

ADMINISTRATIVE PANEL DECISION

Carrefour SA v. Flavia Augusto, FLAVIA FERNANDA GHEDINI MACHADO LTDA

Case No. D2024-4854

1. The Parties

The Complainant is Carrefour SA, France, represented by IP Twins, France.

The Respondent is Flavia Augusto, FLAVIA FERNANDA GHEDINI MACHADO LTDA, Brazil.

2. The Domain Name and Registrar

The disputed domain name <mercado-carrefour.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 25, 2024. On November 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 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 ("Unknown, MA") and contact information in the Complaint. The Center sent an email communication to the Complainant on November 27, 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 27, 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 December 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 25, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 26, 2024.

The Center appointed Torsten Bettinger as the sole panelist in this matter on January 6, 2025. 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 Carrefour SA, a French worldwide company in retail and a pioneer of the concept of hypermarkets back in 1968.

The Complainant operates more than 12,000 stores in more than 30 countries worldwide, has more than 384,000 employees worldwide, and 1.3 million daily unique visitors in its stores. The Complainant additionally offers travel, banking, insurance, or ticketing services.

The Complainant owns several registered trademarks across multiple jurisdictions, including the following ones:

- European Union trademark CARREFOUR No. 008779498, registered on July 13, 2010, and designating goods in international class 35;
- International trademark CARREFOUR No. 563304, registered on November 6, 1990, and designating goods in international class 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, and 42;
- French trademark CARREFOUR No. 1565338, registered on May 25, 1990, and designating goods in international class 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, and 34;
- United States of America trademark CARREFOUR No. 6763415, registered on June 21, 2022, and designating goods in international class 35.

The Complainant also owns numerous domain names identical to, or comprising, its trademarks, both within generic and country code Top-Level Domains, i.e.: <carrefour.com> registered since October 25, 1995 and <carrefour.fr> registered since June 23, 2005.

The disputed domain name <mercado-carrefour.shop> was registered on October 31, 2024, and resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant submits that its earlier trademarks enjoy a wide-spread continuous reputation, and refers to a number of previous UDRP decisions.

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant argues that:

- the disputed domain name is confusingly similar to its earlier well-known CARREFOUR trademark, which is entirely incorporated in the disputed domain name;

- it is established case law that the addition of a generic term such as “mercado” (which is the Spanish word for market) to a trademark in a domain name does nothing to diminish the likelihood of confusion arising from that domain name;
- the first level domain <.shop> should not be taken into consideration when evaluating the risk of confusing similarity.

With regards to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submits that:

- it has found no evidence whatsoever that the Respondent is known by the disputed domain name;
- there is no evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization;
- it has not authorized the use of its earlier trademarks or terms similar thereto in the disputed domain name in any manner or form;
- the Respondent has not, before the original filing of the Complaint, used or made preparations to use the disputed domain name in relation to a bona fide offering of goods or services as no active website is associated with the disputed domain name.

Finally, with regards to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Complainant's trademarks are intensively used in numerous countries worldwide, such as France, Spain, Italy, and Brazil for instance;
- the Complainant enjoys a solid notoriety in these countries, and it is therefore very likely that the Respondent knew the trademark CARREFOUR at the time of registration of the disputed domain name;
- a simple online search for CARREFOUR shows results that relate only to the Complainant;
- the Respondent registered the disputed domain name on October 31, 2024 several years after the registration of the trademark CARREFOUR, which is well-known worldwide;
- it is very likely regarding the complexity and length of the disputed domain name that the disputed domain name was made by the Respondent with the Complainant's trademark in mind;
- it is likely that the Respondent registered the disputed domain name in order to resell it to the Complainant later, or to prevent the Complainant from using it.

B. Respondent

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

6. Discussion and Findings

- (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

The Complainant has demonstrated that it owns multiple trademark registrations for the mark CARREFOUR prior to the registration of the disputed domain name on October 31, 2024.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases. (See sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#))).

As set forth in section 1.7 of the [WIPO Overview 3.0](#): “in cases where a domain name incorporates the entirety of a trademark [...] the domain name will normally be considered confusingly similar to that mark.” (See, e.g., *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“the fact that a domain name wholly incorporates a complainant’s registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy”)).

In this case, the disputed domain is identical to the Complainant’s CARREFOUR trademark except for the addition of the word “mercado” which is the Spanish word for “market”.

Although the addition of other terms, here, “mercado”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s CARREFOUR trademark for the purposes of the Policy.

Finally, it is well accepted in past UDRP decisions that a Top-Level Domain (“TLD”) such as “.shop” is typically not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable TLD may itself form part of the relevant trademark (see section 1.11 of the [WIPO Overview 3.0](#)).

The Panel therefore concludes that the disputed domain name is confusingly similar to the Complainant’s CARREFOUR trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

- “(i) before any notice to you [the Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [the Respondent] are 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 or service mark at issue.”

The Complainant stated that it had not been able to establish that the Respondent had any registered trademarks and that there is no evidence that the Respondent has been commonly known by the disputed domain name or as an individual, company or other organization corresponding to the name “carrefour” and that it had never granted the respondent a license or other authorization to use the name “carrefour”.

These assertions and evidence are sufficient to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent chose not to contest the Complainant’s allegations and has failed to come forward with any evidence to refute the Complainant’s prima facie showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, the disputed domain name does not resolve to an active website, and there is no other evidence to support the assumption that the Respondent has used the disputed domain name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use.

The Panel therefore concludes that the Respondent lacks rights and legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed 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 the Respondent's website or location or of a product or service on the Respondent's website or location.

The Complainant holds multiple trademark registrations for the CARREFOUR mark in various jurisdictions that predate the registration of the disputed domain name.

Given that the Complainant's CARREFOUR marks are well-known in many countries worldwide, it is likely that the Respondent did not coincidentally register the disputed domain name but had knowledge of the Complainant's rights in the CARREFOUR marks when registering the disputed domain name.

The fact that there is no evidence that the disputed domain name has not yet been actively used does not prevent a finding of bad faith use. Although the circumstances listed in paragraph 4(b) are all phrased in terms of affirmative actions by the Respondent, it is by now well accepted that the passive holding of a domain name, in certain circumstances, does not prevent a finding of bad faith use under the Policy. (See, e.g., *Teachers Insurance and Annuity Association of America v. Wrecks Communications Group*, WIPO Case No. [D2006-0483](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), ("Telstra"); see also [WIPO Overview 3.0](#), section 3.3.)

While panels will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include:

- (i) the degree of distinctiveness or reputation of the complainant's mark;
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use; and

(iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and

(iv) the implausibility of any good faith use to which the domain name may be put.

The circumstances of the present case are sufficiently similar to those present in Telstra to establish bad faith passive holding of the disputed domain name.

Based on the record in this proceeding, the Panel is satisfied that the Complainant's CARREFOUR mark is well-known in many countries.

Given that the disputed domain name contains the Complainant's CARREFOUR mark in combination the term "mercado" which is the Spanish term for "market" and clearly refers to the Complainant's hypermarkets, the disputed domain name is also not susceptible to be used in a good faith generic or descriptive sense.

Furthermore, the Respondent has not replied to the Complaint nor provided any evidence of actual or contemplated good faith use of the disputed domain name.

The Panel therefore finds that the circumstances, as described above, show that the Respondent registration and passive holding of the disputed domain name equals a bad faith registration and use of the disputed domain name and therefore the Complainant also 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 <mercado-carrefour.shop> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: January 20, 2025