

ADMINISTRATIVE PANEL DECISION

Carrefour SA, Atacadão S.A. v. Joao Pedro Rodrigues
Case No. D2023-2980

1. The Parties

The Complainants are Carrefour SA, France, and Atacadão S.A., Brazil (hereinafter referred both together as the Complainant), represented by IP Twins, France.

The Respondent is Joao Pedro Rodrigues, Brazil.

2. The Domain Name and Registrar

The disputed domain name <atacadaosa.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 July 12, 2023. On July 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 18, 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 July 21, 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 July 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 16, 2023. The Respondent sent an email to the Center on July 18, 20, and 27, 2023.

The Center appointed Mario Soerensen Garcia as the sole panelist in this matter on September 12, 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 Complainants are Carrefour SA and Atacadão S.A.

The Complainant Carrefour is a worldwide leader in the hypermarket segment since 1968. It operates more than 12,000 stores with more than 384,000 employees worldwide and there are 1.3 million daily visitors at its stores.

The Complainant Atacadão is a Brazilian chain of wholesale stores established in 1960 and acquired by Carrefour in 2007. With over 300 stores and distribution centers in all the Brazilian states and more than 70,000 employees, Atacadão is the largest wholesale network in Brazil.

The Complainant Atacadão began an internationalization program, expanding its activities to other countries beyond Brazil. Since Atacadão is part of the Carrefour Group, the companies opted to join in the present Complaint.

Both companies are hereinafter referred to as “the Complainant.”

The Complainant is the owner of several ATACADAO and ATACADÃO trademarks registered before the registration of the disputed domain name, such as:

- European Union trademark registration No. 012020194, for ATACADAO, registered on May 24, 2015, in international class 35;
- Brazilian trademark registration No. 006785360, for ATACADÃO, registered on October 10, 1978, in international class 29;
- Argentinean trademark registration No. 2426312, for ATACADAO, registered on February 24, 2011, in international class 35;
- Moroccan trademark registration No. 97-148034, for ATACADAO, filed on November 9, 2012, in international class 35.

The Complainant also owns numerous domain names comprising the mark ATACADAO, including the domain name <atacado.com.br>, registered on October 9, 1997.

The disputed domain name was registered on May 11, 2023 and resolves to a webpage informing that the disputed domain name is for sale.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name entirely reproduces the Complainant's trademark ATACADAO, in addition to the term “sa,” which is an abbreviation of the expression “Sociedade Anônima” (the equivalent in Portuguese for a “joint-stock company”). The addition of “sa” refers to the Complainant's type of business organization and would not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark. On the contrary, the addition of “sa” would enhance the risk of confusion as it makes the disputed domain name identical to the Complainant's corporate name ATACADÃO S.A.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name and there is no evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization.

The Complainant informs that it has not authorized the use of its earlier trademarks in the disputed domain name in any manner or form.

The Complainant mentions that it is impossible that the Respondent did not have the Complainant's trademark ATACADAO in mind while registering the disputed domain name.

The Complainant states that the disputed domain name is not connected with an active website but resolves to a parking page rendered by the registrar GoDaddy where the following message appears: "This domain is available for sale." The disputed domain name is offered for sale for USD 12,000. The Complainant argues that this use cannot be considered a *bona fide* offering of goods or services as contemplated by the Policy nor a legitimate noncommercial or fair use.

The Complainant argues that the disputed domain name was therefore registered by the Respondent primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant 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, in bad faith pursuant to paragraph 4(b)(i) of the Policy.

Finally, the Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent was identified as Joao Pedro Rodrigues, from Brazil.

On July 18, 2023, the Respondent replied to the Complainant's contentions, stating the following:

"Hello, I received this message today, if you want to acquire the domain, answer yes or no! If they continue with the threats, I will publish the case publicly on the Internet, and as you already know Carrefour has a "great reputation" on the Internet, every year Carrefour is in the Trending Topics of Twitter due to some negative news, and apparently this will be another one.

If you want to end this, just pay for the domain! And for the threats I will return the price to the original value of 12 thousand USD!

If you want to continue, it's your choice!"

On July 20, 2023, the Respondent replied to the Complainant's contentions, stating the following:

"I'm already sharing on social media the threats that Carrefour is making against me in Brazil!

I'm already posting on social media and I'm going to look for journalists to show who you really are!

Using the power of your group against one person! You can be sure that I will expose everything that you are doing!"

On July 27, 2023, the Respondent replied to the Complainant's contentions, stating the following:

"I can't understand, I don't speak English and the translation isn't understandable!

But it seems like you are charging me 1000 USD, if this is the case I will sue Carrefour in the courts in Brazil and publicize it on social media and protest in front of the Carrefour and Atacadão groups!

You've even threatened me on my personal Instagram profile and now you want me to pay you?"

The above message was the last reply from the Respondent.

6. Discussion and Findings

As per paragraph 4(a) of the Policy, the Complainant must prove that:

- (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 evidence presented demonstrates that the Complainant is the owner of several trademark registrations for ATACADAO and ATACADÃO (hereinafter referred both together as “ATACADAO”).

The disputed domain name incorporates the Complainant’s ATACADAO trademark in its entirety. The element “sa,” added to the disputed domain name, is the abbreviation of “Sociedade Anônima,” which is the Portuguese expression for “joint-stock company.” This addition does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) at section 1.8.

As numerous prior UDRP panels have recognized, the incorporation of a trademark in its entirety or a dominant feature of a trademark is sufficient to establish that a domain name is identical or confusingly similar to the Complainant’s registered mark. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

The Panel finds that paragraph 4(a)(i) of the Policy has been proved by the Complainant, *i.e.*, the disputed domain name is confusingly similar to the Complainant’s trademarks.

B. Rights or Legitimate Interests

The Respondent submitted responses to the Complaint, making an offer of USD 12,000 (EUR 10,938) for the disputed domain name and threatened the Complainant of negative publicity.

There is no evidence that the Respondent has any authorization to use the Complainant’s trademark or to register domain names containing the trademark ATACADAO.

There is no evidence that the Respondent is commonly known by the disputed domain name.

There is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name or that before any notice of the dispute the Respondent has made 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.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(ii) of the Policy has been satisfied, *i.e.*, the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The trademark ATACADAO is registered by the Complainant in many jurisdictions and has been used for decades. The Complainant’s trademarks predate the registration of the disputed domain name. The disputed domain name reproduces the Complainant’s ATACADAO trademark in its entirety together with “sa”, abbreviation of “Sociedade Anônima.” The Panel further notes that one of the Complainants is Atacadão S.A.

The Complainant's trademark has strong reputation in Brazil, where the respondent is resident. The disputed domain name reproduces the Complainant's trademark ATACADAO, and the Respondent has no rights or legitimate interests in the disputed domain name.

It has been established in prior UDRP decisions that when the respondent knew or should have known a trademark prior to registering the disputed domain name, such conduct may be, in certain circumstances, sufficient evidence of bad faith registration and use. See *Weetabix Limited v. Mr. J. Clarke*, WIPO Case No. [D2001-0775](#).

Moreover, the disputed domain name resolves to a webpage offering the disputed domain name for sale. Likewise, the Respondent's e-mails offering to sell the disputed domain name to the Complainant for USD 12,000 provide additional evidence that the Respondent has registered and used the disputed domain name for purposes of profit at the expenses of the Complainant. The files of the case demonstrate that the Respondent tried to sell the disputed domain name for a value much higher than what the Respondent might have spent to register and maintain the disputed domain name. According to Policy 4(b)(i), this behavior can be considered evidence of registration and use of a domain name in bad faith.

Therefore, this Panel finds that the disputed domain name is inherently likely to mislead Internet users, and the Respondent's use of the disputed domain name in this manner indicates neither a *bona fide* offering of goods or services under Policy, nor a noncommercial or fair use of the domain name under Policy.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(iii) of the Policy has been satisfied, *i.e.*, the disputed domain name has been registered and used in bad faith.

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

/Mario Soerensen Garcia/

Mario Soerensen Garcia

Sole Panelist

Date: September 26, 2023