

ADMINISTRATIVE PANEL DECISION

Mercado Libre, Inc., Mercado Libre SRL, Mercado Libre Chile, Ltda.,
Mercado Libre, S. de R. L. C.V., Mercado Libre Venezuela, S.R.L.,
Ebazar.com.br, Ltda., Tech Fund, S.R.L. v. P Mercado Pago,
Pedro Yukio Sato
Case No. D2022-0624

1. The Parties

The Complainants are Mercado Libre, Inc., Argentina, Mercado Libre SRL, Argentina, Mercado Libre Chile, Ltda., Chile, Mercado Libre, S. de R. L. C.V., Mexico, Mercado Libre Venezuela, S.R.L., Venezuela, Ebazar.com.br, Ltda, Brazil, and Tech Fund, S.R.L., Uruguay, (hereinafter collectively referred to as “the Complainants”), represented by Marval O’Farrell & Mairal, Argentina.

The Respondent is P Mercado Pago, Pedro Yukio Sato, Brazil.

2. The Domain Name and Registrar

The disputed domain name <mercadopago.shop> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 22, 2022. On February 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 23, 2022, 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 Complainants on February 24, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on February March 2, 2022.

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 March 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 11, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on April 14, 2022. 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 Complainants comprise a large e-commerce ecosystem in Latin America, chosen by more than 320 million users to advertise, sell, buy, pay for and send their goods and services over the Internet. One of the Complainants' most prominent products is Mercado Pago, a digital payment platform that allows users to process online payments and send and receive money safely, easily and quickly. Complainant introduced Mercado Pago into the Latin American market in 2003. Mercado Pago is available in Argentina, Brazil, Chile, Colombia, Mexico, Peru, Venezuela and Uruguay, and since its introduction in Mercado Libre's ecosystem, has processed over 838 million transactions worth USD 28 billion. The digital platform is one of the most visited e-commerce sites in Latin America, with the highest number of registered users in Argentina, Brazil, Chile, Colombia, Costa Rica, Ecuador, Mexico, Peru, Uruguay, and Venezuela.

The Complainants' business began in Argentina and the Complainants own over 180 registered and active trademarks there. These include the trademark MERCADO PAGO, Argentinean Registration No. 3.074.391 in international class 9, registered on April 30, 2020; Registration No. 3.074.392 in international class 35; Bolivian Registration No. 107.396, in international class 36, registered on February 12, 2007; Chilean Registration No. 1.295.835 in international classes 9, 35, 36, 38 and 42, registered on April 26, 2019; and Colombian Registration No. 635.078 in international classes 9, 35, 36, 38 and 42, registered on December 10, 2019; among many others. Moreover, the Complainants own registrations, or pending applications, for the trademark MERCADO PAGO in many other Latin American countries, including Brazil (where the Respondent purportedly resides), Mexico, Nicaragua, Paraguay, Peru, Uruguay, and Venezuela.

The aforementioned trademarks will hereinafter be referred to as "the MERCADO PAGO Mark".

The Disputed Domain Name was registered on February 17, 2020, and resolves to an inactive landing page with no substantive content that states: "This site can't be reached. Mercadopago.shop's server ip address could not be found."

5. Parties' Contentions

A. Complainants

The following are the Complainants' contentions:

- the Disputed Domain Name is confusingly similar to the Complainants' MERCADO PAGO Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith; and
- the Complainants seek the transfer of the Disputed Domain Name from the Respondent to the Complainants in accordance with paragraph 4(a) of the Policy.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Preliminary Issue: Consolidation

The Complainants submitted a request for consolidation of the multiple Complainants in this proceeding in their Complaint. Pursuant to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11, the consolidation of multiple complainants filing a joint complaint against one or more respondents is subject to the discretion of the appointed panel.

In assessing whether a complaint filed by multiple complainants may be brought against one or more respondents, the appointed panel should consider whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion; and (ii) it would be equitable and procedurally efficient to permit the consolidation.

Keeping this in mind, the Panel notes that all of the Complainants in the present administrative proceeding are affiliated and subsidiaries of the same corporate group. Additionally, the Complainants share a common legal interest in the trademark rights on which this Complaint is based. Specifically, each of the Complainants owns a registration for the MERCADO PAGO Mark in different Latin American countries due to their belonging to the same corporate group.

As noted in greater detail below, the Respondent appears to have engaged in conduct targeting the MERCADO PAGO Mark held by the Complainants. As such, the Complainants have a specific common grievance against the Respondent. The Panel is not aware of any circumstances that would create prejudice to the Respondent by allowing the Complaint filed by multiple Complainants to proceed.

Therefore, the Panel considers that it is fair and equitable under the circumstances of the case to permit the consolidation, as the Complainants are not only affiliated companies, but also have common interests.

Consequently, the Panel allows the Complainants to proceed with their Complaint.

6.2 Substantive Issues

In order for the Complainants to prevail and have the Disputed Domain Name transferred to the Complainants, the Complainants must prove the following (Policy, paragraph 4(a)):

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainants have 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

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry, a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is identical to the MERCADO PAGO Mark.

It is uncontroverted that the Complainants have established rights in the MERCADO PAGO Mark based on its 17 years of use prior to the Respondent's registration of the Disputed Domain Name, as well as its registered trademarks for the MERCADO PAGO Mark in effectively all major countries of Latin America. The consensus view is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainants have rights in the MERCADO PAGO Mark.

The Disputed Domain Name consists of the MERCADO PAGO Mark in its entirety followed by the generic Top-Level Domain ("gTLD") ".shop". The addition of a gTLD such as ".shop" in a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#), and [WIPO Overview 3.0](#), section 1.11. Thus, the Disputed Domain Name is identical to the Complainants' MERCADO PAGO Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainants.

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that a respondent lacks rights or legitimate interests in the domain name at issue. Once such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1. In this case, the Panel finds that the Complainants have made out a *prima facie* case. In particular, the Respondent has not submitted any arguments or evidence to rebut the Complainants' *prima facie* case and there is no evidence in the record that the Respondent is in any way associated with the Complainants.

Moreover, the Complainants have not authorized, licensed, or otherwise permitted the Respondent to use its MERCADO PAGO Mark in the Disputed Domain Name. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any name similar to it nor has the Respondent made any demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Based on the use made of the Disputed Domain Name to resolve to an inactive landing page with no substantive content, the Panel finds that the Respondent is not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name.

Moreover, the Panel finds that the nature of the Disputed Domain Name carries a high risk of implied affiliation and cannot constitute fair use here, as it effectively suggests sponsorship or endorsement by the Complainants. See [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainants.

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainants have demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy.

First, the registration of a domain name that reproduces a widely known trademark in its entirety (being identical or confusingly similar to such trademark) by an individual or entity that has no relationship to that mark, without any reasonable explanation on the motives for the registration, can by itself create a presumption of bad faith. Based on the circumstances here, the Panel finds that the Respondent registered and is using the Disputed Domain Name in bad faith to target the Complainants' MERCADO PAGO Mark.

Second, the Respondent's registration and use of the Disputed Domain Name indicate that such registration and use has been done for the specific purpose of trading on the name and reputation of the Complainants and their MERCADO PAGO Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) (“[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark”).

Third, the Disputed Domain Name was registered at least 17 years after the Complainants first began using its MERCADO PAGO Mark and after the Complainants registered this mark. The Panel finds that the Respondent had the Complainants' MERCADO PAGO Mark in mind when registering the Disputed Domain Name. Moreover, based on the use made by the Complainant of the MERCADO PAGO Mark throughout Latin America, it strains credulity to believe that the Respondent had not known of the Complainants or its MERCADO PAGO Mark when registering the Disputed Domain Name. The Respondent's awareness of the Complainant and its MERCADO PAGO Mark additionally suggests that the Respondent's decision to register the Disputed Domain Name was intended to cause confusion with the Complainants' MERCADO PAGO Mark. Such conduct indicates that the Respondent registered and used the Disputed Domain Name in bad faith. Thus, the Panel finds that the Respondent had actual knowledge of the MERCADO PAGO Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith.

Finally, inactive or passive holding of the Disputed Domain Name by the Respondent does not prevent a finding of bad faith. See *Advance Magazine Publishers Inc. and Les Publications Condé Nast S.A. v. ChinaVogue.com*, WIPO Case No. [D2005-0615](#); *Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry – Succession Saint Exupéry – D'Agay v. Perlegos Properties*, WIPO Case No. [D2005-1085](#). It has long been held in UDRP decisions that the passive holding of a domain name that incorporates a well-known trademark without a legitimate purpose may indicate that the disputed domain name is being used in bad faith under paragraph 4(a)(iii) of the Policy. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#). Here, the Disputed Domain Name resolves to an inactive landing page with no content, and the Panel notes that the distinctiveness of the MERCADO PAGO Mark, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use all support a finding of bad faith.

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainants.

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 <mercadopago.shop> be transferred to the Complainants.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: April 28, 2022