

ADMINISTRATIVE PANEL DECISION

Carrefour SA v. Registration Private, Domains By Proxy, LLC /

Ali Sindhi, Student

Case No. D2022-2091

1. The Parties

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

The Respondent is Registration Private, Domains By Proxy, LLC, United States of America / Ali Sindhi, Student, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <carrefourcatalogue.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 June 9, 2022. On June 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 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 June 13, 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 June 20, 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 June 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 18, 2022.

The Center appointed Prokhorova, Ganna as the sole panelist in this matter on July 21, 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

Given that no Response was filed, the following facts are based on the submissions in the Complaint and the Annexes to the Complaint.

The Complainant is a worldwide leader in retail and a pioneer of the concept of hypermarkets back in 1968. The Complainant operates more than 12,000 stores in more than 30 countries worldwide. The Complainant additionally offers travel, banking, insurance, and ticketing services.

The Complainant owns several hundred trademark rights worldwide in the CARREFOUR term, such as:

- International trademark CARREFOUR No. 351147, registered on October 2, 1968, designating goods in 1-34 classes;
- International trademark CARREFOUR No. 353849, registered on February 28, 1969, designating services in 35-42 classes.

In addition, the Complainant is also the owner of domain name <carrefour.com> registered since 1995.

The disputed domain name was registered on February 23, 2022, and based on the available evidence, has resolved to a parked page by the Registrar where it is advertised as possibly for sale.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to its earlier well-known trademarks CARREFOUR.

The Complainant contends that the Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name. The Complainant asserts that the Respondent has been not commonly known by the disputed domain name as an individual, business, or other organization, and is reproducing the Complainant's earlier registered trademarks in the disputed domain name without any license or authorization from the Complainant.

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. In fact, the disputed domain name is being offered for sale.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith. The Respondent's choice of disputed domain name cannot have been accidental and must have been influenced by the fame of the Complainant and its earlier trademarks.

The Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraphs 14(a) and 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable, and on the basis of the Complaint where no Response has been submitted.

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to the trademarks or service marks 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 in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy, it should be established that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Panel confirms that the Complainant has satisfied the threshold requirement of having relevant trademark rights.

With the Complainant's rights in the CARREFOUR trademark established, the remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the generic Top-Level-Domain ("gTLD") in which the disputed domain name is registered) are identical or confusingly similar to the Complainant's mark.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark CARREFOUR, since it reproduces it in its entirety. The Panel also notes that the addition of the term "catalogue" to the trademark in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark. As discussed in section 1.8 of the [WIPO Overview 3.0](#), in cases where the relevant trademark is recognizable within the disputed domain name, the addition of terms would not prevent a finding of confusing similarity under the first element.

In view of the above, the Panel is satisfied that the Complainant has met the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of "proving a negative", in particular as the evidence needed to show the Respondent's rights or legitimate interests is often primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed

domain name to meet the requirements of paragraph 4(a)(ii) of the Policy.

The Panel notes that there is no evidence that there are CARREFOUR CATALOGUE or CARREFOUR trademarks likely to be held by the Respondent.

The case file also does not contain any evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization.

Moreover, the Respondent reproduces the Complainant's earlier registered trademarks in the disputed domain name without any license or authorization from the Complainant. The Complainant has also not authorized the use of its earlier trademarks or terms similar thereto in the disputed domain name in any manner or form. Nevertheless, the Respondent has registered the disputed domain name consisting of the Complainant's mark along with the term "catalogue", which is a descriptive term affiliated to the Complainant's retail industry and thus carries a risk of implied affiliation, and as such cannot constitute fair use nor vest in the Respondent rights or legitimate interests.

The disputed domain name resolves towards a page indicating that the disputed domain name "may be for sale". There are also no evidence that the Respondent used or made preparations to use the disputed domain name in relation to a *bona fide* offering of goods or services.

In the absence of a Response, the Respondent has failed to demonstrate any of the non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c), or provide any other evidence of rights or legitimate interests in the disputed domain name.

Therefore, the Panel concludes that the Respondent does not have rights or any legitimate interests in the disputed domain name within the meaning of Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Complainant's trademark registrations significantly predate the registration date of the disputed domain name. Previous panels have established that mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising 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. A quick CARREFOUR trademark search would have revealed to the Respondent the existence of the Complainant and its trademarks. The Respondent's failure to do so is a contributory factor to its bad faith (*Lancôme Parfums Et Beaute & Cie, L'Oreal v. 10 Selling*, WIPO Case No. [D2008-0226](#)).

Furthermore, the fact that the disputed domain name appears to be offered for sale is an indication of a use in bad faith. Indeed, while offering domain names for sale is not *per se* constitutive of bad faith, it is well-established that offering a domain name that include a prior trademark is a bad-faith use, all the more when the concerned trademark is famous.

As stated in [WIPO Overview 3.0](#), the panel must examine all the circumstances of the case to determine whether the Registrant is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of its identity. Panels may draw inferences about whether the domain name was used in bad faith given the circumstances surrounding registration, and *vice versa*.

The relevant issue is not limited to whether the Registrant is undertaking a positive action in bad faith in relation to the domain names, but instead whether, in all the circumstances of the case, it can be said that the Registrant is acting in bad faith. The distinction between undertaking a positive action in bad faith and

acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that the concept of a domain name “being used in bad faith” is not limited to positive action, inaction is within the concept. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

In light of these particular circumstances, the Panel concludes that the Complainant has succeeded in proving the requirement of paragraph 4(a)(iii) that the disputed domain name was registered and used in bad faith by the Respondent.

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 <carrefourcatalogue.com> be transferred to the Complainant.

/Prokhorova, Ganna/
Prokhorova, Ganna
Sole Panelist
Date: August 4, 2022