

## **ADMINISTRATIVE PANEL DECISION**

Carrefour SA, and Atacadão S.A. v. Pedro Freitas  
Case No. D2024-3032

### **1. The Parties**

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

The Respondent is Pedro Freitas, Brazil.

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

The disputed domain name <atacado-ofertas.site> 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 July 25, 2024. On July 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 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 (Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainants on July 29, 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 July 30, 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 August 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 6, 2024.

The Center appointed Erica Aoki as the sole panelist in this matter on September 23, 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**

Carrefour is a worldwide leader in retail and a pioneer of the concept of hypermarkets back in 1968. With a revenue of EUR 83 billion in 2022, it is listed on the index of the Paris Stock Exchange (CAC 40). It 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, Carrefour is without a doubt a major and well-known worldwide leader in retail.

Atacadão is a Brazilian chain of wholesale and retail stores established in 1960 and acquired by Carrefour in 2007. With over 300 stores and distribution centers in all the Brazilian states and more than 70,000 employees, Atacadão is one of the largest wholesale networks in the country. In 2010, Atacadão S.A. began an internationalization program, expanding its activities in other countries beyond Brazil.

Atacadão is part of the Carrefour Group, thus, both companies have opted to join in the present Complaint and is jointly referred to the Complainants.

The Complainants own several ATACADAO and ATACADÃO trademarks registered well before the registration of the disputed domain name, such as:

- European Union trademark ATACADAO, No. 012020194, registered on May 24, 2015, and designating services in international class 35;
- Brazil trademark ATACADÃO, No. 006785360, registered on October 10, 1978, duly renewed and designating goods in international class 29.

The Complainants are the holders of numerous domain names identical to, or comprising, its trademarks, both within generic and country-code Top-Level Domains ("TLDs"). For instance, <atacado.com.br> has been registered since 1997.

The disputed domain name was registered on June 24, 2024, and resolves to an error page.

#### **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.

The Complainants contend that their notoriety is also evidenced on the Internet. For instance, the Complainants' Facebook page has more than 3 million followers. Moreover, the Complainants' ATACADÃO brand is featured in several rankings, including one of the biggest Brazil brands and one of the best Latin America brands.

The Complainants contend that the disputed domain name is confusingly similar to their earlier ATACADAO trademarks. In fact, the disputed domain name incorporates in their entirety ATACADAO trademarks together with the term "ofertas", Spanish/Portuguese translation for "offers", separated by a hyphen. It is established practice of UDRP panels that the addition of generic terms, such as "ofertas", to a trademark in a domain name does nothing to diminish the likelihood of confusion arising from that domain name and that the hyphen is of negligible significance when assessing confusing similarity.

The Complainants contend that the earlier ATACADAO trademarks of the Complainants are immediately recognizable at the beginning of the disputed domain name. The Complainants contend that the use of the lower-case letter format on the one hand and the addition of the TLD “.site” on the other hand, are not significant in determining whether the disputed domain name is identical or confusingly similar to the trademarks of the Complainants.

The Complainants contend that the disputed domain name is inherently likely to mislead Internet users. The non-use of a domain name (including an error page) does not prevent a finding of bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainants’ contentions.

## **6. Discussion and Findings**

### **6.1 Multiple Complainants**

The Complaint was filed by two Complainants against a single Respondent. Carrefour is the parent company of Atacadão, 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.

### **6.2 Substantive issues**

The Complainants are required to establish the requirements specified under paragraph 4(a) of the Policy:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in respect of which the Complainants have rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that 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.

The Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name incorporates in their entirety the Complainants’ ATACADAO trademarks together with the term “ofertas”, Spanish/Portuguese translation for “offers”, separated by a hyphen. The addition of offers, such as “ofertas”, to a trademark in a domain name does not prevent a finding of confusing similarity. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 1.8.

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 Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants’ 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.

The disputed domain name currently resolves to an error page and is likely to mislead Internet users.

There is no evidence on record that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

The Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Complainants’ ATACADAO trademarks are long-established and well known, as outlined. The Complainants assert that the Respondent necessarily had the second Complainant’s name and trademarks in mind when registering the disputed domain name. The Respondent’s choice of the disputed domain name cannot have been accidental and must have been influenced by the fame of the Complainants and their earlier trademarks.

The disputed domain name has in the Panel’s view been chosen because of its confusing similarity with a trademarks in which the Complainants have rights. This was most likely done in the hope and expectation that Internet users searching for the Complainants’ services and products would instead come across the Respondent’s disputed domain name. The disputed domain name adds the term “ofertas” and gTLD “.site” to the Complainants’ ATACADAO trademark, and therefore carries a risk of implied affiliation.

In addition, the disputed domain name is currently not used in connection with an active site but it resolves to an error page. The current non-use of the disputed domain name (including an error page) does not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

The Panel finds 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-ofertas.site> be transferred to the Complainants.

*/Erica Aoki/*

**Erica Aoki**

Sole Panelist

Date: October 8, 2024