

ADMINISTRATIVE PANEL DECISION

Carrefour SA, and Atacadão S.A. v. Jose Aladin
Case No. D2024-2557

1. The Parties

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

The Respondent is Jose Aladin, Brazil.

2. The Domain Name and Registrar

The disputed domain name <atacaadao.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 24, 2024. On June 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 24, 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) and contact information in the Complaint. The Center sent an email communication to the Complainants on June 27, 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 28, 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 July 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 11, 2024.

The Center appointed Gilberto Martins de Almeida as the sole panelist in this matter on August 19, 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 two major companies in the supermarket business, Carrefour SA and Atacadão SA, which were founded in, respectively, 1968 and 1960. Carrefour's relation to the dispute is relevant as it acquired Atacadão SA in 2007.

Regarding relevant trademarks, the Complainants have proved to be the owner of the trademark ATACADAO and ATACADÃO as per Annex 4 to the Complaint in the following jurisdiction, registration numbers, and dates:

- EUIPO (European Union Intellectual Property Office) trademark ATACADAO No. 012020194, registered on May 24, 2015, and designating services in international class 35 (Annex 4-1 to the Complaint);
- Brazil - INPI (National Industrial Property Institute) trademark ATACADÃO No. 006785360, registered on October 10, 1978, duly renewed and designating goods in international class 29 (Annex 4-2 to the Complaint);
- Brazil - INPI trademark ATACADÃO No. 006785344, registered on October 10, 1978, duly renewed and designating goods in class 31 (Annex 4-3 to the Complaint).

As for the Complainants' operating domain name, <atacado.com.br>, it has been registered since 1997, according to Annex 5-1 to the Complaint.

Finally, the disputed domain name has been registered on June 8, 2024, as proved by the Registrar and the Annex 2-1 to the Complaint. At the time of the filing of the Complaint, the disputed domain name resolved to an error page (Annex 9-1-1 to the Complaint), but previously the disputed domain name hosted a website which impersonated the Complainants (Annex 9-1-2 to the Complaint). Currently the disputed domain name does not host any operating website, according to the Internet Archive's Wayback Machine.

Given the information available about the Respondent, it was not possible to obtain any further information on past or current activities.

5. Parties' Contentions

A. Complainants

The Complainants contend that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, besides the aforementioned facts, the Complainants contend that the disputed domain name is confusingly similar to the Complainants' trademark.

According to the Complainants, the addition of a letter "a" as the fifth letter in the expression "atacado", resulting in the expression "atacaadao" is a misspelling of its trademark, therefore, confusingly similar for purposes of the Policy.

Supporting this Complaint, the Complainants state that the disputed domain name was used to impersonate the Complainants' original website, at "www.atacado.com.br", thus the Respondent cannot be said to have rights or legitimate interests and should be considered as having registered and use the disputed domain name in bad faith, as proven by Annex 9-1-2 to the Complaint.

B. Respondent

The Respondent did not reply to the Complainants' contentions

6. Discussion and Findings

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 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.

The Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy, as proven by Annex 4 to the Complaint. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainants' previously owned mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 1.9. The only difference between the disputed domain name and the Complainants' trademark is the aforementioned additional letter "a", which does not prevent a finding of confusing similarity.

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.

Moreover, the additional letter "a" in the disputed domain name as compared to the Complainants' trademark reflects an intentional misspelling and thus, "typosquatting", which cannot be considered as fair use given the inherent misleading nature of such disputed domain name. It is clear that the Respondent's intent was to mislead Internet users given the prior use of the disputed domain name to host a website impersonating that of the Complainants.

Panels have held that the use of a domain name for illegal impersonation, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 Respondent was in bad faith when registering and using the disputed domain name.

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.

As for the current state of the applicable website, Panels have found that the non-use of a domain name (including a blank or "coming soon" page) 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 or reputation of the Complainants' trademark, and the typoquatting composition of the disputed 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.

Previous UDRP panels have held that the use of a domain name for illegal impersonation, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, especially the Annex 9-1-2 to the Complaint the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy given the prior use of the disputed domain name to impersonate the Complainants.

The Panel finds that the Complainants 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, <atacaadao.com>, be transferred to the Complainants.

/Gilberto Martins de Almeida/
Gilberto Martins de Almeida
Sole Panelist
Date: September 2, 2024