site being under construction does not constitute cybersquatting», the Panel notes that according to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, the consensus view is the following: “With comparative reference to the circumstances set out in paragraph 4(b) of the UDRP deemed to establish bad faith registration and use, panels have found that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith”.

This Panel agrees with the above consensus view and futher notes that in the present case, while the Complainant has given sufficient elements to infer that the Respondent is not using the disputed domain name, that it has not been commonly known by the disputed domain name, that is has no authorization or legitimate rights to the disputed domain name, the Respondent did not give any clue about the use it wished to make of the disputed domain name. In addition, the Respondent has not denied knowledge of Complainant’s trademark nor has given any explanation as to why it chose and registered the disputed domain name.

The Complainant has further claimed that the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name. A claim that Respondent has not denied.

Finally, with regards to the Respondent’s contention that “The Complainant confuses hosting provider (Goldoweb SL) and supplier (RMI Sarl) with the owner of the disputed domain name (XINTERTOP)”, the Panel notes that while it is true that the Complainant sent its warning letter also to the Registrar (RMI/DNC Holdings) and to the Hosting Provider (Goldoweb SL), thus appearing to create some kind of confusion about the identity of the Respondent, it is also true that when the Complainant sent its first warning letter to Goldoweb on November 28, 2012, Goldoweb was indicated as the registrant, the administrative contact and the technical contact for the disputed domain name. The goldoweb@gmail.com being the administrative and technical contact email.

Whereas now the present Respondent is XINTERTOP, the technical contact is still indicated as Goldoweb and the contact email address is the same, i.e. : goldoweb@gmail.com.

This fact, raises the suspicion that the two entities Goldoweb and Xintertop might be linked and that the fact that the transfer of the domain name from Goldoweb to Xintertop happened soon after the Complainant sent its warning letter to Goldoweb was not a coincidence.

In any case, the Respondent (as well as GOLDOWEB) has never replied to Complainant’s cease and desist letter.

This Panel finds therefore that, on the balance of probability, Respondent knew of the complainant's rights when it registered the disputed domain name and that it chose to register the disputed domain name having in mind Complainant's trademark.

It is the Panel’s opinion that all the above has shown Respondent's bad faith registration and use of the Domain Name that clearly falls within the example given in paragraph 4 of the Policy.

Considering the foregoing, 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

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

The Panel finds that the disputed domain name «topachats.net» is confusingly similar to the Complainant’s trademarks. The Complainant contends that the Respondent has made no use of, or demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services, is not making a legitimate non-commercial or fair use of the disputed domain name, and is not commonly known under the disputed domain name.
The Panel notes that the domain name holder’s name or contact details contain no reference to TOP ACHATS or similar words or names. The domain name is not used for any active web site.

Respondent did not show any legitimate rights to the disputed domain name and has not provided any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant gave several arguments and reasons to infer Respondent’s bad faith in registering and using the disputed domain name (such as lack of a response to its warning letter, passive holding and a hint of cyberflight), whereas the Respondent’s did not deny most of the Complainant’s claims. Indeed, due to its tenure and contents, Respondent’s response had more an effect of confirming Complainant’s claims than rebutting them.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TOPACHATS.NET**: Transferred

## PANELLISTS

| Name | **Dr. Fabrizio Bedarida** |
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DATE OF PANEL DECISION 2013-04-16

Publish the Decision