

ADMINISTRATIVE PANEL DECISION

Carrefour SA, Atacadão - Distribuição, Comércio E Indústria Ltda. v.
ELIONAI SILVA
Case No. DIO2023-0017

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 Elionai Silva, Brazil.

2. The Domain Name and Registrar

The disputed domain name <atacado-fatura.io> is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 1, 2023. On June 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 2, 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 (Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same day, 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 June 6, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain

Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 June 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 28, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on July 4, 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.

4. Factual Background

The Complainant is the French retail company Carrefour and its Brazilian subsidiary Atacadão (hereinafter jointly referred to as “the Complainant”). Carrefour operates in more than 30 countries and pioneered the concept of hypermarket back in 1968; Atacadão is a Brazilian chain of warehouse stores established in 1960 and acquired by Carrefour in 2007.

The Complainant owns numerous trademark registrations in different regions of the world for the brand ATACADÃO, such as European Union Trade Mark no. 012020194, registered on May 24, 2015, and the Brazilian trademarks nos. 006785344, registered on October 10, 1978, and 006937497, registered on May 25, 1979.

The disputed domain name was registered on March 1, 2023.

The Panel accessed the disputed domain name on July 15, 2023, when it was not linked to any active website¹. From the evidence provided by the Complainant, the disputed domain name was also inactive at the time of filing the Complaint.

5. Parties’ Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is confusingly similar to the Complainant’s trademark ATACADÃO. The Complainant has demonstrated rights on the terms ATACADAO and ATACADÃO. The disputed domain name is highly similar to the earlier well-known trademarks ATACADÃO. Indeed, the disputed domain name includes the trademarks ATACADÃO in their entirety. The second part of the disputed domain

¹ Further to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.8, “[n]oting in particular the general powers of a panel articulated *inter alia* in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name...”.

name is the term “fatura”. It is established case law that the addition of a term to a well-known trademark in a domain name does nothing to diminish the likelihood of confusion arising from that domain name. The use of lower-case letter format on the one hand and the addition of the Top-Level Domain on the other hand, are not significant in determining whether the disputed domain name is identical or confusingly similar to the trademarks of the Complainant. In many previous decisions, panels considered that the incorporation of a well-known trademark in its entirety may be sufficient to establish that the domain name is identical or confusingly similar to the Complainant’s trademark.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant performed searches and found no ATACADÃO trademark owned by the Respondent. Furthermore, there is no evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization. Secondly, the Respondent reproduces the Complainant’s earlier registered trademarks ATACADÃO in the disputed domain name without any license or authorization from the Complainant, which is strong evidence of the lack of legitimate interest. Thirdly, 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. Indeed, the disputed domain name resolves to an error page. Such use cannot be seen as a *bona fide* offering of goods or services under the Policy. Fourthly, since the adoption and extensive use by the Complainant of the trademarks ATACADÃO predate the registration of the disputed domain name, the burden is on the Respondent to establish the Respondent’s rights or legitimate interests the Respondent may have or have had in the disputed domain name. None of the circumstances which set out how a respondent can prove rights or legitimate interests in the disputed domain name, are present in this case.

- The disputed domain name was registered and is being used in bad faith. Firstly, it is inconceivable that the Respondent ignored the Complainant or its earlier rights on ATACADÃO. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a trademark by an unaffiliated entity can by itself create a presumption of bad faith. Secondly, it is highly likely that the Respondent chose the disputed domain name because of its identity with or similarity to a trademark in which the Complainant has rights and legitimate interest. The Respondent acquired and is using the disputed domain name to attract Internet users by creating a likelihood of confusion with the Complainant’s earlier marks. Thirdly, the Complainant’s ATACADÃO trademark registrations significantly predate the registration date of the disputed domain name. In this regard, previous panels have established that knowledge of the Complainant’s intellectual property rights, including trademarks, at the time of registration of the disputed domain name, proves bad faith registration. Furthermore, a simple search on an online search engine shows results only related to the Complainant. Fourthly, the current use of the disputed domain name may not be considered a good faith use. By maintaining the disputed domain name, the Respondent is preventing the Complainant from reflecting its trademark in the corresponding domain names. The relevant issue is not limited to whether the Respondent is undertaking a positive action in bad faith in relation to the disputed domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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 or is being used in bad faith.

A. Identical or Confusingly Similar

The Panel has no doubt that “atacado” is a term directly connected with the Complainant’s trademark.

Annexes 3, 4, and 5 to the Complaint show numerous trademark registrations for ATACADÃO, as early as in 1978.

The disputed domain name incorporates the Complainant’s trademark ATACADÃO, with the addition of a hyphen and of the Portuguese dictionary word “fatura” (which corresponds to “bill” in English). The disputed domain name also presents the country-code TLD (“ccTLD”) “.io”.

Previous UDRP decisions have found that the mere addition of symbols such as a hyphen or of descriptive terms (such as “fatura” in this case) to a trademark in a domain name does not prevent a finding of confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#)²; *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S.M.A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well established that the addition of a ccTLD such as “.io” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or

² Given the similarities between the ioDRP and the Uniform Domain Name Resolution Policy (“UDRP”), the Panel finds it appropriate to refer to UDRP jurisprudence, including reference to the [WIPO Overview 3.0](#).

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel notes that the present record provides no evidence to demonstrate the Respondent's intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the disputed domain name is currently not linked to any active website and the Respondent has not indicated any reason to justify why it has chosen the specific term "atacado-fatura" to compose the disputed domain name.

The Complainant has not licensed or authorized the use of its trademark to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

Given the Complainant's primary operations in Brazil under the brand ATACADÃO, the same country of residence of the Respondent, the composition of the disputed domain name naturally implies affiliation with the Complainant.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered or Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in 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 registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

When the disputed domain name was registered in 2023, the trademark ATACADÃO was already famous in Brazil and directly connected to the Complainant's retail services.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – reportedly a resident of Brazil – could not have been aware of the Complainant's trademark at the time of the registration of the disputed domain name, as well as that the adoption of the expression “atacaao-fatura” could be a mere coincidence.

According to the [WIPO Overview 3.0](#), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Actually, the Panel considers that in the present case the addition to the Complainant's trademark of the term “-fatura” may even enhance the risk of confusion, suggesting that the disputed domain name refers to a website where ATACADÃO bills (“fatura” in Portuguese) could be paid.

From the Panel's search, the disputed domain name does not currently resolve to any active website.

However, UDRP panels have frequently found that the apparent lack of so-called active use of the domain name (passive holding) does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and *Polaroid Corporation v. Jay Strommen*, WIPO Case No. [D2005-1005](#).

The non-collaborative posture of the Respondent, *i.e.*, (a) not presently using the disputed domain name, (b) not indicating any intention to use it, and (c) not at least providing justifications for the use of a famous third party trademark, certainly cannot be used in benefit of the Respondent in this Panel's opinion, which circumstances, together with (d) the lack of any plausible interpretation for the adoption of the term “atacaao-fatura” by the Respondent, are enough in this Panel's view to characterize bad faith registration and use in the present case.

Although a transfer may occur under the Policy (for .io domain names) with a showing of either bad faith registration or bad faith use, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied 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, <atacaao-fatura.io>, be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: July 18, 2023