Decision for dispute CAC-UDRP-106299

Case number	CAC-UDRP-106299
Time of filing	2024-02-29 09:06:31
Domain names	leroy-merlin.shop, leroy-merlin.store

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	GROUPE ADEO

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondents

Name	Thais Beserra
Organization	Thais Cabelos

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 names.

IDENTIFICATION OF RIGHTS

Complainant is the owner, among others, of the following trademark registrations:

- The international trademark LEROY-MERLIN n° 591251 registered since 15-07-1992;
- The international trademark LEROY MERLIN n° 701781 registered since 14-08-1998;
- The European trademark LEROY MERLIN n°10843597 registered since 27-04-2012;
- The European trademark LEROY MERLIN n°11008281 registered since 02-07-2012.

Complainant has submitted evidence of the above trademark mentioned registrations.

FACTUAL BACKGROUND

Complainant is Groupe Adeo, a French company specializing in the sale of articles covering all sectors of the home, the development of the living environment and Do It Yourself (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.

Complainant is also the owner of numerous domain names comprising the trademark LEROY MERLIN, such as the domain names <leroymerlin.fr> registered since 12-09-1996 and uses it for the official website of its subsidiary LEROY MERLIN FRANCE; and <leroymerlin.com>, registered since 13-09-1996

Complainant has submitted evidence of owning the two registered domain names <leroymerlin.fr> and <leroymerlin.com>. Moreover, evidence is submitted of the use of <leroymerlin.fr>.

The first disputed domain name <leroy-merlin.shop> was registered on 2024-02-19 in the name of the person Thais Beserra.

The second disputed domain name <leroy-merlin.store> was registered on 2024-02-21 in the name of the organization Thais Cabelos, which name is also registered as the person who owns the domain name.

Both domain names have the same email and physical address as contact address, but the telephone and fax numbers are different. Both domain names resolve to an error page that mentions, i.a. the English text: This store is unavailable.

Complainant requests that the complaint be consolidated, as it asserts that the Respondents are actually the same entity: aside from the name of the Respondents and phone/fax numbers, all information regarding the address and email are identical.

Complainant requests transfer of the disputed domain name, hereby meaning two domain names, namely <leroy-merlin.shop> and <leroy-merlin.store>, as is stated in the consolidation request.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

No administratively compliant Response has been filed.

RIGHTS

According to the Policy paragraph 4(a)(i) it needs first to be established that:

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

Complainant contends that the disputed domain names are identical to the trademark LEROY MERLIN as it is contained without addition or deletion.

Complainant’s trademark is indeed fully integrated in the domain names of Respondent. The addition of the New gTLD “.shop” or “.store” does not change the overall impression of the designation as being connected to Complainant’s trademark.

Further, the trademark registrations predate the registration of the disputed domain names and thus the trademark rights prevail.

Thus, the Panel agrees with this assertion of Complainant.

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 Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

According to the Policy paragraph 4(a)(ii) it needs further to be established that:

(ii) Respondent has no rights or legitimate interests in respect of the domain name.

Paragraph 4 (c) of the Policy provides circumstances that could demonstrate that a Respondent has no rights to and legitimate

interests in the domain name. These circumstances are not exclusive. Circumstances that are providing rights or legitimate interests to the domain name are:

(i) before any notice to the Respondent of the dispute, the 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; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if though it has acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Further, according to WIPO Case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd., Complainant is required to make out a prima facie case that Respondent lacks rights or legitimate interests. Once such prima facie case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

Complainant asserts that Respondent is not identified in the Whois database as the disputed domain names. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. (i.a. Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>)

Complainant contends that Respondent is not related in any way with Complainant.

Complainant does not carry out any activity for, nor has any business with Respondent.

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

Finally, the disputed domain names resolve to an error page. Complainant contends that Respondent did not use the disputed domain names or has no demonstrable plan to use the disputed domain names.

Therefore, Complainant contends that Respondent has no right or legitimate interest in respect of the disputed domain names.

The Panel can only verify as true the information on the ownership of the domain names and that the domain names resolve to error pages.

The ownership notifications demonstrate no connection with Complainant's trademark and therefore is a clear indication that Respondent has no legitimate interest in the disputed domain names.

The fact that the disputed domain names resolve to error page pages is in itself no indication for non legitimate use as the disputed domain names were registered quite recently and therefore it can also be said that the websites are in preparation and thus could follow. But Respondent did not defend itself.

Thus, together with the other arguments as presented by Complainant with respect to having no business relation with Respondents, have given no license or authorization to Respondents, as well as the fact the Respondent did not counterargue against these assertions of Complainant the Panel decides that the assertions are true and thus Respondent does not have rights or legitimate interests.

Complainant has, to the satisfaction of the Panel, shown Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

According to the Policy paragraph 4(a)(iii) it needs to be established that:

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

Paragraph 4 (b) of the Policy provides circumstances on that demonstrate that Respondent has registered and used the domain name in bad faith. These circumstances are not exclusive. Those circumstance are for example:

(i) circumstances indicating that Respondent 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) 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, provided that Respondent has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to it's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Complainant states that the disputed domain names are identical to it's trademark LEROY MERLIN. They have been registered several years after the registration of the trademark LEROY MERLIN.

Further, earlier UDRP decisions have acknowledged Complainant trademark's reputation: WIPO Case No. D2022-2292, Groupe Adeo v. Nicolas Malfate; WIPO Case No. D2016-1451, Groupe Adeo v. Peter Garcia, Leroy Merlin.

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

The Panel accepts the reasoning that LEROY MERLIN is a distinctive trademark as it is a fanciful name that is not descriptive. Further, the Panel can verify, based on an earlier UDRP decisions that LEROY MERLIN is indeed a wellknown trademark, even has a worldwide reputation (WIPO Case No. D2022-3778 Groupe Adeo v. Huseyin Cemal COBAN, CiksNET). Thus, it is likely that Respondent has registered the disputed domain names with the full knowledge of Complainant's trademark.

Further, UDRP panels have found that the incorporation of a well-known trademark in a domain name having no plausible explanation for doing so is in itself an indication of bad faith (see WIPO Case No. D2009-0273 Intel Corporation v. The Pentium Group)

Therefore, the Panel accepts the assertion that the disputed domain names have been registered in bad faith.

With respect to determining if the disputed domain names are also used in bad faith, the Panel has to weigh whether the passive holding of the disputed domain name can be identified as use in bad faith. In previous UDRP decisions (namely and i.a.: WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows,) circumstances are described that would establish that also the use of the disputed domain name, namely the passing holding of it, is use in bad faith. Those circumstances are:

(i) Complainant's trademark has a strong reputation and is widely known;

(ii) Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name,

(iii) Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name,

(iv) Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement, and

(v) taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

Complainant asserts that the error pages in which the disputed domain names resolve are an indication of use of bad faith. Further, Respondent has not demonstrated any activity in respect of the disputed domain names, and it is not possible to conceive of any plausible actual or contemplated active use of the domain names by Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

The Panel opines that the fact that the disputed domain names resolve in an error page is not yet an indication of use in bad faith as the registration of the disputed domain name is quite recent and therefore it is likely that a website still needs to be set up.

However, all the other circumstances with respect to those two disputed domain names cannot lead to another conclusion than that it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain names by Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

Based on the above Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

Complainant seeks transfer of two disputed domain names of two different owners. Therefore, the Respondent is litterally not the same although there can only be one Respondent in the UDRP case. The Panel has therefore to decide whether a decision can be taken in this case.

In earlier case law it is determined that: The mere fact of registrants being differently named has, in various previous cases, not prevented a finding that there is one proper Respondent, in circumstances which indicate that the registrants may be regarded as the same entity in effect (WIPO D2007-1834 General Electric Company v. Marketing Total S.A).

In this case the Panel finds that given that the names of the disputed domain name owners are almost identical and the email and real effective addresses are identical it is likely that they can be regarded as the same entity in effect and thus are controlled by a

single entity. The Panel therefore has to decide whether a decision can be taken in this case.

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 this decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **leroy-merlin.shop**: Transferred
2. **leroy-merlin.store**: Transferred

PANELLISTS

Name	**Marieke Westgeest**

DATE OF PANEL DECISION 2024-04-04

Publish the Decision