

## **ADMINISTRATIVE PANEL DECISION**

Carrefour SA v. Domains By Proxy / Marcelo Matos  
Case No. D2022-2035

### **1. The Parties**

Complainant is Carrefour SA, France, represented by IP Twins, France.

Respondent is Domains By Proxy, United States of America / Marcelo Matos, Brazil.

### **2. The Domain Name and Registrar**

The disputed domain name <carrefoursolucoes.store> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2022. On June 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 8, 2022, 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 and contact information in the Complaint. The Center sent an email communication to Complainant providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on June 13, 2022.

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 Respondent of the Complaint, and the proceedings commenced on June 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 14, 2022. Respondent sent an informal email on July 13, 2022. Respondent did not submit any formal response. Accordingly, the Center notified Respondent’s default on July 21, 2022.

The Center appointed Phillip V. Marano as the sole panelist in this matter on August 10, 2022. 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**

Complainant is a French multinational retail and wholesaling corporation headquartered in Massy, France, which operates a chain of over 13,000 hypermarkets, grocery stores, and convenience stores in more than 30 countries around the world. Complainant owns valid and subsisting registrations for the CARREFOUR trademark in numerous countries, including an International Registration for CARREFOUR (Reg. No. 351,147), with the earliest priority dating back to October 2, 1968.

Respondent registered the disputed domain name on February 11, 2022. At the time this Complaint was filed, the disputed domain name did not resolve to any active website content.

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

##### **A. Complainant**

Complainant asserts ownership of the CARREFOUR trademark and has adduced evidence of trademark registrations in numerous regions and countries around the world including in France, with earliest priority dating back to October 2, 1968. The disputed domain name is confusingly similar to Complainant's CARREFOUR trademark, according to Complainant, because it includes Complainant's CARREFOUR trademark together with the generic term "solucoes", which from Portuguese translates to "solutions" in English, and the ".store" generic Top-Level Domain ("gTLD") is a further confusing element since it is related to Complainant's activities.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the lack of any trademarks owned by Respondent containing the terms "carrefour" or "carrefour solucoes"; the lack of any evidence Respondent, namely Marcelo Matos, is commonly known by the disputed domain name; the lack of any license or authorization between Complainant and Respondent; and the lack of any *bona fide* offering of goods or services in connection with the disputed domain name.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: the widely-known nature of Complainant's CARREFOUR trademark; a quick trademark search or simple online search engine would have revealed to Respondent the existence of Complainant and the CARREFOUR trademarks; Respondent's intentional targeting of Complainant in the hope and expectation that Internet users searching for Complainant's services and products would instead come across the disputed domain name; Respondent's passive holding of the disputed domain name; Respondent's use of a proxy registration service to conceal its identity and escape the present proceeding; and Respondent's failure to respond to the Complaint.

##### **B. Respondent**

Respondent did not reply to Complainant's contentions. In Respondent's informal email of July 13, 2022, the Respondent stated that, "I registered this domain for testing at the company where I work. I'm part of the Carrefour group. I have no interest in maintaining this site."

## 6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
- ii. 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 in bad faith.

UDRP Panels typically treat a respondent's submission of a so-called "informal response" (merely making unsupported conclusory statements and/or failing to specifically address the case merits as they relate to the three UDRP elements, e.g., simply asserting that the case "has no merit" and demanding that it be dismissed) in a similar manner as a respondent default. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), Section 4.3. Indeed, the Panel views Respondent's submissions, asserting Respondent's employer is an unspecified "part of the Carrefour group" and that Respondent has "no interest in maintaining this site", as akin to a respondent default.

The Panel notes that consent to transfer by the Respondent can provide a basis for an order for transfer without a need for consideration of the elements of the Policy. See [WIPO Overview 3.0](#), Section 4.10. In such instances, panels may order the requested remedy solely on the basis of such consent, thus giving effect to an understood party agreement as to the disposition of their case (whether by virtue of deemed admission, or on a no-fault basis). *Id.* However, UDRP panels have also deemed it appropriate to proceed to a substantive decision on the merits despite respondent consent to transfer. "Scenarios in which a panel may find it appropriate to do so include: (i) where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, (ii) where while consenting to the requested remedy the respondent has expressly disclaimed any bad faith, (iii) where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent's consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights.

In this particular Complaint, the Panel is presented with Respondent's assertion that he is "part of the Carrefour group." Respondent did not offer any evidence to support that assertion. Respondent did not identify its employer. Respondent registered the disputed domain name and sent its informal email communication using a personal email address and domain name in the ".eti.br" country-code Top-Level Domain, where registrations are restricted to IT professionals in Brazil. Neither Respondent's email address, physical address, or any other contact information suggest any affiliation with, or authorization from, Complainant. Most importantly, once the identity of Respondent had been revealed to Complainant, Complainant declined the opportunity to suspend this Complaint for the possibility of settlement pursuant to paragraph 17 of the Policy. Instead, on the same day as Respondent's informal email reply, Complainant filed its Amended Complaint specifically updating the caption to replace Respondent's proxy registration service with the name Marcelo Matos. The Panel can only interpret the foregoing as Complainant's preference for a recorded decision on the merits.

Although Respondent did not submit a formal reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g., where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See [WIPO Overview 3.0](#), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

## A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the CARREFOUR trademark has been registered in numerous regions and countries with priority dating back to October 2, 1968. Thus, the Panel finds that Complainant's rights in the CARREFOUR trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's CARREFOUR trademark. In this Complaint, the disputed domain name is confusingly similar to Complainant's CARREFOUR trademark because, disregarding the ".store" gTLD, the trademark is contained in its entirety within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("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 recognizable within the domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regards to gTLDs, such as ".store" in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The combination with the Portuguese term "solucoes" does not prevent a finding of confusing similarity between Complainant's CARREFOUR and the disputed domain name. [WIPO Overview 3.0](#), section 1.8 (Additional terms "whether descriptive, geographic, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity under the first element"); see also *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. [D2000-0553](#) ("Each of the domain names in dispute comprises a portion identical to [the ATT trademark] in which the Complainant has rights, together with a portion comprising a geographic qualifier, which is insufficient to prevent the composite domain name from being confusingly similar to Complainant's [ATT trademark]"); *OSRAM GmbH v. Cong Ty Co Phan Dau Tu Xay Dung Va Cong Nghe Viet Nam*, WIPO Case No. [D2017-1583](#) ("[T]he addition of the letters 'hbg' to the trademark OSRAM does not prevent a finding of confusing similarity between the Disputed Domain Name and the said trademark.").

In view of Complainant's registration of the CARREFOUR trademark, and Respondent's incorporation of that trademarks in its entirety in the disputed domain name, the Panel concludes that Complainant has established the first element of the Policy.

## B. Rights or Legitimate Interests

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, beyond the unsupported assertion Respondent is "part of the Carrefour group", Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1.

It is evident that Respondent, identified by Whois data for the disputed domain name as Marcelo Matos, is not commonly known by the disputed domain name or Complainant's CARREFOUR trademark.

In addition, as discussed above, despite the Respondent's informal email assertion that he is "part of the Carrefour group" and "registered this domain for testing at the company where [he] work[s]", the record is devoid of any corroborating evidence. To the contrary, Complainant, even when presented with the opportunity to suspend this Complaint for the purposes of settlement, has maintained in its Amended Complaint that Respondent lacks any license or authorization to use Complainant's CARREFOUR trademark or register that mark within the disputed domain name.

Passively holding a domain name in and of itself does not constitute a *bona fide* offering of goods or services. *Philip Morris USA Inc. v. Gabriel Hall*, WIPO Case No. [D2015-1779](#). Moreover, based on the undisputed facts and circumstances in the record before it, the Panel finds that Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services. This is especially the case where a disputed domain name is so obviously connected with a complainant and its products, the very registration by a registrant with no connection to a complainant suggests opportunistic bad faith. The Panel concludes from the record that Respondent had Complainant's CARREFOUR trademark in mind when registering the disputed domain name, and that Respondent most likely registered domain name in order to exploit and profit from Complainant's trademark rights. Indeed, a respondent who knowingly adopted a third party's well-known mark as a domain name cannot claim the benefit of paragraph 4(c)(i) of the Policy to establish rights to the domain name based on its mere use of the domain name to offer goods or services prior to the notice of a dispute. *Scania CV AB v. Leif Westlye*, WIPO Case No. [D2000-0169](#); see also *Drexel University v. David Brouda*, WIPO Case No. [D2001-0067](#) (rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the complainant).

In view of the absence of any evidence supporting rights or legitimate interests in the disputed domain name, Respondent's targeting of Complainant's well-known CARREFOUR trademark in the disputed domain name, and Respondent's passive holding of the disputed domain name, the Panel concludes that Complainant has established the second element of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent's documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith (particularly where no conceivable good faith use could be made). [WIPO Overview 3.0](#), Section 3.1.4. Complainant has adduced evidence of recognition of the CARREFOUR trademark and cited several WIPO panel determinations in agreement that Complainant's CARREFOUR trademark is considered to be "well-known" or "famous." See e.g., *Carrefour SA v. hanib bas*, WIPO Case No. [D2020-1798](#); *Carrefour SA. v. isco diaz*, WIPO Case No. [D2021-2639](#); *Carrefour SA. v. Withheld for Privacy Purposes, Privacy Service Provided by Withheld for Privacy ehf / Ben Luis*, WIPO Case No. [D2021-2910](#); *Carrefour SA. v. Reliant-web Domain Admin / Jean Marie Grolleau / Joanne Elvert*, WIPO Case No. [D2021-2389](#); *Carrefour SA v. dreux denis / denis cloud*, WIPO Case No.

[D2021-0276](#); *Carrefour SA v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2021-0807](#); *Carrefour SA v. Privacy service provided by Withheld for Privacy ehf / Ben Luis*, WIPO Case No. [D2021-2670](#); *Carrefour SA v. blackwhite, dolly Tiwari*, WIPO Case No. [D2021-0274](#). As such, the Panel finds it is unconceivable that Respondent could have registered the disputed domain name without knowledge of, or without any intention to benefit from confusion with, Complainant's CARREFOUR trademark.

Passively holding a domain name does not prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.3. This includes domain names that do not resolve to any website content. Where a domain name is being passively held, as alleged in this case, bad faith registration and use exists based upon: (i) the degree of distinctiveness or reputation of the complainant's mark; (ii) the failure of the respondent to submit any response or offer any credible evidence of rights or legitimate interests; (iii) the respondent's concealing its identity or use of false contact details; and (iv) the implausibility of any good faith use which the domain name may be put. See *Id. Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) ("A remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith").

To that end, the Panel acknowledges the multitude of prior UDRP panel determinations under the Policy cited by Complainant concluding that Complainant's CARREFOUR trademark is "well-known." In the Panel's view, these same prior panel determinations, coupled with Complainant's extensive portfolio of worldwide trademark registrations for Complainant's CARREFOUR trademark, make any good faith use of the disputed domain name relatively implausible. Furthermore, the Panel acknowledges Respondent's failure to offer any credible evidence of rights or legitimate interests. And finally, the Panel acknowledges Respondent's either intentional or default use of a proxy registration service, thus concealing its identity from Complainant.

In view of multiple WIPO UDRP panel determinations recognizing the well-known nature of Complainant's CARREFOUR trademark, Respondent's evident bad faith targeting of Complainant's CARREFOUR trademark in the disputed domain name, as well as Respondent's passive holding of the disputed domain name, the Panel concludes that 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, <carrefoursolucoes.store> be transferred to Complainant.

*/Phillip V. Marano/*

**Phillip V. Marano**

Sole Panelist

Date: September 27, 2022