

ADMINISTRATIVE PANEL DECISION

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

Case No. D2024-1686

1. The Parties

The Complainants are Carrefour SA, France (the “First Complainant”) and Atacadão S.A., Brazil, (the “Second Complainant”), both 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 <atacado.club> is registered with Communigal Communications Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 22, 2024. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 25, 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 (REDACTED FOR PRIVACY/Domain Name Privacy Inc) and contact information in the Complaint.

The Center sent an email communication to the Complainants on April 25, 2024, 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 April 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 May 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 29, 2024.

The Center appointed Matthew Kennedy as the sole panelist in this matter on June 3, 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 retailer based in France. The Second Complainant is a Brazilian chain of wholesale and retail stores established in 1960 and acquired by the First Complainant in 2007. The Second Complainant now has over 300 stores and distribution centers throughout Brazil.

The First Complainant holds the following European Union trademark registration:

- number 012020194 for ATACADAO, registered on May 24, 2015, specifying services in class 35.

The Second Complainant holds trademark registrations in multiple jurisdictions, including the following Brazilian trademark registrations:

- number 006785360 for ATACADÃO, registered on October 10, 1978, specifying meats and other goods in Brazilian national class 29;
- number 006785344 for ATACADÃO, registered on October 10, 1978, specifying dairy products in general in Brazilian national class 31; and
- number 006937497 for ATACADAO, registered on May 25, 1979, specifying drinks and other goods in Brazilian national class 35.

The above trademark registrations remain current. According to evidence on record, Interbrand ranked ATACADÃO among the top 25 Brazilian brands in 2023. The Second Complainant operates a Facebook account under the name “Atacadão SA”, which has over 3 million followers. The Second Complainant also registered the domain name <atacado.com.br> on October 9, 1997. This domain name resolves to a website in Portuguese for the Mega Polo Moda, which the site describes as “o maior shopping de atacado do Brasil” (i.e., the largest wholesale mall in Brazil, where “atacado” means “wholesale”)¹.

The Respondent is a privacy service located in Cyprus. The identity of the underlying registrant of the disputed domain name was not disclosed by the Registrar.

The disputed domain name was created on April 10, 2024. It resolves to a page displaying Pay-Per-Click (“PPC”) links related to “estudante” (i.e., “student” in Portuguese), “hotel conference room rentals” and an online trading platform.

The Registrar confirmed that the Registration Agreement for the disputed domain name is in English.

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.

¹The Panel notes its general powers articulated inter alia in paragraphs 10 and 12 of the Rules and has visited the website associated with the Complainant’s domain name <atacado.com.br> (to which the Complainant referred), to verify if and how the Second Complainant uses its marks on that site. The Panel considers this process of verification useful in assessing the case merits and reaching a decision. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 4.8.

Notably, the Complainants contend that the disputed domain name is identical to their marks. The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not authorized the use of its trademarks or similar terms in the disputed domain name. The disputed domain name was registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Preliminary Issue: Multiple Complainants

The Complaint was filed by two Complainants against a single Respondent. The First Complainant is the parent company of the Second Complainant, and both have rights in relevant trademarks. The Panel finds that the Complainants have a common grievance against the disputed domain name registrant and that it is efficient to permit the consolidation of their complaints. Therefore, the Complainants are referred to below collectively as "the Complainant" except as otherwise indicated.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following 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 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. See [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of the ATACADAO and ATACADÃO trademarks for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name reproduces the entirety of the ATACADAO mark. The disputed domain name also reproduces the ATACADÃO mark, except that it substitutes an "a" for the non-ASCII character "ã". Despite this minor difference, the ATACADÃO mark is clearly recognizable within the disputed domain name. The only additional element in the disputed domain name is a generic Top-Level Domain ("gTLD") extension (".club") which, as a standard requirement of domain name registration, may be disregarded in the assessment of identity and confusing similarity for the purposes of the Policy. Accordingly, the disputed domain name is identical to the ATACADAO mark, and confusingly similar to the ATACADÃO mark, for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7, 1.8, and 1.11. Therefore, 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. See [WIPO Overview 3.0](#), section 2.1.

The disputed domain name wholly incorporates the Complainant’s ATACADAO trademark, and it also incorporates the Complainant’s ATACADÃO trademark, except that it substitutes an “a” for the non-ASCII character “ã”. The Respondent uses the disputed domain name to resolve to a PPC links landing page. In the circumstances of the case, the Panel does not consider that this is a use in connection with a bona fide offering of goods and services that would create rights or legitimate interests for the purposes of the Policy. Given that the PPC links presumably operate for the benefit of the Respondent, if it is paid to direct traffic to the linked websites, or for the commercial gain of the operators of the linked websites, or both, this is not a legitimate noncommercial or fair use of the disputed domain name. Further, nothing on the record indicates that the Respondent has been commonly known by the disputed domain name.

The Panel notes that “atacadão” is the augmentative form of the Portuguese dictionary word “atacado”. “Atacado” may be translated as a form of wholesale sales, or large-scale trade, carried out between producers and resellers², while the augmentative suffix “-ão” indicates a large one of its kind. However, the Respondent makes no use of the disputed domain name in connection with any such meaning.

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.

Based on the record, 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. The fourth of these is as follows:

“(iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] 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 [the respondent’s] website or location or of a product or service on [the respondent’s] website or location.”

The disputed domain name was registered in 2024, years after the registration of the Complainant’s marks, including in the European Union, where the Respondent’s contact address is reportedly located. The disputed domain name is identical to the ATACADAO mark and differs from the ATACADÃO mark only insofar as it substitutes an “a” for the non-ASCII character “ã”. The Complainant has made longstanding and extensive use of its ATACADÃO mark in connection with its supermarket business in Brazil. According to the evidence, the top results of a Google search for “atacado” (all in ASCII characters) relate to itself, even when the search is conducted outside Brazil. The Panel has verified that the same is true of a Google search for “atacadão” (written with an accent). Although “atacadão” is the augmentative form of a Portuguese dictionary word, taking into account the strong reputation of the ATACADÃO mark and the other

² See Dicio, Dicionário Online de Português (Online Portuguese Dictionary) at <https://www.dicio.com.br/>.

circumstances of this case, the Panel finds it more likely than not that the disputed domain name was registered with the Complainant and its mark in mind.

The disputed domain name is used in connection with a PPC links landing page. In the Panel's view, it operates by attempting to attract Internet users searching for the Complainant and diverting them to the Respondent's landing page. This use is intentional and either for the commercial gain of the Respondent, if it is paid to direct traffic to the linked websites, or for the commercial gain of the operators of the linked websites, or both. The Panel finds that the circumstances in each of these scenarios fall within the terms of paragraph 4(b)(iv) of the Policy.

Therefore, 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 <atacado.club> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: June 7, 2024