

## **ADMINISTRATIVE PANEL DECISION**

**Carrefour Comércio e Indústria Ltda. v. Ha Nguyen**  
**Case No. D2023-0007**

### **1. The Parties**

The Complainant is Carrefour Comércio e Indústria Ltda., Brazil, represented by Dannemann Siemsen, Brazil.

The Respondent is Ha Nguyen, Viet Nam.

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

The disputed domain names <butantashopping.com> and <jardimpamplonashopping.com> are registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 2, 2023. On January 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 4, 2023, the Registrar transmitted by email to the Center its verification response concerning the domain name <butantashopping.com> confirming that the Respondent is listed as the registrant and providing the contact details and contact information in the Complaint. The Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <jardimpamplonashopping.com> on January 12, 2023. On January 13, 2023, the Registrar transmitted by email to the Center its verification response concerning the domain name <jardimpamplonashopping.com> confirming that the Respondent is listed as the registrant and providing the contact details and contact information in the Complaint. The Registrar also informed the Center that this domain name was deleted by the Respondent. The Center sent two email communications to the Registrar and to the Parties on January 16, 2023 asking them to take the necessary actions required to restore the domain name in order for the proceeding to continue. The Registrar confirmed to the Center on February 3, 2023 that the domain name had been restored.

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 February 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 9, 2023.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on March 20, 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 the largest food retail group in Brazil. It was first opened in the country in the city of Sao Paulo in the year 1975.

In addition to the traditional hypermarkets establishments and supermarkets, the Complainant also owns Butantã Shopping mall, opened on May 3, 1994 and Jardim Pamplona Shopping mall, opened in 2017.

The Complainant is the owner of following Brazilian trademark registrations:

Trademark Registration No. 911722963 BUTANTÃ SHOPPING and design, registered on June 19, 2018, in class 36;

Trademark Registration No. 912153121 JARDIM PAMPLONA and design, registered on October 9, 2018, in class 35 and

Trademark Registration No. 907991297 JARDIM PAMPLONA and design, registered on February 7, 2017, in class 35.

Also, the domain names <jardimpamplonashopping.com.br> and <butantashopping.com.br> have been protected by the Complainant since 2015 and 2016, respectively.

The disputed domain names <butantashopping.com> and <jardimpamplonashopping.com> were both registered on October 28, 2022.

The disputed domain names resolved to sites with sexual content. Both disputed domain names are on offer for sale at Dynadot.com for the price of USD 600 each.

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

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

Due to its renown in the shopping malls field, it is undeniable that trademarks BUTANTÃ SHOPPING and JARDIM PAMPLONA are automatically associated to the Complainant and its services.

The Complainant claims that the disputed domain name is confusingly similar to its trademarks BUTANTÃ SHOPPING and JARDIM PAMPLONA in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain names, which were registered and are being used in bad faith.

The disputed domain names <jardimpamplonashopping.com> and <butantashopping.com> resolved to sites with sexual content and then were offered for sale.

The Complainant claims that, as the Respondent does not use the disputed domain names in connection with active websites, merely offering them for sale, it is clear that they were registered with the only purpose of selling them to the Complainant or its competitors.

The Respondent is not known as the disputed domain names, nor has been authorized to register the Complainant's trademarks as domain names. The Complainant is the only owner of the trademark registrations in the Brazilian Patent and Trademark Office for the BUTANTÃ SHOPPING and JARDIM PAMPLONA trademarks.

It is clear that the Respondent, aware of the fame and goodwill attached to both marks, has been trying to create an association with the Complainant, taking a free ride on the goodwill developed over its trademarks, even offering them for sale.

Finally, the Complainant requests the Panel to issue a decision ordering the transfer of the disputed domain names to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain names are confusingly similar to the Complainant's BUTANTÃ SHOPPING and JARDIM PAMPLONA trademarks.

The disputed domain names incorporate the Complainant's trademarks BUTANTÃ SHOPPING and JARDIM PAMPLONA in their entirety.

The ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name <butantashopping.com> is identical and the disputed domain name <jardimpamplonashopping.com> is confusingly similar to the Complainant's

BUTANTÃ SHOPPING and JARDIM PAMPLONA trademarks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy sets out the following several circumstances which, without limitation, if found by the Panel, shall demonstrate that the respondent has rights to or legitimate interests in a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- before any notice to the respondent of the dispute, the respondent's use of, or 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; or
- the respondent (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is 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.

The Complainant has proved that it owns the BUTANTÃ SHOPPING and JARDIM PAMPLONA trademarks. There is no indication that they have licensed or otherwise permitted the Respondent to use any of their trademarks, nor have they permitted the Respondent to apply for or use any domain name incorporating its trademarks.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein. The name of the Respondent does not resemble the disputed domain name in any manner.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other element to prove that the Respondent has legitimate interests or that it has established rights in the disputed domain names.

The disputed domain names resolved to sites with sexual content and are offered for sale in Dynadot.com, which does not constitute any legitimate interests.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain names.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

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

The Panel is satisfied that the Respondent must have been aware of the Complainant's trademarks BUTANTÃ SHOPPING and JARDIM PAMPLONA mentioned in section 4 above (Factual Background) and also the Complainant's websites "www.butantashopping.com.br" and "www.jardimpamplonashopping.com.br" when it registered the disputed domain names on October 28, 2022. By that time, the Complainant had registered and used the trademarks BUTANTÃ SHOPPING and JARDIM PAMPLONA for several years.

By registering the disputed domain names, the Respondent was targeting the Complainant and its business by incorporating the Complainant's trademarks BUTANTÁ SHOPPING and JARDIM PAMPLONA in the disputed domain names in their entirety.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain names, the nature of the disputed domain names and the fact that they resolved to sites with sexual content and were offered for sale, are indicative of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)).

Currently, the disputed domain name <jardimpamplonashopping.com> does not resolve to an active webpage. Pursuant to section 3.3 of [WIPO Overview 3.0](#), the fact that the disputed domain name does not resolve to any active website does not prevent a finding of bad faith under the doctrine of "passive holding". See also *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Panel finds that the Respondent registered and is using the disputed domain names in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

## 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 names <butantashopping.com> and <jardimpamplonashopping.com> be transferred to the Complainant.

*/Miguel B. O'Farrell/*

**Miguel B. O'Farrell**

Sole Panelist

Date: March 27, 2023