

ADMINISTRATIVE PANEL DECISION

Groupe Adeo v. Huseyin Cemal COBAN, CiksNET
Case No. D2022-3778

1. The Parties

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

The Respondent is Huseyin Cemal COBAN, CiksNET, Türkiye.

2. The Domain Name and Registrar

The disputed domain name <leroymerlin.xyz> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2022. On October 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 11, 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 October 12, 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 October 17, 2022. On October 28, 2022, the Respondent sent an informal email communication.

In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2022. The Respondent did not submit any formal response. Accordingly, the Center informed the Parties that it would proceed to Panel Appointment on November 7, 2022.

The Center appointed Mladen Vukmir as the sole panelist in this matter on November 10, 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 Panel has determined the following non-contested facts:

- (i) the Complainant is a French company, Groupe Adeo, registered at the Paris Trade And Companies Register under the number 358 200 913;
- (ii) the pioneer company in Groupe Adeo is Leroy Merlin, founded in 1923, a do-it-yourself (“DIY”) retail outlet operating in home and lifestyle improvement industry;
- (iii) the Complainant is the holder of a number of LEROY MERLIN international and European Union trademark registrations (hereinafter: “LEROY MERLIN trademarks”), including, but not limited to:

Trademark	Scope of Protection	Reg. no. / Status	Date of registration	Class(es)
LEROY MERLIN (word)	European Union	10843597 / registered	December 7, 2012	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	11008281 / registered	October 2, 2012	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
LEROY MERLIN (word)	International	591251 / registered	July 15, 1992	01, 02, 03, 04, 05, 06, 07, 08, 09, 11, 16, 17, 19, 20, 21, 22, 25, 27, 28, 31 and 37

- (iv) the Respondent is the registrant of the disputed domain name, as disclosed by the Registrar;
- (v) the disputed domain name was registered on September 21, 2021 and resolves to an inactive website;
- (vi) as listed and evidenced in the Complaint, the Complainant is the registrant of a number of domain names incorporating the Complainant’s LEROY MERLIN trademarks, such as:

<leroymerlin.com> registered on September 13, 1996;
 <leroymerlin.net> registered on May 5, 2000;
 <leroymerlin.org> registered on May 5, 2000;
 <leroymerlin.eu> registered on May 1, 2006;
 <leroymerlin.pe> registered on November 17, 2014;
 <leroymerlin.energy> registered on October 5, 2015.

5. Parties' Contentions

A. Complainant

The Complainant, essentially, asserts the following:

(i) it is a very well-known company specialized in hardware shops, operating worldwide and federating 30 autonomous companies and brands. The company group traces its roots back to 1923, when Leroy Merlin, a pioneer of the company group, and one of its most prominent brands, was established;

(ii) Leroy Merlin is the leading major DIY retail outlet specializing in home and lifestyle improvement market with over 21,000 employees in France, and 400 stores located all over the world;

(iii) it is the holder of several different trademarks, both international and European Union trademarks, composed of the terms "Leroy" and "Merlin", as well as the holder of a broad portfolio of domain names composed of the terms "Leroy" and "Merlin";

(iv) the terms "Leroy" and "Merlin" have no meaning, but rather constitute the last names of the founders of the company (Mr. Adolphe Leroy, and Ms. Rose Merlin). According to the Complainant, the disputed domain name incorporates the distinctive terms of the Complainant's prior trademarks, that is, the Respondent merely copied the prior trademarks and domain names of the Complainant;

(v) the disputed domain name is confusingly similar to the Complainant's registered and well-known LEROY MERLIN trademarks, while it reproduces the Complainant's LEROY MERLIN trademarks in its entirety. The Complainant invokes to the previous decisions adopted by the Panel where it was decided that the disputed domain name ought to be transferred to the Complainant due to the similarity of the domain names in question.

(vi) to the Complainant's knowledge, the Respondent has no rights in the name Leroy Merlin. The Respondent is in no way affiliated with the Complainant, nor has any authorization to use the Complainant's LEROY MERLIN trademarks, or to proceed with the registration of the disputed domain name. The Respondent is neither a licensee, nor a third party authorized to use the trademarks, including as a domain name. The Complainant believes that the Respondent could not have chosen the disputed domain name that is highly similar to the intangible rights of the Complainant by sheer coincidence. According to the Complainant, such a choice by the Respondent reveals malicious intention to take advantage of the notoriety of the Complainant's trademarks. Since the Respondent has never received authorization to use the Complainant's trademarks, the Respondent's use of the disputed domain name cannot be considered as *bona fide* use of the disputed domain name.

(vii) the Respondent registered the disputed domain name in bad faith, since the Respondent has neither the rights nor a legitimate interest in the disputed domain name. The Complainant believes that the Respondent must have known or should have known of the Complainant's trademarks and nevertheless chose to register a domain name for which it had no rights or legitimate interests. In support of the aforementioned, the Complainant states how the disputed domain name is almost identical to the Complainant's trademarks – which strongly suggests that the Respondent had the Complainant's trademarks in mind when registering the disputed domain name. Additionally, the Complainant has a significant reputation in the world, and its LEROY MERLIN trademarks significantly predate the date of the registration of the disputed domain name.

(viii) the Respondent is a passive holder of the disputed domain name, which creates the likelihood of confusion with the Complainant's prior trademarks and damages the Complainant's reputation, as the disputed domain name directs to an inactive website;

(ix) the Complainant has recently been the victim of a phishing campaign and is of opinion that the disputed domain name may be in connection with such a campaign.

B. Respondent

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

The Respondent has sent an informal email communication to the Center lacking any content, response or assertions about the substance of the case. The Respondent just briefly stated that he has purchased the disputed domain name from the Registrar for fun, and that he had no previous knowledge of Leroy Merlin as a company. The Respondent also stated that he contacted the Complainant's legal representative, but received no response. The Respondent mentioned that is interested in co-operation with the Complainant related to the disputed domain name and its transfer to the Complainant.

6. Discussion and Findings

The Panel now proceeds to consider this matter on the merits in light of the Complaint, the lack of the Response, the Policy, the Rules, the Supplemental Rules, and other applicable rules and principles of law pursuant to paragraph 15(a) of the Rules.

Paragraph 4(a) of the Policy provides that the Complainant must prove, with respect to the disputed domain name, each of the following:

- (i) the disputed domain name is confusingly similar to a trademark 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.

A. Identical or Confusingly Similar

As provided in section 1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter: "[WIPO Overview 3.0](#)"), it is generally accepted that ownership of a registered trademark by a complainant is sufficient to satisfy the threshold requirement of having the trademark rights for purposes of standing to file a UDRP case.

The Complainant has submitted sufficient evidence to show that it is the holder of several international and European Union LEROY MERLIN trademarks registered before the competent authorities. As such, these trademarks provide to the Complainant all the exclusive rights that are granted with such trademark registrations.

It is well established that the threshold test for confusing similarity under the UDRP involves a reasoned but relatively straightforward comparison between the textual components of the relevant trademark and the disputed domain name. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see section 1.7 of the [WIPO Overview 3.0](#))

After performing a side-by side comparison of the disputed domain name and the Complainant's LEROY MERLIN trademarks, it is evident to this Panel that the disputed domain name incorporates the Complainant's LEROY MERLIN trademarks in its entirety. The only difference between the disputed domain name and the Complainant's LEROY MERLIN trademarks is the deletion of the space between terms "Leroy" and "Merlin" in case of the disputed domain name. Such deletion does not prevent finding of confusing similarity. The Complainant's LEROY MERLIN trademarks are recognizable in the disputed domain name, that is, incorporated entirely in the disputed domain name entirely.

Regarding the generic Top-Level Domain (“gTLD”), “.xyz” suffix in the disputed domain name, as a standard registration requirement, should be disregarded under the confusing similarity test (section 1.11 of [WIPO Overview 3.0](#))

Therefore, the Panel finds that the disputed domain name is identical to the Complainant’s LEROY MERLIN trademarks under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a number of circumstances which, without limitation, may be effective for the Respondent to demonstrate that it has the rights to, or legitimate interests in, the disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy. Those circumstances are:

“(i) Before any notice to [the respondent] of the dispute, [use by the respondent] of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

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

(iii) [Where 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.”

As noted by the previous UDRP panels on the onus of proof under paragraph 4(a)(ii) of the Policy, and as summarized in section 2.1 of the [WIPO Overview 3.0](#): “[...] While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

In the present case, the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, with the Respondent failing to provide any substantive response to the Complaint which would prove his rights or legitimate interests in the disputed domain name.

Namely, the Complainant has established that it is the holder of a number of the LEROY MERLIN trademarks in various jurisdictions, as well as that it has used the same trademarks widely on the market. The Complainant filed sufficient evidence proving extensive and long lasting use of its LEROY MERLIN trademarks and their well-known character.

The Panel observes that there is neither any relation, disclosed to the Panel, nor otherwise apparent from the records, between the Respondent and the Complainant, nor does it arise that the Complainant has ever licensed or otherwise permitted the Respondent to use its LEROY MERLIN trademarks or to apply for or use any domain name incorporating the same trademarks.

Furthermore, there is no evidence that the Respondent has been commonly known by the disputed domain name. Also, there is no evidence in the case file or otherwise apparent to the Panel that the Respondent has been using the disputed domain name in connection with a *bona fide* offering of goods or services or making a legitimate noncommercial or fair use of the disputed domain name.

The Respondent has failed to provide any substantive reply to the Complaint and accordingly failed to rebut the Complainant’s *prima facie* showing that the Respondent has no rights or legitimate interests in the

disputed domain name.

As that there is no evidence that the Respondent is in any way permitted by the Complainant to use the LEROY MERLIN trademarks, nor is there any evidence that the Respondent has made any *bona fide*, fair or otherwise legitimate use of the disputed domain name, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name which includes the Complainant's LEROY MERLIN trademarks.

In addition, the Panel finds that domain name being identical to the Complainant's trademark carry a high risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Panel finds that the requirements set forth in paragraph 4(a)(ii) of the Policy have been fulfilled by the Complainant's making the *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and by the Respondent's failing to produce any arguments or evidence to the contrary.

C. Registered and Used in Bad Faith

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular, but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

“(i) circumstances indicating that the holder has registered or has 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 the holder's documented out-of-pocket costs directly related to the domain name; or

(ii) the holder has 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 holder has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's 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 holder's website or location or of a product or service on the holder's website or location.”

The Panel accepts that the Complainant's arguments have been substantiated on the basis that the Respondent has registered and used the disputed domain name in bad faith. The Complainant has filed sufficient evidence to prove that its LEROY MERLIN trademarks are well known and distinctive, and that the Complainant has a worldwide reputation. The Respondent, on the other hand did not prove his rights and/or legitimate interests in a disputed domain name, nor he presented a credible evidence for registering and using the disputed domain name.

In its informal email communication lacking any substantial response to the Complaint, the Respondent just stated that he was unaware of the existence of the Complainant. In this regards, the Panel accepts the Complainant's arguments that the terms “Leroy” and “Merlin” have no meaning, do not correspond to dictionary terms, represent the last name of the founders of the company Leroy Merlin, and are highly distinctive. Based on evidence filed with the Complaint proving the existence and use of the Complainant's trademarks and domain names worldwide, as well as the Complainant's market presence, the Panel finds it highly unlikely that the Respondent was unaware of the Complainant and its LEROY MERLIN trademarks when registering the disputed domain name.

Further, previous UDRP panels have found that the incorporation of a well-known trademark in a domain name having no plausible explanation for doing so is in itself an indication of bad faith (see *Intel Corporation v. The Pentium Group*, WIPO Case No. [D2009-0273](#)). In its informal email communication lacking any substantiated content, the Respondent stated that he registered the disputed domain name for fun. In this Panel's view, such the Respondent's explanation could not be accepted as plausible explanation which would exclude the indication of bad faith.

Furthermore, in its informal email communication, the Respondent stated that he never utilized the disputed domain name. The Complainant filed evidence that the disputed domain name is being passively held, it directs to an inactive website.

Prior UDRP panels have frequently found that the apparent lack of so-called active use of the domain name (passive holding) does not prevent a finding of bad faith under certain circumstances (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)). In the present case, having in mind:

- the distinctiveness and reputation of the Complainant's LEROY MERLIN trademarks,
 - the Respondent's registration of a domain name confusingly similar to the Complainant's LEROY MERLIN trademarks,
 - the absence of any documented rights or legitimate interests of the Respondent in the disputed domain name,
 - the implausibility of any good faith use to which the disputed domain name may be put,
- this Panel finds that the passive holding of the disputed domain name by the Respondent does not prevent a finding of bad faith registration and use.

Given the above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith.

The Panel concludes that the disputed domain name has been registered and is being used in bad faith, and that the Complainant has fulfilled the third element under 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.xyz> be transferred to the Complainant.

/Mladen Vukmir/

Mladen Vukmir

Sole Panelist

Date: November 24, 2022