

## **ADMINISTRATIVE PANEL DECISION**

Grupo Rotoplas, S.A.B. de C.V. v. JESUS SALVARRRN  
Case No. D2023-3310

### **1. The Parties**

The Complainant is Grupo Rotoplas, S.A.B. de C.V., Mexico, represented by Hurre Abogados, Mexico.

The Respondent is JESUS SALVARRRN, Mexico.

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

The disputed domain name <rotoplas-mx.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 2, 2023. On August 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 3, 2023, the Registrar transmitted by email to the Center its verification response confirming that the 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 the Respondent of the Complaint, and the proceedings commenced on August 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 28, 2023.

The Center appointed Luis C. Schmidt as the sole panelist in this matter on September 7, 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

The Complainant in this proceeding is Grupo Rotoplas, S.A.B. de C.V. a legally established company created in accordance with the laws of Mexico.

The Complainant is dedicated to creating solutions for storing, conveying, purifying, and treating water. A significant portion of its activity involves the production and distribution of water tanks and water reservoirs commonly known as “*tinacos*” in Mexico, as well as spare parts of them.

The Complainant is a Mexican multinational public company headquartered in Mexico City, Mexico, having a presence in 13 Latin American countries and the United States of America.

The Complainant is the owner of the following trademark registrations granted by the Mexican Institute of Industrial Property (“IMPI”):

- Trademark registration number 640070 for the ROTOPLAS word mark in class 20, registered on January 31, 2000;.
- Trademark registration number 762776 for the ROTOPLAS word mark in class 6, registered on September 27, 2002;
- Trademark registration number 987561 for the ROTOPLAS design mark in class 6, registered on May 31, 2007;.
- Trademark registration number 988272 for the ROTOPLAS design mark in class 20, registered on June 19, 2007.
- Trademark registration number 991776 for the ROTOPLAS design mark in class 11, registered on July 9, 2007.

On February 10, 2023, the IMPI issued a declaration of fame for the trademark ROTOPLAS on the file identified with the number M.F.275/2022(G-7)15876.

The Respondent registered the disputed domain name <rotoplas-mx.com> on July 10, 2023. Although it currently does not resolve to any active websites, there is evidence in the Complaint that the disputed domain name has been used to redirect to a website impersonating the Complainant.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant contends that:

- i. The disputed domain name <rotoplas-mx.com> is confusingly similar to the trademarks owned by the Complainant, as the term “rotoplas” is fully included in the disputed domain name.
- ii. Taking into consideration that the Complainant is a Mexican company and that the disputed domain name reproduces the term “MX” usually used to shorten the word “Mexico”, the Respondent is targeting the Mexican market taking advantage of the fame of ROTOPLAS to confuse its customers;
- iii. The term “MX” does not add any distinctive element that might prevent confusion of the disputed domain name with the ROTOPLAS trademark registrations; on the contrary; it states that the disputed domain name is from Mexico, as well as the Complainant, creating confusion among the consumers.
- iv. The Complainant has prior rights over the term “rotoplas”, at least since August 11, 1996, as indicated by the filing date in the Mexican Trademark Registration Certificate number 640070.

- v. The Complainant owns the domain name <rotoplas.com>, a legitimate website of the company, where its services and products are displayed.
- vi. The Respondent has no rights or legitimate interests in relation to the disputed domain name as it is not a licensee or an authorized distributor of the goods and services offered by the Complainant.
- vii. The disputed domain name has been used solely for speculative purposes and to the detriment of the Complainant and its reputation.
- viii. The Respondent did not have any prior rights or legitimate interests in the disputed domain name, and it is not commonly known by the disputed domain name.
- ix. The Respondent is using the Complainant's registered trademark in bad faith and engaging in unfair competition practice.
- x. The Respondent has registered and used the disputed domain name in bad faith and was previously using it to mislead consumers to buy products they would never receive, and to engage in false advertising of the trademark ROTOPLAS.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

In accordance with the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO overview 3.0"), section 1.7 the examination under the first requirement of the Policy involves carrying out a visual or phonetic comparison to assess whether the trademark is recognizable within the disputed domain name.

By comparing the signs, the Panel immediately recognizes the ROTOPLAS trademark owned by the Complainant within the disputed domain name <rotoplas-mx.com>., even though the latter includes the term "MX", which does not prevent a finding of confusing similarity for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#) section 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.").

The term "MX" does not dispel the confusion between the disputed domain name and the Complainant's trademark. See *Grupo Rotoplas, S.A.B. DE C.V. c. Lucrecia Gomez Gomez*, WIPO Case No. [D2019-1919](#).

The ".com" is a suffix, irrelevant for the purposes of this confusion analysis. See [WIPO Overview 3.0](#) section 1.11.1, where it is noted that generic Top-Level Domains ("gTLDs") are standard registration requirements and therefore should not be taken into account to determine whether or not the disputed domain name is confusingly similar to the relevant trademark.

From the above, it is necessary to conclude that the disputed domain name is confusingly similar to the ROTOPLAS trademarks owned by the Complainant.

Under these conditions, the Panel considers the first requirement of paragraph 4(a) of the Policy of the Policy satisfied.

## B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy expressly and non-exhaustively recognizes the following defenses to establish rights or legitimate interests in a disputed domain name:

- “i) before any notice to you 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 (as an individual, company, or other organization) have been commonly known by the domain name, even if you have not acquired product or service trademarks; or
- iii) you are 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.”

In the absence of a response to the Complaint, the Panel is prepared to infer that the Respondent lacks rights or legitimate interests in the disputed domain name. See *Pavillion Agency, Inc., Cliff Greenhouse and Keith Greenhouse v. Greenhouse Agency Ltd., and Glenn Greenhouse*, WIPO Case No. [D2000-1221](#) (holding that the respondent’s failure to respond to the complaint may be interpreted as an admission on its part of its lack of legitimate interest in the disputed name domain).

In any case, it is up to the Complainant to prove *prima facie* that the Respondent lacks rights or legitimate interests in the disputed domain name, for which the Complainant’s allegations that are credible and reasonable to the Panel must be taken into account, as well as the evidence presented. [WIPO Overview 3.0](#), section 2.1.

The Complainant alleges that the Respondent does not have any trademark registration of its own for the term “rotoplas” nor is it a licensee of the Complainant’s ROTOPLAS trademark.

Likewise, the Complainant demonstrates with printouts of the Respondent’s website associated with the disputed domain name, that in the past it was active and offering the Complainant’s products and services under the ROTOPLAS trademark. This use, in the opinion of the Expert, cannot be considered as a legitimate, fair, noncommercial, or good faith use in accordance with the Policy, given that it was aimed at misleading or confusing by the association between the disputed domain name and the trademarks of the Complainant.

Therefore, there is no evidence that the Respondent has used, or made demonstrable preparations to use, the disputed domain name in connection with a good faith offer of products or services.

Under these conditions, the Panel considers the requirement of paragraph 4(a)(ii) of the Policy satisfied.

## C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy imposes on the Complainant the double requirement of proving that the disputed domain name was registered in bad faith and is used in bad faith.

For its part, paragraph 4(b) of the Policy provides, as an example, the following scenarios of bad faith in the registration and use of a domain name:

- “i) Circumstances indicating that you have registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise assigning the registration of the domain name to the plaintiff who is the owner of the product or service trademark or to a competitor of that complainant, for a certain value that exceeds the documented miscellaneous costs that are directly related to the domain name; or

ii) you have registered the domain name in order to prevent the owner of the product or service trademark from reflecting the trademark on a corresponding domain name, provided that you have engaged in such conduct; or

iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; either; or

iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or any other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

Regarding the registration, the Panel takes into account, on the one hand, the complete reproduction of the Complainant's prior trademark in the disputed domain name and, on the other hand, the notoriety of the ROTOPLAS trademark in Mexico, where both the Complainant and the Respondent are located. Under these circumstances, it is reasonable, on the balance of probabilities, to conclude that the Respondent knew or should have known the Complainant's trademark at the time of registration of the disputed domain name. WIPO overview section 3.2.2. It is precisely this prior knowledge that is the circumstance that the Expert assesses to consider that the registration was in bad faith, with the disputed domain name having been registered due to its confusing similarity with the ROTOPLAS trademark.

In this way, it is clear that the disputed domain name <rotoplas-mx.com> was registered with the purpose of obtaining illicit advantages from users, which is an unequivocal sign of registration and use in bad faith. In this regard, the decisions *Grupo Financiero Inbursa, S.A. de C.V. v. inbursa*, WIPO Case No. [D2006-0614](#); *Take-Two Interactive Software, Inc. v. Mark Meir*, WIPO Case No. [D2013-0013](#); *Audi AG v. John Smith*, WIPO Case No. [D2016-0184](#), are illustrative.

In this order of ideas, the Panel considers that the registration and use of the disputed domain name was in bad faith, since the Respondent misappropriated a domain name that widely reproduces a well-known trademark in Mexico as ROTOPLAS to impersonate the Complainant for undue commercial gain.

The Respondent's conduct fully actualizes the bad faith ground provided for in paragraph 4(b)(iv) of the Policy by creating the false appearance that the website linked to the disputed domain name was operated directly by the Complainant.

Based on this, the Panel determines that the disputed domain name was registered and used in bad faith.

Under these conditions, the Panel considers the requirement of paragraph 4(a)(iii) of the Policy satisfied.

## 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 <rotoplas-mx.com> be transferred to the Complainant.

/Luis C. Schmidt/

**Luis C. Schmidt**

Sole Panelist

Date: September 21, 2023