

Decision for dispute CAC-UDRP-104609

Case number	CAC-UDRP-104609
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Time of filing	2022-05-26 11:08:58
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Domain names	colruytgroep.com
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Case administrator

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

Organization	Etablissements Franz Colruyt N.V.
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Complainant representative

Name	Pierre-Yves Thoumsin
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Respondent

Name	Johnson ZHANG
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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 is owner of various registered trademarks including the distinctive term “COLRUYT”, such as:

- EUTM no. 008545774, for the device mark, filed on 14 September 2009 and registered on 7 October 2010 for goods in class 16 and services in classes 35 and 39;
- EUTM no. 009856733 for the word mark, “COLRUYT” filed on 31 March 2011 and registered on 7 October 2011 for goods in class 16 and services in classes 35 and 39;
- EUTM no. 010375434 for the word mark, “COLRUYTGROUP”, of 13 October 2011 for goods in class 16 and services in classes 35 and 39.

The Complainant trades and conducts its businesses under the company and trade name Etablissements Franz Colruyt and has the domain <colruytgroup.com>.

FACTUAL BACKGROUND

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

The Complainant is a Belgian family-owned company, operating one of Belgium's largest discount supermarket chains under the COLRUYT Trademark. The Complainant's history dates back to 1928, when Franz Colruyt started a colonial wholesale goods (coffee, salt and sugar) business to serve grocers in Brussels and the surrounding area. The Complainant is headquartered in the city of Halle, south of Brussels and operates in Belgium, France and Luxembourg. It has more than 30,000 employees.

The disputed domain name was registered on 31 October 2021.

It is passively used since its registration. It redirects to a Chinese lottery website. The Panel visited the site on 4 July 2022.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The term "colruytgroep"

(i) contains the EU TMs COLRUYT of which the Complainant is the owner;

(ii) "groep" is the Dutch translation of the word "Group". The pronunciation is identical.

To the Complainant's best knowledge, it is the only organization in the world using the names COLRUYT and COLRUYT GROUP in the course of trade. COLRUYT is indeed the name of the company's founding father and the Colruyt family currently remains its leading shareholder.

The Complainant does not grant any licenses or authorization to use the COLRUYT mark to third parties outside its group of companies.

According to WIPO Jurisprudential Overview 3.0, even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

A WIPO panel already held that "the mark COLRUYT is the name of the family, which established the Complainant's business and is not a word or term that a person would accidentally think of when registering a domain name" (Case No. 22019-2257, <colruyt-be.com>). Accordingly, the Respondent cannot possibly have any right in the disputed domain name.

The Respondent does not have any legitimate interest in using the disputed domain name either. Indeed, it is not engaged in any legitimate business which would require using the COLRUYT trademarks.

Respondent intentionally attempts to attract business entities for commercial gains, by creating a likelihood of confusion with the Complainant's mark as to the source of the Respondent's activities. Such confusion is created by using (i) the COLRUYT word mark in the domain name.

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The use of a so-called “private” contact details in the Whois databases is also considered as an indication of bad faith, in view of the global context of the case.

From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. “The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trade mark, no response to the complaint having been filed, and the registrant’s concealment of its identity” (WIPO case No. D2017-0246, Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH v. Godaddy.com, Inc., <docmartens.xyz>).

In the present case, the disputed domain name is passively used since its registration. The disputed domain name also redirects to a Chinese lottery website. Moreover, as said, the Respondent is not engaged in any legitimate business which would require using the COLRUYT trademarks.

As mentioned above:

(i) the registrant does not have any rights on the “colruytgroup” or “colruyt” business name, trade name and/or trademark. Indeed, Complainant is the proprietor of all related trademark rights and registrations and it does not grant any licenses to third parties;

(ii) the registrant has no legitimate interest in the name “colruytgroep” either;

(iii) the domain name is used in bad faith, i.e. for the purpose of using a name that is identical to a famous trademark.

See for instance the panel’s very similar finding regarding the bad faith registration of the domain name <colruyt- be.com> “The Panel finds that the following circumstances taken together are indications of bad faith use of the Domain Name: (i) the probability that the Respondent was aware or should have been aware of the Complainant’s rights in the Trade Marks; (ii) the use of a privacy shield upon the initial registration of the Domain Name; (iii) the lack of a formal response to the Respondent.” (WIPO case no. D2019-2257, <colruyt- be.com>).

The Complainant refers to the previous panel’s very similar finding regarding the bad faith registration of the domain name ‘franz-colruyt.com’ by previous panels.

“Considering the distinctive and well-known character of the Complainant’s COLRUYT trademark in Belgium where the Respondent is located, the Respondent must have had knowledge of the Complainant’s rights at the time of registering the Disputed Domain Name. The Panel therefore finds that the Respondent’s awareness of the Complainant’s trademark rights at the time of registration indicates bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011- 2209; BellSouth Intellectual Property Corporation v. Serena, Axel, WIPO Case No. D2006-0007). The Panel is of the opinion that the Complainant’s trademark has a strong reputation, which makes it difficult to conceive any plausible legitimate use of the Disputed Domain Name by the Respondent. (...) Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last element of the Policy”. (WIPO case no. D2020-1993, <franz-colruyt.com>”).

RESPONDENT:

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

There is no question that the Complainant has rights in the name and mark. Indeed, it is a well known mark.

Three previous panels have made this finding in WIPO case no. D2019-2257, <colruyt- be.com> and WIPO case no. D2019-2257 <colruyt- be.com> and CAC case no. 103777 <ets-franz-colruyt.com>.

As to the similarity: we compare the word marks for “colruyt” and “colruytgroup” to the disputed domain name here: <colruytgroep.com>. The only difference is in the spelling of group -and by one character, “e” v. “u”. The “e” version being the Dutch spelling. That word is generic and adds little to the highly distinctive and dominant element, the word, colruyt.

This is a typosquatting case and also a clear case of impersonation as the whole mark is included in the disputed domain name.

The Respondent lacks rights or legitimate interest in the disputed domain name. According to the WIPO case no. D2003-0455, “Croatia Airlines d.d. v. Modern Empire Internet Ltd.”, the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden shifts to the Respondent to demonstrate rights or legitimate interests. The Respondent has not come forward to explain his reasons for selection of the disputed domain name.

Given the distinctiveness of the Complainant's trademark and reputation, the Panel finds the Respondent registered the disputed domain name with full knowledge of the Complainant's trademarks. As prior UDRP panels have held, the incorporation of a famous mark into a domain name, even coupled with an inactive website, may be evidence of bad faith registration and use. Citing: WIPO - D2000-0003 - Telstra Corporation Limited v. Nuclear Marshmallows and WIPO - D2000-0400 - CBS Broadcasting, Inc. v. Dennis Toeppen.

On this basis, the Panel finds the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **COLRUYTGROEP.COM**: Transferred
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PANELLISTS

Name	Victoria McEvedy
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DATE OF PANEL DECISION	2022-07-04
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Publish the Decision

