

ADMINISTRATIVE PANEL DECISION

Carrefour SA v. Eleganzia Express, Sell Better Negocios Digitais LTDA
Case No. D2023-4919

1. The Parties

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

The Respondent is Eleganzia Express, Sell Better Negocios Digitais LTDA, Brazil.

2. The Domain Names and Registrar

The disputed domain names <carrefourfertasbrasil.com> and <superpromoscarefour.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 27, 2023, initially only in relation to the <carrefourfertasbrasil.com> domain name. On November 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <carrefourfertasbrasil.com>. On the same date, the Complainant asked the addition of the domain name <superpromoscarefour.com> to the dispute. Therefore, on November 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <superpromoscarefour.com>. On November 27 and 28, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for both of the disputed domain names 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 November 29, 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 December 4, 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 December 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 25, 2024. The Respondent sent an email communication to the Center on December 15, 2023.

On December 15, 2023, the Complainant requested the suspension of the proceedings for settlement purposes and the proceeding was suspended on December 18, 2023. On January 16, 2024, the Complainant requested for the proceeding to be reinstated and the Center reinstated the proceeding on January 17, 2024 also informing the Parties that the due date to file a Response was extended to January 25, 2024.

The Center appointed Taras Kyslyy as the sole panelist in this matter on January 29, 2024. 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 an international retailer employing hypermarkets concept 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, the Complainant is an international retail player and it can also count on an important commercial presence in Brazil. The Complainant additionally offers travel, banking, insurance, and ticketing services.

The Complainant owns several hundred registrations of its trademark rights in various jurisdiction in the “carrefour” term, for instance: International trademark registration No. 351147, registered on October 2, 1968, and International trademark registration No. 1684738, registered on April 5, 2022, designating also Brazil.

Directly or through its subsidiaries, the Complainant is also the owner of numerous domain names identical to, or comprising, its trademarks, both within generic and country code Top-Level Domains (“gTLD” and “ccTLD”). For instance, <carrefour.com> has been registered since 1995 and <carrefour.com.br> since 1997. The Complainant is also present at the Facebook social network with about 11million “likes” of the network’s users.

The disputed domain name <carrefourofertasbrasil.com> was registered on November 13, 2023. The disputed domain name <superpromoscarefour.com> was registered on November 9, 2023. At the time of the decision in this case the disputed domain names resolve to webpages stating “Sorry, this store is currently unavailable.”. Previously the disputed domain name <carrefourofertasbrasil.com> resolved to a webpage prominently featuring the Complainant’s trademark intending to make a false impression it is owned or authorized by the Complainant.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant’s trademark. The Complainant’s name and trademarks are entirely incorporated at the beginning of the disputed domain name <carrefourofertasbrasil.com> together with the terms “ofertas” (Spanish and Portuguese term which can be translated with “offers” in English) and “brasil”.

With a minor and common misspelling (a missing letter “r”), the Complainant’s name and trademarks are entirely incorporated in the disputed domain name <superpromoscarefour.com> together with the terms “super” and “promos” (short form for “promotions”, offers). The addition of terms, such as “ofertas”, “brasil”, “super” and “promos”, to a trademark in a domain name does nothing to diminish the likelihood of confusion arising from that domain name. Moreover, the absence of a letter “r” from CARREFOUR in the disputed domain name <superpromoscarefour.com>, which is a common typing mistake, does not change the overall impression given by the disputed domain name, both from a visual and a phonetical point of view. The use of the lower-case letter format on the one hand and the addition of the gTLD “.com” on the other hand, are not significant in determining whether a domain name is identical or confusingly similar to the trademarks of a complainant. The incorporation of a well-known trademark in its entirety may be sufficient to establish that the domain name is identical or confusingly similar to a complainant’s trademark. The disputed domain names reproduce the Complainant’s CARREFOUR trademarks which are immediately recognizable in the disputed domain names. Therefore, the disputed domain names are confusingly similar to the Complainant’s earlier trademarks.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain names. There is no CARREFOUR trademark, or term similar thereto, owned by the Respondent. The Respondent has acquired no trademark in the name CARREFOUR, or term similar thereto, which could have granted the Respondent rights in the disputed domain names. Furthermore, there is no evidence whatsoever that the Respondent is known by the disputed domain names. There is no evidence that the Respondent has been commonly known by the disputed domain names as an individual, business or other organization. The Respondent reproduces the Complainant’s earlier registered trademarks in the disputed domain names without any license or authorization from the Complainant. The Complainant has not authorized the use of its earlier trademarks or terms similar thereto in the disputed domain names in any manner or form. The Respondent has not, before the original filing of the Complaint, used or prepared to use the disputed domain names in relation to a *bona fide* offering of goods or services. The disputed domain names resolve to a generic page rendered by Shopify – a popular e-commerce platform – where the following message appears: “Sorry, this store is currently unavailable.” But they originally hosted a deceptive website which illicitly used the Complainant’s name and trademarks to falsely suggest a direct connection with the Complainant and which was used to carry out a malevolent online activity as described by numerous Internet consumers online. Since the adoption and extensive use of its trademarks by the Complainant predates by far the registration of the disputed domain names, 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 names.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. The registration of the disputed domain names, which incorporate the Complainant’s name and trademarks, was not accidental and must have been influenced by the fame of the Complainant and its earlier trademarks. The mere registration of a domain name that is identical or confusingly similar to a famous or well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Considering the content of the website hosted by <carrefourofertasbrasil.com>, the disputed domain names were registered in the hope and expectation that Internet users looking for the Complainant’s services and products would instead come across the disputed domain names and the corresponding websites. Such use cannot be considered a good faith use. The Respondent has actively used the disputed domain names to carry out a malevolent online activity as several consumers have described online, falsely suggesting an affiliation with the Complainant. In fact, a quick search on the Respondent on Google retrieves pages of complaints by deceived consumers, for products that were not received or that did not correspond to their descriptions. The Complainant’s trademark registrations significantly predate the registration date of the disputed domain names. Knowledge of the Complainant’s intellectual property rights, including trademarks, at the time of the registration of the disputed domain name, proves bad faith registration. It is clear from the unauthorized use of the Complainant’s name and trademarks (in the disputed domain names and websites) that the individual who effected the registration of the disputed domain names had full knowledge of the Complainant and intended to mislead Internet users with deceptive domain names and their corresponding websites. Therefore, at the very least, the Respondent knew or should have known that, when acquiring and using the disputed domain names, he would do so in violation of the Complainant’s earlier rights.

Taking into account the long-lasting international relationship of the Complainant and its trademarks, the Complainant cannot think of any future use of the disputed domain names that may be done by the Respondent in good faith.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. In its informal communication via email to the Center, the Respondent stated that since it was not aware of the facts presented, it gives up the disputed domain names, and asks that they be forwarded to the copyright holder. It also gives up any domain names that violate the rules and harms the copyright holder.

6. Discussion and Findings

A. Consent to Transfer

Where parties to a UDRP proceeding have not been able to settle their dispute prior to the issuance of a panel decision using the "standard settlement process" described above, but where the respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, many panels will order the requested remedy solely on the basis of such consent. In such cases, the panel gives effect to an understood party agreement as to the disposition of their case (whether by virtue of deemed admission, or on a no-fault basis).

In some cases, despite such respondent consent, a panel may in its discretion still find it appropriate to proceed to a substantive decision on the merits. Scenarios in which a panel may find it appropriate to do so include where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, which the Panel finds should be applied in this case. [WIPO Overview 3.0](#), section 4.10.

B. 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.

The Complainant has shown rights in respect of the CARREFOUR trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name <carrefourofertasbrasil.com>. Accordingly, the disputed domain name <carrefourofertasbrasil.com> is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the mark is recognizable within the disputed domain name <superpromoscarefour.com>. Accordingly, the disputed domain name <superpromoscarefour.com> is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel considers the disputed domain name <superpromoscarefour.com> consists of an intentional misspelling of the Complainant's trademark, missing the letter "r" of "carrefour". Accordingly, the disputed domain name <superpromoscarefour.com> is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.9.

Although the addition of other terms here, “ofertas” and “brasil” in the <carrefourofertasbrasil.com> disputed domain name, and “super” and “promo” in the <superpromoscarefour.com> disputed domain name, 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 names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

C. 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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The available evidence does not confirm that the Respondent is commonly known by the disputed domain names, which could demonstrate its rights or legitimate interests (see, *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated bona fide or legitimate use of the disputed domain names could be reasonably claimed (see, *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

The composition of the disputed domain names, with the addition of the terms “ofertas” and “brasil” in the <carrefourofertasbrasil.com> disputed domain name, and “super” and “promo” in the <superpromoscarefour.com>, indicate the Respondent’s intention to impersonate or associate with the Complainant, which is further supported by the previous content hosted in the <carrefourofertasbrasil.com> disputed domain name.

The Respondent has no right or legitimate interests in the disputed domain names resolving to an inactive website at the time of this decision (see *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#)).

Panels have held that the use of a domain name for illegal activity here, impersonation/passing off the Complainant at the website at the disputed domain name <carrefourofertasbrasil.com>, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

D. 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.

In the present case, the Panel notes that the Respondent placed at the disputed domain name <carrefourfertasbrasil.com> a website impersonating the Complainant, which confirms the Respondent was aware of the Complainant and its trademark rights, which is bad faith. [WIPO Overview 3.0](#), section 3.2.2.

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. The Panel is convinced that the Complainant's trademark is well established through long and widespread use and the Complainant has acquired a significant reputation and level of goodwill in its trademark both in France and in Brazil, where the Respondent is located at. Thus, the Panel finds that the disputed domain names confusingly similar to the Complainant's trademark were registered in bad faith. [WIPO Overview 3.0](#), section 3.1.4.

According to paragraph 4(b)(iv) of the Policy the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location. In this case, the disputed domain name <carrefourfertasbrasil.com> was resolving to a website featuring the Complainant's trademark and falsely pretended to be the Complainant's official local website to intentionally attract Internet users by creating likelihood of confusion with the Complainant's trademark as to the source of the website and its products. The Panel finds the above confirms the disputed domain name was registered and used in bad faith.

Panels have also found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current non-use of the disputed domain names do not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (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 respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, the composition of the disputed domain names, previous use of the disputed domain name <carrefourfertasbrasil.com>, and finds that in the circumstances of this case the current passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

Furthermore, panels have held that the use of a domain name for illegal activity here impersonation/passing off the Complainant at the website at the disputed domain name <carrefourfertasbrasil.com>, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 names <carrefourofertasbrasil.com>, <superpromoscarefour.com> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: February 12, 2024