

## **ADMINISTRATIVE PANEL DECISION**

Carrefour SA v. Wataru Kaneko

Case No. D2023-0357

### **1. The Parties**

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

The Respondent is Wataru Kaneko, Japan.

### **2. The Domain Name and Registrar**

The disputed domain name <carrefourmarcklimepass.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on January 26, 2023. On January 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 27, 2023, 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 (Whois Privacy Protection Service by VALUE-DOMAIN) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 27, 2023, 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 in English on January 27, 2023.

On January 27, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On January 27, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent in English and Japanese of the Complaint, and the proceedings commenced on February 2, 2023. In accordance with

paragraph 5 of the Rules, the due date for Response was February 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 23, 2023.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on March 1, 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 paragraph 7 of the Rules.

#### **4. Factual Background**

The Complainant is a French hypermarket retail company back in 1968. With a turnaround of EUR 76 billion in 2018, the Complainant is listed on the index of the Paris Stock Exchange (CAC 40). The Complainant operates more than 12,000 stores in more than 30 countries worldwide. With more than 384,000 employees worldwide and 1.3 million daily unique visitors in its stores, the Complainant is a major and well-known worldwide leader in retail.

The Complainant owns worldwide several hundred trademarks in the CARREFOUR term ("CARREFOUR Trademarks"). In particular, the Complainant is the owner of the International trademark CARREFOUR No. 351147, registered on October 2, 1968, the International trademark CARREFOUR No. 353849, registered on February 28, 1969, and the International trademark CARREFOUR PASS No. 719166, registered on August 18, 1999, all of which were registered well before the registration of the disputed domain name.

In addition, the Complainant is also the owner of numerous domain names identical to its CARREFOUR Trademarks, both within generic and country code Top-Level Domains ("TLD"). For instance, <carrefour.com> was registered on October 25, 1995.

The disputed domain name was registered on December 15, 2022 and resolves to an inactive website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant's contentions may be summarized as follows:

The disputed domain name includes the CARREFOUR Trademarks, together with the generic terms "marck lime", and is highly similar to the earlier well-known CARREFOUR Trademarks.

The Respondent has acquired no trademark in the names CARREFOUR or CARREFOUR PASS which could have granted the Respondent rights in the disputed domain name. Furthermore, the Respondent is not commonly known by the disputed domain name. The Respondent reproduces the Complainant's CARREFOUR Trademarks in the disputed domain name without any license or authorization from the Complainant. The Respondent has not, before the original filing of the Complaint, used or made preparations to use the disputed domain name in relation to a *bona fide* offering of goods or services. On the contrary, the disputed domain name resolves to a page stating that the hosting account has been suspended. Since the adoption and extensive use by the Complainant of the CARREFOUR Trademarks predates the registration of the disputed domain name, the burden is on the Respondent to establish the rights or legitimate interests the Respondent may have or have had in the disputed domain name.

The Complainant and its CARREFOUR Trademarks were so widely well-known, that it is inconceivable that the Respondent ignored the Complainant or its earlier rights on the terms CARREFOUR or CARREFOUR PASS. The Respondent had the Complainant's name and CARREFOUR Trademarks in mind when registering the disputed domain name. The Respondent's choice of the disputed domain name cannot have been accidental and must have been influenced by the fame of the Complainant and its CARREFOUR

Trademarks. The Respondent knew or should have known that, when acquiring and using the disputed domain name, they would do so in violation of the Complainant's earlier rights. It is highly likely that the Respondent chose the disputed domain name in the hope and expectation that Internet users searching for the Complainant's services and products would instead come across the Respondent's site. The Respondent acquired and is using the disputed domain name to attract Internet users by creating a likelihood of confusion with the Complainant's CARREFOUR Trademarks. By maintaining the disputed domain name, the Respondent is preventing the Complainant from reflecting its CARREFOUR Trademarks in the corresponding domain name. Moreover, the current use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Issue: Language of the Proceeding**

Pursuant to paragraph 11(a) of the Rules, in the absence of an agreement between the Parties, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the Registration Agreement for the disputed domain name is Japanese.

However, the Complainant requests that the proceeding be held in the English language with the reasons that the Complainant is not able to communicate in Japanese and not in a position to conduct this proceeding in Japanese without a great deal of additional expense and delay due to the need for translation of the Complaint.

Although the Respondent does not expressly agree with the Complainant on the language of the proceeding, the Respondent did not submit any objection to the Complainant's request that the proceeding be held in the English language when the Center had sent a notification regarding the language of the proceeding to the Parties by email both in English and Japanese. Considering that the Respondent was able to understand how to submit an objection to the Complainant's request by reading the Center's email notification in Japanese and it would be unduly burdensome and cause considerable delay to the proceeding for the Complainant to translate the Complaint into Japanese, the necessity for conducting the proceeding in Japanese will not be so critical to justify the costs of translation and delay.

In view of these circumstances of the administrative proceeding, the Panel decides that English should be the language of the proceeding.

### **6.2 Substantive Elements of the Policy**

In accordance with paragraph 4(a) of the Policy, the Complainant must assert and prove the following three elements are present:

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

The Complainant is the owner of CARREFOUR Trademarks worldwide including in Japan. The disputed domain name includes the terms CARREFOUR and CARREFOUR PASS in the Complainant's CARREFOUR Trademarks in its entirety, combined with the letters "marcklime". The insertion of the letters "marcklime" between "carrefour" and "pass" does not prevent the Complainant's CARREFOUR Trademarks from being recognizable within the disputed domain name (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"); see also *Carrefour v. Contact Privacy Inc. Customer 0155401638 / Binya Rteam*, WIPO Case No. [D2019-2895](#)).

It is generally accepted that the ".com" generic TLD ("gTLD") extension may be disregarded when assessing the confusing similarity between the Complainant's trademark and the disputed domain name because such gTLD extension is viewed as a standard registration requirement (see section 1.11.1 of the [WIPO Overview 3.0](#)).

As a result, the Panel finds that the disputed domain name is confusingly similar to the CARREFOUR Trademarks in which the Complainant has rights under paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

As the Complainant asserts, the Respondent has no trademark registrations in the names CARREFOUR or CARREFOUR PASS which could have granted the Respondent rights in the disputed domain name. The Respondent is neither commonly known by the disputed domain name, nor granted any license or authorization of CARREFOUR Trademarks from the Complainant. The Respondent does not seem to make any preparations to use the disputed domain name in relation to a *bona fide* offering of goods or services.

Since the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, the burden to put forward evidence to show that the Respondent has rights or legitimate interests in the disputed domain name shifts to the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)), but the Respondent failed to submit any response in this proceeding and there is no evidence of the existence of any rights or legitimate interests in favor of the Respondent before the Panel.

Consequently, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraph 4(a)(ii) of the Policy.

## C. Registered and Used in Bad Faith

The Complainant's business and its CARREFOUR Trademarks are internationally famous and acclaimed and also well known in Japan because the Complainant's subsidiary was doing business several years in Japan. The Respondent must have recognized the inclusion of CARREFOUR Trademarks in the disputed domain name at its registration.

The disputed domain name resolved to a page stating that the hosting account has been suspended, and now resolves to a blank page with the text "Apache is functioning normally" in the top left corner (see *Foot Locker Retail, Inc. v. zhangshasha / zhang shasha*, WIPO Case No. [D2016-1541](#)). Thus, the Respondent merely passively hold the disputed domain name. Even though the Respondent is not undertaking a positive action in relation to the disputed domain name, in consideration of (i) the degree of distinctiveness or reputation of the Complainant's CARREFOUR Trademarks, (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 by the Registrar's privacy service, and (iv) the implausibility of any good faith use to which the disputed domain name may be put, the totality of the circumstances in this case leads to the conclusion that the Respondent's passive holding amounts to bad faith (see section 3.3 of the [WIPO Overview 3.0](#)).

In light of all the elements above, the Panel concurs with the Complainant that the disputed domain name has been registered and is being used in bad faith by the Respondent 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 <carrefourmarcklimepass.com> be transferred to the Complainant.

*/Yuji Yamaguchi/*

**Yuji Yamaguchi**

Sole Panelist

Date: March 15, 2023