Decision for dispute CAC-UDRP-102874

Case number	CAC-UDRP-102874
Time of filing	2020-01-30 09:29:55
Domain names	walmartdemexico.com

Case administrator

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

Complainant

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

Complainant representative

Organization	HSS IPM GmbH

Respondent

Organization	DotBadger Domains / Online Admin

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has rights in the Mexican trademark registration WAL-MART no. 596598, registered on December 14, 1998 (owned by Walmart Apollo, LLC) under the UDRP for purposes of standing to file the Complaint.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant - Wal-Mart de México, S.A.B. de C.V - owns and operates self-service stores in Mexico and Central America. It operates discount stores, hypermarkets, supermarkets, membership self-service wholesale stores, and pharmacies including approximately 1,910 Bodega Aurrerá discount stores, 274 Walmart hypermarkets, 91 Superama supermarkets, and 163 Sam's Club membership self-service wholesale stores. The Complainant also operates 540 Despensa Familiar and Palí discount stores; 97 Paiz, La Despensa de Don Juan, La Unión, and Más x Menos supermarkets; 143 Bodegas, Maxi Bodega, and Maxi Palí stores; and 31 Walmart hypermarkets in Costa Rica, Guatemala, Honduras, Nicaragua, and El Salvador.

The Complainant is part of WalMart Group, in particular it is a subsidiary of Walmart, Inc. (to be understood as Wal-Mart

Stores, Inc.) the parent entity. In addition, Walmart Apollo, LLC, owning several trademark registrations consisting and/or containing the terms WAL-MART and WALMART worldwide including Mexico, such as Mexican trademark WAL-MART, Registration No 596598, is also part of the WalMart Group, i.e. it is a wholly owned subsidiary of Walmart, Inc.

The Complainant contends that the WalMart Group is internationally well-known as the world's biggest retailer and that due to extensive use, advertising and revenue associated with its trademarks worldwide, the WalMart Group enjoys a high degree of renown including the European Union, where Respondent is located. It also enjoys a high degree of renown in Mexico and Latin America.

The Complainant uses the domain names <www.walmart.com.mx>, <www.walmartmexico.com> and <www.walmartmexico.net> to promote its activity.

The Complainant contends that the trademark "WALMART" is well-known worldwide.

The disputed domain name <walmartdemexico.com> was created on May 29, 2007 and does not resolve to any active website. The Complainant provided evidence that in 2014 the disputed domain name resolved to a parking page displaying sponsored links using the trademark WALMART and in 2018 and in 2019 to a website offering AMAZON products.

The Complainant sent a cease and desist letter in November 2019 to the e-mail address listed in the WhoIs record associated with the disputed domain name, but the Respondent failed to respond.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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 Complaint was filed in the name of Wal-Mart de México, S.A.B. de C.V. In its Complaint, the Complainant contends that it is part of the WalMart Group, in particular it is a subsidiary of Walmart, Inc. (to be understood as Wal-Mart Stores, Inc.). For this scope, the Complainant provided relevant evidence, indicating the significant subsidiaries of Wal-Mart Stores, Inc. among which Wal-Mart de México, S.A.B. de C.V. is included. In its Complaint, the Complainant refers also to the company Walmart Apollo, LLC. In particular, the Complainant contends that the WalMart Group holds WALMART trademarks in numerous countries all over the world. For instance, in Mexico the company Walmart Apollo, LLC owns the following trademark registrations: (i) Mexican Wordmark WAL-MART, Reg. No. 577558, registration date May 27, 1998, (ii) Mexican Wordmark WAL-MART, Reg. No.577559, registered on 27.05.1998, (iii) Mexican Wordmark WAL-MART, Reg. No. 596598,

registered on December 14, 1998. On this regard the Complainant provided relevant evidence.

Under Paragraph 12 of the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) “In addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties”.

According to that paragraph 12, the Panel issued a Procedural Order and requested the Complainant: (1) to comment and submit relevant evidence on the following point: Walmart Apollo, LLC. is an affiliate of Wal-Mart de México, S.A.B. de C.V., being a subsidiary of Wal-Mart Stores, Inc. or, alternatively, (2) to provide relevant evidence of authorization received by Walmart Apollo, LLC. to file this UDRP Complaint.

The Panel granted the Complainant a term to submit the relevant evidence and comments in response to the Procedural Order. The Complainant submitted a Nonstandard Communication providing a declaration from the duly representative of Walmart Apollo, LLC’s (together with the Power of Attorney where the legal faculties of Walmart Apollo, LLC.’s legal representative were specified) confirming amongst others that: (1) Walmart Apollo, LLC, is a wholly owned subsidiary of WalMart, Inc., part of the Walmart Group (which also results from the submitted Power of Attorney); (2) Walmart Apollo, LLC has authorized WalMart lnc., which in turn has authorized Wal-Mart de México, S.A.B. de C.V. to use the relevant Mexican trademark registration WAL-MART no. 596598; (3) Walmart Apollo, LLC has authorized WalMart lnc., which in turn has authorized Wal-Mart de México, S.A.B. de C.V. to file the appropriate legal actions; including UDRP’s to recover - amongst others- the domain name <walmartdemexico.com>.

The Respondent was also given a term to submit a reply, with a copy of the reply provided to the Complainant. However, the Respondent did not reply within the given time.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name is confusingly similar to the trademark WAL-MART in which the Complainant has rights under the UDRP for purpose of standing to file the Complaint.

As specified in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) at point 1.4.1 “A trademark owner’s affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint. While panels have been prepared to infer the existence of authorization to file a UDRP case based on the facts and circumstances described in the complaint, they may expect parties to provide relevant evidence of authorization to file a UDRP complaint. In this respect, absent clear authorization from the trademark owner, a non-exclusive trademark licensee would typically not have standing to file a UDRP complaint".

This Panel inferred the existence of authorization to file a UDRP case based on the facts and circumstance described in the Complaint and relevant evidence submitted by the Complainant also as a consequence of the Panel’s Procedural Order: i.e. Wal-Mart de México, S.A.B. de C.V. is part of the WalMart Group, in particular it is a subsidiary of Walmart, Inc. (to be understood as Wal-Mart Stores, Inc.); the owner of the trademark registration, Walmart Apollo, LLC, is also part of the WalMart Group, in particular it is a wholly owned subsidiary of Walmart, Inc.; Walmart Apollo, LLC has authorized WalMart lnc., which in turn has authorized Wal-Mart de México, S.A.B. de C.V. to file the appropriate legal actions; including UDRP’s to recover - amongst others- the domain name <walmartdemexico.com>.

Furthermore, many panels have found that a domain name is confusingly similar to a complainant’s trademark where the domain name incorporates the complainant’s trademark in its entirety. This is the case in the case at issue where the trademark WAL-MART in which the Complainant have rights under the UDRP for purposes of standing to file the Complaint is fully included in the disputed domain name. In fact, there is a minor variation between the WAL-MART trademark (including a hyphen) and the disputed domain name, which uses WALMART instead.

Moreover, it is the view of this Panel that the addition of the geographic indication “mexico” and the term “de” do not add

distinctive matter so as to distinguish it from trademark WAL-MART. In fact, the trademark “WAL-MART” is clearly recognizable within the disputed domain name. As specified in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) at point 1.8 “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. (..)”.

2. In the absence of any Response, or any other information from the Respondent indicating the contrary, the Panel further holds that the Complainant successfully presented its prima facie case and that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not affiliated with nor authorized by the Complainant in any way, and he is not related in any way to the Complainant’s business. In addition, the Respondent is not commonly known by the disputed domain name. Finally, the website to which the disputed domain name resolves is currently an inactive website. The Complainant provided evidence that the disputed domain name resolved to a parking page displaying sponsored links and then to a website offering AMAZON products. Such use can neither be considered as bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

3. Finally, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

It is the view of this Panel that the Respondent has intentionally registered the disputed domain name which totally reproduces the trademark WALMART in which the Complainant have rights under the UDRP for purposes of standing to file the Complaint. By the time the disputed domain name was registered, it is unlikely that the Respondent did not have knowledge of the WAL-MART trademarks. The Complainant also proved that the Respondent used the disputed domain name to resolve to a parking page displaying sponsored links and then to a website offering AMAZON products. These facts, including the failure to submit a Response, the failure to respond to the cease and desist letter sent by the Complainant in relation to the disputed domain name, the privacy shield to hide the Respondent’s identity also confirm that the disputed domain name has been registered and has being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **WALMARTDEMEXICO.COM**: Transferred

PANELLISTS

Name	**Dr. Federica Togo**

DATE OF PANEL DECISION 2020-04-06

Publish the Decision