

ADMINISTRATIVE PANEL DECISION

Carrefour SA, Atacadão S.A. v. atacadao
Case No. D2024-1952

1. The Parties

The Complainants are Carrefour SA, France, and Atacadão S.A., Brazil, represented by IP Twins, France.

The Respondent is atacadao, Brazil.

2. The Domain Name and Registrar

The disputed domain name <atacadao.app> is registered with Squarespace Domains II LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 9, 2024. On May 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainants on May 14, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on May 15, 2024.

On May 21, 2024, the Center informed the parties in Portuguese and English, that the language of the registration agreement for the disputed domain name is Portuguese. On May 23, 2024, the Complainants requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Portuguese of the Complaint, and the proceedings commenced on May 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 18, 2024.

The Center appointed Gonçalo M. C. Da Cunha Ferreira as the sole panelist in this matter on June 25, 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 Complainants are Carrefour SA ("Carrefour"), and Atacadão S.A. ("Atacadão"). Atacadão is part of the Carrefour group, both companies have opted to join in the present Complaint. Carrefour is a worldwide leader in retail and a pioneer of the concept of hypermarkets back in 1968. With a turnaround of EUR 83 billion in 2022, Carrefour is listed on the index of the Paris Stock Exchange (CAC 40). Carrefour 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, Carrefour is a major and well known worldwide leader in retail. Carrefour additionally offers travel, banking, insurance, or ticketing services. Atacadão is a Brazilian chain of warehouse stores established in 1960. In 2007, it was bought by Carrefour. In 2022, the company has over 300 stores and distribution centers in Brazil and more than 70,000 employees. Atacadão is the largest wholesale network in Brazil. Unless specified otherwise, the Complainants are hereinafter referred to as the "Complainant".

The Complainant is the owner of the following trademarks:

- European Union trademark ATACADAO No. 012020194, registered on May 24, 2015, designating services in international class 35;
- Brazilian trademark ATACADÃO No. 006785344, registered on October 10, 1978, designating goods in international class 31;
- Brazilian trademark ATACADAO No. 006937497, registered on May 25, 1979, designating services in international class 35.

The disputed domain name was registered on April 24, 2024, and at the time of filing of the Complaint, it did not resolve to an active website.

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.

Notably, the Complainant contends that:

1. the earlier ATACADAO and ATACADÃO trademarks enjoy a wide-spread continuous reputation.
2. the Complainant is also the owner of numerous domain names identical to, or comprising, its trademarks, including <atacado.com.br> registered since 1997.
3. the Complainant's notoriety is also evidenced on the Internet where the Complainant's Facebook page has more than 3 million followers.
4. the Complainant's brand is featured in several rankings, including the biggest Brazil brands and the best Latin America brands.
5. the disputed domain name is identical to its earlier trademarks.

6. the use of the lower-case letter format on the one hand and the addition of the Top-Level Domain (“TLD”) “.app” on the other hand are not significant in determining whether the disputed domain name is identical or confusingly similar to the trademarks of the Complainant.
7. the Complainant has not authorized the use of its earlier trademarks or terms similar thereto in the disputed domain name in any manner or form.
8. 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.
9. the disputed domain name is inherently likely to mislead Internet users, and there is no evidence that the Respondent has been making a legitimate noncommercial or fair use of the disputed domain name.
10. the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Portuguese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Complainant is already bearing all the costs related to this proceeding and the burden of providing a translated Complaint would imply additional costs and cause a delay in the current procedure.

The Respondent did not make any submissions with respect to the language of the proceeding or indicate any interest in otherwise participating in this proceeding, despite the Center having sent communications in English and Portuguese regarding the language of the proceeding and the notification of the Complaint.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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 identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 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 finds that that the Respondent could not have ignored the Complainant or its earlier rights, considering that the disputed domain name is identical to Complainant’s name and ATACADAO trademark. Moreover, the Respondent is based in Brazil, country where the Complainant is headquartered and where it is undoubtedly well known, as panels have established in several proceedings (*Carrefour S.A., Atacadão S.A. v. Gabriel Silva*, WIPO Case No. [D2023-4424](#); *Carrefour SA, Atacadão S.A. v. Luiz lima Da silva*, WIPO Case No. [D2023-4209](#); *Carrefour SA and Atacadão S.A. v. atacado varejo*, WIPO Case No. [D2023-3011](#); *Carrefour SA, and Atacadão - Distribuição, Comércio E Indústria LTDA. v. Lohan Medina*, WIPO Case No. [D2023-1900](#) and *Carrefour SA, Atacadão S.A. v. Joao Pedro Rodrigues*, WIPO Case No. [D2023-2980](#)).

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 available record, the Panel notes the distinctiveness and reputation of the Complainant’s trademarks, and the composition of the disputed domain name (identical to the Complainant’s ATACADAO trademark and <atacado.com.br> domain name), 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.app> be transferred to the Complainant.

/Gonçalo M. C. Da Cunha Ferreira/

Gonçalo M. C. Da Cunha Ferreira

Sole Panelist

Date: July 3, 2024