

ADMINISTRATIVE PANEL DECISION

Carrefour SA, Atacadão S.A. v. Luiz lima Da silva
Case No. D2023-4209

1. The Parties

The Complainants are Carrefour SA, France (the “First Complainant”), and Atacadão S/A, Brazil (the “Second Complainant”), represented by IP Twins, France.

The Respondent is Luiz lima Da silva, Brazil.

2. The Domain Name and Registrar

The disputed domain name <cartao-atacado.online> is registered with HOSTINGER operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2023. On October 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 14, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Domain Admin/Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainants on October 17, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on October 19, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 17, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on November 24, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The First Complainant operates in the retail business since 1968, with more than 12,000 stores in over 30 countries, having had a turnaround of EUR 76 billion in 2018. The First Complainant additionally offers travel, banking, insurance, and ticketing services.

The Second Complainant was established as a chain of warehouses in 1960, having been bought by the First Complainant in 2007, presently counting with over 300 stores and distribution centers in all Brazilian states.

The Second Complainant is the owner of the following trademark registrations (collectively hereinafter referred to as the "ATACADAO trademark"):

- Brazilian trademark registration No. 006785344 for the word mark ATACADÃO, filed on July 15, 1977, registered on October 10, 1978, successively renewed, in local class 31.10;
- Brazilian trademark registration No. 006937497 for the word mark ATACADAO, filed on March 21, 1978, registered on May 25, 1979, successively renewed, in local class 35.10, 35.20, and 35.30.

The disputed domain name was registered on July 22, 2023. Presently, the disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainants contend that their ATACADAO trademark enjoys a wide-spread continuous reputation, having already been found to be well known in Brazil by past UDRP panels (*Carrefour SA and Atacadão - Distribuição, Comércio e Indústria LTDA. v. Lohan Medina*, WIPO Case No. [D2023-1900](#); *Carrefour SA and Atacadão S.A. v. atacado varejo*, WIPO Case No. [D2023-3011](#), and *Atacadão - Distribuição, Comércio E Indústria LTDA. v. seong-chea park*, WIPO Case No. [D2022-4615](#)).

According to the Complainants, the disputed domain name is highly similar to the Second Complainant's well-known ATACADAO trademark given its entire reproduction with the addition of the term "cartao" ("card" in Portuguese) and a hyphen which are insufficient add any distinctiveness thereto.

As to the Respondent's lack of rights or legitimate interests in the disputed domain name, the Complainants argue that:

- i. the Respondent does not hold trademark rights over in the term "atacado";
- ii. the Respondent has not been commonly known by the disputed domain name as an individual, business, or other organization;
- iii. the Complainants have not authorized the use of their trademarks or terms similar thereto in the disputed domain name in any manner or form; and

- iv. the Respondent has not, before the original filing of the Complaint, used or prepared to use the disputed domain name in relation to a *bona fide* offering of goods or services, having the disputed domain name never resolved to an active website but solely at times to a generic landing page provided by the Registrar (Annex 9-1 to the amended Complaint).

The Complainants further contends that the Respondent has registered and is using the disputed domain name in bad faith, being it inconceivable that the Respondent ignored the Complainants or their earlier rights in the ATACADAO trademark, necessarily having the Second Complainant's name and trademark in mind when registering the disputed domain name so as to attract Internet users by creating a likelihood of confusion with the Complainants' earlier marks.

In addition, the Complainants further contends that the passive holding of the disputed domain name may not be considered a good faith use since the Respondent is preventing the Complainants from reflecting their trademarks in a corresponding domain name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainants:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have 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 are being used in bad faith.

The Complainants must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1

The Panel finds the entirety of the ATACADAO trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of the term "cartao" and a hyphen may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants’ *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.
- the Respondent (as an individual, business, or other organization) has not been commonly known by the disputed domain name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.
- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel considers that the record of this case reflects that: the Complainants hold a well-known trademark in the Brazilian territory, where the Respondent is located and that the naming chosen by the Respondent (“cartao” in Portuguese translates into “card”) indicates a high risk of association with the Complainants and their activities.

In addition to that, Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to

submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the Respondent failed to participate in this proceeding, thereby failing to provide any good faith explanation as to its registration and intended use of the disputed domain name, and the Respondent seemingly engaged the use of a privacy service to mask its details on the publicly-available Whois, which supports an inference of bad faith. Additionally, given the reputation of the Complainants' ATACADAO trademark and the composition of the disputed domain name, the Panel finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <cartao-atacado.online> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: December 7, 2023