

ADMINISTRATIVE PANEL DECISION

**Carrefour SA. and Atacadão - Distribuição, Comércio E Indústria LTDA. v.
Nikolai P. Golovenkov
Case No. D2023-2576**

1. The Parties

The Complainants are Carrefour SA, France, and Atacadão - Distribuição, Comércio E Indústria LTDA., Brazil, represented by IP Twins, France.

The Respondent is Nikolai P. Golovenkov, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <atacadão.com> (<xn--atacado-2wa.com>) is registered with Dynadot, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 16, 2023. On June 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 16, 2023, 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 (Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainants on June 21, 2023 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 July 11, 2023.

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 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2023. Several email communications were received from the Respondent between July 8 and July 14, 2023. The Response and the amended Responses were filed with the Center on July 26, July 29, and July 30, 2023, respectively.

The Complainant filed an unsolicited supplemental filing on July 31, 2023, and the Respondent submitted a counter reply on August 1, 2023.

The Center appointed Gonalo M. C. Da Cunha Ferreira as the sole panelist in this matter on August 18, 2023. 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.

Generally speaking, unsolicited supplemental filings are discouraged, unless specifically requested by the panel. However, considering the Respondent already replied on August 1, 2023 to the Complainant's unsolicited supplemental filing dated July 31, 2023, and further submissions from the Parties are relevant to the proceeding, the Panel has exceptionally decided to accept the Parties' further submissions pursuant to paragraph 10 of the Rules.

4. Further Procedural Considerations

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Despite the Respondent's mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Taken into consideration that the Respondent has received the Complaint and has responded to the Complaint including the Complainant's unsolicited supplemental filing dated July 31, 2023, and all the circumstances of the case, the Panel is of the view that the proceeding should continue.

The Panel concludes that the Parties have been given a fair opportunity to present their cases, and that the administrative proceeding should take place with due expedition, therefore the Panel will proceed to a Decision accordingly.

5. Factual Background

The Complainants are Carrefour SA ("Carrefour"), and Atacado - Distribuio, Comrcio E Indstria LTDA ("Atacado"). Atacado is part of the Carrefour group, both companies have opted to join in the present Complaint.

Carrefour is a worldwide leader in retail and a pioneer of the concept of hypermarkets back in 1968. With a turnaround of 76 billion euros in 2018, the Complainant is listed on the index of the Paris Stock Exchange (CAC 40). The Complainant operates more than 12,000 stores in more than 30 countries worldwide. With more than 384,000 employees worldwide and 1.3 million daily unique visitors in its stores, the Complainant is a major and well-known worldwide leader in retail. The Complainant additionally offers travel, banking, insurance, or ticketing services.

Atacado is a Brazilian chain of warehouse stores established in 1960. In 2007, it was bought by Carrefour. In 2022, the company has over 250 stores and distribution centers in Brazil.

Unless specified otherwise, the Complainants are hereinafter referred to as the "Complainant".

The Complainant is the owner of the following trademarks:

- European trademark ATACADAO No. 012020194, registered on May 24, 2015, designating services in international class 35;
- Brazilian trademark ATACADÃO No. 006785344, registered on October 10, 1978, designating goods in international class 31;
- Brazilian trademark ATACADAO No. 006937497, registered on May 25, 1979, designating services in international class 35;

The Respondent is Nikolai P. Golovenkov, Ukraine.

The disputed domain name was registered on September 5, 2008, and at the time of filing of the Complaint, it did not resolve to an active website.

6. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical to its earlier trademarks ATACADÃO and highly similar to the earlier trademarks ATACADAO and the use of lower-case letter format and the addition of the Top-Level Domain ("TLD") are not significant to avoid the confusing similarity to the Complainant's trademark.

The Complainant also contends that the Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name that is the subject of the Complaint because the Complainant performed searches and found no ATACADÃO or ATACADAO trademark owned by the Respondent and there is no evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization.

The Complainant further contends that it has not authorized or licensed any trademark rights to the Respondent nor has the Complainant authorized the term "atacado" or terms similar thereto in the disputed domain name in any manner or form.

The Complainant also puts forth that the Respondent has not, before the original filing of the Complaint, used or prepared to use the disputed domain name in relation to a *bona fide* offering of goods or services as the disputed domain name resolves to an error page.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith by the Respondent. In particular, the Complainant contends that the Respondent's choice of the disputed domain name could not have been accidental and must have been influenced by the fame of the Complainant and its earlier trademarks. Although the disputed domain name is an inactive, it does not prevent a finding of bad faith.

In the Complainant's supplemental filing, the Complainant reiterates that it is the owner of the trademarks ATACADAO and ATACADÃO, and therefore has standing in the present proceeding, and the disputed domain name is identical to the earlier trademarks of the Complainant.

The Complainant contends that the Respondent not only registered the disputed domain name many decades after the Complainant's rights in the famous and distinctive ATACADAO and ATACADÃO marks were registered, but also previously used the disputed domain name in an attempt to defraud Internet users. The disputed domain name was used in 2019 in connection with an active website, listing notably offers and coupons to use, and there was a Marketplace section where it seems that the Respondent was displaying goods or services to purchase. The Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant further contends that the Respondent registered other domain names incorporating third party trademarks, one of which seems to be a trademark belonging to company located in Brazil. Therefore, the Complainant asserts that the Respondent appears to have a special knowledge and familiarity with companies in Brazil, like the Complainant, despite having an address in Ukraine. This also supports a finding of a pattern of bad faith on the part of the Respondent preventing trademark holders from reflecting their marks in domain names.

The Complainant also points out that according to Whois history records, the Respondent listed the disputed domain name for sale in 2018 for a price of USD 500, and at the time of filing of the supplemental filing, the selling price increased to USD 120,000. Therefore, the Respondent is attempting to make commercial gain off the name and trademark of the Complainant. An Internet search dated before the registration date of the disputed domain name shows top results only related to the Complainant and its business. The Complainant reiterates that the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

The Respondent argues that the Complainant has used incorrectly the “well-known” term since in Brazil this term will be translated as “marcas de alto renome ou marcas notórias” and in Brazil there are only 106 trademarks recognized as famous or well-known marks and the marks of the Complainant does not belong to this list.

The Respondent contends that according to Brazil trademark law, “marca notoriamente conhecida” should be translated in English as “known mark” or “ordinary mark” and this type of mark is given protection only in its field in related goods or services according to this specific mark, not a special protection as alleged by the Complainant. The Respondent put forth that not only the Complainant trademark is not well known as it is a weak, descriptive mark not an arbitrary or fanciful mark, lacking secondary meaning, and contains a common expression which per se is nothing more than the type of service that the Complainant provides as an identification of a wholesale market segment. The Complainant’s marks are given protection only in related goods or services according to its mark applications and even so, the Complainant’s marks co-exist with other similar marks as they lack distinctive characters.

The Respondent also argues that thousands of businesses today have used the word “atacadão” in their name for self-identification because the term “atacadão” is a common descriptive word necessary for wholesale businesses to use as part of their names to identify products and services in their specific segment (Wholesale) and, therefore, competing businesses certainly do need this expression to market their own products to consumers.

The Respondent states that the Complainant cannot claim that it has exclusive rights for using the word “atacadão” in a domain name, otherwise it could have claims to many thousands of businesses/websites using this name as part of the business name and web addresses. Since the word “atacadão” is a descriptive term for a type of service (wholesale), it cannot acquire a secondary meaning by association with only one wholesale business.

The Respondent presents an extensive list of businesses using the word “atacadão” as part of their company names, many of which hold registered trademarks in Brazil incorporating the word “atacadão” and use this word as part of their website addresses.

The Respondent states that he is in the outsourcing and web development business. He lives and does business in Ukraine and abroad and have invested in a large portfolio of prime generic domain names in various languages, that he purchased for investment, resale, and development purposes. Part of the Respondent’s generic domain name’s portfolio are in Portuguese, such as <serviços.com>, <moradia.com>, and <dedetização.com>. The Respondent registered these common word domain names due to their commercial value.

The Respondent states that he had no awareness of the Complainant at the time of registration and that there is no evidentiary basis to conclude otherwise or to infer such awareness. The Respondent asserts that the Complainant’s trademark is not a coined term. Rather, “atacadão/atacadao” is a common

Portuguese word, a noun of the word “atacado” (translation: wholesale/wholesaler) in the augmentative form. In Portuguese, the most common augmentative suffixes are “-ão” (for masculine words) and “-ona” (for feminine words). They often indicate a larger size. The Respondent registered the disputed domain name in 2008 due to its generic meaning. The Respondent has registered many other generic domain names in the Portuguese language in the augmentative form such as <brasileirão.com>, <mercadão.com>, <salão.com>, <lojão.com>, <rapidão.com>, and <portão.com>.

The Respondent states that he has been developing and using the disputed domain name from 2012 to 2019, offering *bona fide* goods and services. During the development, the website went through three redesigns, and was offering goods and services in the dictionary meaning of the word “atacadão” (wholesale) first in 2012 as cosmetic products sales and then selling products through affiliated marketing and, finally, through 2022 as a wholesale marketplace.

The Respondent informs that the territory where he lives and does business is currently subject to an international conflict, making it difficult to continue business as usual and this situation is also the reason why the Respondent for security purposes keeps privacy on his domain names. The Respondent does not employ the privacy service merely to avoid being notified of a UDRP proceeding filed against him but uses it for personal security.

The Respondent further contends that he has not registered the disputed domain name with the intent to sell it to the Complainant, to disrupt the Complainant’s business, or to confuse consumers seeking to find the Complainant’s website. Finally, the Respondent contends that he did not register the disputed domain name to prevent the Complainant from owning a domain name incorporating its trademark.

In the Respondent’s supplemental filing, the Respondent asserts that the Complainant is twisting the words by saying that the generic term in Portuguese for “wholesale” is not “atacadão” but “atacado”. As indicated in the Response, “atacadão” is the noun of “atacado” (“wholesale”) in the augmentative form. The Respondent does not argue that the Complainant has rights in the ATACADÃO mark but the Respondent wishes to point out that the Complainant’s mark is a weak and descriptive mark.

The Respondent used the disputed domain name for websites from 2012 to 2019, and the disputed domain name has been used in its generic sense - wholesale/wholesaler, listing and selling wholesale goods and services for wholesalers.

The Complainant provides a list of several domain names registered under the name of Nikolai Pavlov and alleges that they all belong to the Respondent. However, Nikolai Pavlov is a very common name.

The Respondent does have domain names for sale, but he has never offered to sell the disputed domain name to the Complainant. UDRP panels have found on many occasions that registering and selling generic domain names is a *bona fide* offering of goods and services under the Policy.

In light of the above arguments, the Respondent requests the Panel to deny the Complaint filed by the Complainant.

7. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (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. 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy through registration. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the Complainant's ATACADAO/ATACADÃO marks are clearly recognizable in the disputed domain names. Accordingly, the disputed domain name is identical or confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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

B. Rights or Legitimate Interests

Noting the Panel's finding under the third element, it is not necessary for the Panel to make a determination under the second element.

C. Registered and Used in Bad Faith

Policy criteria establish that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. To facilitate assessment of whether this has occurred, and bearing in mind that the burden of proof rests with the complainant, UDRP, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

In order to establish the Respondent registered the disputed domain name in bad faith, the Complainant must show that the Respondent knew or should have known of the Complainant at the time of registration of the disputed domain name. The Complainant contends that the disputed domain name *per se* is not a dictionary term, and the Respondent registered the disputed domain name many decades after the Complainant's registration of its famous and distinctive ATACADAO and ATACADÃO marks, therefore, the Respondent targeted the Complainant and its marks at the time of registration of the disputed domain name. The Respondent asserts that he was not aware of the Complainant, and he registered the disputed domain name because the term "atacadão" means "atacado" ("wholesale") in the augmentative form.

Based on the available record, the Panel notes the following that:

- the term “atacado” in Portuguese means “wholesale” and the suffix “ão” in Portuguese means “a large one of its kind”, therefore, the term “atacadão” may mean the scale of wholesale is massive;
- although the top results of a Google search for the term “atacado” before September 5, 2008 (registration date of the disputed domain name) provided by the Complainant shows many results related to the Complainant, there are other results related to third parties as well;
- according to the Respondent, he is in the outsourcing and web development business, and has invested in a large portfolio of prime generic domain names. The Respondent has also many other domain names composed of Portuguese terms in the augmentative form such as <brasileirão.com>, <mercadão.com>, <salão.com>, <lojão.com>, <rapidão.com>, and <portão.com>;
- The Complainant presents a list of domain names registered under the name of Nikolai Pavlov which includes a couple of domain names incorporating third party trademarks. The Respondent asserts that Nikolai Pavlov is a common name. However, even if these domain names were registered by the Respondent, it does not necessarily mean that the Respondent targeted the Complainant when he registered the disputed domain name under the circumstances of this case;
- The use of the disputed domain name in 2019 as evidenced by the Complainant appears to have been offering for sale coupons for wholesale in different area of businesses, corresponding to the dictionary meaning of the disputed domain name;
- The Policy *per se* does not prohibit from selling domain names which have dictionary meanings.

Considering the above, and on the balance of probabilities, the Panel finds no reasonable inference may be drawn that the Respondent specifically targeted the Complainant in bad faith to take advantage of the reputation and fame of the Complainant’s mark at the time of registering the disputed domain name.

Therefore, the Complainant has not satisfied paragraph 4(a)(iii) of the Policy.

8. Decision

For the foregoing reasons, the Complaint is denied.

/Gonçalo M. C. Da Cunha Ferreira/

Gonçalo M. C. Da Cunha Ferreira

Sole Panelist

Date: September 27, 2023