

ADMINISTRATIVE PANEL DECISION

Atacadão - Distribuição, Comércio E Indústria LTDA. v. seong-chea park
Case No. D2022-4615

1. The Parties

The Complainant is Atacadão - Distribuição, Comércio E Indústria LTDA., Brazil, represented by IP Twins, France.

The Respondent is seong-chea park, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <atacado.com> is registered with Whois Corp. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 2, 2022. On December 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 5, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On December 6, 2022, the Center notified the Parties in both English and Korean that the language of the registration agreement for the disputed domain name is Korean. On December 7, 2022, the Complainant requested for English to be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the 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 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 10, 2023.

The Center appointed Kathryn Lee as the sole panelist in this matter on January 25, 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 Brazilian chain of warehouse stores established in 1960. In 2007, it was bought by Carrefour for BRL 2.2 billion. In 2022, the company has over 250 stores and distribution centers in all Brazilian states. The Complainant owns several trademark rights, including the Brazilian Trademark Number 006785344 for ATACADÃO registered on October 10, 1978, and Brazilian Trademark Number 006937497 for ATACADAO registered on May 25, 1979.

The Respondent appears to be an individual with an address in the Republic of Korea.

The disputed domain name was registered on January 17, 2004, and redirects to a blog page.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the ATACADÃO trademark in which the Complainant has rights. The Complainant explains that the only difference between its trademark and the disputed domain name is the tilde grapheme in its trademark registration that is not in the disputed domain name, but that the difference is almost imperceptible and does not prevent a finding that the two are identical or confusingly similar.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name and confirms that it has not authorized or licensed rights to the Respondent in any respect. The Complainant further contends that the disputed domain name currently redirects to an active website with no mention of the Complainant and that it has in the past resolved to a website offering the disputed domain name for sale, neither of which is use in connection with a *bona fide* offering of goods or services.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant explains that given the fame of the Complainant and its marks, it is inconceivable for the Respondent to have registered the disputed domain name without being aware of the Complainant and its marks, and that a quick trademark search would have shown results related to the Complainant and its trademarks. Further, the Complainant asserts that it is highly likely for the Respondent to have chosen the disputed domain name due to the similarity with the Complainant's mark with the expectation that Internet users searching for the Complainant's services and products would come across the disputed domain name. In addition, the Complainant notes that the current use of the disputed domain name is not in good faith and that by maintaining the disputed domain name, the Respondent is preventing the Complainant from reflecting its trademark in the corresponding domain name, and by offering the disputed domain name for sale, the Respondent is actively trying to make commercial gain off the reproduction of the Complainant's trademark.

B. Respondent

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

6. Discussion and Findings

A. Language

Paragraph 11(a) of the Rules provides that the language of the proceeding shall be the language of the registration agreement, unless otherwise agreed to by the parties, subject to the authority of the panel to determine otherwise. In this case, the language of the Registration Agreement is Korean, and both Parties have had an opportunity to argue their positions on this point. The Complainant requested for English to be the language of the proceeding, and the Respondent subsequently chose not to submit any response.

The Panel finds it proper and fair to render this decision in English. Given the fact that the Complainant is based in Brazil and the Respondent is based in the Republic of Korea, English would appear to be a neutral language for rendering this decision. Further, the disputed domain name is composed of Latin characters. Besides, both Parties were given the opportunity to submit arguments in the language of their preference, and the language in which to render the decision is reserved for the Panel. The Panel would have considered a Response in Korean, but no Response was submitted. Accordingly, the Panel determines that rendering the decision in English is fair and procedurally efficient given the circumstances of this case.

B. Identical or Confusingly Similar

The Complainant has demonstrated with supporting evidence that it has rights to the trademarks ATACADÃO and ATACADAO. As for the disputed domain name, it consists of this very mark except without the accent mark above “a” in the trademark ATACADÃO. Previous UDRP Panels have ruled that “minor typographical differences such as the inclusion or omission of grammatical marks such as hyphens and apostrophes are inadequate to avoid a finding of confusing similarity” (See for example, *L’Oreal v. Tracey Johnson*, WIPO Case No. [D2008-1721](#)). Further, according to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7, a domain name is considered confusingly similar to a trademark if it “incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name”. Here, the ATACADÃO mark is readily recognizable in the disputed domain name.

For the same reason, the disputed domain name is identical to the trademark ATACADAO.

For the reasons mentioned above, the Panel finds that the first element has been established.

C. Rights or Legitimate Interests

On the basis of the present record, the Panel finds that the Complainant has made the required allegations to support a *prima facie* case showing that the Respondent has no rights or legitimate interests in the disputed domain name. Once such a *prima facie* case has been established, the burden of production shifts to the Respondent to demonstrate its rights or legitimate interests in the disputed domain name, with the burden of proof always remaining with the Complainant. However, the Respondent in this case has chosen to file no Response to these assertions by the Complainant, and there is no evidence or allegation in the record that would warrant a finding in favor of the Respondent on this point.

The disputed domain name currently redirects to a blog on the Kakaostory platform showing photos of rocks with descriptions of the rocks. However, the term “ataca dao” appears nowhere on any of the blog entries, and coupled with the fact that “ataca dao” is a coined term, the Respondent’s forwarding of the disputed domain name to this blog appears to be an attempt to give the appearance of *bona fide* use. The Panel finds that this attempt was not convincing to show that the Respondent has rights or legitimate interests in the disputed domain name. Further, there is nothing in the record to suggest that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or has been commonly known by the disputed domain name, nor is there any evidence of the Respondent’s demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

For the reasons provided above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, and that the second element has been established.

D. Registered and Used in Bad Faith

The Panel finds that there is strong and clear evidence to find bad faith in this case.

The registration of the disputed domain name, which is identical to the Complainant's ATACADAO and ATACADÃO mark, a coined term, by the Respondent, who is unaffiliated with the Complainant, creates a presumption of bad faith. Further, based on the reputation of the Complainant and the Complainant's mark, the Respondent probably knew of the Complainant and its mark at the time of the registration of the disputed domain name. Even if the Respondent did not, a simple Google search would have shown numerous results on the Complainant. In fact, top results for "atacado" on the date of registration of the disputed domain name related to the Complainant.

Further, the Respondent has been the respondent in another UDRP case involving a domain name identical to a trademark of a Brazilian company (*Copersucar S.A., Copersucar - Cooperativa de Produtores de Cana-de-açúcar, Açúcar e Alcool do Estado de Sao Paulo v. Seong-chea Park*, WIPO Case No. [D2009-0502](#)). In the case, the panel decided that the respondent registered and used the domain name in bad faith and ordered the domain name to be transferred to the complainant. Based on this, under the circumstances of the present proceeding, the Respondent appears to have a special knowledge and familiarity with companies in Brazil, like the Complainant, despite having an address in the Republic of Korea. This also supports a finding of a pattern of bad faith on the part of the Respondent preventing trademark holders from reflecting their marks in domain names.

Currently, the disputed domain name redirects to a blog page with various photos of rocks but there is no mention of the term "atacado" at all. Based on the circumstances, and with no explanation from the Respondent as to why he registered the disputed domain name, the Panel is of the conclusion that the Respondent has linked the disputed domain name to the blog in order avoid a possible negative UDRP decision.

For the reasons given above, the Panel finds that the third element has been established.

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, <atacado.com>, be transferred to the Complainant.

/Kathryn Lee/

Kathryn Lee

Sole Panelist

Date: February 8, 2023