

## **ADMINISTRATIVE PANEL DECISION**

Carrefour SA and Atacadão S.A. v. Domain Privacy, Domain Name Privacy Inc

Case No. D2024-2527

### **1. The Parties**

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

The Respondent is Domain Privacy, Domain Name Privacy Inc, Cyprus.

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

The disputed domain names <atacado.store> and <cartao-atacado.site> are registered with Communigal Communications Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 20, 2024. On June 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 24, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Domain Name Privacy Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 24, 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 June 25, 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 June 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 18, 2024.

The Center appointed Peter Kružliak as the sole panelist in this matter on July 24, 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 retailer based in France with a revenue of EUR 83 billion in 2022 and operates more than 12,000 stores in more than 30 countries worldwide. The Second Complainant is a Brazilian chain of wholesale and retail stores established in 1960 and acquired by the First Complainant in 2007. The Second Complainant now has over 300 stores and more than 70,000 employees in Brazil.

The First Complainant is the owner of the following trademark registrations:

- European Union trademark ATACADAO, number 012020194, registered on May 24, 2015, for services in class 35;
- Argentinian trademark ATACADAO, number 2426312, registered on February 24, 2011, for services in class 35;
- Morocco trademark ATACADAO, number 97-148034, application date November 15, 2012, for services in class 35.

The Second Complainant is the owner of the following trademarks in Brazil:

- ATACADÃO, number 006785360, registered on October 10, 1978, for goods in national class 29;
- ATACADÃO, number 006785344, registered on October 10, 1978, for goods in national class 31;
- ATACADAO, number 006937497, registered on May 25, 1979, for goods in national class 35;
- CARTÃO ATACADÃO, number 840880359, registered as combined trademark on July 24, 2018, for services in international class 36; and
- CARTÃO ATACADÃO, number 840880367, registered as combined trademark on July 24, 2018, for services in international class 36.

The Second Complainant also registered the domain name <atacado.com.br> on October 9, 1997, and the First Complainant's controlled company registered the domain name <cartaoatacado.com.br> on July 24, 2015. Furthermore, the record shows that the Second Complainant operates a Facebook account under the name "Atacadão SA", which has over 3 million followers. ABAAS – NielsenQ ranking included ATACADÃO as the leader among Brazilian wholesalers based on its turnover in 2022 and INTERBRAND ranks it among best Brazilian brands.

The Respondent is a privacy service located in Cyprus. The disputed domain name <atacado.store> was created on May 25, 2024, and it resolves either to a page displaying Pay-Per-Click links or to a page where users are invited to download software in order to access some online video content. The disputed domain name <cartao-atacado.site> was created on May 31, 2024, and it resolves to a page displaying Pay-Per-Click links. The Registrar confirmed that the Registration Agreement for the disputed domain names is in English.

## 5. Parties' Contentions

### A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainants contend that the disputed domain name <atacado.store> is identical to their earlier ATACADAO and ATACADÃO trademarks and the domain name <cartao-atacado.site> is identical or confusingly similar to both its ATACADAO, ATACADÃO, and CARTÃO ATACADÃO trademarks, since the ATACADAO and ATACADÃO trademarks are reproduced in the disputed domain name <cartao-atacado.site> together with the term "cartao" (Portuguese word meaning "card" in English), separated by a hyphen, and identical to the second Complainant's CARTÃO ATACADÃO trademarks as the presence of the hyphen is of negligible significance when assessing confusing similarity and the use of the letters "a" instead of "ã" does nothing to diminish the risk of confusion.

The Complainants further submit that the Respondent has no rights or legitimate interests in respect of the disputed domain names, since:

- the Respondent does not own any ATACADAO trademarks or similar signs;
- the Respondent reproduces the Complainants' earlier registered trademarks in the disputed domain names without any license or authorization from the Complainants;
- the Respondent has not, before the original filing of the Complaint, used or made preparations to use the disputed domain names in relation to a bona fide offering of goods or services; and
- since the adoption and extensive use of its trademarks by the Complainants predates the registration of the disputed domain names, the burden is on the Respondent to establish the Respondent's rights or legitimate interests in the disputed domain names.

And finally, the Complainants assert that the disputed domain name were registered and are used in bad faith, since:

- the Respondent's choice of domain names cannot have been accidental and must have been influenced by the fame of the Complainants and their earlier trademarks, which by itself creates a presumption of bad faith;
- it is very likely that the Respondent chose the disputed domain names in the hope and expectation that Internet users searching for the Complainant's services and products would instead come across the Respondent's domains;
- the Respondent knew or should have known that, when acquiring and using the domain names, he would do so in violation of the Complainants' earlier rights;
- the current use of the disputed domain names may not be considered a good faith use, as the Respondent is preventing the Complainants from reflecting its trademarks in the corresponding domain names and as they resolve to pay-per-click pages of commercial links and the Respondent is presumably obtaining a revenue by virtue of the misled Internet users drawn to the pay-per-click page because of the confusingly similar disputed domain names; and
- the same Respondent has been involved in other recent UDRP cases where domain names were registered through the same registrar and used to host pay-per-click pages, including a UDRP case involving the Complainants and their ATACADO and ATACADÃO trademarks.

## B. Respondent

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

## 6. Discussion and Findings

### 6.1 Consolidation: Multiple Complainants

The amended Complaint was filed by two Complainants against a single Respondent. The First Complainant acquired the Second Complainant, thus both Complainants are part of the same group and both have rights in relevant trademarks. The Panel finds that the Complainants have a common case against the Respondent who registered both disputed domain names and that it is efficient to permit the consolidation of their complaints (see also *Carrefour SA and Atacadão S.A. v. Domain Privacy, Domain Name Privacy Inc*, WIPO Case No. [D2024-1686](#)). As regards fairness and equity, the Panel sees no reason why consolidation would be unfair or inequitable to any Party, but rather that this approach is more fair and more efficient. Therefore, the Complainants are referred to below collectively as “the Complainant” except as otherwise indicated.

### 6.2 Substantive Issues

#### 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 the ATACADAO, ATACADÃO, and CARTÃO ATACADÃO trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the domain name <atacado.store> reproduces ATACADAO trademarks in its entirety and the ATACADÃO trademarks are clearly recognizable in this disputed domain name, despite the minor difference of substituting the letter “ã” for “a” required by the technical limitations of the domain names, which is inadequate to avoid a finding of confusing similarity (see for example *L’Oreal v. Tracey Johnson*, WIPO Case No. [D2008-1721](#) and *Atacadão - Distribuição, Comércio E Indústria LTDA. v. seong-chea park*, WIPO Case No. [D2022-4615](#)).

Similarly, the Panel also finds that the domain name <cartao-atacado.site> reproduces ATACADAO trademarks in its entirety, while containing the descriptive term “cartao” (“card” in Portuguese), which does not impact assessment regarding the first element of the Policy. [WIPO Overview 3.0](#), section 1.8. The CARTÃO ATACADÃO trademarks are also clearly recognizable in this disputed domain name – the minor difference of substituting the letter “ã” for “a” required by the technical limitations of the domain names and the hyphen between the individual words are again not sufficient to avoid finding of confusing similarity (see for example *L’Oreal v. Tracey Johnson*, WIPO Case No. [D2008-1721](#) and *Atacadão - Distribuição, Comércio E Indústria LTDA. v. seong-chea park*, WIPO Case No. [D2022-4615](#)).

The Panel notes that the Top Level Domains of the disputed domain names: “.store” and “.site” are viewed as a standard registration requirement and as such are disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.

Accordingly, the disputed domain names are in case of <atacado.store> identical to the ATACADAO trademarks and confusingly similar to ATACADÃO trademarks and in case of <cartao-atacado.site>

confusingly similar to both the ATACADAO trademarks and CARTÃO ATACADÃO trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7, 1.8, and 1.11.

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 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 Panel notes that based on the available record provided by the Complainant and not rebutted by the Respondent, the disputed domain names are resolved to pages containing pay-per-click links. Since the ATACADAO and ATACADÃO trademarks have reputation, as repeatedly recognized by previous UDRP decisions (see *Carrefour SA and Atacadão S.A. v. atacado varejo*, WIPO Case No. [D2023-3011](#), *Atacadão - Distribuição, Comércio E Indústria LTDA. v. seong-chea park*, WIPO Case No. [D2022-4615](#), *Carrefour S.A., Atacadão S.A. v. Gabriel Silva*, WIPO Case No. [D2023-4424](#), *Carrefour SA, and Atacadão - Distribuição, Comércio E Indústria LTDA. v. Lohan Medina*, WIPO Case No. [D2023-1900](#), *Carrefour SA and Atacadão S.A. v. Jaay Shop, privada*, WIPO Case No. [D2023-5152](#)), and the disputed domain names capitalize on said reputation, such use of disputed domain names does not represent bona fide offering.

Furthermore, the available record does not show any trademark registrations or earlier relevant rights of the Respondent corresponding to the disputed domains, nor the fact that the Respondent is commonly known by the disputed domain names.

And finally, the described use of the disputed domain names by resolving to pages containing pay-per-click links is not noncommercial or fair use of the disputed domain names, as it is intended for commercial gain, either of the Respondent or a third party, and misleadingly diverts customers aware of the Complainant trademarks based on their reputation.

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 ATACADAO and ATACADÃO trademarks are famous as recognized by many previous Panel decisions (see *Carrefour SA and Atacadão S.A. v. atacado varejo*, WIPO Case No. [D2023-3011](#), *Atacadão - Distribuição, Comércio E Indústria LTDA. v. seong-chea park*, WIPO Case No. [D2022-4615](#), *Carrefour S.A., Atacadão S.A. v. Gabriel Silva*, WIPO Case No. [D2023-4424](#), *Carrefour SA, and Atacadão - Distribuição, Comércio E Indústria LTDA. v. Lohan Medina*, WIPO Case No. [D2023-1900](#), *Carrefour SA and Atacadão S.A. v. Jaay Shop, privada*, WIPO Case No. [D2023-5152](#)), and the Respondent registered disputed domain names that are identical or confusingly similar to these famous trademarks, which by itself creates a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4

This finding is further supported by the fact that the disputed domain names were registered in 2024, years after the registration of the Complainant's marks, including in the European Union, where the Respondent's contact address is, and both disputed domain names resolve to pages containing pay-per-click links, thus diverting Internet users looking for the Complainant for commercial gain of the Respondent or a third party, which clearly falls within the requirements of paragraph 4(b)(iv) of the Policy (see *Carrefour SA and Atacadão S.A. v. Domain Privacy, Domain Name Privacy Inc*, WIPO Case No. [D2024-1686](#)).

On a final note, the Panel points out that the Respondent was a party to previous UDRP cases involving abusive registrations (see *Alain Afflelou Franchiseur v. Domain Privacy, Domain Name Privacy Inc*, WIPO Case No. [D2024-0500](#), *Pouring Pounds India Private Limited v. Domain Privacy, Domain Name Privacy Inc.*, WIPO Case No. [DCO2024-0010](#)), including a case involving the Complainant of this proceeding and the same circumstances – the same Registrar and use of the disputed domain names to “park” pages with pay-per-click links (see *Carrefour SA and Atacadão S.A. v. Domain Privacy, Domain Name Privacy Inc*, WIPO Case No. [D2024-1686](#)), which based on the established practice of UDRP panels constitutes a pattern of bad faith conduct. [WIPO Overview 3.0](#), section 3.1.4.

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 <atacado.store> and <cartao-atacado.site> be transferred to the Complainant.

*/Peter Kružliak/*

**Peter Kružliak**

Sole Panelist

Date: August 7, 2024