

ADMINISTRATIVE PANEL DECISION

Alimentation Couche-Tard inc., Circle K Stores Inc, and Circle K Procurement and Brands Limited v. Dave Greason, couche-tard inc, and Jessica Ramos
Case No. D2022-4645

1. The Parties

The Complainants are Alimentation Couche-Tard inc., Canada, Circle K Stores Inc, United States of America, and Circle K Procurement and Brands Limited, Ireland, represented by St. Lawrence Law Firm LLP, Canada (the “Complainant”).

The Respondents are Dave Greason, couche-tard inc, United States of America, and Jessica Ramos, United States of America (the “Respondent”).

2. The Domain Names and Registrars

The disputed domain names <couche-tardinc.com> and <couchetardinc.com> are registered with Name.com, Inc. and Tucows Inc., respectively (the “Registrars”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 1, 2022. On December 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 5 and December 6, 2022, the Registrars transmitted by email respectively to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 10, 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 December 15, 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 December 20, 2022. In accordance with the Rules,

paragraph 5, the due date for Response was January 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 11, 2023.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on January 17, 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 operates thousands of convenience stores across the world under several brands, including COUCHE-TARD which it has used extensively since 1980.

The Complainant is the owner of the following registrations for COUCHE-TARD in Canada, United Kingdom, and the European Union:

Mark	Status	App. No. / Reg. No.	App. Date / Reg. Date	Classes of Goods and Services
Canada				
COUCHE-TARD	Registered	TMA323,571	February 13, 1987	35
COUCHE-TARD MENU (& DESIGN) 	Registered	TMA848,301	April 11, 2013	35
European Union				
COUCHE-TARD	Registered	18024626	September 10, 2019	35, 43
United Kingdom				
COUCHE-TARD	Registered	UK00918024626	September 10, 2019	35, 43

The <couche-tardinc.com> domain name was registered on August 12, 2022, and the <couchetardinc.com> domain name was registered on October 6, 2022 (the "disputed domain names").

The Complainant's COUCHE-TARD Marks were used by the Respondent to impersonate the Complainant's employees to order goods from third-party suppliers and then not paying for the goods ordered.

5. Parties' Contentions

A. Complainant

The disputed domain names are confusingly similar to the Complainant's registered COUCHE-TARD because they simply add the suffix "inc" to the COUCHE-TARD mark (from "couche-tard" to "couche-tardinc" and from "couchetard" to "couchetardinc").

It is clear that the disputed domain names were carefully chosen by the Respondent to impersonate the Complainant and its employees, considering that the disputed domain names are virtually identical to the COUCHE-TARD Marks and trade name, with the addition of a generic term generally associated with corporations "inc".

The Respondent has no rights or legitimate interests in respect of the disputed domain names, as the Respondent did not use either disputed domain name to make a *bona fide* offering of goods or services. The websites displayed on both of the disputed domain names are made to look like a copy of the Complainant's website.

The Complainant has not granted the Respondent any license, consent, or authorization, whether express or implied, permitting the Respondent to use the COUCHE-TARD Marks in any domain name or otherwise, nor have the Complainant ever acquiesced in any way to the use of the COUCHE-TARD Marks in the disputed domain names.

The Respondent also appears to not be known by the disputed domain names as it was not exploiting websites to offer goods or services of any kind; rather the Respondent is using the confusing similarity between the COUCHE-TARD Marks and the disputed domain names to impersonate the Complainant and its employees. This fraudulent impersonation of the Complainant is further aided by the Respondent having concealed its actual name through a privacy service, an additional factor to be taken into account in determining the Respondent's bad faith registration and use of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

6.1 Procedural Issues:

A. Consolidation

The Complaint has been filed against two Respondents. Although the Respondents have different names, the Respondents have provided identical physical addresses, phone numbers, and email addresses. Moreover, the disputed domain names have been used in a common scheme to impersonate the Complainant via email and copycat websites. This illustrates that the disputed domain names are under common control and the consolidation of the Respondents is fair and equitable to all Parties (see section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions Third Edition ("[WIPO Overview 3.0](#)")).

Therefore, the Panel finds that it is appropriate for the Complaint to be brought against the two Respondents. See *Mountain Top (Denmark) ApS v. Contact Privacy Inc. Customer 0133416460 / Name Redacted, Mountaintop Idea Studio*, WIPO Case No. [D2020-1577](#).

For the sake of completeness, the Panel notes that the Complaint has been filed by three Complainants, wherein the Complainant Alimentation Couche-Tard is the owner of the Complainant Circle K Stores, to

which the Complainant Circle K Procurement and Brands Limited is a subsidiary. Since the Complainants are related entities and commonly affected by the Respondent's conduct, consolidation of the multiple Complainants is appropriate.

6.2 Substantive Issues:

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in the COUCHE-TARD mark globally. The COUCHE-TARD mark is clearly recognizable in the disputed domain names, and the addition of the term "inc" does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8.

Accordingly, the disputed domain names are confusingly similar to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain names and has not been commonly known by the disputed domain names. The fact that the Respondent obtained the disputed domain names decades after the Complainant had begun using its unique COUCHE-TARD mark indicates the Respondent sought to piggyback on the mark for illegitimate reasons, namely to trick vendors into sending the Respondent goods under the assumption that the vendor is communicating with the Complainant. Further, the nature of the disputed domain names carries a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1. Such a risk seems to have been the intent of the Respondent, seeing as one of the disputed domain names was used for purposes of a fraudulent email scheme whereby the Respondent impersonated the Complainant, as mentioned above. Such illegal use can never confer rights or legitimate interests upon a respondent. [WIPO Overview 3.0](#), section 2.13.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain names.

In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain names, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The disputed domain names were registered many years after the Complainant first registered and used its unique COUCHE-TARD mark. The evidence on the record provided by the Complainant with respect to the extent of use and fame of the COUCHE-TARD mark, combined with the absence of any evidence provided by the Respondent to the contrary, is sufficient to satisfy the Panel that, at the time the disputed domain name was registered, the Respondent undoubtedly knew of the Complainant's COUCHE-TARD mark, and knew that it had no rights or legitimate interests in the disputed domain names.

There is *prima facie* no reason for the Respondent to have registered the disputed domain names containing the entirety of the COUCHE-TARD mark with the term "inc" other than to target and unfairly benefit from the reputation and goodwill associated with the Complainant's mark. As further described below, the bad faith use of the disputed domain names further reinforces the Panel's finding that the Respondent was aware of, and intentionally targeted, the Complainant when registering the disputed domain names.

Further, the use of the disputed domain names by the Respondent is clearly in bad faith. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent'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 respondent's website or location or of a product or service on the respondent's website or location. The Complainant has submitted evidence that the Respondent has used the disputed domain names in order to direct users to a website which mirrors the Complainant's website. This was done in order to allow the Respondent to send emails to the Complainant's vendors by tricking them into thinking the emails from the Respondent reflect a new domain name owned by the Complainant resulting in the vendor sending goods to the Respondent in expectation of payment none of which would be forthcoming.

This is a textbook example of bad faith use on the part of the Respondent.

In the absence of any evidence or explanation from the Respondent, the Panel finds that the only plausible basis for registering and using the disputed domain names has been for illegitimate and bad faith purposes.

Accordingly, the Panel finds that 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 names, <couche-tardinc.com> and <couchetardinc.com>, be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: January 31, 2023