Decision for dispute CAC-UDRP-101622

Case number	CAC-UDRP-101622
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Domain names	telcelup.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

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

Complainant representative

Organization	GAMA Consult GmbH

Respondent

Name	Juan Hernandez

OTHER LEGAL PROCEEDINGS

No other legal proceedings are known by the Panel.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous trademark registrations consisting of or including the term TELCEL and, in particular:

- TELCEL, Mexican trademark registration no. 879826, class 38, registered on April 28, 2005;
- TELCEL.COM, Mexican trademark registration no. 677446, class 38, registered on October 31, 2000;
- YO SOY TELCEL, Mexican trademark registration no. 43262, class 38, registered on July 25, 2007;
- TELCEL (device), U.S. trademark registration no. 4949189; class 9, 16, 35, 38 and 41, registered on May 03, 2016.

FACTUAL BACKGROUND

The Complainant is Administradora de Marcas RD, S. de R.L. de C.V., a Mexican company which owns several trademarks and domain names worldwide, including the registered trademark "TELCEL". These marks and domain names are mainly used in the fields of telecommunication and entertainment services, especially 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 is offering communications solutions in 25 countries in America and Europe. Furthermore, the Complainant claims that at June 30, 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.

According to the Complainant, "TELCEL" was launched in 1989 and it 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 consisting of or including "TELCEL" especially in Mexico, where the Respondent resides. In particular, the Complainant refers to the Mexican trademark registration 879826 for TELCEL in class 38, the Mexican trademark registration 677446 for TELCEL.COM in class 38 and the Mexican trademark registration 43262 for YO SOY TELCEL in class 38.

The Complainant claims that it has been successful in previous UDRP cases regarding the brand TELCEL such as Administradora de Marcas, RD, S. de R.L. De C.V. Radiomóvil Dipsa S.A. De C.V. v. Jordan Smith, WIPO Case No. D2008-1397; 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, WIPO Case No. D2008-1555 and Administradora de Marcas RD, S. de R.L. de C.V. v. Muñoz Milén, WIPO Case No. DES2015-0034.

The Complainant also claims that, in Administradora de Marcas, RD, S. de R.L. De C.V. v Jose Ramirez/nuB, CAC Case No. 101347, it has been considered that "TELCEL" is a well-known trademark.

The Respondent is a physical person residing in Mexico.

The domain name in dispute <telcelup.com> was registered with 1&1 Internet SE on November 25, 2015.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant states that the domain name in dispute <telcelup.com> is confusingly similar to its well-known registered trademark "TELCEL" since the term "up", which is added to the TELCEL trademark, is very closely connected with TELCEL's business (telecommunication). Furthermore, the Complainant assumes that the addition of the Top-Level Domain ".com" does not add any distinctiveness to the domain name in dispute.

The Complainant also contends that it has not found that the Respondent is commonly known by the disputed domain name. The WHOIS information “Juan Hernandez” is the only evidence in the WHOIS record, which relates the Respondent to the domain name in dispute. The Respondent has not by virtue of the content of the website, nor by its use of the domain name <telcelup.com> shown that the same Respondent should be considered to be using the disputed domain name in connection with a bona fide offering of goods or services. The Complainant also states that when entering the terms “TELCEL” and “Mexico” on Google engine search, all returned results point to Complainant and its business activity.

The Complainant states that there is no evidence that the Respondent has a history of using, or preparing to use, the disputed domain name in connection with a bona fide offering of goods and services. In its view, it is clear that the Complainant has become a distinctive identifier associated with the term TELCEL and that the intention of the domain name in dispute is to take advantage of an association with the business of the Complainant. The Complainant also claims that at the time of the filing of this complaint, the disputed domain name does not resolve 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, the Complainant claims it never authorized the Respondent to use its trademark in any form.

The Complainant highlights that its trademarks significantly predate the registration of the disputed domain name. In addition, the Complainant asserts it has business presence as well as trademarks in Mexico, where the Respondent resides. The Complainant claims that these facts strongly indicate that Respondent was aware of Complainant’s trademarks at the time of the registration.

The Complainant claims it first tried to contact Respondent on July 3, 2017 through a cease and desist letter. The Complainant advised the Respondent that the unauthorized use of the "TELCEL" trademarks violated the Complainant's rights in said trademarks. The Complainant asserts it requested a voluntary transfer of the domain name. On July 13, 2017 the Respondent replied to the Complainant indicating its availability in transferring the domain name. When the Complainant asked about the time it might require to complete the transfer the Respondent indicated from two to six months.
After than, on July 17 the Complainant indicated by a new written communication that the time indicated by the Respondent was not acceptable and indicated that in a maximum period of three days the Respondent should have sent the transfer code and proceed to unlock the domain. After this communication the Complainant has not received any answer.
Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a complaint according to the UDRP process. According with the Complainant's view the content of the Respondent's answer it is a clear indication about his knowledge on Complainant's rights.

The Complainant also 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. The Complainant also contends that 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 the Respondent would have any rights in the name. This has been accomplished by trademark database searches, and according to the Complainant, it cannot find that the Respondent has any registered rights in TELCEL or similar names or has become known under said names.

Finally, the Complainant claims that the Respondent has registered under the name "Juan Hernandez" around 1303 domain names including well-known brands with protected trademarks such as <whatsapptae.com>, <whatsapptae.com.mex> and <whatsapptae.net> and that such pattern of abusive conduct constitutes evidence of bad faith according to the Policy as also confirmed by previous Panel.

RESPONDENT:

The Respondent states that even if the domain name in dispute may be considered to be similar to the trademark TELCEL it is composed by abbreviations of generic Spanish words. In addition the Respondent contends that <telcelup.com> does not match exactly with the TELCEL trademark.

Furthermore, the Respondent declares that its intention has never been to damage the reputation of the Complainant's trademark and that the Complainant failed to demonstrate the contrary. In addition the Respondent assumes that the disputed domain name has been used only for email services.

Finally, the Respondent confirmed its intention to transfer the disputed domain name to the Complainant but that the same Respondent is not available to discuss again with the Authorized Representative (Gama Consult) or with any other law firms.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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 disputed 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 disputed 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.

The Complainant, being represented by GAMA Consult GmbH, filed its complaint in relation to the disputed domain name with the Czech Arbitration Court ("CAC") on July 26, 2017.

The CAC by way of a notification of deficencies in complaint filed on August 1, 2017, informed that the language of the Registration Agreement (Spanish) was different from the language of the proceeding as resulting by the text of the complaint (English). The CAC by way of the above communication assigned to the Complainant a term of five days to file the amended complaint

On August 1, 2017, the Complainant filed the amended compliant requesting the English to be the language of the proceeding and providing its arguments in support of the above request.

The CAC formally commenced proceedings on August 2, 2017, and notified the Respondent accordingly.

The Respondent submitted his response within the time frame required, following which the Complainant requested a temporary suspension of the proceedings to attempt to reach a settlement. The CAC suspended the proceedings accordingly to Par. 11(a) of its UDRP Supplemental Rules. However, the Respondent informed the CAC of its intention to decline the suspension request, and therefore the Czech Arbitration Court decided to resume the proceedings.

After then, the CAC appointed Guido Maffei as the Panel on August 29, 2017.

PRINCIPAL REASONS FOR THE DECISION

A. LANGUAGE OF THE PROCEEDINGS

Article 11(a) of the Rules provides that “unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”.

In the present case the language of the Registration Agreement is Spanish.

The Complainant requested that the language of the proceedings shall be English for the following reasons:

a) The Respondent replied to the cease and desist letter drafted in English and sent by the Complainant on July 11, 2017. With its response dated July 13, 2017, the Respondent accepted to transfer the domain name to Complainant. Although the Respondent replied in Spanish, it is important to mention that the Respondent never mentioned that he did not understand the Complainant´s request in English. In fact, the Respondent replied accepting the transfer while using English terms such as “web services” and “emails”.

b) The disputed domain name includes the English term “up”, which is an English word with the meaning of “directed or moving towards a higher place or position”.

c) In accordance with the current WHOIS information, it seems that the Respondent owns several domain names including well-known brands with protected trademarks such as <whatsapptae.com>, <whatsapptae.com.mx> and <whatsapptae.net>. This conduct gives a clear indication that the Respondent is aware of big companies that operate worldwide.

d) The Complainant is a Mexican company with operations in several countries including the USA and Europe whose business language is English and, therefore, it is unlikely that the Respondent is not at least familiar with the English language.

e) The Respondent has chosen to register the domain name under the Top Level domain name “.com” which is the commercial TLD, and is applicable to a broader audience than merely Mexico. A more suitable TLD if only addressing the Mexican market would be the ".com.mx" extension.

The Panel shall use his discretionary authority to decide on the Complainant request.

First of all the Panel finds that there is no evidence of any agreement having been entered into between the Complainant and the Respondent to the effect that the language of the proceedings should be English.

In consideration of the above, Panel has to determine the language of the proceedings having regard to all the circumstances. In particular, it is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceedings. In particular, it is important to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceedings: (see Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui’erpu (HK) electrical appliance co. ltd., WIPO Case No. D2008-0293 and Solvay S.A. v. Hyun-Jun Shin, WIPO Case No. D2006-0593).

The Panel does not find that the arguments submitted by the Complainant are completely convincing because they do not utterly demonstrate the circumstance that the Respondent is surely capable to handle the English language in a sufficient manner. It is the Panel's view that, in order to preserve the Respondent's rights, it should be demonstrated that the Respondent has a concrete knowledge of the English language which allow him to write and read the arguments connected to a proceeding such as the present one (see Advance Magazine Publishers Inc - Cenk Babaeren Dava, WIPO case No. D2010-2238 and JJGC Industria E Comercio de Materias Dentarias SA v Yun-Ki Kim,WIPO Case No. D2013-1838).

Anyway, in this case there are other circumstances to be considered.

First of all, the Respondent has responded to the amended complaint in English and has demonstrated a concrete knowledge of said language.

Furthermore, the Respondent on July 25, 2017, has communicated in English with the CAC informing the same CAC of its intention to decline the suspension request filed by the Complainant.

In addition, the Respondent when responding to the amended complaint filed no submissions in relation to the language of the proceedings.

Finally, the web page associated to the contested domain name shows a message written in English.

Therefore, the Panel determines the language of the proceedings to be English and given that both parties have shown they understand English he will render the decision in English (see Pentair, Inc v. Ruan Hu Ruan Hu, WIPO Case No. D2015-0572).

B. SUBSTANTIVE ISSUES

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(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.

1) The Panel finds that the Complainant has proven that it is the owner of rights in the trademark "TELCEL" and that said mark is known as the Complainant's mark at least in Mexico, the country where the Respondent resides. Of high relevance is the circumstance that there is a consistent number of domain names including TELCEL which were considered by previous Panels to be confusingly similar to the "TELCEL" trademark of the Complainant (see Administradora de Marcas, RD, S. de R.L. De C.V. Radiomóvil Dipsa S.A. De C.V. v. Jordan Smith, WIPO Case No. D2008-1397 <telcel.net>; 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, WIPO Case D2008-1555, <neltelcel.com>; Administradora de Marcas RD, S. de R.L. de C.V. v. Muñoz Milén, WIPO Case No. DES2015-0034 <telcell.es> and Administradora de Marcas, RD, S. de R.L. De C.V. v Jose Ramirez/nuB, CAC Case No. 101347 <telcel.shop>). In this circumstance the fact that the trademark "TELCEL" is composed by abbreviations of generic Spanish words as stated by the Respondent is of minor importance in Panel's view since TELCEL is not a generic word and since it is clearly perceived by the relevant public as being the trademark of the Complainant due to the intensive use made of it by the same Complainant or with its consent. The Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark. As numerous Panels have recognized, the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant’s registered mark (see for example Quixar Investments Inc. v. Dennis Hoffman WIPO Case No. D2000-0253 and Go Daddy Software, Inc. v. Hostnut.com, Inc, WIPO Case No. D2004-0981). The disputed domain name incorporates the mark "TELCEL” in its entirety with the addition of the generic or descriptive suffix “up.” Therefore, the Panel finds that the domain name <telcelup.com> is confusingly similar to the registered trademark "TELCEL" pursuant to the Policy paragraph 4(a)(i).

2) 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 (See Croatia Airlines d.d. v. Modern Empire Internet Ltd, WIPO Case No. D2003-0455). The Complainant has long standing rights, at least in Mexico, in the mark "TELCEL". The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized to use the domain name by the Complainant. In its response, the Respondent did not manage to disprove the assertions made by the Complainant under this element. Therefore, 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 mark "TELCEL" is well known in Mexico, where both the Complainant and the Respondent reside, the Panel believes that the Respondent registered the domain name in dispute with the only intention of deriving commercial gain from the possible user confusion. This behaviour does not confer legitimate rights to the Respondent in the domain name in dispute.
The Panel is therefore 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.

3) Paragraph 4(b) of the Policy sets out four circumstances which, without limitation, shall be evidence of the registration and use of the domain name in bad faith, namely:

(i) circumstances indicating that Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of Respondent’s documented out-of-pocket costs directly related to the domain name;

or (ii) Respondent has 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 Respondent has engaged in a pattern of such conduct; or
(iii) Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor;

or (iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product.

The Panel finds that the Respondent was aware of the Complainant's trademark when he registered the disputed domain name. Indeed, the mark "TELCEL" has been intensively used in the telecommunication sector by the Complainant or with its consent and it is well known at least in Mexico where both parties reside. This clearly indicates that the disputed domain name was chosen to take advantage of the Complainant's mark reputation. In consideration of the above it is easy for the Panel to find that the disputed domain name has been registered in bad faith. There is substantial authority that registration of a domain name that is confusingly similar to a well-known trademark by any entity that has no relationship to that mark is itself sufficient evidence of bad faith registration and use (see Allianz, Compañía de Seguros y Reaseguros S.A. v. John Michael, WIPO Case No. D2009-0942 in which the Panel concurs with previous WIPO UDRP decisions holding that registration of a well-known trademark as a domain name is a clear indication of bad faith in itself, even without considering other elements; see also Veuve Cliquot Ponsardin, Maison Fondee en 1772 v. The Polygenix Group Co.,WIPO Case No. D2000-0163; Pepsico, Inc. v. "null", aka Alexander Zhavoronkov, WIPO Case No D2002-0562 and Pepsico, Inc. v. Domain Admin, WIPO Case No. D2006-0435).

Furthermore, the Complainant has demonstrated that the Respondent uses the disputed domain name in connection with a website which resolves in one page where it is indicated "Congratulations! Your hosting account has been succesfully created on the server! Your nameservers have been setup properly and DNS propagation is completed. Now you may upload the content for your future site"; after this indication the page shows only a list of alleged useful links.

In consideration of the above the Panel's view is that the Respondent is passively holding the domain name. This finding is also confirmed by the Respondent since in the response it is clearly admitted that the Respondent has been using the domain name only for e-mail services and that he has not yet developed the website he planned to launch for the disputed domain name. Passive holding of a domain name can be bad faith when the Complainant's mark has a strong reputation and the Respondent has provided no evidence of any actual or contemplated good faith use by it of the domain name (see Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273 and Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003).

The Complainant has also verified that the Respondent has registered under its own name around 1303 domain names including domain names highly similar to well-known brands protected through trademark registrations such as <whatsapptae.com>, <whatsapptae.com.mx> and <whatsapptae.net>. The Panel has also verified that the Respondent, in a counterproductive manner considering his position, has enclosed to the response a decision in which he was previously involved as respondent and that transferred the domain names <bestbuiy.mx> and <bestbuiy.com.mx> to the owner of the trademark BEST BUY which is an unequivocally well known trademark. The Panel finds this pattern of conduct is very indicative of bad faith (see Pierre & Vacances Center Parcs Group v Pharm Dinh Nhut, WIPO Case No. D2017-0605).
In consideration of the above explained reasons, the Panel finds that the Complainant has satisfied also paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TELCELUP.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2017-09-04