

ADMINISTRATIVE PANEL DECISION

Association des Centres Distributeurs E. Leclerc – ACD Lec v. Uczciwosc
Jest Zlotem

Case No. D2024-1609

1. The Parties

The Complainant is Association des Centres Distributeurs E. Leclerc – ACD Lec, France, represented by MIIP MADE IN IP, France.

The Respondent is Uczciwosc Jest Zlotem, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <eleclerc-france.com> is registered with Center of Ukrainian Internet Names (UKRNames) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on April 17, 2024. On April 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 19, 2024, the Registrar transmitted by email to the Center its verification response, confirming that the Respondent is listed as the registrant and its contact details.

On April 25, 2024, the Center informed the parties in Ukrainian and English, that the language of the registration agreement for the disputed domain name is Ukrainian. On April 25, 2024, the Respondent requested “official translation in Ukrainian.” On April 26, 2024, the Complainant confirmed its request that English be the language of the proceeding.

The Center verified that 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 in Ukrainian and English of the Complaint, and the proceedings commenced on May 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2024. The Respondent did not submit any formal response. On May 29, 2024, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Taras Kyslyy as the sole panelist in this matter on June 6, 2024. 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. Further Procedural Considerations

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Since the Respondent's mailing address is stated to be in Ukraine (whether this is indeed accurate is not clear), which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should. The Panel has reached this conclusion in part because the Panel does not believe the Respondent's purported mailing address in Ukraine to be genuine. The Panel notes in particular that that address refers to the building of major shopping mall and business center in Kyiv city where hundreds or even thousands of companies are located, at the same time the address lacks any relevant details like office and/or floor number to actually locate the Respondent. This is corroborated by the fact that the courier used for delivering the Center's written communication was also unable to locate the address. The Ukrainian phone number provided by the Respondent for the registration data does not exist. The Panel also notes previous intensive email exchanges between the Complainant and the Respondent in the English language, which may further support an inference that the Respondent is not located in Ukraine, as well as its name in the Polish language suggesting the same. The Panel notes that the Center did, however, successfully send all the procedural communications to the Respondent's email as registered with the Registrar and there is no evidence that these were not successfully delivered. On the contrary the Respondent responded to the language of the proceeding communication once sent to its email.

It is moreover noted that, for the reasons which are set out later in this Decision, the Panel has no serious doubt (albeit in the absence of any substantive Response) that the Respondent registered and has used the disputed domain name in bad faith and with the intention to disrupt business of the Complainant.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to a Decision accordingly.

5. Factual Background

The Complainant is a French company. "Leclerc" refers to the last name of the founder and promoter of the association – Mr. Edouard Leclerc. The Complainant runs a chain of 735 supermarkets and hypermarkets in France. The Complainant also has about 100 stores in Poland, Spain, Portugal and Slovenia. The Complainant hold more than 23% of the grocery market share in July 2023 in France. In 2022, the turnover of the Complainant was EUR 55.6 billion in France, and the Complainant employs approximately 140,000 people.

The Complainant owns several E LECLERC trademarks and notably the European Union trademark registration No. 002700664, registered on January 31, 2005.

The Complainant has its official website at "www.e.leclerc".

The disputed domain name was registered on February 11, 2024 and does not resolve to any active website. MX servers were initially set up on the disputed domain name and then deactivated.

On March 28, 2024, the Complainant sent to the Respondent a cease and desist letter in English. The Respondent commented back on the same day also in English, inter alia referring to some previous correspondence with the Complainant. The Complainant had intensive email exchange with the Respondent in English in the period between February 9 and March 19, 2024 concerning other domain names registered by the Respondent and featuring the Complainant's trademark.

6. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark. The disputed domain name identically reproduces the Complainant's trademark with the mere addition of the geographical term "france". The association of the Complainant's well-known trademark with the term "France" increases the likelihood of confusion since: (i) the head office of the Complainant is in France; (ii) the Complainant's E. LECLERC chain of supermarkets and hypermarkets is mainly implemented in France (more than 730 stores in France as indicated above); (iii) the Complainant's E. LECLERC trademarks and chain of stores benefits from a great reputation in France. The denomination "E LECLERC" has no meaning in French, English or Ukrainian and is highly distinctive. The Internet users and especially the Complainant's customers could believe that the disputed domain name is operated by or at least linked to the Complainant. The element ".com" is not integrated directly into the disputed domain name but only constitutes the Top-Level Domain ("TLD").

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. The content of the website associated with the disputed domain name neither the Whois database details do not indicate that the name of the Respondent is composed of the terms "E LECLERC" or that the Respondent is commonly known under the name "E LECLERC"; the disputed domain name is linked to an official registered company named "E LECLERC"; the Respondent has rights, including trademark rights, on the name "E LECLERC". The Complainant has not authorized, licensed, or permitted the Respondent to use any of its trademarks or to apply for or use any domain name incorporating the Complainant's trademark. Moreover, there is no business relationship existing between the Complainant and the Respondent. The disputed domain name is neither used in connection with a bona fide offering of goods or/and services nor constitutes a legitimate noncommercial fair use: the disputed domain name was initially pointing to a page under construction and then to an error page. The Respondent is involved in the prior registration of domain names reproducing the company names of entities belonging to the Complainant's organization which are used for fraudulent purposes. Most of these domain names resolve or resolved to pages impersonating these companies which belong to the Complainant's organization and masquerading as the official websites of these entities (company name, head offices address, activity description etc.) and were therefore used for fraudulent purposes. The Respondent is engaged in a fraudulent pattern with the aim of monetizing domain name registrations. In its communication with the Complainant the Respondent stated they registered other domain names reproducing company names of entities belonging to the Complainant's organization and the Respondent requested money in exchange for the transfer of these domain names. The Respondent never proved any legitimate interest in the registration of domain names reproducing trademarks or company names from entities belonging to the Complainant's organization. The Complainant's representative found numerous inconsistencies regarding the Respondent's activity and replies. The Respondent threatened and blackmailed the Complainant's organization.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. It is unlikely that the Respondent was unaware of the Complainant's activities and of the existence and use of the Complainant's trademark at the time the registration of the disputed domain name was made. The Complainant's "E LECLERC" supermarket / hypermarket network is well known in France and in several other European countries. The registration of the disputed domain name cannot be a coincidence. The

mere fact that the Respondent registered the disputed domain name, reproducing in the identical way the Complainant's trademark, is in and of itself evidence of bad faith registration. In any case, the registration of the disputed domain name cannot be a coincidence, since the disputed domain name incorporates in the identical way, as its essential distinguishing feature, the element "E LECLERC" which is the famous personal name of the founder of the Complainant's organization, Mr. Edouard Leclerc. Also, the Complainant's trademark has no meaning in French nor English and is not a dictionary or common term. There is no reasonable explanation for choosing this disputed domain name. The Respondent is clearly targeting the Complainant's trademark even stated by email that they are registering domain name reproducing trademarks or company names of entities belonging to the Complainant's organization. There is no legitimate or fair use of the disputed domain name. The disputed domain name initially pointed to a page under construction and then pointed to an error page. Such use is devoid of any real and substantial offer of goods or services and cannot be considered a legitimate non-commercial or fair use. Moreover, MX servers were initially set up on the disputed domain name, thus the Respondent could use it for phishing purposes by sending fraudulent emails. The Complainant's sent a cease and desist letter to the Respondent to which the Respondent replied with a threat. The disputed domain name disrupts the Complainant's business and cause harm to the Complainant's brand image, particularly regarding the page that has been set up on it prior to the filing of the Complaint. Since the disputed domain name incorporates in the identical way the Complainant's trademark, the Internet users and especially the Complainant's customers may wrongly believe that the website to which it resolves is the Complainant's site or that the Complainant's website is not correctly functioning or has been hacked.

B. Respondent

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

7. Discussion and Findings

A. Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Ukrainian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement. It is subject to the authority of the panel to determine otherwise.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that (i) the Respondent has the ability to understand English and to communicate in English as evidenced by the previous intensive communications with the Respondent, (ii) the Complainant is unable to communicate in Ukrainian and the translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter; (iii) the disputed domain name is registered with the TLD ".com" which is in Roman characters, rather than Ukrainian letters; (iv) English is the most widely used language in international relations; (v) the Complainant being based in France and the Respondent being based in Ukraine, English is the fairest neutral language for the proceedings.

In response to the Center's language of the proceedings communication the Respondent commented in Ukrainian inter alia literally stating that it "would like to get official translation in Ukraine". The Panel notes that errors made by the Respondent in its comment confirm its poor ability to understand and use Ukrainian language, in opposite to the Respondent's proficiency in English as demonstrated through its intensive correspondence with the Complainant.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

B. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, a dash and "france", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards gTLD ".com" for the purposes of the confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the first element of the Policy has been established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The available evidence does not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated bona fide or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)). In this regard, the Panel notes that the composition of the disputed domain name itself carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

The Respondent has no right or legitimate interests in the disputed domain name resolving to an inactive website (see, e.g., *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#)).

The Panel finds the second element of the Policy has been established.

D. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the disputed domain name incorporating the Complainant's trademark while already being in communication with the Respondent regarding other Respondent's domain names registrations featuring Complainant's other marks. The Panel finds that the nature of the disputed domain name and circumstances preceding its registration confirm the Respondent knew or should have known of the Complainant's prior trademark rights, which confirms the bad faith. [WIPO Overview 3.0](#), section 3.2.2.

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. The Panel is convinced that the Complainant's trademark is well established through long and widespread use and the Complainant has acquired a significant reputation and level of goodwill in its trademark both in France and internationally. Thus, the Panel finds that the disputed domain name confusingly similar to the Complainant's trademark was registered in bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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 high degree of distinctiveness and reputation of the Complainant's trademark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the implausibility of any good faith use to which the disputed domain name may be put. Having reviewed the available record, the Panel notes the distinctiveness or high reputation of the Complainant's trademark, and the composition of the disputed domain name consisting of the Complainant's trademark and the name of the country where the Complainant's business is most widely known, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

8. 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 <eleclerc-france.com> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: June 11, 2024