Decision for dispute CAC-UDRP-102426

Case number	CAC-UDRP-102426
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Domain names	bodegaurrera.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Wal-Mart de México, S.A.B. de C.V.

Complainant representative

Organization	HSS IPM GmbH

Respondent

Organization	Domain Privacy Guard Sociedad Anonima Ltd

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant has established registered trademark rights on which it may rely in this proceeding. The Complainant has submitted that it has rights in the following registered trademarks:

(I) Mexican TM Wordmark BODEGA AURRERA, No. 17797, filed on 20.02.1985 & registered on 20.01.1987,

(ii) Mexican TM Wordmark BODEGA AURRERA, No. 19350, filed on 01.09.1993 & registered on 27.04.1994, and

iii) Word & device mark in Chile BODEGA AURRERA & design No. 1143858, filed on 11.09.2013 and registered on 02.12.2014,

(collectively "the BODEGA AURRERA" trademark).

The Panel accepts the evidence submitted by the Complainant and its submission that it has trademark rights in all of the trademarks constituting "the BODEGA AURRERA" trademark.

FACTUAL BACKGROUND

The Complainant is a Mexican company that is part of the well -known Walmart Group. It owns and operates self-service stores in Mexico and Central America. The company operates discount stores, hypermarkets, supermarkets, membership self-service wholesale stores, and pharmacies. One of its divisions consists of the Bodega Aurrerá discount stores.

Group's first store outside the United States opened in Mexico in 1991, so the Group has had a long association with Mexico.

The Complainant owns and conducts its business under a series of registered trademarks for BODEGA AURRERA more particularly set out above.

Most of the trademark registrations predate the registration of the disputed domain name bodegaurrera.com which was on May 20, 2006.

Complainant owns also the registration of the domain name www.bodegaaurrera.net which is used to connect to a website which informs potential customers about the BODEGA AURRERA mark and its products and services.

Due to extensive use, advertising and revenue associated with its trademarks worldwide, Complainant enjoys a high degree of renown in Mexico and Central America, including Panama where the Respondent is located.

The Respondent has registered the disputed domain name and has caused it to resolve to a website where Internet visitors find related links under headings which are related to Complainant’s products and trademarks such as “BODEGA AURRERA”.

Naturally this conduct had damaged the Complainant's business and as a result the Complainant's attorneys have sent a cease and desist letter to the Respondent, with reminders, requiring it to transfer the domain name to the Complainant. The Respondent has not replied and the Complainant has therefore filed this Complaint to compel the transfer of the domain name.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

i) THE DOMAIN NAME IS CONSUFINGLY SIMILAR TO COMPLAINANT’S BODEGA AURRERA TRADEMARKS

The domain name <bodegaurrera.com> (hereinafter referred to as the “Disputed Domain Name”), which was registered on May 20, 2006, incorporates the substance of Complainant’s well-known, registered trademark BODEGA AURRERA in its entirety, making only one spelling alteration, namely to omit one letter "a" between BODEGA and AURRERA.

The addition of the generic Top-Level Domain (gTLD) “.com” does not add any distinctiveness to the Disputed Domain Name.

The domain name deliberately gives off the impression that the Respondent is somehow affiliated with Complainant, and that the Respondent is somehow doing business using Complainant`s trademark and permitted to do so, but this is not so.

The Disputed Domain Name is therefore confusingly similar to the BODEGA AURRERA trademarks.

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

The Respondent is not commonly known by the Disputed Domain Name and it has no interest in the Domain Name.

Before registering the domain name the Respondent could have conducted a simple search that would have quickly told him that the BODEGA AURRERA trademarks were owned by Complainant and that the Complainant has been using its trademarks. However, it did not do so, or if it did, it ignored the results.

Respondent has not used the domain name on the internet or by any other means in connection for a bona fide offering of goods or services.

There is no evidence that Respondent has a history of using, or preparing to use, the domain name in connection with a bona fide offering of goods and services. Rather, it is clear that the intention of the Respondent has been to use the Disputed Domain Name to take advantage of a purported association with the business of the Complainant.

Moreover, the website to which the domain name is pointed reveals pay-per-clicks where Internet visitors may find related links under headings which are related to Complainant's products and trademarks such as BODEGA AURRERA.

The Respondent has had an opportunity to present some compelling arguments that it has rights or legitimate interests in the Domain Name but has failed to do so.

The Complainant has therefore made out a prima facie case against the Respondent to which it has not replied.

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

THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

Several of Complainant's BODEGA AURRERA trademarks predate the registration of the Disputed Domain Name and are thus well known.

Respondent has never been authorized by Complainant to register the Domain Name. It is inconceivable that the unique combination of the mark "BODEGA" & "AURRERA" in the Domain Name, even with the minor spelling alteration, is anything but a deliberate and calculated attempt to benefit the Respondent improperly from its pretended association with the Complainant's rights.

THE DOMAIN NAME IS BEING USED IN BAD FAITH

On April 5th, 2019 the Complainant caused a cease and desist letter to be sent to the Respondent advising it that the unauthorized use of its trademark within the Domain Name violated its trademark rights. Complainant requested a voluntary transfer of the Domain Name.

However, no answer was received, despite reminders.

Since its efforts of trying to solve the matter amicably were unsuccessful, Complainant chose to file a complaint according to the UDRP process.

Moreover, the website associated with the Disputed Domain Name states that it may be for sale for USD 2624.

The website is a PPC website where Internet visitors find related links not only to Complainant´s products but also to Complainant´s competitors.

In terms of paragraph 4(b)(iv) of the Policy, this conduct constitutes bad faith use.

Summary:

The BODEGA AURRERA trademark is a well-known mark in the discount stores business, including in Mexico and Central America.

Respondent bears no relationship to the trademarks and the Domain Name has no other meaning except for referring to Complainant's name and trademark.

There is no way in which the Domain Name could be used legitimately by the Respondent.

Further, the domain name is being used for a PPC page using the Complainant’s trademark and other relevant terms, an additional element of bad faith.

Finally, the Disputed Domain Name is also offered for sale at the infringing website for a price higher than the normal out of pocket expenses.

Consequently, the Respondent has registered and used the Disputed Domain Name in bad faith and it should be transferred to the Complainant for breach of the Policy.

RESPONDENT:

The Respondent did not file a Response in this proceeding.

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.

PRINCIPAL REASONS FOR THE DECISION

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

A. Administrative deficiency

By notification dated May 13, 2019 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that it had not correctly identified the Respondent. The CAC invited the Complainant to have regard to the Registrar’s verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder.

On May 13, 2019 the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be

admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiency has been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the Complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(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.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that it has rights in several registered trademarks which are owned by the Complainant. The trademarks are defined collectively as "the BODEGA AURRERA trademarks" and the Panel finds that as such the Complainant has rights in the trademarks which are:

(I) Mexican TM Wordmark BODEGA AURRERA, No. 17797, filed on 20.02.1985 & registered on 20.01.1987,

(ii) Mexican TM Wordmark BODEGA AURRERA, No. 19350, filed on 01.09.1993 & registered on 27.04.1994, and

(iii) Word & device mark in Chile BODEGA AURRERA & design No. 1143858, filed on 11.09.2013 and registered on 02.12.2014.

This evidence establishes that the Complainant has trademark rights sufficient to give it standing in this proceeding.

The Panel next finds that the disputed domain name is confusingly similar to the BODEGA AURRERA trademarks for the following reasons.

First, the disputed domain name includes the substance of the Complainant's well-known BODEGA AURRERA trademarks, making only one spelling alteration, namely to omit one letter "a" between BODEGA and AURRERA.

Accordingly, the attention of the internet user would naturally be drawn to the disputed domain name and would inculcate in the mind of the user the idea that the disputed domain name was an official domain name of the Complainant and that it would lead to an official website of the Complainant. This gives weight to the Complainant's submission that the domain

name deliberately gives off the impression that the Respondent is somehow affiliated with Complainant, and that Respondent is somehow doing business using Complainant`s trademark and permitted to do so, which is untrue.

Secondly, it is now well established that the addition of a generic top level domain, such as ".com" as in the present case cannot negate identity or confusing similarity that is otherwise present, as it is in the present case.

Accordingly, the disputed domain name is confusingly similar to the Complainant's BODEGA AURRERA trademarks and the Complainant has thus shown the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to the Respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [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 [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 [respondent] are making a legitimate non-commercial 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The Respondent has chosen to take the Complainant's BODEGA AURRERA trademark and to use the substance of it in its domain name without permission and making only one minor spelling alteration before Incorporating it in the domain name.

The Panel is satisfied from the evidence that, as the Complainant submits, Respondent is not commonly known by the Disputed Domain Name and that it has no interest in the Domain Name.

It is also clear that the Respondent could have conducted a simple search that would have quickly told him before registering the domain name that the BODEGA AURRERA trademarks were owned by the Complainant and that the Complainant has been using the trademarks in its business. However, the Respondent did not do so, or if it did, it ignored the results.

The Panel also finds that on the evidence Respondent has not used the domain name on the internet or by any other means in connection for a bona fide offering of goods or services.

There is also no evidence that Respondent has a history of using, or preparing to use, the Domain Name in connection with a bona fide offering of goods and services. Rather, it is clear that the intention of the Respondent has been to use the Disputed Domain Name to take advantage of a purported association with the business of the Complainant and to draw attention to the Complainant's competitors, which cannot give rise to a right or legitimate interest.

Moreover, the domain name resolves to a website which reveals pay-per-clicks where Internet visitors will find related links under headings which are related to Complainant’s products and trademarks such as BODEGA AURRERA. This negates any suggestion of a right or legitimate interest in the domain.

The Respondent has had an opportunity to present some compelling arguments that it has rights or legitimate interests in the Domain Name but has failed to do so.

All of these matters are proven by the evidence, which the Panel accepts and are supported by previous UDRP decisions to which the Complainant refers and which are all apposite and persuasive.

The Complainant has therefore made out a prima facie case against the Respondent to which it has not replied and the Complainant has therefore made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith: Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive.

The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or 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 the respondent’s documented out-of-pocket costs directly related to the domain name; or

(ii) the 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s website or other on-line 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 site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent’s conduct puts the case squarely within paragraph 4(b)(iii) and (iv) of the Policy.

That is so because the evidence leads, first, to the conclusion that the Respondent has registered and used the disputed

domain name intentionally to disrupt the business of a competitor, namely itself as it sought by its conduct to compete with the Complainant and harm its business. That brings the case squarely within the meaning of paragraph 4(b) (iii) of the Policy.

Secondly, the evidence shows that the intention of the Respondent must have been to attempt to attract, for commercial gain, Internet users to the website to which the domain name resolves by creating a likelihood of confusion with the Complainant's trademarks.

That is so because the website clearly promotes competitors of the Complainant. The Respondent is not authorised to promote competitors of the Complainant and certainly not by using the Complainant's own trademark.

That brings the case squarely within the meaning of paragraph 4(b) (iv) of the Policy.

The conduct of the Respondent is particularly brazen and illegal and the Respondent must therefore be taken to have registered and used the domain name in bad faith.

Several of Complainant's BODEGA AURRERA trademarks predate the registration of the Disputed Domain Name and are thus well known.

The Panel also agrees with the Complainant that Respondent has never been authorized by Complainant to register the Domain Name. It is inconceivable that the unique combination of the mark "BODEGA" & "AURRERA" in the Domain Name is anything but a deliberate and calculated attempt to benefit the Respondent improperly from its pretended association with the Complainant's rights.

The evidence is also that on April 5th, 2019 the Complainant caused a cease and desist letter to be sent to the Respondent advising it that the unauthorized use of its trademark within the Domain Name violated its trademark rights and requesting a voluntary transfer of the Domain Name. However, no answer was received, despite reminders.

Since its efforts of trying to solve the matter amicably were unsuccessful, Complainant chose to file a complaint according to the UDRP process which it was entitled to do and which has been shown to have been on good grounds.

Moreover, the website associated with the Disputed Domain Name states that it may be for sale for USD 2624 which can also indicate bad faith.

The website referred to is a PPC website where Internet visitors find related links not only to Complainant´s products but also to Complainant´s competitors and that can only give rise to the conclusion that it shows the domain name was registered and used in bad faith.

All of the foregoing conclusions are supported by evidence that the Panel accepts and are consistent with previous decisions cited by the Complainant.

The Complainant has thus made out the third of the three grounds that it must establish.

The Complainant has therefore made out the whole of the case that it must establish and is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BODEGAURRERA.COM**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2019-06-12

Publish the Decision