

Decision for dispute CAC-UDRP-103777

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| Case number | CAC-UDRP-103777 |
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| Time of filing | 2021-05-03 09:58:04 |
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| Domain names | ets-franz-colruyt.com |
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Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (Case admin) |
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Complainant

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| Organization | Etablissements Franz Colruyt NV |
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Complainant representative

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| Name | Pierre-Yves Thoumsin |
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Respondent

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| Name | Paul De Gussem |
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is owner of various registered trademarks including the distinctive term “COLRUYT”, such as:

- EUTM no. 008545774 (device mark) filed on 14 September 2009 and registered on 7 October 2010 for goods in class 16 and services in classes 35 and 39;

- EUTM no. 009856733 (word mark) filed on 31 March 2011 and registered on 7 October 2011 for goods in class 16 and services in classes 35 and 39.

The Complainant conducts its businesses under the company and trade name Etablissements Franz Colruyt.

The Complainant's rights are hereinafter referred to as the COLRUYT Trademark.

FACTUAL BACKGROUND

The Complainant is a Belgian family owned company, operating one of Belgium's largest discount supermarket chains under the COLRUYT Trademark. The Complainant's history dates back to 1928, when Franz Colruyt started a colonial wholesale goods (coffee, salt and sugar) business to serve grocers in Brussels and the surrounding area. The Complainant is headquartered in the city of Halle, south of Brussels and operates in Belgium, France and Luxembourg. It has more than 30,000 employees.

The disputed domain name was registered with privacy / proxy service on 7 February 2020. Upon the CAC's request for registrar verification, the registrar disclosed the registration data identifying the registrant as Paul De Gussem - Franz colruyt, residing at the same address of the Complainant. The Complainant has no employee with such name. The disputed domain name does not resolve to any active website. It has been used to send e-mails impersonating the Complainant with the purpose to obtain business information and/or procure goods from a supplier of the Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is identical to the COLRUYT Trademark, since it fully reproduces such earlier mark.

The Complainant also contends that the Respondent has no rights or legitimate interests to the disputed domain name. The Complainant has not granted any right or authorisation to third parties to use its COLRUYT Trademark or to register the disputed domain name. The disputed domain name does not resolve to any active website, but has been used for e-mail scams impersonating the Complainant. That is not a good faith or fair use of the domain name, without intent for commercial gain to mislead consumers or to tarnish the Complainant's mark.

The Complainant finally contends that the Respondent's bad faith is demonstrated by the registration of the disputed domain name identical to the well-known COLRUYT Trademark and by the use of the same for fraudulent email activities. This would prove the constructive knowledge on behalf of the Respondent of the Complainant's potential rights and business, as well as the intention of the Respondent to exploit the reputation of the Complainant and its rights for commercial gain.

The Complainant, therefore, requests the transfer of the disputed domain name.

RESPONDENT:

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements (so-called three-part test) to succeed in the administrative proceeding:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (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 by the Respondent in bad faith.

I. THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has established that it has rights in registered trademarks including the distinctive term "COLRUYT" since 2009.

The test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademarks and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognisable within the disputed domain name. While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognisable in the domain name, the domain name will normally be considered confusingly similar to that mark for the purposes of the first element of the Policy (see WIPO Overview 1.7).

The disputed domain name consists of the letters "ets", which is the abbreviation of Etablissementen, and the words "franz" and "colruyt" divided by hyphens. Since the disputed domain name incorporates the entirety of the Complainant's COLRUYT Trademark or the dominant feature of such mark (i.e. the wording "COLRUYT") it is to be considered confusingly similar to the Complainant's mark. The addition of hyphens and the top-level suffix .com (which is a technical requirement) neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain name from the Complainant's mark (see Forum/FA128071 <visual-credit-counseling.com>: "Where the only difference between a mark and a domain name is the presence of a hyphen between the prominent elements of the mark, such is not sufficient to negate confusingly similarity"; WIPO/D2000-0017; WIPO/D2000-0038; see also WIPO Overview 1.11.1).

Hence, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's trademark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP panels that the complainant shall establish a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the respondent (see WIPO Overview 2.1: "[...] 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.").

According to the Complainant, it is the only organisation in the world using the names "COLRUYT" and "FRANZ COLRUYT" for conducting business. The Complaint was indeed founded by Franz Colruyt in 1928 and the Colruyt family currently remains its major shareholder. The Complainant has never granted any license or authorisation to third parties outside its group of companies to use the COLRUYT Trademark or to register the disputed domain name. The Complainant has not had any employee named Paul Van Gussem.

The disputed domain name is used to send e-mails impersonating the Complainant which is clearly not a bona fide offering of goods and services or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Panels have categorically held that the use of a domain name for illegal activity (including unauthorised account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see WIPO cases No. D2019-2257 <colruyt-be.com> and No. D2020-1993 <franz-colruyt.com>).

While the Complainant has established its prima facie case, the Respondent has not submitted a Response and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests to the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Complainant has sufficiently demonstrated to be owner of the COLRUYT Trademark registered prior to the registration of the disputed domain name.

The Respondent used a privacy / proxy service when registering the disputed domain name. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact a panel's assessment of bad faith (see WIPO Overview 3.6). Upon the CAC's request for registrar verification, the registrar disclosed the registration data identifying the registrant as Paul De Gussem - Franz colruyt, residing at the same address of the Complainant. Since the Complainant has no employee with such name, it is clear that the Respondent has used fake data for the registration of the disputed domain name to conceal his/her real identity.

The disputed domain name is confusingly similar to the Complainant's mark. Given the good-will and reputation of the Complainant acquired over the years, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant and its mark and the intention to exploit such reputation for commercial gain by diverting traffic away from the Complainant's website (see WIPO Case No. 22019-2257 <colruyt-be.com>: "the mark COLRUYT is the name of the family, which established the Complainant's business and is not a word or term that a person would accidentally think of when registering a domain name").

The disputed domain name does not resolve to any active website. It has been used for fraudulent e-mail activities impersonating the Complainant in order to obtain business information and/or procure goods from a supplier of the Complainant. Therefore, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, business entities by creating a likelihood of confusion with the Complainant's mark as to the source of the Respondent's activities.

Considered all the afore-mentioned circumstances, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

Therefore, the disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ETS-FRANZ-COLRUYT.COM**: Transferred

PANELLISTS

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| Name | Avv. Ivett Paulovics |
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| DATE OF PANEL DECISION | 2021-05-26 |
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Publish the Decision
