

ADMINISTRATIVE PANEL DECISION

Carrefour SA and Atacadão S.A. v. Jaay Shop, privada
Case No. D2023-5152

1. The Parties

Complainants are Carrefour SA, France (“First Complainant”) and Atacadão S.A., Brazil (“Second Complainant”), represented by IP Twins, France.

The Respondent is Jaay Shop, privada, Brazil.

2. The Domain Name and Registrar

The disputed domain name <atacadaobr.com> (“Domain Name”) 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 December 11, 2023. On December 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 12, 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 Complainants on December 13, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainants to submit an amendment to the Complaint. Complainants filed an amended Complaint on December 18, 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 Respondent of the Complaint, and the proceedings commenced on December 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 9, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on January 10, 2024.

The Center appointed Marina Perraki as the sole panelist in this matter on January 23, 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

Second Complainant is a Brazilian chain of wholesale and retail stores established in 1960 and acquired by First Complainant in 2007. With over 300 stores and distribution centers in all the Brazilian states and more than 70.000 employees, Second Complainant is one of the largest wholesale network in the country. In 2010 Second Complainant began an internationalization program, expanding activities in other countries beyond Brazil.

Complainants are the owners of trademark registrations for ATACADAO and ATACADÃO, including the European Union trademark registration ATACADAO (word) No. 012020194, filed on July 12, 2013, and registered on May 24, 2015, for services in international class 35 and the Brazilian trademark registration ATACADÃO (word) No. 006785360, filed on July 15, 1977, and registered on October 10, 1978, for goods in international class 29.

Furthermore, Second Complainant owns the domain name <atacado.com.br> registered on October 9, 1997.

The Domain Name was registered on November 4, 2023, and leads to an inactive website.

5. Parties' Contentions

A. Complainant

Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainants must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainants have rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. 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 Complainants' 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.

Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the ATACADAO or ATACADÃO marks is reproduced within the Domain Name. Accordingly, the Domain Name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other elements, here, the letters “br” (short for “Brazil”), may bear on assessment of the second and third elements, the Panel finds the addition of such letters does not prevent a finding of confusing similarity between the Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The generic Top-Level Domain (“gTLD”) “.com” is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yejun*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which 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 Complainants have established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent has not rebutted Complainants’ prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy or otherwise.

Furthermore, there is no evidence on record giving rise to any rights or legitimate interests in the Domain Names on the part of Respondent within the meaning of paragraphs 4(c)(ii) and 4(c)(iii) of the Policy.

In addition, the nature of the Domain Name, being almost identical to Complainants’ trademarks, carries a risk of implied affiliation ([WIPO Overview 3.0](#), section 2.5.1), also in view of the inclusion of the letters “br”, (short for “Brazil”), which is where the Second Complainant is based.

This, along with the fact that the Domain Name is registered with a privacy shield service, speaks against any rights or legitimate interests held by Respondent (*Ann Summers Limited v. Domains By Proxy, LLC / Mingchun Chen*, WIPO Case No. [D2018-0625](#); *Carrefour v. WhoisGuard, Inc., WhoisGuard Protected / Robert Jurek, Katrin Kafut, Purchasing clerk, Starship Tapes & Records*, WIPO Case No. [D2017-2533](#)).

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainants have established Policy, paragraph 4(a)(ii).

C. 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

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. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does 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.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. Complainants' ATACADAO or ATACADÃO marks had been widely used and registered before the time of the Domain Name registration by Respondent and enjoyed reputation, as repeatedly recognized (e.g., *Atacadão - Distribuição, Comércio E Indústria LTDA. v. seong-chea park*, WIPO Case No. [D2023-3011](#), *Carrefour SA and Atacadão S.A. v. atacado varejo*, WIPO Case No. [D2023-3011](#)). Therefore, noting also the composition of the Domain Name, containing Complainants' trademarks along with the letters "br", (short for "Brazil") where Second Complainant is based, the Panel finds it more likely than not that Respondent had Complainants' marks in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#)).

Respondent knew or should have known about Complainants' rights, noting also that such knowledge is readily obtainable through a simple browser search (*Caesars World, Inc. v. Forum LLC*, WIPO Case No. [D2005-0517](#); *Compart AG v. Compart.com / Vertical Axis, Inc.*, WIPO Case No. [D2009-0462](#)).

As regards bad faith use, Complainants demonstrated that the Domain Name leads to an inactive website. The non-use of a domain name would not prevent a finding of bad faith (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3). Furthermore, the Panel considers also the apparent concealment of the Domain Name holder's identity through use of a shield at the time of filing the complaint, to be further indicative of bad faith (*BHP Billiton Innovation Pty Ltd v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#)).

Under these circumstances and on this record, the Panel finds that Respondent has registered and used the Domain Name in bad faith.

The Panel finds that Complainants have 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 name <atacadaobr.com> be transferred to Complainants.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: February 6, 2024