

ADMINISTRATIVE PANEL DECISION

Grupo Rotoplas, S.A.B. DE C.V. v. Raciél Miranda Gaytan
Case No. D2023-5370

1. The Parties

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

The Respondent is Raciél Miranda Gaytan, Mexico.

2. The Domain Name and Registrar

The disputed domain name <rotoplasplantamx.com> is registered with NameSilo, LLC., (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 27, 2023. On December 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 28, 2023, the Registrar transmitted by email to the Center its verification response disclosing the registrant’s name¹, and contact information for the disputed domain name which differed from the contact information in the Complaint. The Center sent an email communication to the Complainant on January 4, 2024, 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 January 9, 2024.

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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 31, 2024.

The Center appointed Reynaldo Uriaga Escobar as the sole panelist in this matter on February 8, 2024.

¹ The Complainant did not name a respondent in the Complaint, indicating that such information was unavailable.

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.

The proceeding is conducted in English, this being the language of the disputed domain name's registration agreement, as confirmed by the Registrar.

4. Factual Background

The Complainant was established in Mexico in 1978 and in 2014 became a publicly-traded Mexican company that provides individual and integrated solutions for storing, carrying, and treating water.

The Complainant is well known in Mexico for manufacturing and distributing under its ROTOPLAS mark water reservoir tanks for residential and industrial use.

In addition to Mexico, the Complainant operates in Latin America and the United States of America.

The Complainant holds, inter alia, the following trademark registrations:

Mark	Country of registration	Reg. No.	Registration date	Goods or services
ROTOPLAS	Mexico	640070	January 31, 2000	[20] Furniture, mirrors, frames, plastic valves, wooden products.
ROTOPLAS	Mexico	762776	September 27, 2002	[6] Metallic tubes, metallic valves, metallic threads, metallic cables.
ROTOPLAS (and Design)	Mexico	987561	May 31, 2007	[6] Metal locks, metallic hardware, metallic valves for water, metallic float valves.
ROTOPLAS (and Design)	Mexico	988272	June 19, 2007	[20] Furniture, mirrors, frames, plastic valves, wooden products.
ROTOPLAS (and Design)	Mexico	991776	July 9, 2007	[11] Apparatuses for sanitary purposes, water reservoirs, and accessories thereto.

The Complainant's above marks are in full force and effect.

On February 10, 2023, the Mexican Institute of Industrial Property issued a declaration of fame for the ROTOPLAS trademark under case file M.F.275/2022(G-7)15876.

The Complainant owns and operates its main portal at "www.rotoplas.com".

The Respondent registered the disputed domain name on December 5, 2023, which it used to host a website impersonating the Complainant and falsely offering the Complainant's products and services.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- (i) ROTOPLAS is regarded as a famous mark in Mexico, which is the maximum protection afforded to a trademark under Mexican law;
- (ii) The disputed domain name fully incorporates the ROTOPLAS mark, thus creating confusing similarity within the meaning of the Policy;
- (iii) The term "planta" in Spanish, referencing a production plant, does not differentiate the disputed domain name from the ROTOPLAS mark;
- (iv) The term "planta" included in the disputed domain name is only used to create confusion and to make the consumer think that legitimate ROTOPLAS products are being sold through the disputed domain name's website;
- (v) The disputed domain name is actually being used for the fake sale of solutions for storing, conducting, purifying and treating water under the ROTOPLAS mark;
- (vi) The Respondent is not authorized by the Complainant to use its ROTOPLAS marks;
- (vii) The Respondent is fraudulently offering for sale ROTOPLAS products that the consumers will never receive;
- (viii) The disputed domain name is being used to sell counterfeit ROTOPLAS products;
- (ix) The ROTOPLAS mark is immediately associated with water tanks, pipes, and spare parts manufactured by the Complainant;
- (x) As ROTOPLAS is a famous mark in Mexico, it is highly unlikely that the Respondent, at the time of acquiring the disputed domain name, was unaware of infringing upon the Complainant's said mark;

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed in this administrative proceeding, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to trademarks or service marks 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.

These elements are discussed in turn below. In considering these elements, paragraph 15(a) of the Rules provides that the Panel shall decide the Complaint on the bases of statements and documents submitted and in accordance with the Policy, the Rules, and any other rules or principles of law that the Panel deems applicable.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the textual components of the Complainant's mark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the ROTOPLAS marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name fully encapsulates the mark ROTOPLAS, which in and of itself is sufficient to demonstrate confusing similarity with the Complainant's registered (and famous) mark notwithstanding the addition of "planta" and "mx", these being descriptive terms (in Spanish) for factory, and for Mexico's ISO 3166 country code, respectively. 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, meaningless, or otherwise, would not prevent a finding of confusing similarity under the first element).

Accordingly, the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Complainant submitted screenshots of the disputed domain name's website showing that prior to the filing of the Complaint, the Respondent impersonated the Complainant by using its trademarked ROTOPLAS logo², and falsely advertised the Complainant's water reservoirs for sale in Mexico at 35% discount.

As such, the Respondent created the misperception that its website was the Complainant's online factory store of genuine ROTOPLAS products.

² Mexican trademark registrations Nos. 987561, 988272, and 991776, asserted in the Complaint. See section 4 *supra*.

The Respondent's use of the disputed domain name for illegal purposes, here impersonation/passing off, negates the existence of rights or legitimate interests within the meaning of the Policy. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Pursuant to Policy, paragraph 4(a)(iii), in order to be granted relief, the Complainant must show that the disputed domain name was registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets forth the following non-exhaustive grounds of bad faith registration and use:

- “(i) circumstances indicating that you [the respondent] have 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 your [the respondent's] documented out-of-pocket costs directly related to the domain name; or
- (ii) you [the respondent] have 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 you [the respondent] have engaged in a pattern of such conduct; or
- (iii) you [the respondent] have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you [the respondent] have intentionally attempted to attract, for commercial gain, Internet users to your [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your [the respondent's] website or location or of a product or service on your [the respondent's] website or location.”

In the Policy context, bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1 of the [WIPO Overview 3.0](#).

As explained in section 4 supra, the Complainant owns Mexican trademark registrations for ROTOPLAS, all of which predate the Respondent's registration of the disputed domain name.

Moreover, on February 10, 2023, ROTOPLAS was officially acknowledged as a famous mark in Mexico, meaning that said mark is known by the majority of the Mexican consumers.³

The Panel finds that, by misappropriating the Complainant's famous mark to include it in the disputed domain name, and by using the latter to host a deceptive website aimed to impersonate the Complainant for undue commercial gain, the Respondent is deemed to have registered and used the disputed domain name in bad faith. See *Grupo Rotoplas, S.A.B. de C.V. v. JESUS SALVARRRN*, WIPO Case No. [D2023-3310](#) (the panel considers that the registration and use of the disputed domain name <rotoplas-mx.com> was in bad faith since the respondent misappropriated a domain name that widely reproduces a well-known trademark in Mexico like ROTOPLAS to impersonate the complainant for undue commercial gain).

All these circumstances, taken together, persuade the Panel that the disputed domain name was registered in bad faith and is being used in bad faith.

The Complainant has discharged its burden in relation to paragraph 4(a)(iii) of the Policy.

³This in accordance with article 190 of Mexico's Federal Law for the Protection of Industrial Property.

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 <rotoplasplantamx.com> be transferred to the Complainant.

/Reynaldo Urtiaga Escobar/

Reynaldo Urtiaga Escobar

Sole Panelist

Date: February 22, 2024