

ADMINISTRATIVE PANEL DECISION

Association des Centres Distributeurs E. Leclerc – ACD Lec v. Registration Private, Domains By Proxy, LLC / Patrick Harding
Case No. D2022-1526

1. The Parties

The Complainant is Association des Centres Distributeurs E. Leclerc – ACD Lec, France, represented by Inlex IP Expertise, France.

The Respondent is Registration Private, Domains By Proxy, LLC, United States of America / Patrick Harding, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <eleclerc-group.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 27, 2022. On April 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 2, 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 May 3, 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 amended Complaint on May 4, 2022.

The Center verified that the Complaint together with the amended 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 May 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2022. The Respondent did not submit any response. Accordingly, the Center sent notification of the Respondent’s default on May 27, 2022.

The Center appointed Petra Pecar as the sole panelist in this matter on June 3, 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 French association which operates a large chain of supermarkets and hypermarkets in France, with more than 700 such stores, and whose name refers to its founder and promoter Edouard Leclerc. The Complainant also operates around 100 stores in other European countries such as Poland, Spain, Portugal, and Slovenia. With more than 22% of the grocery market share at the beginning of 2022, the Complainant is the leader of large-scale distribution in France, and employs approximately 133 000 people.

The Complainant holds trademark registrations for E LECLERC, including:

-European Union Trade Mark No. 002700664, registered on January 31, 2005, for E LECLERC;

-European Union Trade Mark No. 011440807, registered on May 27, 2013, for the figurative mark:



The disputed domain name was registered on February 23, 2022, and as evidenced in the Complaint, and at the time of the decision, resolves to a pay-per-click page, with commercial links, and MX servers are configured.

5. Parties' Contentions

A. Complainant

The Complainant states that it holds several trademark registrations for the term E LECLERC. The term "e leclerc" does not have a meaning in French or English, and it resembles the name of the Complainant's founder. The Complainant claims that it is the most renowned chain of supermarkets and hypermarkets in France and that its chain of stores and the E LECLERC trademark are well known in France and in several other European countries.

The Complainant contends that the disputed domain name is confusingly similar to the E LECLERC trademark in which the Complainant has rights, as the disputed domain name incorporates the entire E LECLERC trademark with the mere addition of a hyphen and the descriptive term "group" which does not prevent the confusing similarity between the disputed domain name and the Complainant's trademarks.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the Respondent is not commonly known by the disputed domain name. The Complainant contends that the Respondent is not related in any way to the Complainant and that no license or authorization has been granted to the Respondent by the Complainant to register or use the disputed domain name. The Complainant states that the disputed domain name previously resolved to a pay-per-click page, with commercial links, and then resolved to an inactive webpage at the time of filing the Complaint, and that MX servers were set up, and concludes that this type of use is not a *bona fide* offering of goods or services.

The Complainant contends that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark and that the Respondent could not have ignored the reputation of the Complainant's trademark E LECLERC as it is well-known. The Complainant alleges that the Respondent is using the disputed domain name in bad faith and provided evidence of the Respondent's page targeting the Complainant's business. The Complainant submits that such use of the disputed domain name

constitutes use in bad faith since the disputed domain name was registered for the purpose of disrupting the business of the Complainant. Therefore, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

Even if the Respondent did not file a Response to the Complainant's contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant. "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable", as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

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

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must, firstly, establish rights in a trademark or service mark and, secondly, establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.2.1). The Panel finds that the Complainant has provided evidence of ownership of registrations for the E LECLERC trademark, demonstrating that it has rights in the E LECLERC trademark, through registrations and use for goods and services in all 45 classes, which predate the registration date of the disputed domain name.

The Panel finds that the disputed domain name incorporates the Complainant's trademark E LECLERC in its entirety along with a hyphen and an additional term "group" and the generic Top-Level Domain ("gTLD") ".com". Where the relevant mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise), would not prevent a finding of confusing similarity, in accordance with section 1.8 of the [WIPO Overview 3.0](#). Accordingly, the addition of the term "group" to the Complainant's trademark does not prevent a finding of confusing similarity here.

Finally, it is well accepted practice by UDRP panels that a gTLD, such as ".com", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11.1 of the [WIPO Overview 3.0](#)). Accordingly, the Panel determines that the disputed domain name is confusingly similar to the Complainant's trademarks.

In accordance with the above, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to its E LECLERC mark.

B. Rights or Legitimate Interests

Under the second element of the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is generally deemed to have satisfied the second element, as set out in paragraph 4(a)(ii) of the Policy (see also [WIPO Overview 3.0](#), section 2.1).

Moreover, the Policy provides guidance to respondents on how to demonstrate rights or legitimate interests in a domain name. In particular, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name, including: (i) use of the domain name “in connection with a *bona fide* offering of goods or services”; or (ii) demonstration that the Respondent has been “commonly known by the domain name”; or (iii) “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”.

The Panel notes that the Respondent has not filed a response and thus did not deny the Complainant’s assessment, nor brought any information or evidence demonstrating any rights or legitimate interests in respect of the disputed domain name. The Complainant has made a *prima facie* showing that the Respondent does not have any rights or legitimate interests in the disputed domain name, particularly by asserting that the Respondent is not connected with the Complainant, nor affiliated with it in any way, and that it never authorized, licensed, or permitted the Respondent to use its trademark as part of the disputed domain name. The Respondent is not commonly known under the disputed domain name, does not own any rights in the E LECLERC mark, and does not make any *bona fide* use – either commercial or noncommercial, of the same.

The disputed domain name resolves to a pay-per-click page with links that compete with or capitalize on the reputation and goodwill of the Complainant’s mark, which is not a legitimate or *bona fide* use.

The Panel therefore finds that the Complainant has made a *prima facie* demonstration of the Respondent’s lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent, and that the Complainant has accordingly established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires the Complainant to demonstrate that the Respondent registered and is using the disputed domain name in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a Respondent’s bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when, by using the 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 trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

The Complainant has substantiated that its trademark E LECLERC was registered in 2005, 17 years before the registration of the disputed domain name, and was also used before the registration of the disputed domain name. Regarding the prior registration of the Complainant’s trademarks, as well as its reputation, it seems unlikely and implausible that the Respondent was unaware of the activities of the Complainant and of the existence of its trademarks E LECLERC at the time the registration of the disputed domain name was made.

Having in mind the distinctiveness of the Complainant’s trademark, which has no meaning in English or French and is not a dictionary word, and its reputation as determined and confirmed by a previous UDRP

panel (see *Association des Centres Distributeurs E. Leclerc - A.C.D Lec v. Domain Administrator, PrivacyGuardian.org / cunshuo zhang*, WIPO Case No. [D2019-1580](#)), the Panel agrees with the Complainant's claims that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark E LECLERC. Moreover, as noted above, the Panel has concluded it is very unlikely that the Respondent has chosen the domain name without intention to target the Complainant.

The Complainant provided evidence of the Respondent's use of the disputed domain name in connection with a website with pay-per-click links that compete with or capitalize on the reputation and goodwill of the Complainant's mark, which indicates the Respondent's bad faith and attempt to use the disputed domain name in order to attract, for commercial gain, Internet users to its website or other online location by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

Use of the trademark E LECLERC in combination with the term "group" which directly refers to the Complainant's corporate structure cannot be a coincidence, as the reputation of the Complainant's trademark is taken into account, suggesting that the Respondent was perfectly aware of the Complainant and its trademark.

The Panel observes that the Complainant has provided evidence demonstrating that the disputed domain name has active MX records, enabling its use for email, which could be perceived as an intent to use the disputed domain name in connection with phishing activities and further supports a finding of bad faith use (see *Novartis AG v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2021-2149](#), and *Accor SA v. Domain Admin, C/O ID#10760, Privacy Protection Service INC d/b/a PrivacyProtect.org /Yogesh Bhardwaj*, WIPO Case No. [D2017-1225](#)). Although no evidence of phishing activities has been provided by the Complainant, the Panel deems that the presence of such MX records represents a severe risk of phishing or other fraudulent and abusive activities and together with other evidence, supports an inference of bad faith on the Respondent's side. Given the confusing similarity of the disputed domain name to the Complainant's E LECLERC trademark, it is difficult to imagine any good faith use of the mail server attached to such a domain name (see in particular *Accenture Global Services Limited v. WhoisGuard Protected, WhoisGuard, Inc. / Basikta James*, WIPO Case No. [D2020-2955](#)).

Given these circumstances and the fact that the Respondent failed to submit a response or to provide any evidence of actual possible good-faith use, the Panel concludes that the Respondent's registration and use of the disputed domain name is in bad faith. Accordingly, the Complainant has satisfied 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 <eleclerc-group.com> be transferred to the Complainant.

/Petra Pecar/

Petra Pecar

Sole Panelist

Date: June 17, 2022