

# **DISPUTE RESOLUTION SERVICE**

**D00022234**

## **Decision of Independent Expert**

**ASSOCIATION DES CENTRES DISTRIBUTEURS E.  
LECLERC (ACD LEC)**

and

**Turbado SE**

### **1. The Parties:**

**Lead Complainant:** ASSOCIATION DES CENTRES DISTRIBUTEURS E.  
LECLERC (ACD LEC)  
26 Quai Marcel Boyer  
IVRY SUR SEINE  
94200  
France

**Respondent:** Turbado SE  
Safarikova 5922/39  
PRESOV  
SK  
080 01  
Slovakia

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

eleclerc.uk

(the “**Contested Domain**”)

### **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 they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

15 January 2020 09:36 Dispute received  
15 January 2020 11:14 Complaint validated  
15 January 2020 11:17 Notification of complaint sent to parties  
29 January 2020 17:49 Response received  
29 January 2020 17:49 Notification of response sent to parties  
03 February 2020 01:30 Reply reminder sent  
03 February 2020 12:39 Reply received  
03 February 2020 12:40 Notification of reply sent to parties  
05 February 2020 12:47 Mediator appointed  
06 February 2020 11:13 Mediation started  
20 February 2020 14:51 Mediation failed  
20 February 2020 14:53 Close of mediation documents sent  
03 March 2020 01:30 Complainant full fee reminder sent  
03 March 2020 12:08 Expert decision payment received

This Decision is determined in accordance with Nominet's Dispute Resolution Service Policy Version 4 dated October 2016 (the "**DRS Policy**").

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

The following matters are taken from the Complaint and the Response. The facts are substantially unchallenged and I record as claims those matters, which are addressed in the Discussion and Findings below.

The Complainant is the owner of registered trade marks for E LECLERC and domain names in several EU member states in the form "eleclerc.xx" where xx denotes the country code. It is an organisation which has traded extensively and obtained a substantial reputation under the name E LECLERC, the name of its founder, since 1964, and is well known throughout Europe as an operator of super and hypermarkets and associated websites.

The Respondent is a Slovakian company. The Response provided on behalf of the Respondent came from an individual, SD, at the same address in Slovakia. SD claims that he wants to use the domain as an EU-wide platform for negative reviews of the Complainant and its websites because of a bad personal experience with the Complainant.

The Contested Domain resolves to a holding page, which advertises the services of the Registrar, but contains no information about the Complainant or the Respondent or the Respondent's avowed reason for registering the Contested Domain.

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

##### **The Complaint**

The Complainant claims prior Rights in the name E LECLERC in the form of various trade marks and pre-existing domain names, all of which incorporate the name "eleclerc".

It complains that the domain name of the Contested Domain is identical to Complainant's trade marks and domains, which will lead consumers to believe, wrongly, that the Contested Domain is associated with the Complainant. Such consumers will conclude that the Complainant's website is not functioning and that this perception will obviously be harmful for the activities and for the image of the Complainant.

It complains that the Respondent has no link of any kind with the Complainant and has no legitimate interest or rights in the registration for a number of reasons, namely that:

- The domain name was registered anonymously.
- The Respondent was not authorized by the Complainant to use the term "E LECLERC" or to register this domain name and there was no business relationship existing between the Complainant and the Respondent.
- The website on the Contested Domain does not indicate that the Respondent is commonly known by, or that its name includes the sign E LECLERC or that it has any rights to that name.
- The Contested Domain is not used in connection with a bona fide offering of goods or services and does not constitute a legitimate non-commercial fair use. Instead, the website associated with the Contested Domain resolves to a holding page of the registrar NETIM.

It complains that the Contested Domain is being used in bad faith for the following reasons, namely that:

- The Complainant's business operating under the name "E LECLERC" is well known and immediately associated, at least with French consumers, with its trade marks.
- The reservation of the Contested Domain is not a coincidence, and is identical to the name of the Complainant's founder
- The term "E LECLERC" has no meaning in English or any other language, and is not a dictionary or common word.
- There is no reasonable explanation for choosing this term.
- The Respondent must have been aware of the Complainant and its business at the time the registration of the disputed domain name was made and the Respondent's selection of this name reflected that knowledge.
- The MX lookup conducted on the Contested Domain revealed the existence of mail servers configured to operate with the Contested Domain, which suggests a risk that the Respondent may be engaged in a phishing scheme aiming to deceive Internet users and make them believe that they are dealing with the Complainant.

### **The Response**

The Response was short and did not contest that the Complainant owned the Rights claimed or contest most of the points raised by the Complainant.

The rationale used to justify the registration of the Contested Domain by the Respondent, a Slovakian company, Turbado SE, is allegedly based on a personal experience by SD, listed as the Respondent's contact on Nominet records.

SD claimed to have had a negative personal experience with the Complainant in France, of which no details were given, and that he viewed the Complainant as biased and “possibly promoting only supermarkets that donate money”. He stated that he wanted to use the site as an EU wide platform for leaving negative reviews of the Complainant and its other websites.

The Response relies, in part, on the alleged residence of SD in the UK. The Response asserted that the Complainant does not operate in the UK, and has no physical office or customers in the UK. SD states that he lives in Peterborough and therefore has a right to own the Contested Domain. However, the address listed for SD on Nominet records is the same as the Respondent’s address in Slovakia.

### **The Reply**

In the Reply, the Complainant re-iterates the arguments raised initially and points out that they have not been disputed or disproved in the Response. For reasons of economy these are not repeated.

In its Reply, the Complainant made the following additional points:

- The Contested Domain resolved at the dates of the filing of the Complaint and of the Reply to a holding page.
- SD states that the Respondent registered the Contested Domain with the sole intention of engaging commercial disparagement of the Complainant's business. Disparaging the Complainant or its business cannot constitute rights or legitimate interests in the Contested Domain.
- The argument raised by the Respondent, that the Contested Domain was to be used for the exercise of criticism is primarily a pretext for cybersquatting, commercial activity or tarnishment.
- The Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name and the burden of proof on the question of whether it is an Abusive Registration shifts to the Respondent, who has not come forward with substantive evidence of his rights or legitimate interests in the disputed domain name.
- At the date of the filing of the Complaint, the Respondent was not using the domain name for a non-legitimate or fair use, because is resolved only to a holding page and the intended use for the commercial disparagement of the Complainant's business is not a legitimate use of the disputed domain name, consisting of the Complainant's trademarks.

## **6. Discussions and Findings**

To succeed under the Nominet DRS Policy the Complainant is required to demonstrate, on the balance of probabilities, that (1) it has Rights in respect of a name or mark which is identical or similar to the Contested Domain (§2.1.1 of the DRS Policy), and (2) the Contested Domain, in the hands of the Respondent, is an Abusive Registration (§2.1.2 of the DRS Policy).

## **Identity of the Respondent**

In the present case, there is a distinction to be drawn between the Respondent, and SD, an individual who provided the Response on the Respondent's behalf.

The Respondent is formally defined in the DRS Policy as "the person (including a legal person) in whose name or on whose behalf a Domain Name is registered"

While SD is the Respondent's contact, it has not been claimed that he, personally, is the Respondent or that the Contested Domain was registered by Turbado SE on his behalf. Further, SD does not provide any context in the Response, which connects his alleged negative experience with the Complainant to the Respondent.

SD does assert that he has a right to own the Contested Domain by reason of his alleged residence in the UK, but Nominet's records indicate that the Contested Domain was registered in the name of Turbado SE, which has an address in Slovakia. Therefore, I do not take SD to be the Respondent.

## **The Complainant's Rights**

I can deal with this shortly. There is no dispute that the Complainant owns trade marks and domain names, which include the name E LECLERC, and that, as a result of substantial trading over decades it owns a valuable reputation in the name E LECLERC, which appears in domain names as eleclerc and which would, even without the space between E and LECLERC, be easily recognisable as the trade mark and trading name, particularly as this is how it used by the Complainant in its other domain names. Spaces in names which do not appear in the domain are usually ignored for the purpose of comparison in §2.1.1 of the DRS Policy (see §2.3 DRS Experts Overview).

Accordingly, the Complainant owns Rights in respect of the Contested Domain and the first element of the test set out above is satisfied.

## **Is the Contested Domain an Abusive Registration?**

This is a multifactorial assessment and the DRS Policy provides a non-exhaustive list of factors, which may demonstrate that the domain is an Abusive Registration.

These include the following relevant factors:

- The Respondent has registered or otherwise acquired the Contested Domain primarily for the purpose of unfairly disrupting the business of the Complainant;
- The Respondent is using or threatening to use the Contested Domain 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;
- The Contested Domain is an exact match for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the

Respondent has no reasonable justification for having registered the Domain Name.

Similarly, the DRS Policy provides a non-exhaustive list of factors, which may demonstrate that the registration is not an Abusive Registration.

These include the following relevant factors:

- The Respondent has made legitimate non-commercial or fair use of the Contested Domain.
- Fair use may include sites operated solely in tribute to or in criticism of a person or business.

It is implicit in the Response that the Respondent seeks to rely on the right to free speech, which is recognised within the DRS Policy as being a potential justification for the registration of a domain with a similar name. Domains for such protest sites are often characterised by the inclusion of an additional term in the domain name e.g. "...sucks". As set out above, the DRS Policy makes it clear that such sites may involve fair use of a trade mark or right in a domain name. This involves balancing the right to free speech with the right of the Complainant to enjoy its Rights and property in its trade marks and trading name.

It is clear, in the present case, that it is the motivation of the Respondent and its justification for registering an identical name to the trade mark in which it is accepted the Complainant owns valuable Rights, which have to be considered.

Initially, on registering the Contested Domain, the Respondent elected to remain anonymous. Had the Contested Domain been registered in the name of an individual, such as SD, this could potentially be justified on data protection grounds. The same justification does not apply where the Respondent is a company. The fact that the Respondent chose to remain anonymous is also a factor which I can take into account in assessing the justification provided for the registration of the Contested Domain. I consider that if the Respondent was genuinely seeking to host a protest site, it would make the fact of and reason for its protest clear to consumers attracted to the site. In my view, that would involve including the name of the organisation controlling the protest site, so that consumers coming to the site could assess whether the protest was justifiable and not malicious or simply "fake news", so that they could decide whether, in the circumstances, they wanted to associate themselves with the protest, by contributing to the site. The choice of anonymity therefore may indicate that the alleged motivation is not genuine.

It is made clear in the Response that SD's unspecified unsatisfactory experience with the Complainant occurred in France. If SD does, as he asserts, live in the UK, this would appear to contradict the point he makes that the Complainant does not have customers in the UK. Indeed, I think it highly likely that many UK residents have travelled to France in the decades since 1964 and that at least a reasonable proportion of those visitors from the UK would have come across the Complainant's businesses in France and other Member States of the EU, and, as a result would recognise the trade mark E LECLERC. Accordingly, the first argument that the Respondent raises, that the Complainant is not entitled to register a .uk domain, does not follow. I should

also point out that registration of a .uk domain does not include any requirement for trading in the UK. In any event, as I have explained above, the Respondent is in Slovakia, not the UK, so the second argument raised as justification does not work for the Respondent.

The Respondent accepts that the Contested Domain was deliberately chosen to refer to the Complainant, and that the Respondent does not have any rights in the name “E LECLERC”. The Contested Domain is identical to the Complainant’s trade marks and other domains (save for the country identifier). There is no doubt that the intention of the Respondent was to attract internet users familiar with the Complainant to the Contested Domain.

While the Response indicates that SD may have a motive to register the Contested Domain as a protest site, there is no explanation why the Respondent would register the Contested Domain. No evidence is provided as to the business operated by the Respondent and how that business might interact with the Complainant’s business.

In addition, the Respondent chose the identical name for the Contested Domain without any additional component that would identify it as a protest site. There was no indication on the holding page to indicate that purpose to an internet user or any disclaimer, which might indicate that the Contested Domain is not, in fact, associated with the Complainant.

As a result, a potential customer would have no reason to think the Contested Domain was not associated with the Complainant. Indeed, there is evidence that the Complainant has registered a number of domains using national tIDs, with the trade mark “eleclerc”. This would appear to be another domain in the same stable.

As a result, the Respondent is creating a likelihood of confusion with the Complainant and attracting Internet users to the Contested Domain, who would not otherwise follow the link.

In the Appeal Panel’s decision in DRS 06284 ([rayden-engineering.co.uk](http://rayden-engineering.co.uk)), the Appeal Panel explain that the use of an identical name with no qualifiers was, in the circumstances, not fair use of the sign. The Respondent in this case has put forward less justification than in that case.

This is also consistent with the guidance provided by the Appeal Panel in DRS 02193 ([guidestar.co.uk](http://guidestar.co.uk)) where they stated:

“Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is.

Rarely will it be the case that deliberate impersonation of this kind will be acceptable under the DRS Policy.”

Overall, I consider that the registration of the Contested Domain is not a fair use of the name E LECLERC, and that the justification provided by or on behalf of the

Respondent does not outweigh the Rights of the Complainant. In the balance, I do not think that this prevents SD from expressing his personal views about the Complainant in some other way, in particular by registering a domain for a protest site, which makes clear to internet users that it is such a site and is not associated with the Complainant. I do not consider that the Respondent has provided any evidence of a justification for its use of an identical name in the Contested Domain, without any indication that it is a protest site.

## **7. Decision**

Accordingly, I find that the Complainant has Rights in respect of a name or mark which is identical or similar to the Contested Domain and that the Contested Domain in the hands of the Respondent is an Abusive Registration.

I direct that the Contested Domain be transferred to the Complainant,  
ASSOCIATION DES CENTRES DISTRIBUTEURS E. LECLERC (ACD LEC).

**Signed** .....

**Dated** .....