

ADMINISTRATIVE PANEL DECISION

Carrefour SA , Atacadão - Distribuição, Comércio E Indústria LTDA. v. Jair Silva, Atacadao

Case No. D2025-0263

1. The Parties

The Complainants are Carrefour SA, France, and Atacadão - Distribuição, Comércio E Indústria LTDA., Brazil (hereinafter collectively referred to as “the Complainant”), represented by IP Twins, France.

The Respondent is Jair Silva, Atacadao, Brazil.

2. The Domain Name and Registrar

The disputed domain name <mercadoatacadaooficial.com> is registered with Tucows Domains Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 23, 2025. On January 23, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 23, 2025, 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 (Contact Privacy Inc. Customer 0173469459) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 27, 2025, 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 February 3, 2025.

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 February 4, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 24, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 26, 2025.

The Center appointed Marcello Do Nascimento as the sole panelist in this matter on March 7, 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

Firstly, Carrefour SA is a global retail giant based in France. Since its inception in 1959, Carrefour has expanded its operations to over 30 countries, becoming one of the leading hypermarket chains worldwide. The Complainant offers a diverse range of products, including groceries, electronics, apparel, and household items. Carrefour's business model is centered around providing a wide selection of goods at competitive prices, catering to the varied needs and preferences of consumers.

Furthermore, Atacadão - Distribuição, Comércio E Indústria LTDA is a Brazilian wholesale company acquired by Carrefour in 2007. Founded in 1960, Atacadão operates in the cash-and-carry sector, supplying bulk products to businesses and individual consumers at discounted rates. Its offerings include food, beverages, cleaning supplies, and other essential items. Atacadão's strategy focuses on affordability and accessibility, making it a favored choice among small businesses and large families seeking economical shopping options.

At this respect, it is important to inform that Atacadão - Distribuição, Comércio E Indústria LTDA changed its name to Atacadão S.A. This Panel conducted a search in the database of the Receita Federal do Brasil to confirm this information.

The Complainant holds registrations for the trademarks ATACADÃO and ATACADAO (the "ATACADAO trademark"). The Complainant has attached evidence of those listed below:

- Brazilian trademark ATACADÃO No. 006785344, registered on 10 October 1978, duly renewed, and designating goods in class 31;
- Brazilian trademark ATACADÃO No. 006937497, registered on 25 May 1979, duly renewed, and designating goods in class 35; and
- European Union Trade Mark ATACADAO No. 012020194, registered on May 24, 2015, duly renewed, and designating services in International Class 35.

The Respondent appears to be an individual with an address in Brazil.

The disputed domain name was registered on December 6, 2024, and seems to have not been in use so far.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the disputed domain name is highly similar to its well-known trademarks, ATACADAO. The disputed domain name incorporates the ATACADAO trademark in its entirety, along with the generic terms "mercado" and "oficial", which mean "market" and "official" in Spanish or Portuguese. The Complainant argues that adding generic terms to a well-known trademark does not reduce the likelihood of confusion. In fact, these terms may increase the risk of confusion, as they relate directly to the retail services offered by the Complainant. Average Internet users might believe that the domain name is affiliated with or endorsed by the Complainant.

The Complainant also notes that the use of lowercase letters and the addition of a Top-Level Domain do not significantly impact the assessment of whether the disputed domain name is identical or confusingly similar to the Complainant's trademarks. The Complainant has also argued that many WIPO decisions have

established that incorporating a well-known trademark in its entirety can be sufficient to determine that a domain name is identical or confusingly similar to the trademark, such as a similar case of *Atacadão - Distribuição, Comércio E Indústria LTDA. v. seong-chea park*, WIPO Case No. [D2022-4615](#), where the panel found that the contested domain name reproduced the complainant's trademarks. Therefore, the Complainant contends that the disputed domain name is identical or highly similar to its earlier trademarks, satisfying the first condition under the Policy.

The Complainant asserts that the Respondent has reproduced the Complainant's earlier registered trademarks, ATACADAO, in the disputed domain name without any license or authorization. This lack of authorization indicates that the Respondent has no legitimate interest in the disputed domain name. The Complainant confirms that it has not permitted the use of the term "atacado" or any similar terms in the disputed domain name.

Furthermore, the Complainant argues that the Respondent has not used or prepared to use the disputed domain name for a bona fide offering of goods or services before the original filing of the Complaint. The disputed domain name currently resolves to an error page, which does not constitute a bona fide offering under the Policy. Since the Complainant's trademarks predate the registration of the domain name, the burden is on the Respondent to prove any rights or legitimate interests in the disputed domain name. The Complainant contends that none of the circumstances that could establish such rights or interests are present in this case, thus satisfying the second condition under the Policy.

The Complainant also contends that the disputed domain name was registered and is being used in bad faith. It is inconceivable that the Respondent was unaware of the Complainant or its trademarks when registering the disputed domain name. The Respondent likely chose the disputed domain name due to its similarity to the Complainant's trademarks, intending to attract Internet users searching for the Complainant's services. This use does not constitute good faith. The Complainant's trademark registrations significantly predate the disputed domain name, and a simple trademark search would have revealed the Complainant's rights. The current use of the disputed domain name prevents the Complainant from reflecting its trademark in the corresponding domain name, further indicating bad faith. Therefore, the third condition under the Policy is also satisfied.

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

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires that the Complainant prove the following three elements in order to succeed:

- (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.
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1.

The Panel finds the Complainant's trademark ATACADAO is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainant's registered ATACADAO trademark.

It is well-established that when a domain name incorporates the entirety of a trademark, making it recognizable within the domain name (as in this case), the addition of other terms, including geographic or descriptive terms, does not prevent a finding of confusing similarity. This principle is supported by section 1.8 of the [WIPO Overview 3.0](#), which states that the inclusion of additional terms does not prevent a finding of confusing similarity.

Although the addition of other terms "official" and "mercado" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 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.

The Complainant argues that the Respondent has not used or prepared to use the disputed domain name for a bona fide offering of goods or services, as the disputed domain name resolves to an error page. In this respect, the Respondent has not submitted any Response to the Complainant's claims, in order to attempt to demonstrate any rights or legitimate interests in the disputed domain name. Furthermore, although the website appears to have never been used, the Respondent included in the disputed domain name not only the well-known and registered ATACADAO trademark but also the terms "mercado" and "oficial". This suggests an intention to associate with the recognized brand, indicating the market segment and implying that the disputed domain name is an official domain name of the Complainant. Moreover, in these circumstances, the Panel finds that the Respondent is not commonly known by the disputed domain name for the purposes of the Policy, and the Respondent's election of the organization name "Atacadao" is most likely a further attempt to falsely suggest an association with the Complainant.

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.

For the reasons provided above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, and that the second element 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 Panel concludes that there is evidence indicating bad faith in this case. The Respondent's registration of the disputed domain name, which incorporates the Complainant's well-known ATACADAO trademark, creates a presumption of bad faith, especially since the Respondent is not affiliated with the Complainant. Furthermore, given the Complainant's reputation and the recognition of its mark, it is likely that the Respondent was aware of the Complainant and its trademark at the time of registering the disputed domain name. Even if the Respondent was unaware, a simple Internet search would have revealed numerous results related to the Complainant. Indeed, the top search results for "atacado" are associated with the Complainant.

Additionally, when registering the domain name, the Respondent included not only the well-known and registered ATACADAO trademark, but also the terms "mercado" and "oficial". This suggests an intention to associate with the recognized brand, as these terms relate to the Complainant's of business and imply that the disputed domain name is an official domain name of the Complainant.

UDRP panels have consistently determined that simply registering a domain name that is identical or confusingly similar to a famous or well-known trademark by an unaffiliated entity can, in itself, establish a presumption of bad faith. This is especially true for domain names that incorporate the trademark along with a descriptive term, such as the descriptive terms in this case ([WIPO Overview 3.0](#), section 3.1.4). This presumption remains unrebutted in this instance.

The UDRP Policy, paragraph 4(b), outlines several circumstances that may indicate bad faith in the use of a domain name. These include:

- (i) circumstances indicating that you have registered or you have 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 complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Additionally, the non-use of a website does not prevent a finding of bad faith. The concept of “passive holding” refers to the situation where a domain name is registered but not actively used. According to the Policy, passive holding can still be considered bad faith under certain circumstances. This doctrine was initially established in the landmark Telstra case (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)) – and is further elaborated in section 3.3 of the [WIPO Overview 3.0](#). Factors that panels consider when determining bad faith in cases of passive holding include: (i) the distinctiveness or reputation of the complainant’s mark, (ii) the respondent’s failure to submit a response or provide evidence of good-faith use, (iii) the respondent’s concealment of identity or use of false contact details, and (iv) the implausibility of any good faith use for the domain name. In this case, the Respondent’s passive holding of the disputed domain name, combined with the use of the well-known ATACADAO trademark and the terms “mercado” and “oficial” in the disputed domain name, strongly suggests an intention to create confusion and implies bad faith.

Finally, it is worth mentioning that there is no evidence that the Respondent’s name actually includes “Atacadao”, which also means it cannot be considered a possible legitimacy for the disputed domain name. The absence of such evidence strengthens the claim of bad faith, as the Respondent could not justify the use of the disputed domain name based on a legitimate right or pre-existing interest. In UDRP proceedings, it is essential for the Complainant to demonstrate that the registration and use of the domain name were made in bad faith, and the lack of a legitimate connection to the name “Atacadao” further supports a finding of bad faith, in connection with the other evidence discussed above.

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 <mercadoatacadaooficial.com> be transferred to the Complainant.

/Marcello Do Nascimento/

Marcello Do Nascimento

Sole Panelist

Date: March 21, 2025