

ADMINISTRATIVE PANEL DECISION

Groupe Adeo v. Jean Phillipe
Case No. D2022-3088

1. The Parties

The Complainant is Groupe Adeo, France, represented by Coblence Avocats, France.

The Respondent is Jean Phillipe, France.

2. The Domain Name and Registrar

The disputed domain name <leroymerlin-france.com> is registered with Register SPA (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 20, 2022. On August 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 23, 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 August 23, 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 amendment to the Complaint on August 23, 2022.

The Center verified that the Complaint together with the amendment to the 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 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 14, 2022.

The Center appointed William Lobelson as the sole panelist in this matter on September 19, 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 ADEO, a French and worldwide retail group, devoted to the operation of DIY stores under the name LEROY MERLIN.

The Complainant is the owner of numerous trademarks for or incorporating LEROY MERLIN, including:

- European Union word Trademark "LEROY MERLIN" No. 10843597, filed on April 27, 2012 and registered on December 7, 2012, in classes 01, 02, 03, 04, 05, 06, 07, 08, 09, 11, 12, 14, 16, 17, 18, 19, 20, 21, 22, 24, 25, 26, 27, 28, 31, 35, 36, 37, 40, 41, 42 and 44;

- European Union device Trademark "LEROY MERLIN" No. 11008281, filed on July 2, 2012 and registered on October 2, 2013, in classes 01, 02, 03, 04, 05, 06, 07, 08, 09, 11, 12, 14, 16, 17, 18, 19, 20, 21, 22, 24, 25, 26, 27, 28, 31, 35, 36, 37, 40, 41, 42 and 44;

- International word Trademark "LEROY MERLIN" No. 591251, filed and registered on July 15, 1992, in classes 01, 02, 03, 04, 05, 06, 07, 08, 09, 11, 16, 17, 19, 20, 21, 22, 25, 27, 28, 31 and 37, and designating Austria, Bulgaria, Benelux, Switzerland, China, Czech Republic, Germany, Egypt, Spain, Hungary, Italy, Liechtenstein, Morocco, Monaco, Montenegro, Poland, Portugal, Romania, Serbia, Slovakia, San Marino, Viet Nam, Ukraine;

The Complainant is also the owner of a large portfolio of LEROY MERLIN formative domain names.

The disputed domain name is <leroymerlin-france.com>, registered on August 3, 2022. It resolves to an inactive webpage.

5. Parties' Contentions

A. Complainant

The Complainant claims that the disputed domain name is confusingly similar to its earlier trademarks, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith. The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Notwithstanding the default of the Respondent, it remains incumbent on the Complainant to make out its case in all respects under the Rules set out in paragraph 4(a) of the Policy. Namely, the Complainant must prove that:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (paragraph 4(a)(i));

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name (paragraph 4(a)(ii)); and

(iii) the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii)).

A. Identical or Confusingly Similar

The Complainant is the owner of numerous LEROY MERLIN trademarks.

The disputed domain name is <leroymerlin-france.com>. It reproduces the Complainant's trademark LEROY MERLIN in its entirety.

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise), in this case a hyphen and the name "france", would not prevent a finding of confusing similarity under the first element; see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Furthermore, the addition of the generic Top-Level Domain ("gTLD") ".com" does not prevent a finding of confusing similarity.

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

B. Rights or Legitimate Interests

To demonstrate rights or legitimate interests in a domain name, non-exclusive Respondent defenses under UDRP, paragraph 4(c) include the following:

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

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

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed 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 assertions, nor brought any information or evidence for demonstrating any rights or legitimate interests.

The Complainant has made a *prima facie* case 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 affiliated with it in any way and that it never authorized the Respondent to use its trademark as part of the disputed domain name.

The Complainant further contends that the Respondent is not known under the disputed domain name, has not acquired any trademark in the term "LEROY MERLIN", and does not make any *bona fide* use - neither commercial nor noncommercial, of the disputed domain name.

The Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name.

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

C. Registered and Used in Bad Faith

The Complainant has substantiated the fact that its trademark LEROY MERLIN, which has been registered and used for years, now benefits from a high level of public's awareness, particularly – but not only – in France. Earlier UDRP decisions have acknowledged the Complainant's trademark's reputation: *Groupe Adeo v. Nicolas Malfate*, WIPO Case No. [D2022-2292](#); *Groupe Adeo v. Peter Garcia, Leroy Merlin*, WIPO Case No. [D2016-1451](#).

When the identity of the Respondent was disclosed by the Registrar, it was found that the said Respondent had declared a place of residence in France. Due to the longstanding use of the Complainant's mark in France, the Respondent could not reasonably be unaware of the Complainant's rights when it registered the disputed domain name.

The Panel observes besides that the Respondent made the choice of associating the trademark LEROY MERLIN with the name "france", that is very likely to let the public believe that the disputed domain name is owned or controlled by the Complainant.

For this Panel it is a clear indication that the Respondent necessarily had the Complainant's trademark in mind when it registered the disputed domain name, and intended to distract Internet users searching for the Complainant's services and products.

The Panel infers from the above that the Respondent acted in bad faith when it registered the disputed domain name.

It is further noted by the Panel that the disputed domain name is not being actively used by the Respondent, and does not resolve to any active webpage with substantive content.

It is a consensus view among UDRP panels that, with comparative reference to the circumstances set out in paragraph 4(b) of the UDRP deemed to establish bad faith registration and use, the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name, does not prevent a finding of bad faith.

The Panel must examine all the circumstances of the case to determine whether the Respondent 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 and no response to the Complaint having been filed. UDRP panels may draw inferences about whether a domain name is used in bad faith given the circumstances surrounding registration.

As stated in [WIPO Overview 3.0](#), section 3.3, there is a consensus view about "passive holding":

"From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put."

Such passive holding is to be regarded as use in bad faith (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#); *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#); *Westdev Limited v. Private Data*, WIPO Case No. [D2007-1903](#); *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#); *Intel Corporation v. The Pentium Group*, WIPO Case No. [D2009-0273](#)).

In the circumstances of this case, the Panel further finds that passive holding of the disputed domain name does not prevent a finding of 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, <leroymerlin-france.com> be transferred to the Complainant.

/William Lobelson/

William Lobelson

Sole Panelist

Date: September 27, 2022