

Decision for dispute CAC-UDRP-105993

Case number **CAC-UDRP-105993**

Time of filing **2023-11-23 09:29:36**

Domain names **leroymerlin-fr.com**

Case administrator

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

Complainant

Organization **GROUPE ADEO**

Complainant representative

Organization **NAMESHIELD S.A.S.**

Respondent

Name **james madison**

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 the owner of various trademarks LEROY MERLIN, among which, are the following:

- LEROY MERLIN (word), European Union Trade Mark ("EUTM") registration No. 10843597, filed on 27 April 2012, and registered on 7 December 2012, for goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, 14, 16, 17, 18, 19, 20, 21, 22, 24, 25, 26, 27, 28, 31, 35, 36, 37, 40, 41, 42 and 44;
- LEROY MERLIN (figurative), EUTM registration No. 11008281, filed on 2 July 2012, and registered on 2 October 2013, for goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, 14, 16, 17, 18, 19, 20, 21, 22, 24, 25, 26, 27, 28, 31, 35, 36, 37, 40, 41, 42 and 44;
- LEROY MERLIN (word), International registration No. 591251, of 15 July 1992, for goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 16, 17, 19, 20, 21, 22, 25, 27, 28, 31 and 37, designating several countries;
- LEROY MERLIN (figurative), International registration No. 701781, of 14 August 1998, for goods and services in classes 01, 02, 03, 04, 05, 06, 07, 08, 09, 11, 12, 14, 16, 17, 18, 19, 20, 21, 22, 24, 25, 26, 27, 28, 31, 35, 36, 37, 38, 39, 40, 41 and 42, designating several countries.

The Complainant is also the owner of the domain names <leroymerlin.fr>, registered on 12 September 1996 that is used for the official website of its subsidiary, LEROY MERLIN France, and <leroymerlin.com>, registered on 13 September 1996.

FACTUAL BACKGROUND

The Complainant is the French company Groupe Adeo, specialized in the sale of articles covering all home sectors, as well as the development of the living environment and DIY, both for individuals and professionals. The pioneer company in Groupe Adeo is Leroy Merlin, created in 1923. Leroy Merlin is the leading DIY retail outlet in home and lifestyle improvement and living environment market, with 30,000 employees in France.

The disputed domain name was registered on 13 November 2023, and resolves to a parking page with commercial links. The Respondent has set up Mail exchanges ("MX records") for the disputed domain name.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant's contentions are the following.

The disputed domain name is confusingly similar to the Complainant's trademark LEROY MERLIN as this trademark is identically reproduced in the disputed domain name and the addition of the geographic country code "fr", which stands for "France", is not sufficient to escape a finding of confusing similarity.

The Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent is not identified in the Whois database as the disputed domain name. Moreover, the Respondent is not related to the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with, the Respondent. The Complainant did not license the use of its trademark to the Respondent, nor otherwise authorized the Respondent to make use of the LEROY MERLIN mark or to apply for the registration of the disputed domain name. Furthermore, the disputed domain name resolves to a parking page with commercial links. Such use of the disputed domain name cannot amount to a bona fide offering of goods or services, or to a legitimate noncommercial or fair use.

Finally, regarding the registration and use of the disputed domain name in bad faith, the Complainant maintains that the disputed domain name reproduces its LEROY MERLIN trademark entirely. The disputed domain name was registered several years after the registration of the Complainant's mark, which is highly distinctive and enjoys reputation. A simple online search on the Google search engine using the keywords "leroy merlin" would have exclusively led to results related to the Complainant. Thus, it is reasonable to conclude that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark. Moreover, the disputed domain name resolves to a parking page with commercial links. Accordingly, the Complainant contends that through the disputed domain name the Respondent is attempting to attract Internet users for commercial gain to its own website, which is evidence of use in bad faith. Finally, the Respondent has set up MX records for the disputed domain name, which suggests that the disputed domain name could be used for the purpose of sending e-mails, which is further evidence of bad faith.

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

I. Rights

The Complainant has proved that it is the owner of the registered trademark LEROY MERLIN since many years before the date of registration of the disputed domain name. The disputed domain name consists of the Complainant's trademark followed by the acronym "fr", which is the common abbreviation for "France". Between the trademark LEROY MERLIN and the acronym "fr" there is a hyphen. Accordingly, the Complainant's trademark is immediately recognizable within the disputed domain name, while the addition of the hyphen and the acronym "fr" cannot prevent a finding of confusing similarity of the disputed domain name with the Complainant's trademark under the first element of the Policy. See also section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "WIPO Jurisprudential Overview 3.0").

In light of the above, the Panel is satisfied that the first condition under the Policy is met.

II. Rights or Legitimate Interests

As also confirmed in the WIPO Jurisprudential Overview 3.0, a 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 of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a) (ii) of the Policy.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Respondent is not a licensee of, nor was otherwise authorised to use the Complainant's LEROY MERLIN trademark. The disputed domain name leads to a parking page displaying pay-per-click links related to the Complainant's business, through which the Complainant is probably deriving an income. Such use does not represent a bona fide offering as the pay-per-click links compete with or capitalize on the reputation and goodwill of the Complainant's mark and mislead Internet users. For the same reasons, such use does not represent a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In light of the above, the Panel finds that the Complainant has satisfied its burden of proof that the Respondent lacks rights or legitimate interests in the disputed domain name. It is now up to the Respondent to come forward with appropriate evidence that instead, it owns rights or legitimate interests on the disputed domain name. However, the Respondent did not submit a Response and waived its right to reverse the burden of proof.

Accordingly, the Panel is satisfied that the second condition under the Policy is met.

III. Bad Faith

The Panel finds that it is clear that the Respondent registered the disputed domain name being well aware of the Complainant's trademark, which is inherently distinctive and uniquely associated with the Complainant. Previous UDRP panels, in various decisions, have recognized the reputation of the LEROY MERLIN trademark; see among them, Groupe Adeo v. Peter Garcia, Leroy Merlin, WIPO Case No. D2016-1451; Groupe Adeo v. Etori Mathieu, WIPO Case No. D2021-0503; Groupe Adeo v. Nicolas Malfate, WIPO Case No. D2022-2292. Moreover, the Respondent added to the disputed domain name, the acronym "fr", which is the country of origin of the Complainant, where the Complainant has a substantial presence. The disputed domain name resolves to a parking page displaying pay-per-click links related to the Complainant's business.

All these circumstances clearly indicate that the Respondent registered the disputed domain name to target the Complainant and its well-known trademark to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the LEROY MERLIN trademark. Furthermore, the fact that the Respondent has set up MX Records for the disputed domain name shows an intention of the Respondent to send e-mail communications under the Complainant's trademark, which is a further indication of bad faith.

In view of the above, the Complainant is satisfied that also the third and last condition under the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **leroymerlin-fr.com**: Transferred

PANELLISTS

Name **Angelica Lodigiani**

DATE OF PANEL DECISION 2023-12-26

Publish the Decision
