

ADMINISTRATIVE PANEL DECISION

Groupe ADEO v. Privacy Service Provided by Withheld for Privacy ehf /
Ivan Urgant
Case No. D2022-0828

1. The Parties

The Complainant is Groupe ADEO, France, represented by Coblençe Avocats, France.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Ivan Urgant, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <leroymerliin.com> (“the Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 9, 2022. On March 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 10, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 15, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on March 16, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 12, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on April 20, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a company incorporated in 1923 under the laws of France that operates a “do-it-yourself” (“DIY”) home and lifestyle improvement retail business with 21,000 employees and 400 outlets across twelve countries. The Complainant holds numerous registrations for the trademark LEROY MERLIN in numerous jurisdictions including, for example: International Trademark Registration No. 591251 for LEROY MERLIN, registered on July 15, 1992.

The Complainant owns numerous domain names that incorporate its trade mark including <leroymerlin.com> registered on June 27, 1997.

The Respondent registered the Disputed Domain Name <leroymerliin.com> on November 1, 2021. According to the Complaint, the Disputed Domain Name resolved to a website which purported to offer for sale similar products to the ones available at Complainant’s main website. At the time of the Decision, the Disputed Domain Name resolves to an inactive webpage.

5. Parties’ Contentions

A. Complainant

The Complainant cites its European Union trademark No. 11008281 registered on registered on October 2, 2013 and numerous other registrations internationally for the mark LEROY MERLIN as *prima facie* evidence of ownership.

The Complainant submits that the mark LEROY MERLIN is “well known” and that its rights in that mark predate the Respondent’s registration of the Disputed Domain Name <leroymerliin.com>. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the LEROY MERLIN trademark and that the similarity is not removed by the addition of the letter “i”, or the addition of the generic Top-Level Domain (“gTLD”) “.com”.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it resolved to a webpage displaying the Complainant’s device trademark and, subsequently, resolved to an inactive webpage.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules and submits that the Respondent was well aware of the trademark LEROY MERLIN and that “By registering the domain name <leroymerliin.com> to redirect to a website which offers sales of similar products than the Complainant’s products and on which the Complainant’s word and figurative trademark is reproduced, the Respondent clearly intends to take advantage of the use of a domain name whose resemblance to the Complainant’s well-known trademarks ‘LEROY MERLIN’ is confusing. Therefore, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the websites to which the disputed domain name resolves, by creating a likelihood of confusion with the Complainant’s trademarks”.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark LEROY MERLIN in numerous jurisdictions including France. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the LEROY MERLIN trademark, the Panel observes that the Disputed Domain Name comprises: (a) an exact reproduction of the Complainant's trademark LEROY MERLIN; (b) with an additional letter "i" next to the letter "r" in the word "merlin"; (c) followed by the gTLD ".com".

It is well established that the gTLD used as technical part of a domain name may be disregarded. (see section 1.11 of the [WIPO Overview 3.0](#)). The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: "leroymerliin".

It is also well established that in cases where a domain name consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element (see [WIPO Overview 3.0](#), section 1.9).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because "To the Complainant's knowledge, the Respondent has never registered 'LEROY MERLIN' trademark and has never acquired any common law rights on this wording. Hence, the Respondent has no right in and to the domain name <leroymerliin.com>. The Complainant has neither authorized nor licensed the Respondent in any way to use or exploit the 'LEROY MERLIN' trademarks, to register this domain name, or to associate itself with the Complainant. Neither did the Complainant know the Respondent, nor has it ever been in relationship with it".

The Complainant also contends that "By registering the domain name <leroymerliin.com> to redirect to a website which offers false discount coupons for the Complainant's products and on which the Complainant's word and figurative trademark is reproduced, the Respondent clearly intends to take advantage of the use of a domain name whose resemblance to the Complainant's well-known trademarks 'LEROY MERLIN' is

confusing”.

The Respondent is not an authorized reseller with legitimate interests in a domain name incorporating a Complainant’s mark. Nor, alternatively, is the Respondent commonly known by the Disputed Domain Name. The Panel is satisfied that the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. In the absence of a response, this Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Panel finds for the Complainant on the second element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy requires that the complainant must also demonstrate that the Disputed Domain Name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the content of the website it resolves to, the Panel is satisfied that the Respondent knew of the Complainant’s trademark LEROY MERLIN when it registered the Disputed Domain Name (see *Groupe Adeo v. Peter Garcia, Leroy Merlin*, WIPO Case No. [D2016-1451](#) (“considering that the Complainant’s LEROY MERLIN trademarks predate the registration of the disputed domain name <leroymerlin-fr.com>, the well-known status of these trademarks, the fact that the Respondent did not reply to the Complainant’s contentions and then did not offer any plausible explanation, the Panel infers that the Respondent had actual knowledge of the Complainant’s trademarks at the time he registered the disputed domain name”); *Groupe Adeo v. Gruppo Cipa Srl Gruppo Cipa Srl, Gruppo Cipa Srl*, WIPO Case No. [D2016-1674](#) (“It is highly improbable to this Panel that given the reputation and fame of the LEROY MERLIN trademark, the Respondent was unaware of it at the time of the registration of the disputed domain name”).

In addition, the gap of several years between registration of the Complainant’s trademark and the Respondent’s registration of the Disputed Domain Name, along with the composition of the Disputed Domain Name (containing a typosquatted version of the Complainant’s well-known trademark) in the circumstances of this case is a further indicator of bad faith. (See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#)). In this case, the Complainant’s rights in its trademark predate any rights that could possibly flow from the Respondent’s registration by at least 29 years.

On the issue of use, the Complainant’s evidence is that the Disputed Domain Name previously resolved to a website that displayed the Complainant’s figurative trademark and, currently, does not resolve to an active website. This Panel accepts the Complainant’s evidence the Disputed Domain Name resolved to a website displaying the Complainant’s trademark as evidence that the Respondent was well aware of the Complainant’s trademark LEROY MERLIN when registering the Disputed Domain Name and has used it in bad faith.

This Panel also finds that the subsequent use of the Disputed Domain Name to resolve to a passive website is further evidence of bad faith. Previous UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the ‘passive holding’ doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put” (see [WIPO Overview 3.0](#), section 3.3). This Panel notes that the evidence is that all of these factors are present in this proceeding.

This Panel also views the provision of false contact information underlying the privacy or proxy service as an additional indication of bad faith (see [WIPO Overview 3.0](#), section 3.6).

In the absence of any evidence to the contrary, this Panel accepts the Complainant's evidence and finds that the Respondent has created a misspelled version of the Complainant's trademark LEROY MERLIN for the Disputed Domain Name, without the Complainant's consent or authorization, for the very purpose of typosquatting to capitalize on the reputation of the trademark to infringe upon the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name, <leroymerliin.com>, be transferred to the Complainant.

/Nicholas Weston/
Nicholas Weston
Sole Panelist
Date: May 4, 2022