

## **ADMINISTRATIVE PANEL DECISION**

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

Case No. D2024-4581

### **1. The Parties**

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

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

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

The disputed domain name <atacadaovarejista.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 November 7, 2024. On November 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 7, 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 (Contact Privacy Inc. Customer 0172212611) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 8, 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 November 12, 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 November 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 4, 2024.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on December 10, 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**

Complainant No. 1 is the French company Carrefour SA, while Complainant No. 2 is Complainant No. 1's Brazilian subsidiary Atacadão S.A.

Complainant No. 1 is a world leader in retail, and pioneer of the concept of hypermarkets in 1968. Complainant No. 1 is listed on the Paris Stock Exchange, operates more than 12,000 stores in over 30 countries worldwide, and generated revenues for EUR 83 billion in 2022. Complainant No. 1 employs more than 384,000 employees worldwide and has 1.3 million daily visitors in its stores.

Complainant No. 2 is a Brazilian chain of wholesale and retail stores established in 1960 and acquired by Complainant No. 1 in 2007. With more than 300 stores and distribution centers all over Brazil and more than 70,000 employees, Complainant No. 2 is the largest wholesale network in the country. In 2010, Complainant No. 2 began an internationalization program, expanding its activities in other countries beyond Brazil.

Complainant No. 1 is the owner of the following European Union trademark registration:

- ATACADAO, No. 012020194, registered on May 24, 2015, for services in class 35;

Complainant No. 2 is the owner of various ATACADAO trademark registrations in multiple jurisdictions, including the following:

- ATACADAO, Brazilian registration No. 006937497, registered on May 25, 1979, for services in class 35;

The disputed domain name was created on August 25, 2024, and at the time of filing the Complaint resolved to a webpage displaying pay-per-click ("PPC") links referring to wholesale activities.

#### **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 contend that the disputed domain name is confusingly similar to their ATACADAO mark as it fully incorporates this mark followed by the Portuguese term "varejista", which means "retailer".

The Complainants further contend that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent does not own trademark rights for the term "ataca dao". Moreover, the Complainants have found no evidence that the Respondent is commonly known by the disputed domain name. The Complainants did not authorize the Respondent to use their ATACADAO mark as part of the disputed domain name or in any other manner or form. The disputed domain name, which entirely reproduces the Complainants' mark, is inherently likely to mislead Internet users as it carries a high risk of implied affiliation. The use of the disputed domain name does not amount to fair use as it effectively impersonates the Complainants or suggest sponsorship or endorsement by them. Moreover, the Respondent has not used or made preparations to use the disputed domain name in connection with a bona fide offering of goods or services as the disputed domain name resolves to a web page containing PPC links.

Such use is also not legitimate nor fair as it is for commercial gain and misleadingly diverts customers aware of the Complainants' ATACADAO mark.

Regarding bad faith registration and use, the Complainants affirm that the Respondent was certainly aware of the ATACADAO mark when it registered the disputed domain name. According to the Complainants, the ATACADAO mark enjoys substantial reputation. Complainant No. 2 has 3 million followers on Facebook, the ATACADAO mark is featured in several rankings, including the biggest Brazilian and Latin America brands, and the reputation of the ATACADAO mark has been already recognized in other past UDRP decisions. A quick online search on the term "atacado" would have revealed the Complainants and their corresponding mark. Thus, the choice of the disputed domain name was not accidental but influenced by the fame of the ATACADAO mark. By registering the disputed domain name, the Respondent is preventing the Complainants from reflecting their ATACADAO mark in a corresponding domain name. In addition, the Respondent is presumably obtaining an economic advantage from the PPC links associated with the disputed domain name.

The Complainants also point out that the Respondent did not provide accurate information when registering the disputed domain name as the Respondent used a privacy protection service in order to conceal its real identity and avoid accountability for its infringing activity.

Finally, the Complainants note that the Respondent has been the Respondent in other recent UDRP proceedings including against the same Complainants for domain names incorporating the ATACADAO mark. In all these proceedings, the Respondent was using the domain names to resolve to webpages containing PPC links and panels ordered the transfer of the domain names to the relevant complainants.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary issue – Consolidation of multiple complainants**

Before evaluating the Complainants arguments, it is necessary for the Panel to assess whether it is possible, in this case, to consolidate a Complaint brought by two Complainants against a single Respondent. Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. In assessing 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.11.1.

In the instant case, the Panel notes that both Complainants own registered rights over the ATACADAO mark, that they belong to the same group, and that the Respondent has engaged in common conduct that has affected the Complainants in a similar fashion. Moreover, it would certainly be equitable and procedurally efficient to permit the consolidation. Therefore, the Panel allows the consolidation of the Complaint. Hereinafter, the Complainants are collectively referred to below 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 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. In particular, the Complainant owns registered rights over the trademark ATACADAO.

Although the addition of other terms here, "varejista", 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 the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Accordingly, 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 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.

In particular, the Respondent has no relationship with the Complainant and there is no evidence in the case file that the Respondent might be commonly known by the disputed domain name. The Complainant did not authorize the Respondent to use its ATACADAO mark in any manner, including as part of the disputed domain name.

The disputed domain name consists of the ATACADAO mark coupled with the Portuguese term "varejista", meaning "retailer", which is strictly associated with the Complainant who operates in the retail field. Accordingly, Internet users could be misled to believe that the disputed domain name belongs to, or is sponsored or endorsed by, the Complainant. Therefore, the disputed domain name carries a risk of implied affiliation.

As noted above, at the time of the filing of the Complaint, the disputed domain name resolved to a webpage containing PPC links. These links referred to the Complainant's activity. The use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with, or capitalize on, the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users. [WIPO Overview 3.0](#), section 2.9.

Accordingly, 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 Complainant has provided evidence in support the reputation of its ATACADAO mark and that previous UDRP Panels have recognized such reputation in the Complainant's business field. Furthermore, the term "atacadao" is a coined term and the ATACADO mark is inherently distinctive. The disputed domain name includes the Portuguese term "varejista", which means "retailer" and is strictly associated with the Complainant's business. Complainant No. 2 is a Brazilian company, which mainly operates in Brazil, where Portuguese is the national language. All these circumstances support the Respondent's knowledge of the Complainant, its trademark and activity, at the time of the registration of the disputed domain name. The registration of a domain name confusingly similar to a third party's mark, being aware of such mark and without rights or legitimate interests, amounts to registration in bad faith.

As far as use in bad faith is concerned, the Panel notes that the use of the disputed domain name to resolve to a website with PPC links amounts to use in bad faith. In particular, this is so because the Complainant's mark enjoys reputation, and the disputed domain name incorporates the mark entirely and is thus highly misleading. The Panel further notes that the Respondent has been involved in previous UDRP cases against the same Complainant for domain names incorporating the Complainant's ATACADAO mark which, at least in one other instance, included a Portuguese term. All these domain names resolved to websites containing PPC links. The Respondent's intention to target the Complainant and its mark is therefore clear. It also appears that by using the disputed domain name, the Respondent wants to exploit the Complainant's recognition and goodwill for its own undue profit. Accordingly, the Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark.

Lastly, the Panel notes that the Respondent has concealed its identity behind a privacy service provider, thus rendering more difficult the Complainant's defense of their trademark rights. Such a circumstance further supports a finding of bad faith.

For all the reasons described above, the Panel finds that the Complainant has established the third and last 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 <atacadaovarejista.com> be transferred to the Complainant.

*/Angelica Lodigiani/*

**Angelica Lodigiani**

Sole Panelist

Date: December 24, 2024