

ADMINISTRATIVE PANEL DECISION

Carrefour SA v. Domains By Proxy, LLC/Razi Shapira
Case No. D2022-2628

1. The Parties

The Complainant is Carrefour SA, France, represented by IP Twins, France.

The Respondent is Domains By Proxy, United States of America, LLC/Razi Shapira, Israel.

2. The Domain Name and Registrar

The disputed domain name <carrefour-il.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 July 19, 2022. On July 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 20, 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 July 22, 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 July 26, 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 August 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2022. Several emails were received from the Respondent on July 24, 25, 27, 2022, August 5, 2022. On August 2, 2022, the Center sent out a Possible Settlement Notice. The Notice informed the Parties that should they wish to explore settlement options, the Complainant should submit a request for suspension by August 7, 2022. As no request for suspension was received, the proceeding was continued. The Response was filed with the Center on August 22, 2022.

The Center appointed William R. Towns as the sole panelist in this matter on September 26, 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 multinational retail and wholesaling corporation headquartered in France, founded in 1959 and operating under the CARREFOUR brand. The Complainant conceived of and has operated in CARREFOUR hypermarkets since as early as 1968, and now features as many as 12,000 stores in over 30 countries. The Complainant holds itself out as the eighth-largest retailer in the world by revenue.¹

The Complainant makes substantial use of its CARREFOUR brand through the internet and social media, and holds numerous trademark registrations for its CARREFOUR mark, including among the following:

International trademark No. 351147, CARREFOUR registered on October 2, 1968;

International trademark No. 353849, CARREFOUR, registered on February 28, 1969; and

Israel trademark No. 22856, CARREFOUR, registered on March 6, 2011.

The Complainant uses its domain name <carrefour.com>, created in 1995, which reflects the Complainant's registered CARREFOUR mark. The Complainant makes available its services through "Apps," including the Android Google Play Store, which according to the Complainant accounts for over 5,000,000 downloads. The Complainant has registered numerous domain names reflecting the Complainant's CARREFOUR mark.

The disputed domain name <carrefour-il.com>, which reflects the Complainant's CARREFOUR mark, was registered by the Respondent on February 19, 2022, according to the concerned registrar's Whois records. The disputed domain name resolves to a parking page comprising pay-per-click hyperlinks.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's CARREFOUR mark, in which the Complainant has demonstrated rights dating back to 1968 for retail stores and related goods and services. According to the Complainant, the test for confusing similarity involves a relatively straightforward comparison between the Complainant's mark and the disputed domain name and normally will be considered confusingly similar for standing purposes.

The Complainant asserts that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. The Complainant explains that once the Complainant has established a *prima facie* case the burden shifts to the Respondent to come forward with relevant evidence, in which event the Complainant is considered to have satisfied the second element.

In that respect, the Complainant emphasizes given the Complainant's well-known and famous CARREFOUR mark that any attempted legitimate commercial use of the disputed domain name by the Respondent in the circumstances of this case would be inconceivable, citing *Carlsberg A/A v. Brand Live Television*, WIPO Case No. [DTV2008-0003](#). In view of the foregoing, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

¹ See *Carrefour SA v. Whois Privacy Protection Foundation/RemTyled Lantak, Megatour*, WIPO Case No. [D2022-0010](#).

The Complainant considers that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant finds its CARREFOUR mark to be so widely known and in use for so many years that the Respondent cannot plausibly claim to have been unaware of the Complainant's mark when registering the disputed domain name. Moreover, according to the Complainant, even were the Respondent unaware of the Complainant's CARREFOUR mark when registering the disputed domain name, WIPO UDRP panelists consistently have found that the mere registration of a famous or well-known trademark by an unaffiliated entity can of itself create a presumption of bad faith.

B. Respondent

The Respondent maintains that he purchased the disputed domain name according to the law and with a pure heart, intending to offer "carrefour as a joint venture in Israel", and hoping to cooperate with the Complainant to lower high food prices. According to the Respondent, however, before he was able to approach Carrefour it was announced that the Complainant would be coming to Israel instead, shortly after the Respondent had started his business. The Respondent is adamant that when purchasing the disputed name he was unaware that the Complainant was planning to open a new Carrefour store in Israel.

6. Discussion and Findings

A. Scope of the Policy

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. [D2002-0774](#). Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain names", also known as "cybersquatting". *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. [D2000-0187](#). See Final Report of the First WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169-177. The term "cybersquatting" is most frequently used to describe the deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks or service marks. *Id.* at paragraph 170. Paragraph 15(a) of the Rules provides that the panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the panel deems applicable.

Paragraph 4(a) of the Policy requires that the complainant prove each of the following three elements to obtain a decision that a domain name should be either cancelled or transferred:

- (i) the 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 with respect to the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

Cancellation or transfer of the domain name is the sole remedy provided to the complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the view is that the burden of production shifts to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has

made a *prima facie* showing. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.1. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

B. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar if not identical to the Complainant’s CARREFOUR mark, in which the Complainant has established rights through registration and extensive use. In considering identity and confusing similarity, the first element of the Policy serves essentially as a standing requirement.² The threshold inquiry under the first element of the Policy involves a relatively straightforward comparison between the Complainant’s trademark and the disputed domain name.

The Complainant’s CARREFOUR mark is clearly recognizable in the disputed domain name.³ When the relevant trademark is recognizable in the disputed domain name the addition of other terms (such as “-il”), whether descriptive, geographical, pejorative, meaningless, or otherwise, does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy.⁴ Top-Level Domains (“TLDs”) generally are disregarded when evaluating the identity or confusing similarity of the Complainant’s mark to the disputed domain name under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the TLD.⁵

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

C. Rights or Legitimate Interests

As noted above, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in a domain name. The Panel is persuaded from the record of this case that a *prima facie* showing under paragraph 4(a)(ii) of the Policy has been made. It is undisputed that the Respondent has not been authorized to use the Complainant’s CARREFOUR mark. The record nonetheless reflects the Respondent’s registration and use of the disputed domain name, in which the Complainant’s CARREFOUR mark clearly is recognizable.

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the 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.

The Respondent has not submitted a response to the Complaint, in the absence of which the Panel may accept all reasonable inferences and allegations in the Complaint as true. See *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#). The Panel has carefully reviewed the record in this case, and

² See [WIPO Overview 3.0](#), section 1.7.

³ *Id.*

⁴ See [WIPO Overview 3.0](#), section 1.8 and cases cited therein.

⁵ See [WIPO Overview 3.0](#), section 1.11.2 and cases cited therein.

finds nothing therein that would bring the Respondent's registration and use of the disputed domain name within any of the "safe harbors" of paragraph 4(c) of the Policy.

It is evident to the Panel that the Respondent had the Complainant's distinctive and well-known CARREFOUR mark firmly in mind when registering the disputed domain name. The record reflects that the Respondent in all probability registered the disputed domain name seeking to exploit and profit from the Complainant's CARREFOUR mark. And as previously noted, the Respondent intentionally has directed the disputed domain name to a parking page comprising pay-per-click hyperlinks.

There is no indication that the Respondent at any time has been commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy. Accordingly, nothing in the record before the Panel supports a finding of the Respondent's rights or legitimate interests in the disputed domain name.

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

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt 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 its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

For the reasons discussed under this and the preceding heading, the Panel concludes that the Respondent's conduct constitutes bad faith registration and use of the disputed domain name within the meaning of paragraph 4(a)(iii) of the Policy. The Respondent had the Complainant's CARREFOUR mark firmly in mind when registering the disputed domain name, and the Respondent's use of the disputed domain name is demonstrative of bad faith. The Respondent intentionally sought to capitalize on the Complainant's CARREFOUR mark by creating a likelihood of confusion.

Accordingly, the Panel finds 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 <carrefour-il.com> be transferred to the Complainant.

/William R. Towns/

William R. Towns

Sole Panelist

Date: October 18, 2022