



URS | DETERMINATION
(URS Procedure 9, URS Rules 13)

URS DISPUTE NO. 6DDAB859

Determination FINAL

I. PARTIES

Complainant: Association Des Centres Distributeurs E.LECLERC (ACD Lec), FR
Complainant's authorized representative(s): Inlex Ip Expertise, FR

Respondent: Xitromedia, Andre Ahner, DE

II. THE DOMAIN NAME(S), REGISTRY OPERATOR AND REGISTRAR

Domain Names: le-clerc.shop, leclerc.shop
Registry Operator: GMO Registry, Inc.
Registrar: Mesh Digital Limited

III. PROCEDURAL HISTORY

Complaint submitted: 2016-12-27 10:19
Lock of the domain names: 2017-01-03 14:08
Notice of Complaint: 2017-01-04 11:40
Response submitted: 2017-01-17 22:52

IV. EXAMINER

Examiner's Name: Tobias Malte Müller

The Examiner certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as the Examiner in this administrative proceeding.

V. RELIEF SOUGHT

The Complainant requests that the domain names be suspended for the balance of the registration period.

The Respondent requests that the domain names be unlocked and returned to its full control.

The Respondent further requests to make a finding that the Complaint was brought in abuse of the proceedings in accordance with the 11.2 and/or 11.3 URS Procedure.

VI. STANDARD OF REVIEW

Clear and convincing evidence.

VII. DISCUSSIONS AND FINDINGS

A. Complainant:

According to the Complainant's undisputed allegations it operates a well-known chain of super and hypermarket stores since 1949, namely 652 hypermarkets/supermarkets in France and 112 hypermarkets/supermarkets Europe. Furthermore, the Complainant claims to be the leader of distribution in France with a turnover of 44,3 billion Euros generated by 110.000 employees in France.

The Complainant is the registered owner of European Union trademark No. 002700656 for the sign LECLERC, on which the Complaint is based.

Complainant alleges that the disputed domain names are confusingly similar to the its trademark since it identically reproduces the element LECLERC and adds the gTLD .shop which increases the risk of confusion since it points the Complainant's business.

According to Complainant, Respondent has no rights or legitimate interests on the disputed domain names. His name is not LECLERC. He is not commonly known nor runs his business under this name. He has no trademark rights on LECLERC and has not been authorized by the Complainant to use the sign LECLERC. There is no business relationship between the parties.

On October 19, 2016 the Complainant contacted the Respondent in English language requesting information on the purposes for which the domain name leclerc.shop has been registered. The Respondent replied in English language and asked if his substantial reply could be further provided in German language in order to avoid misunderstandings. Afterwards the Complainant wrote several emails to the Respondent in English language to which the Respondent replied in German language. In his email dated October 21, 2016 the Respondent proposed on his own motion to negotiate on a possible assignment of the domain names (Appendix 5, English translation: *"Or is the interest in it focussed on obtaining the domain names for itself? If this is the case, would that be up for negotiation, as our customer would eventually renounce operation of the domain names and switch to other domain names if your client has such great interest in it"*). However, the Respondent did not specify any concrete price or request for the assignment of the domain names.

From the correspondence between the parties it further results that the Respondent knows the Complainant's trademark rights (Email dated October 20, 2016, Appendix 5, English translation: *"Your client's trademark rights are known both to us and to our customer"*).

Complainant therefore concludes that the disputed domain names have been registered with the sole intention to benefit from the Complainant's widely known rights, to prevent the Complainant from reflecting his trademark rights in the extension .shop and to sell or lease the disputed domain names. Besides, the disputed domain names are used in bad faith and disturb the Complainant's business.

B. Respondent:

The Respondent brings forward that he registered the disputed domain names in trust for his life partner due to familiar and fiscal reasons. He is, however, well aware that he is liable for the disputed domain names in relation to third parties.

As to the conditions under Paragraph 1.2.6 of the URS Procedure the Respondent first challenges the validity of the Complainant's trademark "LECLERC". In his view, absolute grounds for refusal are applicable to this mark that needs to be kept available for third parties' use. In addition, the sign "le clerc" means "clergyman" or "priest" and would therefore be generic/descriptive. Finally, "Leclerc" is a common French surname.

The Respondent further claims to have a legitimate interest in the domain names. He alleges that the disputed domain names are intended to present a charitable/non-profit cafe or restaurant called "Le Clerc" in a tourist region in the south of Thailand, where works crafted in this region could be distributed (in return to donations), and to attract tourists for donations. The name "Le Clerc" would refer to an old priest of Australian-French origins, who lived in Vietnam and was called "Le Clerc".



The Respondent further contests having registered and used the disputed domain names in bad faith. In his view, use of the disputed domain names for the above purposes in Thailand does not affect the Complainant's European Trademarks. Furthermore, the Respondent's life partner wishes to keep the disputed domain names and did only propose an economic usage of those domain names in order to support the charitable project in Thailand or even further projects in Vietnam.

In addition, many other domain names consisting of the terms "le cleric" are currently available for registration, in particular also under the ".fr" top level domains, so that consumers are used to the fact that such domain names may lead to websites other than the Complainant's website so that any risk of confusion or association between the disputed domain names and the Complainant is excluded.

The Respondent contests having registered the disputed domain names for rent or lease. The current content to which both domain names resolve (Appendix 6) is not a proposal for sale or lease but only formulated as an alternative.

C. Procedural findings:

Having reviewed the communications records, the Examiner finds that MFSD has discharged its responsibility under 3 and 4 URS Procedure and URS Rules paragraph 4.

The Examiner, who is fluent both in English and German, determines in his sole discretion that the language of this Determination will be English. The Complaint has duly been submitted in English. The Notice of Complaint to the Respondent has been transmitted in English and German, the language used in the registrant's country, as determined by the country listed in the Whois record when the Complaint is filed. Consequently, the Respondent was entitled to submit his Response in German language. Under such circumstances 4.2. URS Procedure states that the Examiner has to determine, in its sole discretion, in which language to issue its Determination. For his decision, the Examiner took into consideration that English is the only relevant "neutral" language in this case, because it is not the language of any of the parties, while German is only the Respondent's language. In addition, the Respondent communicated in English language both with the Complainant at the beginning of the extrajudicial correspondence (see email of October 19, 2016, Annex 5) and with MFSD. Also the websites to which the disputed domain names resolve, display a message formulated by the Respondent amongst others in English language (Appendix 6). Finally, this case has an international scope since the Complaint is based on an European Union Trademark.

D. Findings of fact:

Complainant has rights in the mark "LECLERC" dating back to 2002. According to the Registry Operator's verification, the current holder/registrant registered the disputed domain names on October 18, 2016.

The Complainant has demonstrated being the registered owner of a European Union trademark No. 002700656 consisting in the word mark "LECLERC", which is in current use and have been registered well before the registration of the disputed domain names.

Complainant has not licensed or otherwise authorized Respondent to use its mark.

The disputed domain names resolve to websites both displaying a message in German and English language formulated by the Respondent which reads as follows (Appendix 6): *"The domain/website address leclerc.shop [le-clerc.shop] that you requested is either temporarily parked here for a customer or a customer project, or can be rent. If you have interest or any questions regarding that domain, please get in touch with us"*.

E. Reasoning:

According to Paragraph 13 of the URS Rules, the Examiner shall make a Determination of a Complaint in accordance with the URS Procedure, the URS Rules and any rules and principles of law that it deems applicable.

For the Complainant to succeed, it must establish that each of the three following conditions under 1.2.6 URS Procedure are satisfied:

- That the disputed domain name is identical or confusingly similar to a word mark;
- That the Registrant has no legitimate right or interest to the disputed domain name;
- That the disputed domain name was registered and is being used in bad faith.

1. The domain name(s) is(are) identical or confusingly similar to a word mark

It results from the evidence provided that the Complainant is the registered owner of the European Union trademark No. 002700656 consisting of the verbal element “LECLERC”, filed on May 17, 2002, registered on February 26, 2004, covering goods and services in classes 1 to 45, which is currently used by the Complainant.

If a complainant owns a registered trademark, then it generally satisfies the threshold requirement of having trademark rights. The Respondent’s allegations are not suitable to call into question this principle or the validity of this mark. In fact, European Union trademark No. 002700656, as all European Union trademarks, has been registered following an ex-officio examination of absolute grounds. It has duly been renewed in 2012 and is currently in force. Therefore, the Examiner has no doubt that this mark is a valid base for this Determination.

The second level domain of the disputed domain names consists respectively of the term “leclerc” and is therefore identical to the Complainant’s word mark. In particular, the new generic TLD “.shop” does not affect the identity between the disputed domain names and the Complainant’s trademark. It will rather be understood by the relevant public as a descriptive term underlining the commercial character of a “shop” intended to be displayed under the disputed domain names.

Under these circumstances, the Examiner finds that the requirements of 1.2.6.1 URS Procedure have been satisfied.

2. Respondent has no rights or legitimate interests to the domain name(s)

The Examiner is satisfied that Respondent has no rights or legitimate interests in the disputed domain names. It is undisputed among the parties, that Complainant did not authorize Respondent nor granted him a license or permission to register the disputed domain names or use its trademark. Furthermore, there is no evidence in the files to indicate that Respondent is commonly known by the disputed domain names. Finally, Respondent did not claim any own trademark rights on the term “LECLERC”.

It is acknowledged that once the Panel finds such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain names. URS Procedure 5.7 sets out examples of circumstances demonstrating bona fide registration of the domain names, e.g. if before any notice to the Respondent of the dispute, there is evidence of Respondent's use of, or demonstrable preparations to use, the domain name(s) or a name corresponding to the domain name(s) in connection with a bona fide offering of goods or services. In this context it is to be recalled, however, that under 8.2 URS Procedure the “burden of proof shall be clear and convincing evidence”. The Respondent ascertains to plan a charity project in Thailand somehow connected to an Australian-French priest called “le clerc”. However, Respondent failed to provide evidence of any of concrete circumstances which could demonstrate, pursuant to the URS, any rights or legitimate interests in the disputed domain names. In particular, he did not provide any evidence of the alleged charity project with a café/restaurant in Thailand. Taking into account the burden of proof and the requirement of “clear and convincing evidence”, simple allegations - as those presented by the Respondent - cannot satisfy this threshold.



Under these circumstances, the Examiner finds that the requirements of 1.2.6.2 URS Procedure have been satisfied.

3. The domain name(s) was(were) registered and is(are) being used in bad faith

The Examiner notes that in the extrajudicial correspondence between the parties, the Respondent affirmed that he positively knows the Complainant's trademark rights (Email dated October 20, 2016, Appendix 5, Engl. translation: "Your client's trademark rights are known both to us and to our customer"). The Examiner further notes that Complainant's "LECLERC"-mark has been deemed a well-known and highly distinctive mark by URS Examiners (see, e.g. *Association Des Centres Distributeurs E. LECLERC - A.C.D. LEC v Chandler Dave*, MFSD Dispute no. D70B9442) and UDRP Panels (see, e.g. *Association des Centres Distributeurs E. Leclerc - A.C.D Lec v Daniel Leclerc*, WIPO Case No. D2012-1685; *Association des Centres Distributeurs E. Leclerc - A.C.D Lec v Marie-Laure Neau/Anne-Charlotte Neau/Guillaume Neau/Philippe Neau*, WIPO Case No. D2013-1793). The Examiner joins the view of these previous Panels.

Therefore, in the Examiner's view the Respondent knew that the disputed domain names included the Complainant's trademark when he registered the disputed domain names. Registration of a domain name in awareness of a reputed mark and in the absence of rights or legitimate interests in this case amounts to registration in bad faith (see, e.g., *KOC Holding A.S. v. VistaPrint Technologies Ltd*, WIPO Case No. D2015-1910; *The Chancellor, Masters and Scholars of the University of Oxford v. Oxford College for PhD Studies*, WIPO Case No. D2015-0812; *The Chancellor, Masters and Scholars of the University of Oxford v. Almutasem Alshakhissa*, WIPO Case No. D2014-2100; *Deutsche Lufthansa AG v. Mustermann Max, Muster AG*, WIPO Case No. D2015-1320).

In addition, the Examiner notes that the disputed domain names resolve to websites displaying the Respondent's message stating that the disputed domain names are either temporarily parked for a customer or can be rent. It is true that the wording does only present the possibility to rent the domain names as one out of two alternatives, however the Examiner considers that such an alternative does nevertheless include the possibility that the domain names can be rented.

In contrast to the above findings, the Respondent did not provide any clear and convincing evidence that could demonstrate that his use of the disputed domain names is not in bad faith (see the examples and factors set forth in 5.8 and 5.9 URS Procedure).

In the light of the above, the Examiner finds that the requirements of 1.2.6.3 URS Procedure have been satisfied.

4. Abusive Complaint

The Examiner finds that the Complaint was neither abusive nor did it contain deliberate material falsehoods.

VIII. DETERMINATION

A. Demonstration of URS elements

Demonstrated

B. Complaint and remedy

Complaint: Accepts

Domain Names:

LE-CLERC.SHOP Suspends for the balance of the registration period

LECLERC.SHOP Suspends for the balance of the registration period

C. Abuse of proceedings

Finding of abuse of proceedings: Not finds

D. Publication

Publication: Publish the Determination

SIGNATURE

Name: Tobias Malte

Surname: Müller

Date: 23 January 2017