

## **ADMINISTRATIVE PANEL DECISION**

Carrefour SA v. Luis Bertoldo

Case No. D2023-1611

### **1. The Parties**

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

The Respondent is Luis Bertoldo, Brazil.

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

The disputed domain name <carrefoursolucaofinanceira.info> is registered with One.com A/S (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 13, 2023. On April 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 14, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Registrar also informed that the language of registration agreement is different from the language of the Complaint. The Center sent an email communication to the Complainant on April 17, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 19, 2023. The Center informed the Parties about the language of the proceeding and, on April 27, 2023, the Complainant submitted an amendment to the Complaint, requesting English as language of proceeding.

The Center verified that the Complaint, together with the amendment to the Complaint and 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 did not submit any response. Accordingly, the Center notified the Respondent’s default on June 9, 2023.

The Center appointed Gonalo M. C. Da Cunha Ferreira as the sole panelist in this matter on June 14, 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 worldwide leader in retail and a pioneer of the concept of hypermarkets since 1968. With a turnaround of EUR 76 billion in 2018, the Complainant is listed on the index of the Paris Stock Exchange (CAC 40). The Complainant operates more than 12,000 stores in more than 30 countries worldwide with more than 384,000 employees worldwide and 1.3 million daily unique visitors in its stores and is considered a major and well-known worldwide leader in retail. The Complainant also offers travel, banking, insurance, and ticketing services. The Complainant owns several hundred trademark rights worldwide in the CARREFOUR term. The earliest registration of the CARREFOUR mark is under International registration number 351147, registered on October 2, 1968. The Complainant is also the owner of numerous domain names identical to its trademarks, both within generic and country code Top-Level Domains. The Complainant's social media pages are currently "liked" or "followed" by more than 11 million Internet users.

The disputed domain name was registered on January 20, 2023, and it resolves to an inactive page.

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

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

The Complainant argues that:

- a) there is no evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization.
- b) the Respondent reproduces the Complainant's earlier registered trademarks CARREFOUR in the disputed domain name without any license or authorization from the Complainant
- c) has not authorized the use of the terms "carrefour" in the disputed domain name in any manner or form.
- d) the Respondent has not, before the original filing of the Complaint, used or made preparations to use the disputed domain name in relation to a *bona fide* offering of goods or services.
- e) the disputed domain name resolves to an error page.
- f) since the adoption and extensive use by the Complainant of the trademark CARREFOUR predates the registration of the disputed domain name, the burden is on the Respondent to establish the Respondent's rights or legitimate interests the Respondent may have or have had in the disputed domain name.
- g) the Respondent has registered and is using the disputed domain name in bad faith
- h) its trademarks were so widely well-known, that it is inconceivable that the Respondent ignored the Complainant or its earlier rights on the terms CARREFOUR.
- i) enjoys a long-lasting worldwide reputation, which has now been established by panels for years.

- j) the Respondent's choice of domain name cannot have been accidental and must have been influenced by the fame of the Complainant and its earlier trademarks.
- k) the Respondent knew or should have known that, when acquiring and using the disputed domain name, it would do so in violation of the Complainant's earlier rights.
- l) 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 marks.
- m) the current absence of use of the domain name may not be considered a good faith use of the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **Language**

The language of the registration agreement was in the Portuguese language, but the Complainant requested the proceedings to be conducted in English.

Pursuant to paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the default language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise.

Paragraph 10 of the UDRP Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

Although the Respondent was duly notified in both Portuguese and English of the language of the proceeding, and of the Complaint, the Respondent did not make any submissions regarding the language of the proceeding, and did not file any response in either Portuguese or English.

Taking into account the circumstances of this case, the Panel determines that English is the language of proceedings.

### **Substantive Matters**

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. Under paragraph 4(a) of the Policy, the Complainant must prove each of the following: (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.

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

The disputed domain name is confusingly similar to the trademark CARREFOUR. The disputed domain name includes the trademark CARREFOUR, followed by the terms in Portuguese "solucao" and "financeira" (meaning, "financial solution"). It is well established case law that the addition of a term to a trademark in a domain name does not prevent a finding of confusing similarity.

Accordingly, the Panel finds that the Complainant's trademark is recognizable within the disputed domain name and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has no connection to or affiliation with the Complainant and the Complainant has not licensed nor given its consent to the Respondent to use or register any domain name incorporating the Complainant's trademarks. The Respondent did not submit a response and has failed to invoke any circumstance which could have demonstrated rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy.

The Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

The Panel, based on the evidence presented, accepts and agrees with the Complainant's contentions that the disputed domain name was registered and has been used in bad faith.

The Complainant and its trademarks are so widely well-known, that it is inconceivable that the Respondent ignored the Complainant or its earlier rights and it is highly likely that the Respondent chose the disputed domain name because of its similarity to the trademark.

Previous panels have established that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. In this case, a quick Internet search for "Carrefour" would have revealed to the Respondent the existence of the Complainant and its trademarks.

The disputed domain name does not resolve to an active website and appears to be passively held. From the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Noting: (i) the degree of distinctiveness and reputation of the Complainant's trademark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the implausibility of any good faith use to which the inherently misleading disputed domain name may be put, the Panel finds that the passive holding of the disputed domain name does not prevent a finding of bad faith.

Accordingly, the Panel finds, based on the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith. Therefore, the Complainant has satisfied paragraph 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 <carrefoursolucaofinanceira.info> be transferred to the Complainant.

*/Gonçalo M. C. Da Cunha Ferreira/*

**Gonçalo M. C. Da Cunha Ferreira**

Sole Panelist

Date: June 28, 2023