

ADMINISTRATIVE PANEL DECISION

Carrefour SA and Atacadão S.A. v. Gustavo Kauan, LEGACY N DIGITAIS
Case No. D2024-2535

1. The Parties

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

The Respondent is Gustavo Kauan, LEGACY N DIGITAIS, Brazil.

2. The Domain Name and Registrar

The disputed domain name <atacadooficial.com> 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 June 21, 2024. On June 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 21, 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 (Registration Private/Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainants on June 25, 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 June 26, 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 Erica Aoki as the sole panelist in this matter on July 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 and Atacadão S.A.

Carrefour is a worldwide leader in retail and a pioneer of the concept of hypermarkets back in 1968. With a revenue of EUR 83 billion in 2022, the Complainant 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, the Complainant is without a doubt a major and well-known worldwide leader in retail.

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

Atacadão is part of the Carrefour Group, thus, both companies have opted to join in the present Complaint and is jointly referred to the Complainants.

The Complainants own several ATACADAO and ATACADÃO trademarks registered well before the registration of the disputed domain name, such as:

- 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 10, 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; and
- Morocco trademark ATACADAO, No. 97-148034, application date November 15, 2012, and designating services in international class 35.

The Complainants are the holder of numerous domain names identical to, or comprising, its trademarks, both within generic and country-code Top-Level Domains. For instance, <atacado.com.br> has been registered since 1997.

The disputed domain name was registered on June 4, 2024, and currently resolves to an error page, but the disputed domain name previously hosted a website which used a color scheme similar to that of the Complainants and employed a similar prominent letter “A” before “Atacadão” with three stripes as does the Complainant).

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 name.

The Complainants contend that their notoriety is also evidenced on the Internet. For instance, the Complainants’ Facebook page has more than 3 million followers. Moreover, the Complainants’ ATACADÃO brand is featured in several rankings, including one of the biggest Brazil brands and one of the best Latin America brands.

The Complainants contend that the disputed domain name is confusingly similar to its earlier ATACADAO trademarks. In fact, the disputed domain name incorporates in their entirety the above-mentioned trademarks together with the term “oficial”, a misspelling of the English word “official” or the Spanish/Portuguese translation for “official”. It is established case law that the addition of generic terms, such as “oficial”, to a trademark in a domain name does nothing to diminish the likelihood of confusion arising from that domain name.

The Complainants contend that the disputed domain name reproduces the Complainants’ trademarks in their entirety.

The Complainants contend that the disputed domain name is inherently likely to mislead Internet users. The non-use of a domain name (including an error page) does not prevent a finding of bad faith. Moreover, the use of a domain name to impersonate the Complainants can never confer rights or legitimate interests.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

The Complainants are required to establish the requirements specified under paragraph 4(a) of the Policy:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in respect of which the Complainants have rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that 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 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 disputed domain name incorporates in their entirety the Complainants ATACADÃO trademarks together with the term “oficial”, a misspelling of the English word “official” or the Spanish/Portuguese translation for “official”. It is established case law that the addition of terms, such as “oficial”, to a trademark in a domain name does not prevent a finding of confusing similarity between the complainant’s trademark and the domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 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 Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants' 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 disputed domain name currently resolves to an error page, but it previously hosted a website which used a color scheme similar to that of the Complainants and employed a similar prominent letter "A" before "Atacadão" with three stripes as does the Complainant. The disputed domain name and its prior use is likely to mislead Internet users.

There is no evidence on record that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainants' trademark. The Panel moreover notes that the use of the (misspelled) term "official" undercuts any potential argument by the Respondent that the disputed domain name was registered because of any dictionary value, and points to invocation of a brand.

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

C. Registered and Used in Bad Faith

The Complainants' ATACADAO trademarks are long-established and well-known, as outlined. The Complainants assert that the Respondent necessarily had the Complainants' name and trademarks in mind when registering the disputed domain name. The Respondent's choice of the disputed domain name cannot have been accidental and must have been influenced by the fame of the Complainants and their earlier trademarks.

The disputed domain name has in the Panel's view been chosen because of its similarity with a name and trademarks in which the Complainants have rights. This was most likely done in the hope and expectation that Internet users searching for the Complainants' services and products would instead come across the Respondent's disputed domain name. The disputed domain name adds the term "oficial" to the Complainants' ATACADAO trademark, and therefore carries a risk of implied affiliation. Such use cannot be considered a good faith use.

The previous use of the disputed domain name indicates that the Respondent intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainants' mark. In addition, the disputed domain name is currently not used in connection with an active site but it resolves to an error page. The current non-use of the disputed domain name (including an error page) does not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.4.

The Panel finds 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 <atacadaooficial.com> be transferred to the Complainants.

/Erica Aoki/

Erica Aoki

Sole Panelist

Date: August 8, 2024