

## **ADMINISTRATIVE PANEL DECISION**

Carrefour SA. v. seydina Sokhna, b-smart  
Case No. D2023-2055

### **1. The Parties**

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

The Respondent is seydina Sokhna, b-smart, Senegal.

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

The disputed domain name <marketcarrefour.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 May 9, 2023. On May 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 10, 2023, 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 (Registration Private / Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 11, 2023 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 15, 2023.

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 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2023.

On May 24 and 26, 2023, the Center received informal communications from a third party email. The Center asked the sender to identify himself on May 26, 2023, to which he replied that he was “Seydina Sokhna”, director of b-smart and the owner of the disputed domain name. The Response was filed with the Center on June 4 and 5, 2023.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on June 20, 2023. 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 global retail company. The Complainant owns trademarks in the marks CARREFOUR and CARREFOUR MARKET, amongst which the following:

- International Trademark No. 351147 for CARREFOUR, registered on October 2, 1968, in International Classes 1 to 34;
- International Trademark No. 353849 for CARREFOUR, registered on February 28, 1969, in International Classes 35 to 42;
- European Union Trademark No. 006659643 for CARREFOUR MARKET, registered on December 18, 2008, in International Class 35; and
- International Trademark No. 1034794 for CARREFOUR MARKET (figurative), registered on December 23, 2009, in International Class 35.

The Complainant also owns, *inter alia*, the domain names <carrefour.com>, <carrefourmarket.fr> and <carrefour.sn> which resolve to official websites where it promotes and offers its products and services.

The disputed domain name was registered on April 11, 2023, well after the Complainant secured rights to the abovementioned trademarks. The disputed domain name currently redirects to a GoDaddy parking page.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant asserts that each of the three elements specified in paragraph 4(a) of the Policy are present. The three elements being: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (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 in bad faith.

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant contends that the disputed domain name is identical or confusingly similar to its CARREFOUR and CARREFOUR MARKET trademarks, which are incorporated in their entirety in the disputed domain name. Moreover, the addition of the term "market" in the disputed domain name does nothing to prevent confusing similarity. Finally, the addition of the top-level domain ".com" is not significant in determining whether the disputed domain name is identical or confusingly similar to the trademarks of the Complainant.

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent does not own any trademarks in the mark CARREFOUR and is neither known by the disputed domain name. The Complainant also points out that they did not authorize, license, or permit the Respondent to use any of its trademarks or to apply for or use any domain name incorporating

their trademarks. Furthermore, the Respondent has not, before the original filing of the Complaint, used or made preparations to use the disputed domain name in relation to a *bona fide* offering of goods or services. On the contrary, the Complainant claims, the disputed domain name is used for pay-per-click advertisements and therefore trades off the goodwill of the Complainant.

(iii) The disputed domain name has been registered and is being used in bad faith.

The Complainant contends that the disputed domain name has been registered and is being used in bad faith. The Complainant claims that the Respondent had or should have had knowledge of the Complainant's trademarks and business at the time when it registered the disputed domain name. Furthermore, the Complaint asserts that the current use of the disputed domain name (as described above) may not be considered good faith use and it is difficult to imagine any plausible future active use of the disputed domain name by the Respondent that would be legitimate.

## **B. Respondent**

The Respondent's Response merely consisted of a few comments which were submitted by email of June 4, 2023 to the Center. In its Response, the Respondent acknowledges the Complainant's trademarks, but questions why the Complainant has not purchased the disputed domain name. The Respondent claims that since the Complainant did not purchase the disputed domain name, they cannot prevent the Respondent from purchasing and owning it. Furthermore, the Respondent contends that they have no intention to harm or damage the Complainant and that, despite the fact that they had plans for the disputed domain name, they are willing to transfer it to the Complainant.

## **6. Discussion and Findings**

### **A. Language of the Proceedings and Jurisdiction**

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, 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 language of the Registration Agreement for the disputed domain name is English. In addition, even though the Respondent informed the Center by emails of May 24 and 26, 2023 that they were unable to understand the contents of the English language Complaint and accompanying letter, they submitted a Response with the Center on June 4 and 5, 2023 in which they did not request for French to be the language of the proceedings. Consequently, the Panel is satisfied that the Respondent was given a fair opportunity to appreciate the true nature of the proceedings and what its consequences may be, as well as present its case, and to inform the Center on its language preference. The Panel concludes that the Respondent will not be prejudiced by the proceeding being conducted in English and it has the advantage of avoiding unnecessary delay of the proceeding and further expense on translations into French of the Complaint and the annexes. Accordingly, the Panel determines that the language of the proceeding shall be English.

Furthermore, the Panel finds that it has jurisdiction to hear this dispute as the Policy has been incorporated by reference into the registration agreement between the Registrar and the Respondent.

Paragraph 4(a) of the Policy requires that in order for its complaint to succeed, the Complainant must prove that the following three elements are present:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 in bad faith.

The above three elements will each be discussed in further detail below.

## **B. Identical or Confusingly Similar**

The Complainant is required to establish: (1) that it owns rights in a trademark or service mark, and, if so, (2) that the disputed domain name is identical or confusingly similar to its trademarks.

Firstly, the Panel finds that the Complainant has clearly evidenced that it owns registered trademark rights to CARREFOUR and CARREFOUR MARKET. The Panel is satisfied with the evidence provided in support of the existence of trademarks for CARREFOUR and CARREFOUR MARKET and the Respondent has not disputed this. The international trademark for CARREFOUR MARKET that the Complainant relies on is figurative, however this can also be taken into account to show “rights in a mark” since the dominant portions of these trademarks are the words “Carrefour” and “Market”. It is a consensus view of UDRP panels, with which the Panel agrees, that trademark registrations with design elements can *prima facie* satisfy the requirement that a complainant shows “rights in a mark” so long as the textual elements are not overtaken (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.10). Finally, it should be noted that paragraph 4(a)(i) of the Policy does not set minimum requirements as to the jurisdictions of the trademarks a complainant relies on, nor as to the number, nature or scope of protection of such trademarks.

Secondly, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s registered trademarks since it incorporates CARREFOUR and CARREFOUR MARKET marks in their entirety (see [WIPO Overview 3.0](#), section 1.7, as well as *L’Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang*, WIPO Case No. [D2011-1627](#); *Rapidshare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#); and *The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co., Inc.*, WIPO Case No. [D2000-0113](#)). As the CARREFOUR trademark is recognizable within the disputed domain name, the addition of “market” before it does not prevent the Panel’s finding of confusing similarity under the first element. It is a well-established view of UDRP panels, with which the Panel agrees, that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see for instance: *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. [D2001-0110](#); *Nintendo of America Inc. v. Fernando Sascha Gutierrez*, WIPO Case No. [D2009-0434](#); *M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts*, WIPO Case No. [D2015-1384](#); and *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#)).

Finally, as for the applicable Top-Level Domain (“TLD”), *i.e.*, the suffix “.com”, the Panel holds that this can be disregarded under the first element confusing similarity test (*CANAL + FRANCE v. Franck Letourneau*, WIPO Case No. [DTV2010-0012](#); *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#); and *SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*, WIPO Case No. [D2015-0565](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, this Panel finds and concludes that the disputed domain name is confusingly similar to the Complainant’s trademarks.

## **C. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy non-exhaustively lists three circumstances that shall demonstrate a right or legitimate interest:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.”

It is a well-established view of UDRP panels, with which the Panel agrees, that a *prima facie* case advanced by a complainant is generally sufficient to satisfy the requirements under paragraph 4(a)(ii) of the Policy, and the burden of production shifts to the respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain name (*AGUAS DE CABREIROA, S.A.U. v. Hello Domain*, WIPO Case No. [D2014-2087](#); *Spigen Korea Co., Ltd., Spigen Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2016-0145](#); and *HubSpot, Inc. v. WhoisGuard Protected, WhoisGuard, Inc. / Steve Johnson*, WIPO Case No. [D2016-1338](#)).

The Panel notes that the Respondent has not responded to any of the Complainant’s contentions in detail, let alone submitted evidence to the contrary. The Respondent only made a general comment that they have future plans for the disputed domain name, however they did not provide any evidence demonstrating rights or legitimate interests in the disputed domain name. Consequently, this Panel finds that the Complainant has made out an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, considering the following factors.

The Panel finds that there is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. The fact that the disputed domain name does not currently resolve to an active website, but instead a parking page containing pay-per-click links relating to the services and goods offered by the Complainant indeed supports this. The Panel also notes that the disputed domain name is confusingly similar to the Complainant’s trademarks, which carries a risk of implied affiliation. As is clear from sections 2.2, 2.5, and 2.8 of the [WIPO Overview 3.0](#), UDRP Panels have consistently found that such use of a domain name can neither be considered legitimate noncommercial or fair use of the domain name nor a *bona fide* offering of goods or services.

In addition, the Complainant asserts that the Respondent is not affiliated with the Complainant in any way nor has the Complainant licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant’s trademarks. The Panel has taken note of the Complainant’s confirmation in this regard and has not seen any evidence that would suggest the contrary. In the absence of any license or permission from the Complainant to use its trademarks, no actual or contemplated *bona fide* or legitimate use of the disputed domain name could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

Finally, the Panel agrees with the Complainant that there is no evidence that the Respondent has been commonly known by the disputed domain name.

For all the foregoing reasons, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

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

Paragraph 4(b) of the Policy non-exhaustively lists four circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of the domain name in bad faith:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The Panel finds that the circumstances and evidence presented by the Complainant offer sufficient proof that both the Respondent's registration and current use of the disputed domain name are in bad faith.

The Panel will first discuss the Respondent's registration of the disputed domain name. With the Complainant, the Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain name included the Complainant's abovementioned trademarks. Prior panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see [WIPO Overview 3.0](#), section 3.1.4). The Panel also agrees with the Complainant that, given the notoriety of its trademarks and its activities in Senegal, the Respondent should have known about the Complainant at the time of registration. Furthermore, the CARREFOUR and CARREFOUR MARKET trademarks have been registered in different countries and existed for a long time prior to the Respondent's registration of the disputed domain name. The Respondent's knowledge of the Complainant and its abovementioned trademarks and therefore its registration in bad faith of the disputed domain name may also be inferred from these circumstances (see Section 3.2.2 of the [WIPO Overview 3.0](#) and in particular: *SembCorp Industries Limited v. Hu Huan Xin*, WIPO Case No. [D2001-1092](#); and *American Funds Distributors, Inc. v. Domain Administration Limited*, WIPO Case No. [D2007-0950](#)).

As for the use of the disputed domain name, notwithstanding the Respondent's unsubstantiated claims that they have no intention to harm or damage the Complainant, the Panel agrees with the Complainant that the current use of the disputed domain name (as detailed above) cannot be considered good faith use. The disputed domain name is being used to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainants' trademarks as to the source, sponsorship, affiliation, or endorsement of this website (paragraph 4(b)(iv) of the Policy). The fact that the disputed domain name is confusingly similar to the Complainant's trademarks carries a risk of implied affiliation. The Panel also agrees with the Complainant that there is no evidence of any actual or intended use of the disputed domain name in good faith. Finally, the Panel believes that the Respondent's retention of control of the disputed domain name represents an implied and ongoing threat to the Complainant, which further supports a finding of bad faith.

In light of the above, the Panel finds that the disputed domain name was registered and is being used by the Respondent in bad faith.

## 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, <marketcarrefour.com> be transferred to the Complainant.

*/Benoit Van Asbroeck/*

**Benoit Van Asbroeck**

Sole Panelist

Date: July 4, 2023