

DISPUTE RESOLUTION SERVICE

D00021306

Decision of Independent Expert

Carrefour

and

Richard & Co Residence

1. The Parties:

Complainant:

Carrefour
93 Avenue de Paris
Massy
91300
France

Respondent:

Richard & Co Residence
172 High Road Leytonstone
London
E11 3HU
United Kingdom

2. The Domain Name:

carrefour-pass.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

11 April 2019 Dispute received
11 April 2019 Complaint validated
11 April 2019 Notification of complaint sent to parties
3 May 2019 Response reminder sent
8 May 2019 No Response received
8 May 2019 Notification of no response sent to parties
20 May 2019 Summary/full fee reminder sent
22 May 2019 Expert decision payment received

4. Factual Background

The Nominet records show that the Domain Name was registered on 14 November 2018.

Based on the Complainant's submissions (see section 5 below), which are unchallenged by the Respondent, I set out below the main facts which I have accepted as being true in reaching a decision in this case:

- a. The Complainant owns trade mark registrations for CARREFOUR and CARREFOUR PASS.
- b. The Complainant has made extensive use of the CARREFOUR name for many years. The Complainant has thereby established substantial goodwill in the CARREFOUR name, which is well-known, in particular for supermarket retail services.
- c. The Complainant also provides banking and insurance services, including the PASS Mastercard.
- d. The Respondent is not affiliated in any way with the Complainant, nor has it been authorised by the Complainant to use the Domain Name.

5. Parties' Contentions

Complaint

The Complainant's contentions are as follows:

The Complainant has rights in respect of a name and mark which is identical or similar to the Domain Name:

- (1) The Complainant is a global leader in food retail with its headquarters in France. Since it was founded in 1958, Carrefour has acquired considerable goodwill and renown, in France as well as worldwide, in connection with a wide range of services, including supermarkets and banking and insurance services.
- (2) The Complainant operates more than 12,300 stores and e-commerce sites in more than 30 countries, and employs more than 375,000 people worldwide. In 2017, Carrefour generated 88.24 billion euros in sales. Every day, the Complainant welcomes around 104 million customers around the world. It also receives 1.3 million unique visitors per day across all its websites, including www.carrefour.com.
- (3) The Complainant also offers financial and insurance services. As a banking subsidiary of the Carrefour group, Carrefour Banque has been offering a wide range of accessible and efficient products for more than 30 years, adapted to the needs of customers and consumers: PASS MasterCard, current account, revolving credit, personal loan, credit redemption, savings, auto and home insurance, complementary health, etc. The Complainant also digitalizes some of its banking services which can be accessed online by its customers, for instance applications enabling customers to manage their account independently.
- (4) The Complainant owns the trade marks CARREFOUR and CARREFOUR PASS which are well-known trade marks protected worldwide.
- (5) The Complainant is the owner of the following trade mark registrations:
 - EU trade mark CARREFOUR no. 005178371 filed on 20 June 2006 and registered on 30 August 2007;
 - EU trade mark CARREFOUR no. 008779498 filed on 23 December 2009, registered on 13 July 2010;
 - International trademark CARREFOUR PASS no. 719166, registered on 18 August 1999.
- (6) In addition, Complainant operates, among others, the following domain names to promote its services:
 - carrefour.com, registered on 25 October 1995
 - carrefour.fr, registered on 23 June 2005.
- (7) In view of the above CARREFOUR and CARREFOUR PASS registered trade marks, the Complainant has rights in respect of a trade mark that is either identical or confusingly similar to the Domain Name.

- (8) The Domain Name `carrefour-pass.co.uk` reproduces the Complainant's trade marks `CARREFOUR` and `CARREFOUR PASS` in their entirety. This establishes that the Domain Name is identical or similar to the Complainant's trade marks `CARREFOUR` and `CARREFOUR PASS`.
- (9) Moreover, the presence of hyphens does not negate the confusing similarity created by the Respondent's complete inclusion of the Complainant's trade marks in the Domain Name. The Domain Name is likely to confuse Internet users into believing that the Domain Name will direct them to a website dedicated to the Complainant's online services.
- (10) It is well established that the suffix ".co.uk" is not taken into account when evaluating the similarity existing between the Domain Name and the Complainant's trade marks as it is merely a technical set-up of the domain name system (Nominet Case no. D00004867, Grupo Ferrovial S.A. v. Andy Watson).
- (11) By registering the Domain Name, the Respondent has created a likelihood of confusion with the Complainant's trade marks. The Complainant has used the trade marks `CARREFOUR` and `CARREFOUR PASS` in connection with a wide variety of services around the world. Consequently, the public has learnt to perceive the services offered under these marks as being those of the Complainant. Therefore, the public would reasonably assume that the Domain Name is owned by, or affiliated to, the Complainant.
- (12) For all these reasons, the Complainant has rights in respect of a name or mark which is similar or identical to the Domain Name.

The Domain Name, in the hands of the Respondent, is an abusive registration:

- (1) On 20 November 2018, the Domain Name was resolving to an inaccessible page.
- (2) A search carried out by the Complainant revealed that email servers have been configured on the Domain Name. As such, there is a risk of phishing.
- (3) The Domain Name presently resolves to an error page, in other words an inactive page.
- (4) The Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use its trade mark, or to seek registration of any domain name incorporating said trade mark.
- (5) The Respondent cannot claim prior rights or legitimate interest in the Domain Name as the `CARREFOUR` and `CARREFOUR PASS` trade marks precede the registration of the Domain Name by many years.

- (6) The Respondent is not commonly known by the Domain Name or the name CARREFOUR. There is no evidence that the Respondent may be commonly known by the name CARREFOUR.
- (7) The Respondent cannot assert that, before any notice of this dispute, it was using, or had made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services, in accordance with the DRS Policy. As described above, the Domain Name has been resolving to an inaccessible page.
- (8) The Domain Name is so confusingly similar to the CARREFOUR and CARREFOUR PASS trade marks of the Complainant that the Respondent cannot reasonably pretend it was intending to develop a legitimate activity through the Domain Name.
- (9) Considering the reputation of the Complainant's trade marks and its long history, it is implausible that the Respondent was unaware of the Complainant when it registered the Domain Name. The Complainant is well-known throughout the world, including in Europe (where it is established). This is additional proof that the Respondent was aware of the Complainant's existence and activities at the time of the registration of the Domain Name.
- (10) The fact that the Complainant's CARREFOUR and CARREFOUR PASS trade mark registrations significantly predate the registration date of the Domain Name constitutes additional proof that the Respondent was aware of the Complainant's existence and activities at the time of the registration of the Domain Name.
- (11) In this day and age of the Internet and advancement in information technology, the reputation of brands and trade marks transcends national borders. A simple search via Google or any other search engine using the keywords "CARREFOUR" or "CARREFOUR PASS" demonstrate that all the first results relate to the Complainant's products or news.
- (12) In view of these circumstances, it is inconceivable that the Respondent did not have the Complainant's trade marks in mind at the time of registration of the Domain Name. It is most likely that the Respondent acquired the Domain Name based on the attractiveness of the trade marks CARREFOUR and CARREFOUR PASS in order to confuse Internet users into believing that the Domain Name is registered by the Complainant and will direct them to a website relating to the Complainant's services.
- (13) The Domain Name resolves to an inactive page. Nevertheless, this state of inactivity does not mean that the Domain Name is being used in good faith. Indeed, previous Nominet decisions have already concluded that passive holding of a disputed domain name can satisfy the requirements of abusive registration: "*So, when presented with what seems to be an inactive site, potential purchasers will assume that the Complainant's UK website is inactive, or is temporarily out of operation. As a result, such users may indeed, as the Complainant suggests, go to other internet sites operated by the*

Complainant's competitors in order to purchase their goods. Thus, not only does the existence of the disputed domain name have the potential for disrupting the Complainant's business there is no doubt that its continued existence is likely to confuse users into believing that the disputed domain name is connected with the Complainant when it is not" (Case no. D00001781, Amazon.com Inc. v Microplace Ltd. t/a Netknowledge).

(14) Moreover, e-mail servers have been configured on the Domain Name and there is therefore a risk that the Respondent is engaged in a phishing scheme. The use of an email address using the Domain Name presents a significant risk where the Respondent could intend to steal valuable information such as credit card or other financial information from the Complainant's clients. Indeed, if the Respondent sends emails via the Domain Name, the public is likely to make an assumption, based on the Domain Name's similarity to the Complainant's trade marks CARREFOUR and CARREFOUR PASS, that the Domain Name is associated with the Complainant. Such use of the Domain Name for phishing purposes would cause unfair detriment.

(15) Given the nature of the Domain name, which is confusingly similar to the Complainant's trade marks, it is not possible to conceive a plausible circumstance in which the Respondent could legitimately use the Domain Name, as it would invariably result in misleading diversion and taking unfair advantage of the Complainant's rights.

Response

The Respondent has not filed a Response.

6. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

In light of the factual findings set out in section 4 above, it is clear that the Complainant has Rights in the names and marks CARREFOUR and CARREFOUR PASS. These rights comprise the Complainant's trade mark registrations, together

with goodwill arising from its use of the names CARREFOUR and CARREFOUR PASS, such goodwill also being a legally protectable right.

Disregarding the generic .co.uk suffix, the Domain Name is identical to the CARREFOUR PASS name and mark in which the Complainant has Rights, and similar to the CARREFOUR name and mark.

I therefore find that paragraph 2.1.1 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the Policy defines an "Abusive Registration" as:

"A Domain Name which either:

- i was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The relevant factor under paragraph 5 on which the Complainant relies is as follows:

"5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant"

By way of preliminary comment, although the Respondent has not filed a Response, it is still necessary for the Complainant to prove its case. It is nevertheless relevant that the Respondent has not sought to provide any explanation for why it chose to register the Domain Name.

There is no doubt that CARREFOUR is a famous trade mark, which is very well-known, especially in Europe. Accordingly it is not credible that the Respondent could have chosen the Domain Name without being aware of the CARREFOUR name. The Respondent must have been aware of it. This conclusion is further reinforced by the Respondent adding "PASS" to the end of the Domain Name, a term which is also associated with the Complainant because of its PASS Mastercard.

When a distinctive brand name is completely reproduced in a domain name, with the only addition being a term which is also associated with it, the normal presumption is that there is no bona fide reason for the registration of that domain name. I find that this presumption applies in this case.

As already noted, the Respondent has chosen not to file a Response and has thereby failed to offer any explanation for the choice of the Domain Name. The Respondent has therefore failed to rebut the presumption which applies.

Disregarding the .co.uk suffix, the Domain Name is identical to the CARREFOUR PASS name and mark of the Complainant. When a domain name is identical to the name or mark of a complainant, without any adornment, barring exceptional circumstances this is almost inevitably going to lead to people being confused into believing that the domain name is owned or authorised by the complainant. There are no exceptional circumstances in this case.

It is clear to me that any use which the Respondent could make of the Domain Name is likely to cause people to be confused into believing that the Domain Name belongs to the Complainant or is connected with, or authorised by, the Complainant in some way. Even if the Respondent were to use the Domain Name for a website, the content of which makes clear that it is not in fact connected with the Complainant, the nature of the Domain Name would still be likely to give rise to what is known as "initial interest confusion". This is the type of confusion whereby people believe that they are accessing a website belonging to someone else, i.e. the Complainant, and are only disabused of that confusion after spending time reviewing the website. "Initial interest confusion" has been found in several DRS decisions to be a relevant type of confusion for the purposes of the DRS Policy.

Paragraph 8 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. I find that none of these factors apply in this case, and that there is no other evidence that the Domain Name is not an Abusive Registration.

The fact that any use which the Respondent could make of the Domain Name would be likely to give rise to at least initial interest confusion means that the Domain Name takes unfair advantage of the Complainant's Rights. This is because, whatever the content of a website using the Domain Name, the Respondent would thereby unfairly attract visitors to its website who would not otherwise have accessed it.

In fact, the website under the Domain Name is currently an error page. Some people accessing may give up looking for the Complainant and in any case gain a negative impression of the Complainant. This is also unfairly detrimental to the rights of the Complainant.

In addition, any website under the Domain Name is outside the Complainant's control. Since any such website will be perceived by consumers as belonging to, or connected with the Complainant, it follows that everything related to that website will reflect on the Complainant. The combination of this reflection with the Complainant's lack of control is itself inherently detrimental to the Complainant's rights.

All of this means that the Domain Name is an Abusive Registration under paragraph 1 of the Policy.

7. Decision

Having found that the Complainant has Rights in respect of names and marks which are either identical or similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *carrefour-pass.co.uk* be transferred to the Complainant.

Signed:

Dated: 17 June 2019

Jason Rawkins