

## **ADMINISTRATIVE PANEL DECISION**

**Carrefour SA, Atacadão - Distribuição, Comércio e Indústria Ltda. v. LUAN ALVES RIBEIRO**

**Case No. D2023-1546**

### **1. The Parties**

The Complainants are Carrefour SA, France (the “First Complainant”), and Atacadão - Distribuição, Comércio e Indústria LTDA., Brazil (the “Second Complainant”), represented by IP Twins, France.

The Respondent is LUAN ALVES RIBEIRO, Brazil.

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

The disputed domain name <atacadaoshopbrasil.com> 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 April 7, 2023. On April 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 11, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainants on April 27, 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 April 27, 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 May 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2023. The Respondent sent email communications to the Center on May 4, 2023, and on May 9, 2023. The Complainants requested a suspension of proceedings on May 4, 2023 and, on the same date, the Center sent a Notification of Suspension to the parties. The Complainants

requested the reinstatement of proceedings on May 9, 2023, and submitted a second amended Complaint. The Center reinstated the proceedings on May 10, 2023 and indicated that the due date for response was May 28, 2023. The Center informed the parties that it would proceed to panel appointment on June 9, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on June 23, 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 exploits the retail business since 1968, operating 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 250 stores and distribution centers in all Brazilian states.

The Second Complainant is the owner of the following trademark registrations:

- 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 ATACADÃO, filed on March 21, 1978, registered on May 25, 1979, successively renewed, in local class 35.10/20/30

The disputed domain name was registered on March 1, 2023. The disputed domain name resolved to an inactive website. In accordance with the evidence submitted in the second amended Complaint, the disputed domain name resolved to a web site purportedly offering various products for sale and displaying the Complainant's trademark ATACADÃO. Presently, when attempting to access the disputed domain name browsers display a message alerting of potential harmful content associated with the disputed domain name.

#### **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 ATACADÃO trademark enjoys a wide-spread continuous reputation, being the disputed domain name highly similar thereof given its entire reproduction with the addition of the generic terms "shop" and "brasil" 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 ATACADÃO;
- ii. the Respondent has not been commonly known by the disputed domain name as an individual, business, or other organization;

- iii. 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 resolved to a web site offering various products for sale (Annex 8 to the amended Complaint), also not displaying said web site any element as to clarify or disclaim the relationship between the Respondent and the Complainants.

The Complainants further contend 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 on ATACADÃO, necessarily having the Respondent 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 contend that the use of the disputed domain name in connection with an online store is a further evidence of bad faith on the part of the Respondent, being it clear that the Respondent is actively trying to benefit from the renown and fame of the Complainants and their brands to make commercial gain, by creating confusion in the mind of the Internet user of average attention. The Complainants further submit that the Respondent choose to use a privacy protection service in an attempt to escape the present proceeding. Lastly, the Complainants uncovered that the Respondent also registered other domain names that reproduce trademarks owned by third parties, such as <vendamaisiphone.com.br>, indicating that the Respondent has engaged in a pattern of bad faith conduct.

## **B. Respondent**

On May 4, 2023 the Respondent informed that it was seeking legal assistance to deal with this case but was "open to negotiations" and therefore would be willing to "give up this domain and all the branding done for my business brand" given that "I already have many clients and I will have to do a whole lot of work to change the name and gain credibility again", therefore "await a considerable proposal from the claimant, otherwise I will start the judicial process in Brazil".

On May 9, 2023 the Respondent sent a second informal message stating that "I am open to negotiations so that I can sell this domain to the claimant. This will help me recoup the branding and marketing spend around Atacadao Shop Brasil. The initial proposal, aiming to cover all my investment, fees, clients and amounts spent with advertisements for the site, I have an initial sale proposal for U\$ 5,000.00 being open to negotiations. As soon as the payment is made, I will transfer the ownership of the domain and start the new brand project. If this possibility of sale is not accepted, I will file a lawsuit in Brazil".

No further message or formal reply was submitted by the Respondent.

## **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 mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms "shop" and "brasil" 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' mark reputation and the displaying of the Complainants' mark ATACADÃO in the website associated with the disputed domain name shows that the Respondent registered the disputed domain name with the Complainants' mark in mind.

The Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainants or to a competitor of the Complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name. Paragraph 4(b)(i) of the Policy, and [WIPO Overview 3.0](#), section 3.1.1.

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

In the present case, the Panel further notes that the Respondent's bad faith conduct is also evidenced by the Respondent's choice to retain a privacy protection service and registration of other domain names that reproduce well-known third parties trademarks.

Based on the available record, the Panel finds the third element of the Policy 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 <atacadaoshopbrasil.com> be transferred to the Complainants.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: July 7, 2023