

Decision for dispute CAC-UDRP-105783

Case number CAC-UDRP-105783

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Domain names leroym Merlin-russia.com

Case administrator

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

Complainant

Organization GROUPE ADEO

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization 1337 Services LLC

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 has evidenced to be the owner of the following trademark registrations:

- Trademark LEROY MERLIN, International registration n° 591251, registered since July 15, 1992 and duly renewed since;
- Trademark LEROY MERLIN (figurative) International Registration n° 701781 registered since August 14, 1998 and duly renewed since;
- Trademark LEROY MERLIN European registration n° 10843597 registered since April 27, 2012 and duly renewed since;
- Trademark LEROY MERLIN (figurative) European registration n°11008281 registered since July 2, 2012 duly renewed since.

Also, the Complainant has substantiated to own e.g. since 2003 the domain name <leroym Merlin.ru> which resolves to the Complainant's main website for the territory of Russia at "www.leroym Merlin.ru", intended to promote the Complainant's home living products and related services in that area and the domain name <leroym Merlin.fr> registered since 1996 and uses it for the official website of its subsidiary LEROY MERLIN FRANCE amongst numerous domain names comprising the trademark LEROY MERLIN.

The disputed domain name <leroym Merlin-russia.com> was registered on July 30, 2023 and is alleged to have been used in a phishing scheme.

FACTUAL BACKGROUND

GROUPE ADEO (the "Complainant") is a French company specializing in the sale of articles covering all sectors of the home, the development of the living environment and DIY, both for individuals and professionals.

The pioneering company of GROUPE ADEO is LEROY MERLIN, created in 1923. LEROY MERLIN is the leading DIY retailer in the home improvement and living environment market, with 21,000 employees in France and 400 stores throughout the world

The Complainant contends that the disputed domain name <leroymerlin-russia.com> is confusingly similar to the trademark LEROY MERLIN. Indeed, the domain name includes it in its entirety.

The Complainant asserts that the addition of the geographical term "RUSSIA" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark and branded goods LEROY MERLIN. It does not change the overall impression of the designation as being connected to the Complainant's trademark LEROY MERLIN. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and the domain name associated. It is well established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP". Please see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasily Terkin.

The Complainant relies also on the fact that past panels have confirmed the Complainant's rights over the terms "LEROY MERLIN" citing in particular,

- WIPO Case No. D2022-3778, Groupe Adeo v. Privacy service provided by Withheld for Privacy ehf / Huseyin Cemal COBAN, CiksNET, <leroymerlin.xyz>;
- WIPO Case No. D2022-3088, Groupe Adeo v. Jean Phillipe <leroymerlin-france.com>.

So, the disputed domain name is in the view of the Complainant confusingly similar to Complainant's trademark LEROY MERLIN.

The Complainant asserts that the Respondent is not known as the disputed domain name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Complainant contents that neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark LEROY MERLIN, or apply for registration of the disputed domain name by the Complainant.

The Complainant states that the disputed domain name is identical to its trademark LEROY MERLIN. It has been registered several years after the registration of the trademark LEROY MERLIN. In addition, the disputed domain name was used in a phishing attempt. Indeed, the Respondent attempted to pass of as one of the LEROY MERLIN employees. Therefore, the Complainant states that the Responded used the disputed domain name in bad faith, as it is well-established that using a domain name for purposes of phishing or other fraudulent activity constitutes solid evidence of bad faith use.

Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark.

PARTIES CONTENTIONS

Complainant:

The Complainant contends that the requirements of the Policy have been met (see factual backgrounds) and that the disputed domain name should be transferred to it.

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

First, the Panel finds that the disputed domain name <leroymerlin-russia.com> is confusingly similar to the Complainant's LEROY MERLIN trademark, as it incorporates the latter entirely, simply added by the geographical term "russia". Numerous UDRP panels have recognized that where a domain name incorporates a trademark in its entirety, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that trademark. Also, it has been held in many UDRP decisions and has meanwhile become a consensus view among UDRP panels that the mere addition of descriptive, or geographical or other terms, such as e.g. the term "russia", is not capable to dispel the confusing similarity arising from such (almost) entire incorporation of the Complainant's LEROY MERLIN trademark in the disputed domain name.

Therefore, the Complainant has established the first element under the Policy as set forth by paragraph 4(a)(i).

Second, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent has neither made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent commonly known under the disputed domain name, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain. The Respondent has not been licensed or otherwise authorized to use the Complainant's LEROY MERLIN trademark, either as a domain name or in any other way. Also, there is no reason to believe that the Respondent's name somehow corresponds with the disputed domain name and the Respondent does not appear to have any trademark rights associated with the terms "leroy" and/or "merlin" on its own. Finally, the Complainant has demonstrated that the disputed domain name did not resolve to a website but that MX servers have been activated under the disputed domain name, possibly intending to send unauthorized/illegal e-mails thereunder. Such making use of the disputed domain name, obviously in a fraudulent manner, neither qualifies as a bona fide nor as a legitimate noncommercial or fair use under the UDRP and may not of itself confer rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that, therefore, the Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

Third, the Panel holds that the disputed domain name was registered and is being used by the Respondent in bad faith. It is obvious from the circumstances to this case that the Respondent was well aware of the Complainant's rights in the LEROY MERLIN trademark when registering the disputed domain name, and that the latter is directly targeting such trademark. Indeed, it leaves no doubts that the Respondent, by registering and making use of the disputed domain name, had the intention to somehow unjustifiably profit from the undisputed reputation attached to the Complainant's LEROY MERLIN trademark and related website(s). Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the larger meaning of paragraph 4(b)(iv) of the Policy.

This finding also takes into consideration that MX servers have been activated under the disputed domain name to attempt impersonation and phishing. Indeed, the Respondent attempted to pass off as one of the LEROY MERLIN employees.

Therefore, the Complainant has also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. leroym Merlin-russia.com: Transferred

PANELLISTS

Name	David-Irving Tayer
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DATE OF PANEL DECISION 2023-10-22

Publish the Decision
