

ADMINISTRATIVE PANEL DECISION

Carrefour SA and Atacadão S.A. v. redouane toujana
Case No. D2024-2667

1. The Parties

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

The Respondent is redouane toujana, Morocco.

2. The Domain Name and Registrar

The disputed domain name <atacado.shop> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 5, 2024. On July 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 5, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainants on July 10, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainants filed an amended Complaint on July 10, 2024.

The Center verified that the Complaint together with the amendment to 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 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 5, 2024, The Respondent sent an email communication to the Center on July 18, 2024. Accordingly, the Center notified the Parties of the Commencement of Panel Appointment Process on August 13, 2024. The Center appointed a panelist who subsequently had to be replaced, necessitating a delay in the proceeding.

The Center appointed Edoardo Fano as the sole panelist in this matter on October 8, 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.

The Panel has not received any requests from the Complainants or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to [the] Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules, and the Supplemental Rules and without the benefit of a formal response from the Respondent.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainants are Carrefour SA and Atacadão S.A., being the former a French Company operating as one of the worldwide leaders in the retail field, and the latter a Brazilian Company also operating worldwide in the retail field and acquired by the former in 2007, both owning several trademark registrations for ATACADAO (ATACADÃO in the Portuguese Brazilian version), among which the following ones:

- European Union Trademark Registration No. 012020194 for ATACADAO, registered on May 24, 2015;
- Brazilian Trademark Registration No. 006785360 for ATACADÃO, registered on October 10, 1978;
- Moroccan Trademark Registration No. 147309 for ATACADAO, registered on November 8, 2012; and
- Moroccan Trademark Registration No. 156012 for ATACADÃO and design, registered on December 26, 2013.

The Complainants also operate on the Internet, owning several domain name registrations for ATACADAO, among which <atacado.com.br> and <atacadaomaroc.ma>.

The Complainants provided evidence in support of the above.

According to the Whois records, the disputed domain name was registered on June 4, 2024, and it resolves to an active website in Arabic, in which the Complainants' trademark is reproduced and several different products are purportedly offered for sale.

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.

Notably, the Complainants state that the disputed domain name is identical to their trademark ATACADAO.

Moreover, the Complainants assert that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainants to register the disputed domain name or to use their trademark within the disputed domain name, it is not commonly known by the disputed domain name and it is not making either a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name.

The Complainants submit that the Respondent has registered the disputed domain name in bad faith, since the Complainants' trademark ATACADAO is distinctive and well known in the retail field. Therefore, the Respondent targeted the Complainants' trademark at the time of registration of the disputed domain name and the Complainants contend that the use of the disputed domain name to impersonate the Complainants and attract, for commercial gain, Internet users to the Respondent's website, creating a likelihood of confusion with the Complainants' trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website, qualifies as bad faith registration and use.

B. Respondent

The Respondent has made no formal reply to the Complainant's contentions.

However, on July 18, 2024, the Respondent sent the following email communication to the Center:

"Dear WIPO Support Team For some time now, I have been receiving a message stating that the online store I own is not mine, due to a complaint submitted by you I am writing to you today regarding a problem I have encountered regarding the domain name that I hold atacadao.shop .against me, which I had previously purchased from namecheap I used it to create my online store. I have been managing and supervising it without any problems so far In fact, I purchased this domain name through namecheap. Therefore, I would like to submit a request to you for an explanation as to why I have received this complaint from you. Please check your records and confirm that I own the domain name I indicated, and provide any information or clarification that may help. solve this problem. I am also .prepared to provide any documents or proof that may be required to confirm my ownership of the domain name .I hope this will be resolved as soon as possible, as this issue is affecting my work and causing me anxiety .Thank you for your time and interest, and I look forward to your response as soon as possible .Sincerely".

6. Discussion and Findings

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

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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. Consolidation of Multiple Complainants

The Complaint and the amended Complaint were filed by two Complainants, and the Complainants have requested consolidation of multiple complainants. No objection to this request was made by the Respondent.

Pursuant to the [WIPO Overview 3.0](#), section 4.11.1: "[a]ssessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation."

The Panel finds that there is sufficient evidence that the Complainants have common grievance against the Respondent, who has engaged in a conduct that has affected both of them, and that the consolidation would be procedurally efficient and equitable. The Panel further notes that the Respondent did not object to the consolidation request. The Panel therefore accepts the Complainants' consolidation request.

For the purpose of this decision, the "Complainant" will refer to both the Complainants.

B. 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 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 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.

It is also well accepted that a generic Top-Level Domain, in this case ".shop", is typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the first element of the Policy has been established.

C. 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.

While 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 often impossible 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. 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 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 notes that the Respondent offered the possibility of providing evidence of its ownership of the disputed domain name, but no explanation as to the selection of the disputed domain name being it identical to the Complainant's trademark. The Panel considers that the mere ownership of the disputed domain name would not be sufficient to establish rights or legitimate interests under the Policy, particularly where the disputed domain name is identical to the Complainant's trademark, and it is being used for the same purpose.

The disputed domain name resolves to a website purportedly providing several of the same products as the Complainant, which coupled with the composition of the disputed domain name leads the Panel to the conclusion that the disputed domain name is not being used in connection with a bona fide offering of goods or services.

Based on the available record, the Panel finds the second element of the Policy has been established.

D. 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, regarding the registration in bad faith of the disputed domain name, the reputation of the Complainant's trademark ATACADAO in the retail field is clearly established, and the Panel finds that the Respondent must have known of the Complainant, and deliberately registered the disputed domain name in bad faith, especially because the Complainant has a relevant presence in Morocco, the Respondent's country, both offline and online, with different stores across the country and a dedicated website at "https://atacadaomaroc.ms".

The Panel further notes that the disputed domain name is also used in bad faith, since the Respondent is trying to impersonate the Complainant with the purpose of intentionally attempting to create a likelihood of confusion with the Complainant's trademark as to the disputed domain name's source, sponsorship, affiliation, or endorsement. Panels have held that the use of a domain name for illegal activity, here impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), sections 3.1.4 and 3.4.

Finally, the Panel considers that the nature of the inherently misleading disputed domain name, which is identical to the Complainant's trademark, further supports a finding of bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Based on the available record, the Panel finds the third element of the Policy has been established.

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, <atacadao.shop>, be transferred to the Complainants.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: October 9, 2024