

ADMINISTRATIVE PANEL DECISION

Carrefour SA, Atacadão S.A. v. Jorge Guido Pereira Leitao
Case No. D2024-4650

1. The Parties

The Complainants are Carrefour SA (“first Complainant”), France and Atacadão S.A. (“second Complainant”), Brazil, represented by IP Twins, France.

The Respondent is Jorge Guido Pereira Leitao, Brazil.

2. The Domain Name and Registrar

The disputed domain name <atacadaobusca.shop> is registered with Hostinger Operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 12, 2024. On November 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 14, 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 Complainant on November 14, 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 15, 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 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 6, 2024.

The Center appointed Steven A. Maier as the sole panelist in this matter on December 11, 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 first Complainant is a company registered in France. The second Complainant is a company registered in Brazil, and is a subsidiary of the first Complainant. The Panel is satisfied that the Complainants have a specific common grievance against the Respondent and that it would be equitable and procedurally efficient to permit the consolidation of their Complaints against the Respondent (see section 4.11 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainants operate supermarket and related services in Brazil under the name and mark ATACADAO.

The Complainants are the owners of trademark registrations including the following:

- Brazil trademark registration number 006785360 for the word mark ATACADÃO, registered on October 10, 1978 for various food products; and
- European Union trademark number 012020194 for the word mark ATACADAO, registered on May 24, 2015 for goods and services in International Class 35.

The Complainants' trademark ATACADAO has been found by previous panels under the UDRP to have attained the status of a famous or well-known trademark, at least in Brazil (see e.g. *Carrefour S.A., Atacadão S.A. v. Gabriel Silva*, WIPO Case No. [D2023-4424](#)).

The disputed domain name was registered on October 8, 2024.

The disputed domain name does not appear to have resolved to any active website.

5. Parties' Contentions

A. Complainants

The Complainants submit that the name Atacadao is a coined term, and that the supermarket chain under that name began trading in 1968, being acquired by the second Complainant in 2007. They state that the Atacadao chain comprises over 300 stores and distribution centres in Brazil, with over 70,000 employees, and that it commenced extending its activities internationally in 2010.

The Complainants submit that the disputed domain name is confusingly similar to their ATACADAO trademark. They contend that the disputed domain name incorporates that trademark in its entirety, with the addition of the dictionary term "busca", which means "search" in both Portuguese and Spanish. The Complainants submit that an addition of that nature does nothing to diminish the confusing similarity of the disputed domain name.

The Complainants submit that the Respondent has no rights or legitimate interests in respect of the disputed domain name. They state that they have no relationship with the Respondent and have never authorized it to use its ATACADAO trademark, that the Respondent has not commonly been known by the disputed domain name, and that the Respondent is not making any bona fide commercial use of the disputed domain name.

The Complainants contend that the disputed domain name was registered and is being used in bad faith. They state that, in view of the well-known status of the ATACADAO trademark, particularly in Brazil, where the Respondent is also located, it is implausible that the Respondent was unaware of that trademark when it registered the disputed domain name.

The Complainants submit that the Respondent can only be using the disputed domain names to attempt confuse Internet users who are looking for the Complainants' services, and to prevent the Complainants from reflecting their trademark in the disputed domain name.

The Complainants adds that the fact that the disputed domain name has not resolved to any active website, i.e. is "passively" held, does not prevent a finding of bad faith in all the circumstances of the case.

The Complainants request the transfer of the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainants are required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have 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. Identical or Confusingly Similar

The Complainants have established that they are the owners of registered trademark rights in the mark ATACADAO. The disputed domain name wholly incorporates that mark, together with the term "busca", which the Panel accepts translates from Portuguese as "search" or a similar term. The addition of a dictionary word of this nature does not prevent the Complainants' trademark from being recognizable within the disputed domain name, and the Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainants have rights.

B. Rights or Legitimate Interests

In the view of the Panel, the Complainants' submissions set out above give rise to a prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. However, the Respondent has failed to file a Response in this proceeding and has not submitted any explanation for its registration and use of the disputed domain name, or evidence of rights or legitimate interests on its part in the disputed domain name, whether in the circumstances contemplated by paragraph 4(c) of the Policy or otherwise. The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Complainants have established that their ATACADAO trademark is an invented term, and is well-known, in any event in Brazil. The Respondent has provided no explanation for its registration of the disputed domain name, which the Panel finds to be likely to be understood by Internet users as referring to the

Complainant. The Panel infers in the circumstances that the Respondent registered the disputed domain name with the Complainants' trademark in mind, and with the intention of deriving unfair commercial advantage from the goodwill attaching to that trademark.

The Panel finds the disputed domain name to be inherently misleading, as inevitably suggesting to Internet users that it is owned or operated by, or otherwise legitimately affiliated with, the Complainants. While the Respondent's ultimate intentions with regard to the disputed domain name are unclear, the Panel can conceive of no use that the Respondent could make of the disputed domain name without causing confusion with the Complainants' trademark and taking unfair advantage of, and/or causing unfair detriment to, that trademark.

The Panel notes that the "passive" holding of a domain name does not prevent a finding of registration and use of that domain name in bad faith when all the circumstances of the case point to that conclusion (see e.g., *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

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 <atacadaobusca.shop> be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: December 23, 2024