

## **ADMINISTRATIVE PANEL DECISION**

### **Marelli Cofap do Brasil Ltda - Aftermarket Division v. Ha Nguyen Case No. D2022-4001**

#### **1. The Parties**

Complainant is Marelli Cofap do Brasil Ltda - Aftermarket Division, Brazil, represented by Ariboni, Fabbri & Schmidt, Brazil.

Respondent is Ha Nguyen, Viet Nam.

#### **2. The Domain Name and Registrar**

The disputed domain name <mmcofap.com> (“the Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2022. On October 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. Also on October 26, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on October 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 17, 2022. Upon request from Complainant, the proceedings were suspended on November 2, 2022 for purposes of settlement discussions concerning the disputed domain name. Also upon request from Complainant, the proceedings were reinstated on December 12, 2022.

Aside from two informal communications, Respondent did not submit any substantive response. Accordingly, the Center notified the Commencement of Panel Appointment Process on December 29, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on January 6, 2023. 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**

Complainant is part of the Marelli Cofap group and is active in the automotive parts and aftermarket market. The Marelli Cofap group is active in the manufacturing, trade, and technical assistance of components, auto parts, and accessories for vehicles, motorcycles, and automobiles in general, exporting to 62 countries, annually selling more than 10 million items in 50 different product lines under the brands “Magneti Marelli” and “Cofap”. Since its incorporation in 1998 Complainant holds the trade name composed by “Magneti Marelli”, “Cofap”. Its trade name changed to “Magneti Marelli Cofap Fabricadora De Pecas Ltda.” on June 7, 2013, and to “Marelli Cofap DO Brasil Ltda.” on September 25, 2019. Complainant maintains its main website at “www.mmcofap.com.br”.

Complainant owns trademark registrations for COFAP, including the Brazilian trademark registration no 921669577, filed on December 22, 2020 and registered on October 04, 2022 for goods in international class 17.

The Domain Name was registered on October 8, 2022 and leads to a website (the Website) offering pornographic content, while it is also being offered for sale against a “promotional price”.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for the transfer of the Domain Name.

##### **B. Respondent**

Respondent did not formally reply to Complainant’s contentions. It did send some communications stating that the Domain Name was registered without bad faith, and that it agreed to transfer the Domain Name to the Complainant.

Nevertheless, after the proceedings were suspended the Respondent did not sign the Standard Settlement Form as requested by the Complainant, so the proceedings were reinstated.

#### **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists the three elements, which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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**

Complainant has demonstrated rights through registration and use on the COFAP trademark.

The Panel finds that the Domain Name is confusingly similar to the COFAP trademark.

The Domain Name incorporates Complainant's COFAP mark in its entirety. This is sufficient to establish confusing similarity (*Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#)).

The addition of the letters "mm" (likely short for Magneti Marelli) does not prevent a finding of confusing similarity, as the COFAP trademark remains clearly recognizable (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8). Furthermore, it is noted that Magneti Marelli had been part of the trade name of Complainant and Complainant maintains its main website at "www.mmcofap.com.br".

The generic Top-Level Domain ("gTLD") ".com" is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Name is confusingly similar to the COFAP mark.

Complainant has established paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to Respondent of the dispute, 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) Respondent (as an individual, business, or other organization) has been commonly known by the Domain Name, even if it has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial 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.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not replied to Complainant's contentions and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per the Complaint, Respondent was not authorized to register the Domain Name.

There is no evidence that Respondent has been commonly known by the Domain Name.

Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant has demonstrated, the Domain Name leads to the Website that features pornographic content. Furthermore, the Domain Name was being offered for sale.

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in bad faith:

(i) circumstances indicating that Respondent has registered or has 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 that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) that 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) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online 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 or service on Respondent’s website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. Complainant’s mark COFAP had been used and registered at the time of the Domain Name registration by Respondent. Therefore, the Panel finds it more likely than not that Respondent had Complainant’s mark in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#)).

The Panel finds it unlikely that Respondent did not know of and also target Complaint, in particular noting that Magneti Marelli had been part of the trade name of Complainant and Complainant maintains its main website at “www.mmcofap.com.br”..Respondent should have known about Complainant’s rights, as such knowledge is readily obtainable through a simple browser search (*Caesars World, Inc. v. Forum LLC*, WIPO Case No. [D2005-0517](#); *Compart AG v. Compart.com / Vertical Axis, Inc.*, WIPO Case No. [D2009-0462](#)).

Moreover, Respondent could have searched different trademark registry databases and would have found Complainant’s prior registrations in respect of the COFAP trademark (*Citrix Online LLC v. Ramalinga Reddy Sanikommu Venkata*, WIPO Case No. [D2012-1338](#)).

As regards bad faith use, Complainant demonstrated that the Domain Name leads to a website displaying pornographic content. Accordingly, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website, by creating a likelihood of confusion with Complainant’s mark. It has been recognized that use of another’s trademark to generate revenue from Internet advertising can constitute registration and use in bad faith (*McDonald’s Corporation v. ZusCom*, WIPO Case No. [D2007-1353](#); *Volkswagen Aktiengesellschaft v. Robert Brodi*, WIPO Case No. [D2015-0299](#); *SAP SE v. Domains by Proxy, LLC / Kamal Karmakar*, WIPO Case No. [D2016-2497](#); [WIPO Overview 3.0](#), section 3.5).

The Domain Name use furthermore tarnishes Complainant's reputation by suggesting a connection between Complainant and adult services. This is an indication of bad faith use ([WIPO Overview 3.0](#), section 3.12; *Christian Dior Couture v. Identity Protection Service / Tom Birkett*, WIPO Case No. [D2014-1053](#)). Under these circumstances and on this record, the Panel finds that Respondent has registered and is using the Domain Name in bad faith.

Complainant has established Policy paragraph 4(a)(iii).

## **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, <mmcofap.com> be transferred to Complainant.

*/Marina Perraki/*

**Marina Perraki**

Sole Panelist

Date: January 20, 2023