

ADMINISTRATIVE PANEL DECISION

Carrefour SA v. nicolas sousa
Case No. D2022-4545

1. The Parties

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

The Respondent is nicolas sousa, Brazil.

2. The Domain Name and Registrar

The disputed domain name <carrefourcontrato.com> (the “Disputed Domain Name”) is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 29, 2022. On November 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 29, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 30, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amended Complaint. The Complainant filed an amended Complaint on December 1, 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 the Respondent of the Complaint, and the proceedings commenced on December 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 27, 2022.

The Center appointed Haig Oghigian as the sole panelist in this matter on January 17, 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 Complainant is a French multinational retail and wholesaling corporation operating a chain of hypermarkets, groceries stores, and convenience stores in more than 30 countries. The Complainant operates 12,000 stores and employs more than 384,000 employees worldwide. It generates revenues of over 76 billion euros (as reported in 2018) and around 1.3 million people visit the Complainant's stores every day. In addition to its retail operations, the Complainant also offers travel, banking, and insurance services.

The Complainant owns numerous trademark registrations worldwide for the word mark CARREFOUR and for the word "Carrefour" in various stylized forms, as it appears from Annex 3 to the Complaint. More specifically, the Complainant refers the Panel to two international trademark registrations:

- CARREFOUR, No. 351147, registered on October 2, 1968, for goods in classes 1 to 34;
- CARREFOUR, No. 353849, registered on February 28, 1969, for services in classes 35 to 42.

According to the Whois records, the Disputed Domain Name was registered on October 25, 2022.

At the time the Complaint was filed, and to this day, the Disputed Domain Name resolves to an inactive website (as it appears from Annex 13 to the Complaint).

5. Parties' Contentions

A. Complainant

Put briefly, the Complainant contends as follows.

First, the Complainant submits that the Disputed Domain name is highly similar to the earlier well-known trademark CARREFOUR. The Complainant submits that the Disputed Domain Name consists of the trademark CARREFOUR followed by the "generic" term "contrato." The Complainant submits that the addition of a term to a well-known trademark in a domain name does nothing to diminish the likelihood of confusion arising from that domain name – in support of that point, the Complainant refers this Panel to another WIPO decision where the use of the word "contrato" did not prevent a finding of confusion between the Disputed Domain Name and the trademark PETROBRAS: *Petrleo Brasileiro S.A – Petrobras v. Paul More*, WIPO Case No. [D2015-1095](#). The Complainant submits that in a case where a domain name incorporates the entirety of a well-known trademark in the domain name may be sufficient to establish that the domain name is identical or confusingly similar to the Complainant's CARREFOUR trademark, the Disputed Domain Name will normally be considered confusingly similar to that trademark.

The Complainant also submits that the Respondent has no rights or legitimate interest in the Disputed Domain Name because (1) no CARREFOUR trademark is owned by the Respondent which could have granted the Respondent rights in the CARREFOUR trademark and there is no evidence that the Respondent has been commonly known by the Disputed Domain Name as an individual, business or other organization, (2) the Complainant has not granted any license nor any authorization to use the CARREFOUR trademark as part of the Disputed Domain Name and (3) the Respondent has not used or made preparations to use the Disputed Domain Name in relation to a *bona fide* offering of goods or services.

Finally, the Complainant submits that the Disputed Domain Name was registered in bad faith. First, the Complainant submits that the CARREFOUR trademark is so widely well known, that it is inconceivable that the Respondent ignored the Complainant or its earlier rights on the term "Carrefour" – the Respondent knew or should have known that acquiring and using the Disputed Domain Name would be in violation of the

Complainant's earlier rights. Second, the Complainant submits that the Respondent acquired and is using the Disputed Domain Name to attract Internet users by creating a likelihood of confusion with the Complainant's earlier CARREFOUR trademarks. Thirdly, the Complainant submits that the Respondent knew of the Complainant's trademark rights in the CARREFOUR trademark and acted despite this knowledge to secure registration of the Disputed Domain Name. Finally, the Complainant submits that the non-use of a domain name, such as the blank page where the Disputed Domain Name resolves to, does not prevent a finding of bad faith under the doctrine of "passive holding."

B. Respondent

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

6. Discussion and Findings

Even in the absence of a substantive response from the Respondent, and in accordance with paragraph 4(a) of the Policy, the Complainant bears the burden to prove to the Panel each of the following elements:

- i. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- 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 in bad faith.

The Panel will successively rule on each of these elements.

A. Identical or Confusingly Similar

The Complainant satisfactorily established its rights in the CARREFOUR trademark and that the Disputed Domain name is confusingly similar to the CARREFOUR trademark.

The Complainant has shown its rights in the CARREFOUR trademark through the above-cited valid international registrations as well as through the list of other trademark registrations included at Annex 3 of the Complaint. Evidence of such registrations is sufficient to *prima facie* satisfy the threshold requirement of having trademark rights in the CARREFOUR trademark, according to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

As stated in section 1.7 of the [WIPO Overview 3.0](#), a domain name which incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the domain name will normally be considered confusingly similar to that trademark. The test for identity or confusing similarity typically involves a side-by-side comparison of the domain name, to assess whether the trademark is recognizable within the domain name.

In this case, the Disputed Domain Name is composed of two elements: (1) the word "Carrefour" and (2) the word "contrato". The Panel is permitted to ignore the generic Top-Level Domain ".shop", in accordance with section 1.11 of the [WIPO Overview 3.0](#). The first element is identical to the CARREFOUR trademark of the Complainant and the second element is the word "contrato", which means "contract" in Portuguese. The CARREFOUR trademark of the Complainant remains clearly recognizable within the Disputed Domain Name, despite the presence of the "contrato" word, which is consistent with section 1.8 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Disputed Domain Name is confusingly similar to the CARREFOUR trademark and thus the Complainant has discharged its burden under subparagraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant satisfactorily established that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

Following section 2.1 of the [WIPO Overview 3.0](#), the Complainant must demonstrate, *prima facie*, that the Respondent has no rights to or legitimate interests in the Disputed Domain Name. If the Complainant succeeds, the burden of production of this second element of the Policy shifts to the Respondent. Here, the Respondent must now produce relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. Such a legitimate interest is defined, non-exhaustively at paragraph 4(c) of the Policy, as use of the domain name in connection with a *bona fide* offering of goods or services, the Respondent being commonly known by the Disputed Domain Name, or a legitimate noncommercial fair use of the Disputed Domain Name, without misleading the consumers or tarnishing the trademark at issue.

In the present case, the Respondent did not file a response and thus provided no evidence that it holds any such rights or legitimate interests in the Disputed Domain Name, namely that it has used or made preparation to use the Disputed Domain Name in connection with a *bona fide* offering of goods and services.

The CARREFOUR trademark is clearly present in the Disputed Domain Name, and in the absence of evidence from the Respondent to the contrary, this is sufficient for the Panel to agree with the Complainant's submissions that the Complainant did not authorize the Respondent to register or use the Disputed Domain Name, that there is no connection between the Complainant and the Respondent and thus, no conceivable basis upon which the Respondent could possibly claim to have any rights or legitimate interest in respect of the Disputed Domain Name.

Moreover, the presence of the well-known CARREFOUR trademark along with the term of "contrato" (the stark linguistic contrast between the French word "carrefour" and the word "contrato" in Portuguese, suggests that the word "carrefour" has been adjoined to the word "contrato" solely because it is the Complainant's trademark) carries a risk of implied affiliation since it effectively impersonates or suggests sponsorship or endorsement by the Complainant of the Respondent's activities and website, according to section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Respondent does not hold any rights or legitimate interests in the Disputed Domain Name and that the Complainant has discharged its burden under subparagraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant satisfactorily established that the Respondent has registered and uses the Disputed Domain Name in bad faith.

Paragraph 4(a)(iii) of the Policy states this double requirement. According to section 3.1 of the [WIPO Overview 3.0](#), bad faith occurs if the Respondent takes unfair advantage of or otherwise abuses the Complainant's trademark. The same paragraph lists non-exhaustive scenarios, which could constitute evidence of bad faith.

The Panel notes that the evidence provided to it regarding the Respondent's use or intent to use the Disputed Domain Name is a screen capture of a blank landing page where the Disputed Domain Name resolves (Annex 13 to the Complaint).

After reviewing past decisions, including those cited by the Complainant, the Panel is convinced that the doctrine of "passive holding" supports the Complainant's position that the Disputed Domain Name was registered and is being used in bad faith by the Respondent, despite the Respondent's apparent lack of actual use of the Disputed Domain Name.

This doctrine states that when reviewing the totality of circumstances, the non-use of a domain name may not necessarily prevent a finding of bad faith, in accordance with [WIPO Overview 3.0](#), section 3.3. This section namely states that: “While 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, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put”. *Id.*

The Panel notes that the Complainant has successfully established that the CARREFOUR trademark became famous and well known prior to the Respondent’s registration and use of the Disputed Domain Name.

As stated above, the Complainant also established that the Respondent had no legitimate connection to the Complainant, namely that the Complainant never authorized the Respondent to register and use the Disputed Domain Name. This Panel also concluded above that there were no other conceivable grounds upon which the Respondent could claim a legitimate interest in the Disputed Domain Name. Given the extensive notoriety of the CARREFOUR trademark, the Panel is of the view that the Respondent was more likely than not aware of the CARREFOUR trademark and the Complainant’s reputation.

The Panel cannot conceive of any other purpose for the incorporation of the Complainant’s CARREFOUR trademark in the Disputed Domain Name than for the Respondent to use the Disputed Domain Name in a confusingly similar way so as to take an unfair advantage of the goodwill of the Complainant.

Therefore, the Panel finds that the Respondent registered and used the Disputed Domain Name in bad faith and that the Complainant has established the third element under subparagraph 4(a)(iii) 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 <carrefourcontrato.com> be transferred to the Complainant.

/Haig Oghigian/

Haig Oghigian

Sole Panelist

Date: February 6, 2023