Decision for dispute CAC-UDRP-101347

Case number	CAC-UDRP-101347
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Domain names	telcel.shop

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Administradora de Marcas RD, S. de R.L. de C.V.

Complainant representative

Organization	GAMA Consult GmbH

Respondent

Organization	Jose Ramirez / nuB

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending and/or decided legal proceedings between the parties to this dispute or relating to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant has established that it has extensive trademark rights in the TELCEL trademark.

The Complainant is the registered owner of various trademark registrations consisting of or containing the term “TELCEL”. Two of these marks include: a registration in Mexico since April 28th, 2005 under registration number 879826 for TELCEL in class 38; and a registration in Mexico since October 31st, 2000 under registration number 677446 for TELCEL.COM in class 38. The Complainant has also registered and operates various domain names, including: <telcel.com> and <telcel.net>.

FACTUAL BACKGROUND

Administradora de Marcas RD, S. de R.L. de C.V. (hereinafter “Complainant”) is a Mexican company which owns several trademarks and domain names worldwide, including the registered trademark TELCEL®. These marks are mainly used in the fields of telecommunication and entertainment services, mainly in Mexico. The Complainant is a wholly owned subsidiary of America Móvil, S.A.B de C.V. (“AMX”), which the Complainant claims is the leading provider of integrated telecommunications services in Latin America and offering communications solutions in 25 countries in America and Europe. Furthermore, the Complainant claims that as of June 30th, 2016, AMX had 364.5 million access lines, including

282.9 million wireless subscribers, 33.7 million landlines, 26 million broadband accesses and 22 million PayTV units.

The Complainant also states that is the owner of the trademarks and domain names TELCEL in several countries, including Mexico under which AMX operates there (please see <www.telcel.com>). According to the Complainant, TELCEL was founded in 1989 and is the leading provider of wireless communications services in Mexico, covering around 90% of Mexico's population.

Regarding the trademark registrations for TELCEL, the Complainant claims that it owns several registrations, including in Mexico, where the Respondent resides, for example the Mexican trademark registration 879826 for TELCEL at class 38, the Mexican trademark registration 677446 for TELCEL.COM at class 38, the Mexican trademark registration 43262 for YO SOY TELCEL at class 38. Please see below an overview offered by the Complainant on its trademark registrations.

Overview of some of Complainant's trademark registrations:

i) TELCEL (word mark), Mexican trademark registration no. 879826, class 38, date of registration 28.04.2005;

ii) TELCEL.COM (Word mark), Mexican trademark registration no. 677446, class 38, date of registration 31.10.2000;

iii) YO SOY TELCEL (Word mark), Mexican trademark registration no. 43262, class 38, date of registration 25.07.2007;

iv) TELCEL (word mark), New Zealand trademark registration no. 777301, class 38, date of registration 10.04.2008;

v) TELCEL (word mark), Japanese trademark registration no. 5186040, class 38, date of registration 05.12.2008;

vi) TELCEL (device), U.S. trademark registration no. 86545847; class 38, date of registration 03.05.2016;

vii) TELCEL (device), EUIPO trademark registration no. 004384921, classes 9, 16, 25, 35, 38 & 41 date of registration 02.05.2006;

viii) TELCEL (device), Danish trademark registration no. VR 2014 01966, classes 9, 16, 35, 38 & 41 date of registration 11.09.2014.

The Complainant claims that it has been established in previous decisions that TELCEL is considered a well-known trademark, see for example WIPO Case No. D2008-1397 Administradora de Marcas, RD, S. de R.L. De C.V. Radiomóvil Dipsa S.A. De C.V. v. Jordan Smith concerning the domain name <telcel.net>, case No. D2008-1555 Administradora de Marcas, RD, S. de R.L. De C.V. Radiomóvil Dipsa S.A. De S.V. v. Francisco Ito, El Mesero Express / NELTELCEL.COM concerning the domain name <neltelcel.com>, case No. DES2015-0034 Administradora de Marcas RD, S. de R.L. de C.V. v. Muñoz Milén concerning the domain name <telcell.es>.

Additionally, the Complainant states that it has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term TELCEL, see for example <www.telcel.com> (registered in May 23rd, 1996), <www.telcel.net> (registered in December 16th, 1997) and <www.telcel.com.mx> (registered in June 04th, 2004). Complainant is using the domain names to connect to a website through which it informs potential customers about its trademarks and its products and services.

PARTIES CONTENTIONS

Although no Administratively Compliant Response has been filed in this dispute, the Respondent did submit a brief communication.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant's contentions can be summarized as follows:

i) THE DOMAIN NAME IS IDENTICAL

The Complainant claims that the domain name <telcel.shop> (hereinafter referred to as "the Domain Name"), which was registered on September 26th, 2016 (which was confirmed by the Registrar's verification); directly and entirely incorporates Complainant's well-known, registered trademark TELCEL and the addition of the new Top-Level Domain (gTLD) ".shop" does not add any distinctiveness to the Domain Name. See as an example the WIPO Overview on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.2. as well as the recent case International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following "In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., ".com") is to be disregarded under the confusing similarity test". The following should apply in the current case and the Domain Name should be considered as identical to the registered trademark TELCEL.

ii) THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Complainant states that it has not found that the Respondent is commonly known by the Domain Name. The WHOIS information "Jose Ramirez" is the only evidence in the WHOIS record, which relates the Respondent to the Domain Name. The Respondent has not by virtue of the content of the website, nor by its use of the Domain Name shown that the Respondent should be considered to be using the Domain name in connection with a bona fide offering of goods or services.

The Complainant states that when entering the terms "TELCEL" and "Mexico" as well as "TELCEL SHOP" and "Mexico" on Google engine search, all returned results point to Complainant and its business activity. The Respondent could easily perform a similar search before registering the Domain Name and would have quickly learnt that the trademarks are owned by Complainant and that the Complainant has been using its trademarks in Mexico.

The Complainant states that there is no evidence that the Respondent has a history of using, or preparing to use, the Domain Name in connection with a bona fide offering of goods and services. It is clear that Complainant has become a distinctive identifier associated with the term TELCEL and that the intention of the Domain Name is to take advantage of an association with the business of Complainant.

The Complainant claims that at the time of the filing of this Complaint, the Domain Name does not resolves to an active website. The Respondent has made no claims to neither having any relevant prior rights of its own, or to having become commonly known by the Domain Name. Moreover, Complainant claims it never authorized the Respondent to use its trademark in any form. Also, according to the Complainant, the Respondent has been granted several opportunities to present some compelling arguments that it has rights in the Domain Name but has failed to do so. This behaviour coupled with the use of the Domain Name cannot be considered as legitimate use of the Domain Name, according to the Complainant.

iii) THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

It has to be highlighted that Complainant's trademarks significantly predate the registration of the Domain Name. In addition, the Complainant asserts it has business presence as well as trademarks in Mexico, where the Respondent resides according to Whois lookup. The Complainant claims that these facts strongly indicate that Respondent was aware of Complainant's trademarks at the time of the registration.

THE DOMAIN NAME IS BEING USED IN BAD FAITH

The Complainant claims it first tried to contact Respondent on November 04th, 2016 through a cease and desist letter. Complainant advised the Respondent that the unauthorized use of the TELCEL trademarks violated Complainant's rights in said trademarks. The Complainant assert it requested a voluntary transfer of the Domain Name, however, no reply was received. The letter was sent to the email address listed in the Who is record, and a reminder was sent on November 11th, 2016 and again on November 16th, 2016. The Complainant states that despite several reminders from the Complainant concerning the use of the Domain Name, the Respondent disregarded such communications. Since the efforts of trying to solve the matter amicably were unsuccessful, Complainant chose to file a complaint according to the UDRP process. It has been mentioned in earlier cases that the failure of a respondent to respond to a cease and desist letter, or a similar attempt at contact, has been considered relevant in a finding of bad faith, e.g., WIPO Case No. D2000-1623, News Group Newspapers Limited and News Network Limited v. Momm Amed Ia,; WIPO Case No. D2000-1598 Nike, Inc. v. Azumano Travel; and WIPO Case No. D2000-1460 America Online, Inc. v. Antonio R. Diaz.

THE WEBSITE

The Complainant states that some Panels have found that the concept of passive holding may apply even in the event of sporadic use, or of the mere "parking" by a third party of a domain name as it happens in the current case. See as an example WIPO Overview 2.0, paragraph 3.2. In the WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmellows the Panel established that the registration and passive holding of a domain name which has no other legitimate use and clearly references Complainant's trademark may constitute registration and use in bad faith. In the Complainant's view, in the current case it is clear that Respondent has registered the Domain Name in bad faith by intentionally adopting Complainant's widely known mark in violation of Complainant's rights.

The Complainant further states, the inaction in relation to a domain name registration can also constitute a domain name being used in bad faith and any attempt to actively use the Domain Name would lead to confusion as to the source, sponsorship of the Respondent's web site among the internet users who might believe that the web site is owned or in somehow associated with the Complainant.

The Complainant states it has conducted thorough searches to try to establish whether Respondent would have any rights in the name. This has been accomplished by trademark database searches, such as the Mexican Trademark Office, and according to the Complainant, it cannot find that the Respondent has any registered rights in the names or has become known under the name.

Finally, the Complainant claims that the Complainant's Mexican trademark registrations predates Respondents Domain Name registration and the cease and desist letter remained unanswered. These cumulative factors clearly demonstrate that Respondent should be considered to have registered and to be using the Domain Name in bad faith as stated at the WIPO case No. D2016-0456 Amis Paris v. Amiparis, Amipa.

RESPONDENT:

The Respondent's contentions can be summarized as follows:

The Respondent claims that the domain is not being used with any bad faith, as it was registered because it was free and available and the Respondent intended to use it as a blog to talk about where to find or buy telephones and cell phones.

The Respondent claims that he hopes that that he did not caused any problems to the trademark owner in question, and he manages to keep the domain name, he intends to use it in the manner explained above. Finally, he states that he did not registered the domain to damage, abuse, or any of the bad faith causes mentioned.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision. On December 28th, a Respondent's default was dully notified by the Provider, however, for the purposes of this Decision, the Panel will consider the brief Response submitted by the Respondent on December 23th.

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, for this Complaint to succeed in relation to <telcel.shop>, the Disputed Domain Name, the Complainant must prove each of the following:

(i) The 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 Domain Name; and
(iii) The Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has registered trademark rights in respect of the name TELCEL. This, in the view of the Panel and for the purposes of paragraph 4(a)(i) of the Policy, is sufficient to grant the Complainant trademark rights in the name.

The Disputed Domain Name comprises of the trademark, which is reproduced in its entirety, and the generic ".shop" top-level domain suffix. Since it is well established that this suffix may be ignored when carrying out the assessment required by paragraph 4(a)(i) of the Policy (See: VAT Holdings v. Vat.com, WIPO Case No. D2000-0607), the Panel finds that the Disputed Domain Name is identical to the Complainants' trademark.

B. Rights or Legitimate Interests

In order to succeed under this element, the Complainant needs to make a prima facie case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. Once the Complainant has made a prima facie case, the burden shifts to the Respondent to disprove the Complainant's allegations and to show that it has rights or legitimate interests in the Disputed Domain Name under paragraph 4(c) of the Policy. See Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455.

In this case, the Respondent filed a very brief response, however, this response did not manage to disprove the assertions made by the Complainant under this element. Therefore, based on an assessment of the case file, the Panel finds there is no indication that the Respondent has been commonly known by the Disputed Domain Name or that the Respondent has authorization to use the TELCEL trademark. Furthermore, since the name TELCEL is well known in Mexico, where both the Complainant and the Respondent reside, and due to the Respondent's own admission, it is clear to the Panel that the Respondent had the intention of deriving commercial gain from user confusion and this does not confer legitimate rights to the Respondent.

The Panel is satisfied that the Complainant has made a prima facie case under paragraph 4(a)(ii) of the Policy and that the

Respondent lacks rights and legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

The final element under paragraph 4(a) of the Policy requires the Complainant to establish that the Disputed Domain Name was registered and used in bad faith by the Respondent.

The TELCEL trademark is well known in Mexico, where both the Complainant and the Respondent reside, and the response does not dissuade the Panel from the conclusion that the Respondent was aware of this fact when registering the Disputed Domain Name. See British Sky Broadcasting Group plc, v. Mr. Pablo Merino and Sky Services S.A., WIPO Case No. D2004-0131. Furthermore, in assessing the case file and even though the Dispute Domain Name points to a blank page at the time of the filing of the dispute, the Panel shall consider the Respondent's own admission that the Disputed Domain Name was registered with the intention to use it as a blog to discuss where to buy cell phones. From this, it is clear to the Panel that the Respondent has the intention to attract Internet users to <telcel.shop> by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement. This, as it is in line with the indicative circumstance enunciated under paragraph 4(b)(iv) of the Policy, leads the Panel to conclude that there is sufficient evidence that the Disputed Domain Name was registered and used in bad faith.

The Panel is convinced that the Respondent registered and used the Disputed Domain Name in bad faith. Accordingly, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(iii) of the Policy.

D. Decision

For the foregoing reasons, in accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the domain name <telcel.shop> be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **TELCEL.SHOP**: Transferred

PANELLISTS

Name	**Rodolfo Carlos Rivas Rea**

DATE OF PANEL DECISION 2017-01-04

Publish the Decision