



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Unidas S.A. v. Sonny Jhoe

Case No. D2019-2798

1. The Parties

The Complainant is Unidas S.A., Brazil, represented by Baril & Advogados Associados, Brazil.

The Respondent is Sonny Jhoe, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <portaldereservasunidas.com> is registered with Tucows Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 14, 2019. On November 15, 2019, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 15, 2019, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on November 25, 2019 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 November 28, 2019.

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").

The Complainant filed the Complaint in English and requested Portuguese to be the language of the proceeding. The request was withdrawn by email by the Complainant on November 28, 2019.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 10, 2019. In accordance with the Rules, paragraph 5, the due date for Response was December 30, 2019. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 7, 2020.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on January 15, 2020. 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

The Complainant Unidas S.A. is involved in the car rental business, which goes back to 1985 when five car rental companies and two investors joined forces in the city of São Paulo, Brazil. Toward the end of 2017 the Complainant merged with Locamerica which specialized in the outsourcing of corporate fleets and all their operations were consolidated under the trademark UNIDAS.

The Complainant is the owner of many trademark registrations in Brazil formed by the word UNIDAS, including the following:

Trademark Registration No. 914761889 UNIDAS, filed on May 28, 2018 and registered on June 4, 2019 for services in class 35; and

Trademark Registration No. 914761943 UNIDAS filed on May 28, 2018 and registered on July 16, 2019 for services in class 39.

The Complainant is also owner of several domain names constituted by the word "unidas", including <portaldereservas.unidas.com.br>, <unidasautos.com>, and <unidasrentacar.com.br>.

The Respondent registered the disputed domain name <portaldereservasunidas.com> on August 14, 2019 which resolves to a website with a similar layout to the one of the Complainant's website <portaldereservas.unidas.com.br> offering similar services.

5. Parties' Contentions

A. Complainant

The Complainant claims to be the market leader in fleet rentals in Brazil, with over 80 used car stores, and the second largest car rental company in the country, with more than 230 rental points and with more than 110,000 vehicles at the service of their clients.

UNIDAS is not a common use word and nor is it identified with a legitimate business or activity other than the business of the Complainant.

That the disputed domain name <portaldereservasunidas.com> is confusingly similar to the trademark and trade name UNIDAS in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, the Complainant contends that the Respondent is not known as the disputed domain name and that the Respondent is not related in any way to the Complainant.

The Complainant asserts that the Respondent is not making any *bona fide* offering of goods or services, but rather intends to mislead consumers and tarnish the trademark and trade name UNIDAS.

Furthermore, the Complainant claims that the Respondent has copied the layout of the Complainant's website <portaldereservas.unidas.com.br> which clearly demonstrates the intention to create confusion to attract Brazilian Internet users to Respondent's website and illegally profit from the goodwill attached to the Complainant's trademark famous trademark UNIDAS.

Finally, the Complainant requests the Panel to order the transfer of the disputed domain name to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has proved that it has rights in the trademark UNIDAS.

The standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the domain name is confusingly similar to the trademark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name.

In this case, the disputed domain name <portaldereservasunidas.com> contains the Complainant's trademark UNIDAS in its entirety. The Panel considers that the addition of the descriptive Spanish words "portal de reservas", in English "entry for reservations", does not avoid a finding of confusing similarity.

As set forth in [section 1.8](#) of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#) ("WIPO Overview 3.0"), 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.

For the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the Top-Level Domain ("TLD") as it is viewed as a standard registration requirement ([section 1.11.1](#) of [WIPO Overview 3.0](#)). Thus, for the test for confusing similarity of the first prong the Panel shall disregard the ".com" included in the disputed domain name.

The Panel therefore finds that the disputed domain name is confusingly similar to the trademark UNIDAS in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's 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) the respondent has been commonly known by the domain name, even if it has acquired no trade mark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in [section 2.1](#) of the [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Panel considers that the Respondent's use of the disputed domain name is not a *bona fide* offering but rather an attempt to capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complaint also succeeds on the second prong of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Respondent registered the disputed domain name that contains a third party's trademark without authorization. It is unlikely that the Respondent could have ignored the existence of the UNIDAS trademark when it registered the disputed domain name on August 14, 2019. The Spanish word "unidas", in English "united" is a fanciful term when applied to identify a car rental business. Therefore it is difficult to conceive that the use of the disputed domain name is not related to the Complainant's activities. This assumption is further proved by the fact that the disputed domain name entirely contains the Complainant's trademark UNIDAS.

In this day and age of the Internet and advancement in information technology, the reputation of brands and trademarks transcends national borders. As such, a cursory Internet search would have disclosed the UNIDAS trademark and its use by the Complainant. As such, a presumption arises that that the Respondent was aware of the Complainant and its trademarks when it registered the disputed domain name, particularly given that the disputed domain name contains the Complainant's UNIDAS mark in its entirety. Registration of a domain name that incorporates a complainant's trademark suggests opportunistic bad faith.

The Panel considers that the Respondent's purpose in registering the disputed domain name incorporating UNIDAS was very likely to capitalize on the reputation of Complainant's trademark by diverting Internet users seeking information about this distinctive sign to its own website. See *Hoffmann-La Roche Inc. v. Doroven*, [WIPO Case No. D2010-1196](#).

With respect to the use in bad faith, as described above, the disputed domain name directs to a webpage with a layout almost exactly the same as the Complainant's website <portaldereservas.unidas.com.br>, which clearly demonstrates Respondent's intent to confuse Internet users.

Many UDRP panels have found the respondent acting in bad faith where respondent sought or realized commercial gain from the use of a domain name identical or confusingly similar to a complainant's trademark. See *Terroni Inc. v. Giocchino Zerbo*, [WIPO Case No. D2008-0666](#) and *Zinsser Co. Inc., Zinsser Brands, Co. v. Henry Tsung*, [WIPO Case No. D2006-0413](#).

The Panel finds that the Respondent is intentionally attracting Internet users for commercial gain to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website.

In light of the above, the Panel considers that the disputed domain name was registered and is being used in bad faith and that the third prong of paragraph 4(a) of the Policy has therefore been fulfilled.

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 <portaldereservasunidas.com> be transferred to the Complainant.

Miguel B. O'Farrell

Sole Panelist

Date: January 29, 2020