

ADMINISTRATIVE PANEL DECISION

Carrefour SA and Atacadão S.A. v. atacado varejo
Case No. D2023-3011

1. The Parties

The Complainant is Carrefour SA, France and Atacadão S.A., Brazil, represented by IP Twins, France.

The Respondent is atacado varejo, Brazil.

2. The Domain Name and Registrar

The disputed domain name <atacadaovarejo.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 13, 2023. On July 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 17, 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 (Registration Private / Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 28, 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 August 2, 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 August 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 29, 2023.

The Center appointed Alvaro Loureiro Oliveira as the sole panelist in this matter on September 19, 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 is the French company Carrefour SA, a leader in retail in the world, specialized in hypermarkets. This Complainant operates over 12,000 stores in more than 30 countries worldwide, with 384,000 employees and over 1,3 million daily visitors. This Complainant additionally offers travel, banking, insurance or ticketing services.

The second Complainant is the Brazilian company Atacadão - Distribuição, Comércio E Indústria LTDA., which is a Brazilian chain of warehouse stores established in 1960.

The first Complainant, Carrefour SA, is the owner of the second Complainant, Atacadão – Distribuição, Comércio E Indústria LTDA. Specifically, the second Complainant was bought by the first Complainant in 2007. The second Complainant has over 300 stores and distribution centers in all Brazilian states.

The Complainants are the owners of several trademark registrations comprising the word element ATACADAO and ATACADÃO (hereinafter referred to indistinctively as “the Trademark”), including, but not limited to, the European Union Trademark registration for ATACADAO (word mark), with registration no. 012020194 registered on May 24, 2015, for services in class 35; Brazilian trademark registration for ATACADÃO, no. 006785360 registered on October 10, 1978 for goods in class 29; and the Brazilian trademark registration for ATACADÃO (word mark), with registration no. 006785344 registered on October 10, 1978, for goods in class 31 (evidence of these registrations figure as Annexes 4-1, 4-2 and 4-5).

The disputed domain name was registered on April 10, 2023, and resolves to an error page.

5. Parties' Contentions

A. Complainant

The Complainants state that the disputed domain name is confusingly similar to the Trademark – in fact, the disputed domain name includes the Trademark in its entirety, followed by the term “varejo”, which is the Portuguese word for “retail”, or “sale”, directly related to the services provided by the Complainants under the Trademark.

The Respondent has no rights nor legitimate interests in the disputed domain name, whereas the Respondent has not acquired any trademark rights with respect to the disputed domain name. As stated by the documents presented, the registration and use of the trademark ATACADAO predates the registration of the disputed domain name in decades.

Moreover, the Respondent is not commonly known by the disputed domain name. The Respondent has also not secured a license nor any other authorization from the Complainants to use the Trademark. Lastly, the disputed domain name does not direct to an active website – in fact, it directs to an apparently malevolent use, as the browser protection flashes a warning sign, and if this sign is ignored it leads to an error page. Evidence of this is presented as Annexes 9-1-1 and 9-1-2 to the Complaint.

In sum, the Complainants allege that it is clear that the Respondent has no rights or legitimate interests in the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

The Policy, in its paragraph 4(a), determines that three elements must be present and duly proven by a complainant to obtain relief. These elements are:

- i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- ii. the respondent has no rights or legitimate interests in respect to 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 ATACADAO trademark, as the latter is entirely incorporated in the disputed domain name, with the mere addition of the Portuguese term "varejo".

The Complainants have presented consistent evidence of ownership of the trademark ATACADAO and ATACADÃO in jurisdictions throughout the world, by presenting international registrations for it, as well as comprehensive evidence of the use of the trademark for over decades.

The use of the trademark with the addition of the Portuguese term "varejo" in the disputed domain name does not prevent a finding of confusing similarity with the Trademark.

The Trademark is clearly recognizable in the disputed domain name, and as set out in the [WIPO Overview 3.0](#), section 1.8, the addition of other terms would not prevent a finding that a disputed domain name is confusingly similar to the relevant mark for purposes of the first element.

Lastly, the Panel notes that, in accordance with section 1.11.1 of the [WIPO Overview 3.0](#), the generic Top-Level Domain ("gTLD") ".com" is in principle disregarded under the first element.

Given the above, the Panel concludes that the disputed domain name is confusingly similar to the registered trademark of the Complainants.

B. Rights or Legitimate Interests

The Panel notes that the Trademark is widely known as identifying the Complainants' activities, and that the Complainants have not licensed this to the Respondent.

Furthermore, the Respondent does not appear to be commonly known by the disputed domain name.

It has also been shown that the Respondent is not making any direct use of the disputed domain name, noting the disputed domain name directs to an apparently malevolent use, as the browser protection flashes a warning sign, and if this sign is ignored it leads to an error page. The Respondent is not making a noncommercial or fair use of the disputed domain name, nor a *bona fide* offering of goods or services.

The Panel finds that the Complainants have established *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. In the absence of a Response, the Respondent has not rebutted such *prima facie* case. The mere use of the terms "atacado varejo" as registrant's details for the registration of the disputed domain name does not show that the Respondent has any rights or legitimate interests in it.

The Panel, thus, finds for the Complainants under the second element of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent has probably registered the disputed domain name with the purpose of taking unfair advantage of the Complainants' mark.

The disputed domain name reproduces the Trademark in its entirety, with the addition of the term "varejo", which is the Portuguese word for "retail" or "sale".

The composition of the disputed domain name points towards the Respondent's likely intent to give an impression that the disputed domain name is associated with the Complainants. In the absence of any reasonable explanation for the selection of the disputed domain name by the Respondent, and in the circumstances of this case, the Panel finds that it is more likely than not that the disputed domain name has been registered to take unfair advantage due to its value as a trademark owned by the Complainants.

The current apparent passive holding of the disputed domain name is also evidence of bad faith from the Respondent. Previous UDRP panels have found that the apparent lack of so-called active use of the disputed domain name, without any active attempt to sell or to contact the trademark holder, does not prevent a finding of bad faith. See, e.g., *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also *Redcats S.A. And La Redoute S.A. v. Tumay Asena*, WIPO Case No. [D2001-0859](#); and *DCI S.A. v. Link Commercial Corporation*, WIPO Case No. [D2000-1232](#).

Here, the Panel notes the distinctive and well-known nature of the Trademark, the failure of the Respondent to submit a Response, and the implausibility of any good faith use to which the disputed domain name may be put, support a finding of bad faith.

In the totality of the circumstances, the Panel finds the Respondent has registered and is using the disputed domain name 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, <atacadaovarejo.com>, be transferred to the Complainant.

/Alvaro Loureiro Oliveira/

Alvaro Loureiro Oliveira

Sole Panelist

Date: October 3, 2023