Decision for dispute CAC-UDRP-106226

Case number	CAC-UDRP-106226
Time of filing	2024-02-05 09:43:36
Domain names	leroymerlinoficial.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	GROUPE ADEO

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Alfredo Julio Rossi

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, amongst others, of the following trademark registrations:

1) International trademark LEROY-MERLIN n° 591251 registered on July 15, 1992, and duly renewed for classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 16, 17, 19, 20, 21, 22, 25, 27, 28, 31 and 37;

2) International trademark LEROY MERLIN (dev.) n° 701781 registered on August 14, 1998, and duly renewed for 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, 38, 39, 40, 41 and 42;

3) European Union trademark LEROY MERLIN n°10843597 registered on December 7, 2012, and duly renewed for 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;

4) European Union trademark LEROY MERLIN (dev.) n°11008281 registered on October 2, 2013, and duly renewed for 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, 44.

FACTUAL BACKGROUND

The Complainant (GROUPE ADEO) 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 30,000 employees in France.

The Complainant is the owner of several trademarks LEROY MERLIN and is also the owner of numerous domain names comprising the wording LEROY MERLIN,

The disputed domain name <leroymerlinoficial.com> was registered on January 24, 2024

The Complainant states that the disputed domain name <leroymerlinoficial.com> is confusingly similar to its trademark LEROY MERLIN. In particular, in the Complainant's view, the addition of the term "oficial" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark LEROY MERLIN.

The Complainant states that the Respondent is not affiliated with him nor authorized by him in any way. The Complainant states that the Respondent has no right nor legitimate interest in the disputed domain name and it is not related in any way to its business. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Respondent, according to the Whois database, is not commonly known by <leroymerlinoficial.com> or by other names similar to the disputed domain name.

The Complainant also notes that the domain name <leroymerlinoficial.com> resolves to a parking page with commercial links and that, given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with the full knowledge of the Complainant's trademarks. It is the Complainant's view that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation or endorsement of the Respondent's website to which the disputed domain name resolves.

PARTIES CONTENTIONS

Complainant´s contentions are summarized above.

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

According to access list of the online case file, the Respondent has accessed the online case file on March 1, 2024 and reviewed all documents of the file. Nevertheless there was no contact of the Respondent.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of he disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1) The disputed domain name wholly incorporates the textual element of the LEROY MERLIN trademark. It also includes the word “oficial” (meaning “official” in Portuguese). However, this addition does not avoid a finding of confusing similarity because the textual element of the Complainant's trademark remains clearly recognizable within the disputed domain name (see AB Electrolux v. Name Redacted, Loja Electrolux
WIPO Case No. D2023-1306). Furthermore, according with the consensus view of past UDRP panels, the Top-Level domain (".COM" in this case) is not sufficient to exclude the likelihood of confusion since it is a mere technical requirement included in all domain names. For the above reasons, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. Therefore, the Complainant has satisfied the first condition in paragraph 4(a) of the Policy.

2) The Complainant has long standing rights in the mark LEROY MERLIN. The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized to use the domain name by the Complainant. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant has not licenced or otherwise permitted the Respondent to use the Complainant's marks in the disputed domain name. On the basis of the evidences submitted, and in the absence of a response, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant therefore has satisfied also the second condition in paragraph 4(a) of the Policy.

3) Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed 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 Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 Respondent's website or location or of a product or service on the Respondent's website or location.

The Respondent registered the disputed domain name many years after the use and registration of the LEROY MERLIN mark by the Complainant. In consideration of the reputation achieved by LEROY MERLIN it is clear that the Respondent was surely aware of the Complainant’s trademark when he registered the domain names in dispute. The disputed domain name resolves to parked page with commercial links. Such use here constitutes bad faith. In WIPO Case no. D2009-0258 Mpire Corporation vs. Michael Frey, the panel found that “While the intention to earn click-through-revenue is not in itself illegitimate, the use of a domain name that is deceptively similar to a trademark to obtain click-through-revenue is found to be bad faith use.” It is the Panel's view that such conduct of using a domain name, to attract Internet users for commercial gain fall within the meaning of paragraph 4(b)(iv) of the Policy. Given the above, the Panel believes that the Respondent has registered the disputed domain name in order to trade off the reputation of the Complainant’s trademark. The Complainant therefore has satisfied also the third condition in 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. **leroymerlinoficial.com**: Transferred

PANELLISTS

Name	**Guido Maffei**

DATE OF PANEL DECISION	2024-03-04

Publish the Decision