

ADMINISTRATIVE PANEL DECISION

Carrefour SA v. Juan Saez and Diego Juarez
Case No. D2024-3108

1. The Parties

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

The Respondents are Juan Saez and Diego Juarez, Spain, ("Respondent").

2. The Domain Names and Registrars

The disputed domain names <carrefour-express.top> and <carrefourmarket.fun> are registered with Hostinger Operations, UAB (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 30, 2024. On July 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 31, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 12, 2024, 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 August 14, 2024.

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 August 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 9, 2024.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on September 16, 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. Factual Background

The Complainant is a French company mainly active in the retail sector. It was founded in 1968 and has more than 12,000 retail locations, including supermarkets, in more than 30 countries worldwide, including Spain.

The Complainant is the owner of registered trademarks in the marks CARREFOUR, CARREFOUR EXPRESS and CARREFOUR MARKET, amongst which:

International Trademark No. 351147 for CARREFOUR, registered on October 2, 1968, in International Classes 01 to 34;

International Trademark No. 353849 for CARREFOUR, registered on February 28, 1969, in International Classes 35 to 42;

European Union Trademark No. 5405832 for CARREFOUR EXPRESS (figurative), registered on October 18, 2007 in International Classes 29, 30, 31, 32, 33, and 35; and

International Trademark No. 1034794 for CARREFOUR MARKET (figurative), registered on December 23, 2009, in International Class 35.

In addition, the Complainant owns domain names containing the CARREFOUR and CARREFOUR MARKET trademarks, amongst which <carrefour.com>, <carrefour.fr>, and <carrefourmarket.fr>.

The disputed domain names were registered on 14 and 17 July 2024, well after the Complainant secured rights in the marks. Neither of the disputed domain names are currently active.

5. 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 names.

With respect to the first element, the Complainant contends that it has rights in the marks CARREFOUR, CARREFOUR EXPRESS and CARREFOUR MARKET and that the disputed domain names are identical or confusingly similar to these marks. Both disputed domain names reproduce the well-known CARREFOUR mark in its entirety. Moreover, the Respondent merely appends the descriptive terms "express" and "market" to the Complainant's CARREFOUR trademark, which does nothing to diminish the likelihood of confusion. In addition, the Complainant notes, the disputed domain name <carrefour-express.top> is identical to and reproduces the CARREFOUR EXPRESS mark in its entirety and the disputed domain name <carrefourmarket.fun> is identical to and reproduces the CARREFOUR MARKET mark in its entirety.

Finally, the Complainant claims that the generic Top-Level Domains ("gTLD") ".top" and ".fun", featured in the disputed domain names, are not significant in determining whether the domain names are identical or confusingly similar to the trademarks of the Complainant.

Regarding the second element, the Complainant claims that the Respondent lacks rights or legitimate interests in the disputed domain names. The Complainant contends that the Respondent does not own any trademark rights in CARREFOUR or similar marks and is not commonly known by the disputed domain names. Furthermore, the Complainant confirms that the Respondent has not been granted any license or authorization from the Complainant to use domain names featuring its trademarks. Moreover, the Complainant contends that the Respondent is not using the disputed domain names in connection with a bona fide offering of services or is making preparations for such use. On the contrary, the Complainant mentions that the disputed domain names are not in use and the Registrar has set the status of both disputed domain names to “clientHold”, meaning that the disputed domain names have not been activated in the DNS.

As to bad faith registration, the Complainant contends that its trademarks were so widely well-known, that it is inconceivable that the Respondent had the Complainant’s name and trademarks in mind when registering the domain names. Furthermore, the Complainant submits that it is highly likely that the Respondent chose the disputed domain names because of their identity with or similarity to the Complainant’s trademarks in the hope and expectation that Internet users searching for the Complainant’s services and products would instead come across the Respondent’s domains. Such use cannot be considered a good faith use. Moreover, the Complainant notes that its trademark registrations significantly predate the registration dates of the disputed domain names and that a simple Google search would have revealed the Complainant and their trademarks. In addition, the Complainant points out that the current use of the disputed domain names may not be considered a good faith use. By simply maintaining the disputed domain names, the Respondent is preventing the Complainant from reflecting its trademarks in the corresponding domain names. Finally, the Complainant contends that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. Given the international reputation of the Complainant and its trademarks, the Complainant points out that it cannot think of any future use of the disputed domain names that may be done by the Respondent in good faith.

B. Respondent

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

6. Discussion and Findings

A. Preliminary Issue: Consolidation - Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant’s request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant’s request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.11.2.

As regards common control, the Complainant has convincingly demonstrated that: (i) the two disputed domain names have similar naming patterns (“carrefour” + “express” or “market”); (ii) the registrants have similar contact information since both use contact addresses in Valencia, Spain; (iii) the disputed domain names were created only three days apart and were registered with the same registrar (Hostinger); and (iv)

the registrant email addresses are both Google Mail addresses and these addresses also share a similar naming pattern (person name + numbers + letters). The Panel believes that these circumstances, in combination with the absence of a response from the disputed domain name registrants, sufficiently indicate that the disputed domain names are under common control. With respect to fairness and equity, since the disputed domain name registrants have not responded to this Complaint and splitting the Complaint would not be beneficial to procedural efficiency, the Panel finds that consolidation of the Complaint would be fair and equitable to all parties concerned and grants the Complainant's request.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of the trademarks CARREFOUR, CARREFOUR EXPRESS and CARREFOUR MARKET for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The CARREFOUR EXPRESS and CARREFOUR MARKET trademarks that the Complainant relies on are figurative, however these can also be taken into account to show "rights in a mark" since the dominant portion of these trademark are the words "Carrefour Express" and "Carrefour Market" respectively. It is a consensus view of UDRP panels, with which the Panel agrees, that trademark registrations with design elements can prima facie satisfy the requirement that a complainant shows "rights in a mark" so long as the textual elements are not overtaken. [WIPO Overview 3.0](#), section 1.10.

The entirety of the CARREFOUR mark is reproduced within the disputed domain names. In addition, the disputed domain name <carrefour-express.top> reproduces the word elements of the CARREFOUR EXPRESS mark in their entirety and the disputed domain name <carrefourmarket.fun> reproduces the word elements of the CARREFOUR MARKET mark in their entirety. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms to the CARREFOUR mark, here respectively "express" and "market" , 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 names and the CARREFOUR mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Finally, as for the applicable gTLDs ".top" and ".fun", the Panel holds that these can be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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 names. 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 names such as those enumerated in the Policy or otherwise.

The Panel finds that the Respondent did not use the disputed domain names in connection with a bona fide offering of services and has neither made a legitimate noncommercial or fair use of the disputed domain names. Both of the disputed domain names are currently not being used. Moreover, the Complainant claims to have found no evidence that the Respondent has been commonly known by the disputed domain names prior to or after the registration of the disputed domain names or that the Respondent owns any trademarks or other rights in CARREFOUR or similar marks. The Panel notes that the Respondent failed to respond to the Complaint and the evidence on record therefore does not contain any evidence of the same either. In addition, the Complainant confirmed that the Respondent is not affiliated with the Complainant in any way nor has the Complainant licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant's trademarks. The Panel has taken note of the Complainant's confirmation in this regard and has not seen any evidence that would suggest the contrary. Noting the composition of the disputed domain names, in the absence of any license or permission from the Complainant to use its trademarks, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

Based on the available record, 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.

As the Panel found above under the first element, the disputed domain names are confusingly similar to these marks, registration of the disputed domain names has clearly been done to attract Internet users by creating a likelihood of confusion with the Complainant's CARREFOUR, CARREFOUR EXPRESS and CARREFOUR MARKET trademarks (paragraph 4(b)(iv) of the Policy).

Furthermore, it should be noted that paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may also be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

First of all, the Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain names included the Complainant's CARREFOUR, CARREFOUR EXPRESS and CARREFOUR MARKET trademarks. As demonstrated by the Complainant, prior Panels have previously recognised that the CARREFOUR trademark is well-known (see, for example: *Carrefour v. Contact Privacy Inc. Customer 0155401638 / Binya Rteam*, WIPO Case No. [D2019-2895](#); and *Carrefour v. Perfect Privacy, LLC / Milen Radumilo*, WIPO Case No. [D2019-2610](#)). Other prior Panels have consistently found that 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 (see [WIPO Overview 3.0](#), Section 3.1.4). Moreover, the Complainant's evidence shows that the CARREFOUR, CARREFOUR MARKET and CARREFOUR EXPRESS trademarks were registered many years before registration of the disputed domain names in several countries. The Respondent's knowledge of the Complainant and its trademarks and therefore its registration in bad faith of the disputed domain names may accordingly also be inferred from these circumstances. [WIPO Overview 3.0](#), section 3.2.2.

Second, 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 names 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 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, and (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. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's CARREFOUR trademark as well as the composition of the disputed domain names. Finally, the Panel notes the Respondent's use of a proxy service to conceal its identity in the Whois data. In light of these circumstances, the Panel finds that 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.

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 <carrefour-express.top> and <carrefourmarket.fun> be transferred to the Complainant.

/Benoit Van Asbroeck/

Benoit Van Asbroeck

Sole Panelist

Date: September 30, 2024