

ADMINISTRATIVE PANEL DECISION

Carrefour SA, Atacadão S.A. v. ELIANE COSTA
Case No. D2024-1077

1. The Parties

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

The Respondent is ELIANE COSTA, Brazil.

2. The Domain Name and Registrar

The disputed domain name <atacado-cartao.org> is registered with Hostinger Operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 12, 2024. On March 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 13, 2024, 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 (REDACTED FOR PRIVACY/ Privacy Protect, LLC, (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 13, 2024, 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 March 14, 2024.

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 March 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 5, 2024.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on April 12, 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 first Complainant is a company incorporated under French law. The second, is a company incorporated under Brazilian law.

The Complainant Carrefour is a worldwide leader in retail and a pioneer of the concept of hypermarkets back in 1968. 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 without a doubt a major and well-known worldwide leader in retail.

The second Complainant is Atacadão, a Brazilian chain of wholesale and retail stores established in 1960 and acquired by Carrefour in 2007. The second Complainant has more than 300 stores and distribution centers in all the Brazilian states and more than 70,000 employees. In 2010, the Complainant began an internationalization program, expanding its activities in other countries beyond Brazil.

The Complainant is the owner of several ATACADAO and ATACADÃO trademarks registered in:

- European Union trademark ATACADAO No. 012020194, registered on May 24, 2015, and designating services in international class 35;
- Brazil trademark ATACADÃO No. 006785360, registered on October 19, 1978, duly renewed and designating goods in international class 29;
- Brazil trademark ATACADÃO No. 006785344, registered on October 10, 1978, duly renewed and designating goods in class 31;
- Brazil trademark ATACADAO No. 006937497, registered on May 25, 1979, duly renewed and designating services in class 35;
- Argentina trademark ATACADAO No. 2426312, registered on February 24, 2011, duly renewed and designating services in classes 35;
- Morocco trademark ATACADAO No. 97-148034, application date November 15, 2012, and designating services in international class 35.

The Complainant owns trademark rights also in CARTÃO ATACADÃO:

- Brazil trademark CARTÃO ATACADÃO No. 840880359, registered on July 24, 2018 and designating services in international class 36, and
- Brazil trademark CARTÃO ATACADÃO No. 840880367, registered on July 24, 2018 and designating services in international class 36.

The Respondent registered the disputed domain name on January 19, 2024. The disputed domain name is not in use.

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 name, namely:

- (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 of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements which a complainant must satisfy in order to succeed. The Complainants must satisfy that:

- (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 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

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 a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

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

Although the addition of other terms like "cartao" (card in English) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name 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.

B. 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 name. 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 name such as those enumerated in the Policy or otherwise.

The inclusion of the term "cartao" ("card" in English) together with the mark "atacadao" in the disputed domain name can only heighten the risk of confusion as this specific term is directly related to Complainant's business activity (in particular, to one of its payment methods), therefore misleading Internet users into believing that the disputed domain name is affiliated with, or endorsed by, the Complainant. In fact, it cannot be ignored that the Complainant also manages a dedicated website for its payment services at "www.cartaoatacadao.com.br".

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

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.

In the present case, the Panel notes that:

- the Complainant trademarks are well known (see *Carrefour SA v. blackwhite, dolly Tiwari*, WIPO Case [D2021-0274](#)).
- the Respondent registered the disputed domain name on January 19, 2024.
- the ATACADAO and ATACADÃO trademarks were registered well before the registration of the disputed domain name.
- the disputed domain name is not in use.

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. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name (including the term "cartao" related to Complainant payment services), and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of 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 name <atacado-cartao.org> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: April 26, 2024.