

## **ADMINISTRATIVE PANEL DECISION**

Carrefour SA. v. Manuela Silva

Case No. D2023-3069

### **1. The Parties**

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

The Respondent is Manuela Silva, Brazil.

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

The disputed domain name <app-carrefoursolucoes.com> is registered with Google LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2023. On July 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 19, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 19, 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 in English on July 19, 2023.

On July 19, 2023, the Center transmitted an email communication to the parties in English and Portuguese regarding the language of the proceeding, as the Complaint has been submitted in English and the language of the registration agreement for the disputed domain name is Portuguese. On the same day, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 17, 2023.

The Center appointed Gonçalo M. C. Da Cunha Ferreira as the sole panelist in this matter on August 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**

According to the Complaint, the Complainant is a worldwide leader in retail and a pioneer of the concept of hypermarkets since 1968. With a turnaround of EUR 80,7 billion in 2019, 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 321,000 employees worldwide, 11 million of daily checkout in its stores 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, designating goods in international classes 01 to 34 and International trademark CARREFOUR No. 353849, registered on February 28, 1969, designating services in international classes 35 to 42.

The Complainant enjoys a strong presence in Brazil, where it manages hundreds of stores of various sizes. The first Brazilian CARREFOUR hypermarket was opened in 1975. The website of the banking business of the Complainant dedicated to its Brazilian customers, Carrefour Soluções Financeiras, is available at "www.carrefoursolucoes.com.br".

The Complainant's social media pages are currently "liked" or "followed" by more than 11.9 million Internet users. The disputed domain name was registered on April 5, 2023, and it resolves to an inactive page.

In addition, the Complainant is also the owner of numerous domain names identical to its CARREFOUR trademarks, both within generic and country-code Top-Level domains. For instance, <carrefour.com> has been registered since 1995.

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

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

The Complainant claims that:

a) the disputed domain name is highly similar to the earlier well-known trademarks CARREFOUR once the disputed domain name reproduces the earlier trademark CARREFOUR in its entirety, together with terms "app" and "solucoes" a Portuguese word translated by "solutions" which is part of the name of the banking business of the Complainant in Brazil is "Carrefour Soluções Financeiras".

The addition of "solucoes" and "app" in the case of the disputed domain name aggravates the risk of confusion among Internet users, as the disputed domain name will lead them to believe it is associated with the banking services mobile app of the Complainant's Brazilian subsidiary.

b) the Respondent has no rights or legitimate interests in respect of the disputed domain name since:

i. the Complainant performed searches and found no CARREFOUR trademark owned by the Respondent, the Complainant did not find a CARREFOUR SOLUCOES (with and without special characters), or APP CARREFOUR trademark that would grant the Respondent rights in the disputed domain name as well, therefore the Complainant asserts that the Respondent has acquired no trademark in the terms “carrefour”, “carrefour solucoes” or “app carrefour” which could have granted the Respondent rights in the disputed domain names.

ii. the Respondent reproduces the Complainant’s earlier registered trademarks CARREFOUR in the disputed domain name without any license or authorization from the Complainant, which is a strong evidence of the lack of legitimate interest. The Complainant submits that it has not authorized the use of the term “carrefour” in the disputed domain name in any manner or form.

iii. the Complainant puts forth that 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.

The disputed domain name redirects towards an error page.

iv. the adoption and extensive use by the Complainant of the trademark CARREFOUR predates the registration date of the disputed domain name therefore the Complainant argues that 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.

c) the Complainant argues that the Respondent has registered and is using the disputed domain name in bad faith, for the following reasons:

i. the Complainant and its trademarks were so widely well-known, that it is inconceivable that the Respondent ignored the Complainant or its earlier rights on the term “carrefour”.

ii. it is very likely that the Respondent chose the disputed domain name because of its identity or similarity to a trademark in which the Complainant has rights and legitimate interest and according to the Complainant this was most likely done in the hope and expectation that Internet users searching for the Complainant’s services and products would instead come across the Respondent’s site.

The Complainant thus states that 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. The Respondent knew, when acquiring and using the disputed domain name, that it would do so in violation of the Complainant’s earlier rights. The search requests on “carrefour solucoes” and “app carrefour solucoes” result to the official website “Carrefour Soluções Financeiras” managed by the subsidiary of the Complainant. This further suggests that the Respondent had the Complainant in mind when registering the disputed domain name.

iii. the Complainant’s CARREFOUR trademark registrations significantly predate the registration date of the disputed domain name.

iv. Although the disputed domain name is not actively used, the Complainant contends that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding.

## **B. Respondent**

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

## 6. Discussion and Findings

### Language

The language of the registration agreement for the disputed domain name is in the Portuguese language and the Complainant requests to conduct the proceedings in English. Pursuant to paragraph 11 of the Rules, the Panel has authority to determine the language of proceedings. As it is reminded in section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), “panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement”. Facing the arguments of the Complainant, namely that the Complainant is not able to effectively communicate in Portuguese, being a French entity, the Complainant is not in a position to conduct the proceedings in Portuguese without a great deal of additional expense and delay, and that the English language is not the native language of the Complainant, therefore conducting the proceedings in English would not represent unfair advantage to the Complainant over the Respondent, and the circumstances of this case including the absence of a reply from the Respondent both to the Complainant’s language request and to the Complaint, 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 incorporates the CARREFOUR trademark in its entirety, with the term “app” and the term “solucoes”. As the trademark is clearly recognizable within the disputed domain name, the addition of these terms with a hyphen does not prevent a finding of confusing similarity.

Accordingly, the Panel finds 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. As highlighted in several previous UDRP decisions, in such a case the burden of production shifts to the Respondent to rebut the *prima facie* case (see [WIPO Overview 3.0](#), section 2.1). 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. Additionally, the Panel finds that the nature of the disputed domain name, incorporating the Complainant’s trademark in its entirety with the terms “app” and “solucoes” points to an intention to confuse Internet users seeking for or expecting the Complainant especially bearing in mind that the subsidiary of the Complainant “Carrefour Soluções Financeiras” manages its official website at “www.carrefoursolucoes.com.br”.

In this sense, the Respondent does not appear to make any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services. Based on the available record, the disputed domain name resolves to an inactive webpage. 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 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 confusing similarity with the Complainant's trademarks.

Also, the disputed domain name resolves to an inactive webpage. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the degree of distinctiveness and reputation of the Complainant's CARREFOUR mark, the failure of the Respondent to submit a response and the Respondent's use of a privacy service to conceal its identity are all circumstances that indicate the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

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 <app-carrefoursolucoes.com> be transferred to the Complainant.

*/Gonçalo M. C. Da Cunha Ferreira/*

**Gonçalo M. C. Da Cunha Ferreira**

Sole Panelist

Date: September 11, 2023