

ADMINISTRATIVE PANEL DECISION

Carrefour SA, Atacadão S.A. v. johson dire
Case No. D2024-3006

1. The Parties

The Complainant is Carrefour SA, Atacadão S.A., France, represented by IP Twins, France.

The Respondent is johson dire, Türkiye.

2. The Domain Name and Registrar

The disputed domain name <oficialatacado.com> (“Disputed Domain Name”) is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 24, 2024. On July 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 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 (Not Disclosed, Not Disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 25, 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 July 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 August 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 4, 2024.

The Center appointed Michal Havlík as the sole panelist in this matter on September 23, 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 SA is a French company operating in the field of retail. It is listed on the index of the Paris Stock Exchange (CAC 40) and operates more than 12.000 stores in more than 30 countries worldwide.

Atacadão is a Brazilian chain of wholesale and retail stores established in 1960 and acquired by Carrefour in 2007. In 2010 the Complainant began an internationalization program, expanding its activities in other countries beyond Brazil.

Since Atacadão is part of the Carrefour Group, both companies have opted to join in the present Complaint. Both companies are hereinafter referred to as “the Complainant”.

The Complainant is the owner of several ATACADAO and ATACADÃO trademarks (hereinafter referred both together as “ATACADAO”) registered well before the registration of the Disputed Domain Name, such as:

- European Union (EU) trademark ATACADAO No. 012020194, registered on May 24, 2015, and designating service in international class 35;
- Brazilian trademark ATACADÃO No. 006785360, registered on October 10, 1978, duly renewed and designating goods in international class 29; and
- Brazilian trademark ATACADÃO No. 006785344, registered on October 10, 1978, duly renewed and designating goods in class 31.

In addition, the Complainant is also the owner 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 July 4, 2024 and it is not used in connection with an active website but it resolves to an error page. There was no change on the website after filing of the Complaint.

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.

The Complainant contends that the Disputed Domain Name is confusingly similar to its earlier ATACADAO trademark. Moreover, it contains the ATACADAO trademark in its entirety as its second half. In fact, the Disputed Domain Name incorporates the above-mentioned trademarks together with the term “oficial” (a misspelling of the English word “official” or the Spanish/Portuguese translation for “official”). The Complainant states that 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. Therefore, only the addition of the term “oficial” is not sufficient to exclude confusion with the Disputed Domain Name, and neither the generic Top-Level-Domain (gTLD) “.com”. The Complainant claims that the Disputed Domain Name is confusingly similar to the Complainant's earlier trademarks.

The Complainant contends that the Respondent has no prima facie rights or legitimate interests in respect of the Disputed Domain Name. Furthermore, the Complainant contends that its earlier rights precede the Disputed Domain Name by a long period. Moreover, the Complainant states that it has never licensed or

granted an authorization to the Respondent to use ATACADAO mark. By simply maintaining the Disputed Domain Name, the Respondent is preventing the Complainant from reflecting its trademarks and name in the corresponding Disputed Domain Name. The Complainant notes that the non-use of a domain name (including an error page), does not prevent a finding of bad faith under the doctrine of passive holding and alleges that the Respondent does not make fair use of it.

Finally, the Complaint alleges that the registration and use of the Disputed Domain Name was undertaken in bad faith. With regard to the long-term and broad use of the Complainant's trademarks, the Complainant alleges that the Respondent must have known about their existence when registering the Disputed Domain Name.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or a service mark in which the Complainant has right; and
- (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

The Complainant has shown rights regarding a trademark or service mark for the purpose of the Policy. WIPO Overview section 1.2.1.

The entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the mark for the purpose of the Policy. WIPO Overview, section 1.8.

Although the addition of the term "oficial" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between Disputed Domain Name and the mark for the purposes of the Policy. WIPO Overview section 1.8.

The Complainant has demonstrated existence of its trademark rights in the European Union and Brazil. The requirements of the first element for the purposes of the Policy may be satisfied by a trademark registered in any country. See *Thaigem Global Marketing Limited v. Sanchai Aree*, WIPO Case No. [D2002-0358](#). The Disputed Domain Name incorporates the entirety of the Complainant's trademark ATACADAO and adds the word "oficial" and the generic Top-Level-Domain (gTLD) ".com". The additional word is either a misspelling of the common English word "official" or the correct spelling of the Spanish/Portuguese word "oficial". Regardless of which it is, the addition of "oficial" is not capable of preventing a finding of confusing similarity of the Disputed Domain Name and the Complainant's trademark. See *Hoffmann-La Roche AG v. Popo*, WIPO Case No. [D2008-0423](#); and WIPO Overview section 1.8.

A gTLD is an obligatory part of a domain name and is to be disregarded in assessment of confusing similarity. See *Autodesk v. MumbaiDomains*, WIPO Case No. [D2012-0286](#).

Accordingly, this Panel finds that the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights.

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, previous panels have recognized that proving a respondent lack of 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 right 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 (even though 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.

There is no evidence that the Respondent has been commonly known by the Disputed Domain Name as an individual, business or other organization. In addition, the Respondent reproduces the Complainant’s earlier registered trademarks in the Disputed Domain Name without any license or authorization from the Complainant, which is strong evidence of the lack of rights or legitimate interests. The Complainant submits that it has not authorized the use of its earlier trademarks or terms similar thereto in the Disputed Domain Name in any manner or form.

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 illustrating 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 purpose of paragraph 4(a)(iii), paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

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.

The current non-use of the Disputed Domain Name does not prevent a finding of bad faith under the doctrine of passive holding. In similar cases, prior UDRP Panels have found that the passive holding of a disputed domain name is neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use. See, for instance, *Carrefour SA v. Eleganzia Express, Sell Better Negocios Digitais LTDA*, WIPO Case No. [D2023-4919](#).

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. When taking into account all relevant facts and circumstances, the Panel notes that the Disputed Domain Name is confusingly similar to the Complainant’s distinctive trademark, the Respondent has no legitimate rights or interests in the Disputed Domain Name and has failed to prove any evidence of actual or contemplated good-faith use. Taking into account the aforesaid circumstances, the Panel finds that the Respondent has registered and used the Disputed Domain Name in bad faith primarily for the purpose of misleading Internet users and causing harm to the Complainant.

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 <oficialatacado.com> be transferred to the Complainant.

/Michal Havlik/

Michal Havlik

Sole Panelist

Date: October 11, 2024