Panel Decision for dispute CAC-ADREU-008479

Case number	CAC-ADREU-008479
Time of filing	2023-02-09 09:16:09
Domain names	leroymerlin-sa.eu

Case administrator

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

Complainant

Organization	GROUPE ADEO

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	JOEL MILLER

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any pending or decided legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is GROUPE ADEO, a French and worldwide retail group, devoted to the operation of DIY stores under the name LEROY MERLIN.

The Complainant is the owner of numerous trademarks LEROY MERLIN, including:

- The international trademark LEROY-MERLIN n° 591251 registered since July 15, 1992;
- The international trademark LEROY MERLIN n° 701781 registered since August 14, 1998;
- The European trademark LEROY MERLIN n°10843597 registered since April 27, 2012;
- The European trademark LEROY MERLIN n°11008281 registered since July 2, 2012.

The Complainant is also the owner of a large portfolio of LEROY MERLIN formative domain names.

The disputed domain name is <leroymerlinsa.eu> registered on May 25, 2022. It resolves to an inactive webpage.

The Complainant filed a Complaint on February 7, 2023, and amended the same on February 21, 2022.

A. COMPLAINANT

The Complainant claims that the disputed domain name violates its trademark rights, that the Respondent has no legitimate interest in the disputed domain name and that the same was filed and is used in bad faith.

The Complainant requests the transfer of the disputed domain name.

B. RESPONDENT

The Respondent did not file any response to the complaint and was found in default on April 4, 2023.

DISCUSSION AND FINDINGS

The Panel is to decide, in view of the facts and arguments of the parties, whether the conditions of article Article 4.4 of Reg. (EU) 2019/517 are satisfied to decide whether the disputed domain name should be transferred to the Complainant or not.

1) ON THE PRIOR RIGHTS

Pursuant to Article 4.4 of Reg. (EU) 2019/517, “A domain name may also be revoked, and where necessary subsequently transferred to another party, following an appropriate ADR or judicial procedure […] where that name is identical or confusingly similar to a name in respect of which a right is established by Union or national law”

The Panel finds that the trademark rights vested in the name LEROY MERLIN claimed by the Complainant are substantiated.

The Complainant justifies that it owns several LEROY MERLIN formative trademarks:

- The international trademark LEROY-MERLIN n° 591251 registered since July 15, 1992;

- The international trademark LEROY MERLIN n° 701781 registered since August 14, 1998;

- The European trademark LEROY MERLIN n°10843597 registered since April 27, 2012;

- The European trademark LEROY MERLIN n°11008281 registered since July 2, 2012.

Consequently, the Panel finds that the Complainant demonstrated it has prior rights.

2) ON THE IDENTITY OR CONFUSINGLY SIMILARITY OF THE DISPUTED DOMAIN NAME

The disputed domain name <leroymerlinsa.eu> reproduces the Complainant’s registered trademark LEROY MERLIN.

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise), in this case the abbreviation “SA” that stands for “Société Anonyme” and refers to the legal status of a company, would not prevent a finding of confusing similarity.

Furthermore, the addition of the Top-Level Domain (“eu”) “.com” does not prevent a finding of confusing similarity.

The Panel finds therefore that the disputed domain name is identical and confusingly similar to the Complainant’s trademark and that the requirements of Article 4.4 of Reg. (EU) 2019/517 are satisfied.

3) ON THE LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

Article 4.4 of Reg. (EU) 2019/517: "A domain name may also be revoked, and where necessarily subsequently transferred to another party, following an appropriate ADR or judicial procedure […] where it (a) has been registered by its holder without rights or legitimate interest in the name".

Pursuant to Article 4.4 of Reg. (EU) 2019/517, the legitimate interest condition is considered as fulfilled when:

1. Prior to any notice of an alternative dispute resolution procedure, the respondent has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;

   b) the respondent has been commonly known by the domain name;

   c) the respondent is making a legitimate and non-commercial or fair use of the domain name, without intend to mislead consumers or harm the reputation of the name on which a right is recognized.

   It is the Panel’s view that the overall burden of proof under the above provision rests with the Complainant, which is required to establish that the Respondent prima facie lacks any rights to, or legitimate interests in, the disputed domain name, and that if the Respondent fails to answer such case, the Complainant is deemed to have satisfied its burden of proof.

2. The Complainant states that the Respondent has no rights to or legitimate interests in the disputed domain name on the grounds that:

- the Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks and has not permitted the Respondent to apply for or use any domain name incorporating the LEROY MERLIN Marks;

- there is no evidence of the Respondent's use of, or demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services within the meaning of paragraph B(1)(b)(10)(i)(B) of the ADR Rules; and

- there is also no evidence which suggests that the Respondent is commonly known by the disputed domain name or the name LEROYMERLIN.

The Respondent, being in default, has not presented any justification for holding the disputed domain name.

The Panel observes on its part that the disputed domain name does not resolve to any website which would indicate that the Respondent has any kind of trademark or trade name rights in the name "Leroy Merlin" or which would contain any reference to a commercial use of the said name in the course of trade or would indicate that Respondent has been commonly known by the disputed domain name.

In view of the factual situation, and the Complainant's contentions, that are contested by the Respondent, the Panel finds that the Respondent does not appear to have any rights or legitimate interests in the disputed domain name.

The conditions of article Article 4.4 of Reg. (EU) 2019/517 are therefore satisfied.

4) ON THE RESPONDENT'S BAD FAITH

Article 4.4 of Reg. (EU) 2019/517: "A domain name may also be revoked, and where necessarily subsequently transferred to another party, following an appropriate ADR or judicial procedure where it:

(b) has been registered or is being used in bad faith."

The Complainant has substantiated the fact that its trademark LEROY MERLIN benefits from public's awareness, particularly in France.

The Respondent has indicated in the WHOIS Register, as the time of registration of the domain name, an address in France as well as a mobile phone number that corresponds to the French numbering code, which implies that the Respondent would be a French resident. Due to the longstanding use of the Complainant's mark in France, the Respondent could not reasonably be unaware of the Complainant's rights when it registered the disputed domain name.

It is further noted by the Panel that the disputed domain name is not being actively used by the Respondent, and does not resolve to any active webpage with substantive content.

It is however a consensus view among panels that lack of so-called active use (e.g., to resolve to a website) of a domain name does not prevent a finding of bad faith.

The Panel must examine all the circumstances of the case to determine whether the Respondent is acting in bad faith.

In addition to the notoriousness of the Complainant's mark that the Respondent could not reasonably not be aware of, the Complainant has justified that the Respondent has also registered another domain name, formed with the Complainant's trademark LEROY MERLIN, that has been used as an e-mail address for phishing purposes.

The Respondent clearly appears engaged in a bad faith pattern of conduct.

In the circumstances of this case, the Panel finds that passive holding of the disputed domain name does not prevent a finding of bad faith.

The Panel is thus satisfied that the disputed domain name was registered and is used in bad faith in the meaning of Article 4.4 b) of Reg. (EU) 2019/517.

5) TRANSFER OF THE DISPUTED DOMAIN NAME / ELIGIBILITY OF COMPLAINANT

The Complainant is a French company and having its domicile / place of business within the European Community. Therefore, the requirements for the requested transfer of the disputed domain name to the Complainant are satisfied (Section B No.1 (b) (12) of the ADR Rules).

The Panel finds that the Complainant satisfies the general eligibility criteria for registration set out in Article 3 of Reg. (EU) 2019/517.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the disputed domain name <leroymerlin-sa.eu> be transferred to the Complainant.

PANELISTS

Name	William Lobelson

DATE OF PANEL DECISION 2023-04-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: leroymerlinsa.eu

II. Country of the Complainant: France, country of the Respondent: France

III. Date of registration of the domain name: 25 May 2022

IV. Rights relied on by the Complainant (B(11)(f) ADR Rules) on which the Panel based its decision:

International trademark LEROY-MERLIN n° 591251 registered since July 15, 1992;

International trademark LEROY MERLIN n° 701781 registered since August 14, 1998;

European trademark LEROY MERLIN n°10843597 registered since April 27, 2012;

European trademark LEROY MERLIN n°11008281 registered since July 2, 2012.

V. Response submitted: No

VI. Domain name is identical/confusingly similar to the protected right/s of the Complainant

VII. Rights or legitimate interests of the Respondent (B(11)(f) ADR Rules)::
1. No
2. Why: No authorization from Complainant / Domain name inactive

VIII. Bad faith of the Respondent (B(11)(e) ADR Rules):
1. Yes
2. Why: Reputation of Complainant's mark / no active use of domain name / registration in parallel of a similar domain name used for phishing purposes

IX. Other substantial facts the Panel considers relevant: -

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: -

XII. [If transfer to Complainant] Is Complainant eligible? Yes