

# **DISPUTE RESOLUTION SERVICE**

**D00020053**

## **Decision of Independent Expert**

Carrefour S.A.

and

NORTHCORE

### **1. The Parties**

Complainant: Carrefour S.A.  
33 avenue Emile Zola  
Boulogne-Billancourt  
Ile-de-France  
92100  
France

Respondent: NORTHCORE  
Old Gloucester Street 27  
Monomark House  
London  
WC1N 3AX  
United Kingdom

### **2. The Domain Name**

<carrefour-shop.co.uk> (“the Domain Name”)

### **3. Procedural History**

06 April 2018 09:11 Dispute received  
10 April 2018 14:57 Complaint validated  
10 April 2018 14:59 Notification of complaint sent to parties

27 April 2018 02:30 Response reminder sent  
02 May 2018 10:00 No Response Received  
02 May 2018 10:01 Notification of no response sent to parties  
15 May 2018 02:30 Summary/full fee reminder sent  
17 May 2018 09:41 Expert decision payment received

The Expert has confirmed that he is independent of each of the parties and that, to the best of his 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 they might be of a such a nature as to call in to question his independence in the eyes of one or both of the parties.

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

The Complainant is a company registered in France. It is a multinational food retailer.

The Complainant is the owner of trademark registrations including European Union Trade Mark number 005178371 for the word mark CARREFOUR registered on 20 June 2006 in Classes 9, 35 and 38.

The Domain Name was registered on 27 September 2017.

The Domain Name does not appear to have resolved to any active website.

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

##### **The Complainant**

The Complainant states that it is a global leader in food retail, operating nearly 12,000 stores and e-commerce sites in more than 30 countries. It states that it employs over 380,000 individuals worldwide, that it generated sales of EUR 103.7 billion in 2016 and that it services 13 million customers every day. The Complainant provides screen prints from its website and links to filed returns in support of these contentions.

The Complainant further states that it has used the domain names <carrefour.com> and <carrefour.fr> in connection with its business since 1995 and 2005 respectively.

The Complainant submits that it has well-established trademark rights in the mark CARREFOUR as a result of these matters. It also refers to previous decisions under the Nominet UK Dispute Resolution Service Policy ("the Policy") and the Uniform Domain Name Dispute Resolution Policy ("UDRP") in which panels have held that the mark CARREFOUR has the status of a well-known trademark.

The Complainant submits that it has Rights in respect of the name and mark CARREFOUR which is identical or similar to the Domain Name, <carrefour-shop.co.uk>. The Complainant contends that the addition of the term "-shop" to its

trademark is not sufficient to distinguish the Domain Name from its trademark, and that the suffix “.co.uk” is to be disregarded for the purposes of comparison.

The Complainant further contends that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complainant says that it has no affiliation with the Respondent and has never authorised the Respondent to use its CARREFOUR marks; that the Respondent has not legitimately been known by the name CARREFOUR; and that the Respondent is not using the Domain Name for any legitimate purpose, whether commercial or non-commercial.

The Complainant submits that the Respondent’s holding of the Domain Name amounts to an Abusive Registration in circumstances where the Respondent must have known of the Complainant’s trademark at the date of registration of the Domain Name and can only have registered it in order to benefit from the Complainant’s goodwill in that mark. The Complainant states that it does not assist the Respondent that the Domain Name has not resolved to any active website, as Internet users will still assume it to be associated with the Complainant.

The Complainant also contends that email servers have been configured to the Domain Name, enabling the Respondent to send emails from the address “@carrefour-shop.co.uk”, which are likely to be confused by the Complainant’s customers or others with emails from the Complainant.

The Complainant provides evidence of a “cease and desist” communication sent to the Respondent on 19 October 2017. The Complainant states that, while it did not deny that the Domain Name could be linked with the CARREFOUR trademark, the Respondent refused to transfer the Domain Name to the Complainant and invited the Complainant to make an offer for the Domain Name. The Complainant relies on this as further evidence of Abusive Registration.

The Complainant requests the transfer of the Domain Name.

### **The Respondent**

The Respondent has not filed a Response or otherwise participated in these proceedings.

## **6. Discussion and Findings**

This matter falls to be determined under the terms of the Policy.

Under paragraph 2 of the Policy:

*“2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:*

*2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

2.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration*

2.2 *The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”*

Under paragraph 1 of the Policy the term “Rights”:

*“... means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.”*

Also under paragraph 1 of the Policy, the term “Abusive Registration” means 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”*

Paragraph 5 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 8 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

### **Rights**

The Complainant has established that it is the owner of the registered trademark CARREFOUR. The Domain Name <carrefour-shop.co.uk> is identical to the Complainant’s trademark but for the addition of the generic term “-shop” and the suffix “.co.uk”, which the Complainant rightly submits is to be disregarded for the purposes of comparison. In the view of the Expert, the addition of the term “-shop” is ineffective to distinguish the Domain Name from the Complainant’s trademark, particularly in circumstances where the Complainant itself is known as an operator of retail outlets. The Expert therefore finds that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

### **Abusive Registration**

In the view of the Expert, the submissions and evidence advanced by the Complainant give rise to a *prima facie* case for the Respondent to answer that the Domain Name in its hands is an Abusive Registration. In particular, the Expert accepts that the Complainant’s trademark CARREFOUR is distinctive and widely known internationally in connection with retail services. In the circumstances, in the absence of any explanation to the contrary, the inference is compelling that the Respondent registered the Domain Name in the knowledge of the Complainant’s trademark and with the intention of taking unfair advantage of it.

The Respondent has, however, elected to not participate in these proceedings, to dispute or challenge the Complainant's case, or to offer any alternative explanation for its registration of the Domain Name. The Expert therefore concludes that the Domain Name was indeed registered abusively. The Expert does not consider it material that the Domain Name has not been used for any active website, as the Expert finds that it constitutes an impersonation of the Complainant and therefore an instrument of deception in the hands of the Respondent. Furthermore the Expert accepts the Complainant's concern that the configuration of the Domain Name for emails gives rise to the risk of misleading emails being sent to the Complainant's customers or others.

Specifically, the Expert finds there to be 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 (paragraph 5.1.2 of the Policy).

In the circumstances, the Expert concludes that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

## **7. Decision**

The Expert has concluded that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complaint therefore succeeds and the Expert directs that the Domain Name, <carrefour-shop.co.uk>, be transferred to the Complainant.

**Steven A. Maier**  
Independent Expert

Date: 18 May 2018