

## **ADMINISTRATIVE PANEL DECISION**

ELO v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Patrice Joubert

Case No. D2022-1029

### **1. The Parties**

The Complainant is ELO, France, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Domain Admin, Privacy Protect, LLC (PrivacyProtect.org), United States of America / Patrice Joubert, France.

### **2. The Domain Name and Registrar**

The disputed domain name <auchan-hypermarche.com> (the “Disputed Domain Name”) is registered with Beget LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 24, 2022. On March 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 28, 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 31, 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 April 1, 2022.

On March 31, 2022, the Center sent an email communication to the parties in both Russian and English regarding the language of the proceeding. On April 1, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in both English and Russian, and the proceedings commenced on April 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 3, 2022.

The Center appointed Mariya Koval as the sole panelist in this matter on May 16, 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, previously known as Auchan Holding SA, is a multinational retail group. Founded in 1960, the company has grown exponentially throughout its history and is now the 11th largest food retailer in the world, operating in 17 countries, across Europe, Africa and Asia. Additionally, with 354,851 employees worldwide, Auchan is also the 35th largest employer in the world. As of December 2020, its consolidated revenue, excluding taxes, was of EUR 32 billion.

The Complainant is the owner, through its subsidiaries Auchan Holding and Groupe Auchan Société Anonyme, of a number of AUCHAN trademark (the "AUCHAN Trademark") registrations throughout the world, among which are:

- International Trademark Registration No. 284616, registered on June 5, 1964, in respect of goods in classes 3, 9, 11, 25, 29, 32;
- International Trademark Registration No. 332854, registered on January 24, 1967, in respect of services in classes 35, 36, 37, 38, 39, 40, 41, 42;
- International Trademark Registration No. 625533, registered on October 19, 1994, in respect of goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42;
- French Trademark Registration No. 1244726, registered on September 9, 1983, in respect of goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45.

The Complainant has a significant Internet presence, it operates over 600 different domain names reflecting its AUCHAN Trademark for sale and promotion of its goods and services, *inter alia*: <auchan.com> (registered on April 1, 1996), <auchan.fr> (registered on February 11, 1997), <auchan-retail.com> (registered on October 27, 2015). According to the service "Similarweb.com", the Complainant's official website under domain name <auchan.fr> has received an average of 10.1 million visitors during the three-month period from September to November 2021. Additionally, this website is ranked the 3,083rd globally and the 109th in France.

The Disputed Domain Name was registered on November 10, 2021. At the time Complaint was filed the Disputed Domain Name resolved to a Registrar parking webpage stating. "The domain is not linked to a directory on the server!". The Disputed Domain Name was also being used to send fraudulent emails.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts that it has spent a considerable amount of time and money protecting its intellectual property rights. The word "Auchan" is not a dictionary term and does not have a generic meaning. The company was named after the "Hauts Champs" neighborhood in Roubaix, where the

Complainant's first shop was opened in 1961. The Complainant's name and trademark are, therefore, a direct reference to the company's origins and history. Additionally, the Complainant has spent substantial time, effort and money in marketing and promoting its AUCHAN Trademark.

The Complainant contends that the Disputed Domain Name is confusingly similar to its AUCHAN Trademark in view of the Disputed Domain Name contains the Complainant's Trademark in its entirety with addition of a hyphen and the term "hypermarche". The fact that such term is closely linked and associated with the Complainant's Trademark only serves to underscore and increase the confusing similarity between the Disputed Domain Name and the Complainant's Trademark. More specifically: "hypermarche" – is a French translation of "hypermarket" and the Complainant is a French company that operates hypermarkets worldwide. The additional term "hypermarche" closely relates to the Complainant's business. Addition of a hyphen does nothing to distinguish the Disputed Domain Name from the Complainant's Trademark.

The Complainant further claims that that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name in view of the following:

- the Respondent is not sponsored by or affiliated with the Complainant in any way;
- the Complainant has not given the Respondent permission to use the Complainant's Trademark in any manner, including in domain names;
- the Respondent is not commonly known by the Disputed Domain Name, which evinces a lack of rights or legitimate interests;
- at the time of filing the Complaint, the Respondent was using a privacy service, which past UDRP panels have also found to equate to a lack of legitimate interest;
- the Respondent's previous use of the Disputed Domain Name does not constitute a *bona fide* offering of goods or services;
- the Respondent was previously using the Disputed Domain Name for the sole purpose of sending emails, which had the appearance of coming from one of the Complainant's employees. More specifically, the Respondent has set up the email address to impersonate one of the Complainant's employees, and send phishing emails to the Complainant's unsuspecting customers, seeking to confuse them into entering supply partnerships with the Respondent, presumably for its own benefit. Further, in order to support this impression, the Respondent has included the Complainant's full address, French commercial registration number and their VAT number. By sending emails from the Disputed Domain Name, the Respondent was attempting to impersonate the Complainant as part of a fraudulent email phishing scheme;
- at present the Disputed Domain Name directs Internet users to a website that resolves to generic registrar holding page and lacks content. The Respondent has failed to make use of the Disputed Domain Name's website and has not demonstrated any attempt to make legitimate use of the Disputed Domain Name and website, which evinces a lack of rights or legitimate interests in the Disputed Domain Name;
- the Respondent registered the Disputed Domain Name on November 10, 2021, which is significantly after the Complainant filed for registration of its AUCHAN Trademark, and also significantly after the Complainant's first use in commerce of its Trademark in 1961.

The Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. By registering the Disputed Domain Name that incorporates the entirety of the Complainant's AUCHAN Trademark along with a hyphen and the related term "hypermarche", the Respondent has created the Disputed Domain Name that is confusingly similar to the Complainant's Trademark. As such, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. Moreover, the Respondent is using the Disputed Domain Name to send phishing emails to the Complainant's unsuspecting customers. In light of the facts set forth within this Complaint, it is not possible

to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's Trademark at the time the Disputed Domain Name was registered.

The Respondent registered and used the Disputed Domain Name with the primary aim of launching a phishing attack, which is clear evidence of bad faith registration and use. After first creating a strong likelihood of confusion by misappropriating the Complainant's Trademark in the Disputed Domain Name, the Respondent used the Disputed Domain Name to send fraudulent emails, which had the appearance of originating from the Complainant, to the Complainant's customers. In these emails, the Respondent sought to fool the Complainant's customers into believing it sought to establish supply partnerships with them, presumably for its own benefit. The Respondent's efforts to masquerade as the Complainant certainly constitutes fraud, which must be considered bad faith registration and use of the Disputed Domain Name.

The Disputed Domain Name currently resolves to a Registrar holding page. The inactive website at the Disputed Domain Name can constitute a factor in finding bad faith registration and use pursuant to the Policy.

Moreover, the Respondent, at the time of initial filing of the Complaint, had employed a privacy service to hide its identity, which is a further evidence of bad faith registration and use.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, in order for the complainant to succeed it must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which 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 was registered and is being used in bad faith.

### **6.1. Preliminary Issue: Language of Proceedings**

The Registrar confirmed that the language of the Registration Agreement for the Disputed Domain Name is Russian.

The Complainant has filed the Complaint in English and requests that English be the language of this proceeding due to the following reasons:

- the Complainant is unable to communicate in Russian and, taking into consideration the Respondent's use of the Disputed Domain Name (to send fraudulent emails in English) and the Respondent's decision to register the Disputed Domain Name that misappropriates the well known AUCHAN Trademark, translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter;
- such additional delay, considering the obviously abusive nature of the Disputed Domain Name (the Respondent has used the Disputed Domain Name as part of a phishing scheme), poses continuing risk to the Complainant and unsuspecting consumers seeking the Complainant or its products;
- the Disputed Domain Name is comprised of Latin characters;

- the website under the Disputed Domain Name features a message in English from the Registrar;
- the term “Auchan”, which is the dominant part of the Disputed Domain Name, does not carry any specific meaning in the Russian language.

In accordance with paragraph 11(a) of the Rules unless otherwise agreed by the Parties, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant is a French company and its representative is a Swedish company. The Panel takes into account that neither the Complainant nor its representative are able to understand and to communicate in Russian and therefore forcing the Complainant to translate the Complaint and annexes thereto, would result in unfair additional expenses for the Complainant and would delay this UDRP proceeding.

The Disputed Domain Name and generic Top-Level domain (“gTLD”) comprise Latin script. The Disputed Domain Name reproduces the well-known AUCHAN Trademark in its entirety. The Respondent is a resident of France where Russian is not an official language. Furthermore, the Respondent, having received the Center’s communication regarding the language of the proceeding, also in both English and Russian, did not make any submissions regarding the language of the proceeding.

Paragraph 10(c) of the Rules sets out that the Panel shall ensure that the administrative proceeding takes place with due expedition.

Having considered all circumstances of this case, the Panel concludes under paragraph 11(a) of the Rules that English shall be the language of the proceeding.

## **6.2. Substantive Issues**

### **A. Identical or Confusingly Similar**

The Complainant is the owner of the AUCHAN Trademark for more than fifty years. The Complainant has provided evidence and has established its rights in the well-known AUCHAN Trademark.

The Disputed Domain Name reproduces the AUCHAN Trademark in its entirety with addition of the word “hypermarche” (a French translation of “hypermarket”), hyphen and and the gTLD “.com”. According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.8, where the relevant trademark 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 under the first element. Also, addition of a hyphen is typically irrelevant to the consideration of confusing similarity between a trademark and a domain name. The gTLD “.com” should be disregarded under the confusing similarity test as a standard registration requirement. In this case, the addition of the term “hypermarche” and hyphen does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant’s Trademark.

Pursuant to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s Trademark pursuant to paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

The Complainant has used its AUCHAN Trademark for more than 50 years and its domain name <auchan.com> since 1996, which is long before the Respondent registered the Disputed Domain Name in 2021.

The Complainant alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy. The Complainant has never authorized in any way, licensed, or permitted the Respondent to use its AUCHAN Trademark.

In accordance with section 2.1 of the [WIPO Overview 3.0](#) while the overall burden of proof in UDRP proceedings is on the Complainant, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If 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 Disputed Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element.

Taking into account the facts and arguments set out above, the Panel finds that the Complainant has made a *prima facie* case: the Respondent registered the Disputed Domain Name long after the AUCHAN Trademark had been registered; there is no evidence that the Respondent owns any AUCHAN Trademarks, nor that it is commonly known by the Disputed Domain Name. Therefore, the Respondent has failed to come forward with any evidence to rebut such *prima facie* case.

The Complainant submits that the Respondent is not using the Disputed Domain Name in connection with a *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy. Namely, according to the evidence presented by the Complainant (Annex 9 to the Complaint) the Respondent is using the Disputed Domain Name for phishing scheme, namely the Respondent has set up the email address to impersonate one of the Complainant's employees, and send phishing emails to the Complainant's customers with suggestion of commercial partnership's establishment with the Respondent, presumably for its own benefit. Moreover, the Respondent has included the Complainant's full address, French commercial registration number and their VAT number. The Panel agrees with the Complainant that by sending emails from the Disputed Domain Name, the Respondent was obviously attempting to impersonate the Complainant as part of a fraudulent email phishing scheme. Such use of the Disputed Domain Name cannot be considered as *bona fide* offering of goods or services, or a legitimate noncommercial or fair use. In accordance with section 2.13.1 of the [WIPO Overview 3.0](#) UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.

Moreover, in accordance with the [WIPO Overview 3.0](#), section 2.5.1, even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. Therefore, the addition of the term "hypermarche" in French, which is a direct reference to the Complainant's business, to the Complainant's Trademark in the Disputed Domain Name, is further evidence, that the Respondent was very well aware of the Complainant's Trademark and business at the time of registration of the Disputed Domain Name and has done so for the only purpose of creating an impression that the Disputed Domain Name is connected with the Complainant and its Trademark.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

### **C. Registered and Used in Bad Faith**

Taking into consideration that the AUCHAN Trademark has been in use more than 50 years and that the Complainant has spent huge amounts and efforts for promotion of its Trademark, which is undoubtedly globally known, the Panel considers it is clear that the Respondent was well aware of the Complainant and its Trademark at the time of registration of the Disputed Domain Name. Moreover, the Disputed Domain Name, incorporating the Complainant's AUCHAN Trademark in its entirety, is clearly deceptive for the Internet users with respect to the person producing the goods and rendering the services.

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety that creates a strong likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name.

In accordance with the [WIPO Overview 3.0](#), section 3.4, UDRP panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution (in some such cases, the respondent may host a copycat version of the complainant's website). Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers. Taking into account the Respondent's use of the Disputed Domain Name for impersonating the Complainant in the furtherance of a fraudulent email scheme, such Respondent's behavior cannot be in any way considered as a good faith.

In addition,, according to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is of opinion that it is clear that the Respondent, having registered and used the Disputed Domain Name, which is confusingly similar to the well-known Complainant's Trademark, primarily intended to disrupt the Complainant's business. In view of the absence of any evidence to the contrary and that the Respondent did not file any statement, the Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith.

In view of the foregoing, the Panel finds that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant

### **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 <auchan-hypermarche.com> be transferred to the Complainant.

*/Mariya Koval/*

**Mariya Koval**

Sole Panelist

Date: May 30, 2022