

ADMINISTRATIVE PANEL DECISION

Aguirre y Compañía S.A. v. Roger Llohis, Luzon Lighting INC and Yuliani Llohis, PADEL USA

Case No. D2022-1558

1. The Parties

The Complainant is Aguirre y Compañía S.A., Spain, represented by Elzaburu, S.L.P., Spain.

The Respondents are Roger Llohis, Luzon Lighting INC, United States of America (“United States”) and Yuliani Llohis, PADEL USA, United States.

2. The Domain Names and Registrar

The disputed domain names <americabullpadel.com>, <bullpadelusa.com>, <bullpadelus.com>, <usabullpadel.com>, and <usbullpadel.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 29, 2022. On April 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 2, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. On May 3, 2022, the Respondent sent an email communication to the Center, which was acknowledged by the Complainant on the same date. The Center sent an email communication to the Complainant on May 13, 2022 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 May 17, 2022. The Respondent sent two email communications on May 17, 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 Respondents of the Complaint, and the proceedings commenced on May 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 13, 2022. The Response was filed with the Center on June 13, 2022.

The Center appointed John Swinson as the sole panelist in this matter on July 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 Complainant is a Madrid-based sports company. The Complainant sells rackets, footwear and textile products under the BULLPADEL trademark. The BULLPADEL trademark was first used in 1995 by a predecessor of the Complainant.

The Complainant owns several trademark registrations for BULLPADEL, including United States Trademark Registration No. 5232306 for a word mark for BULLPADEL that was filed on November 21, 2016.

The Respondent, Roger Llohis, is a person involved with Respondent Luzon Lighting Inc (being Respondent Luzon Lighting Inc the registrant organization for the majority disputed domain names, except for the disputed domain name <bullpadelusa.com> where the registrant organization as confirmed by the Registrar is PADEL USA) and another company, Zytech Inc. which does business as “PadelCart” and as “Amazon Padel”. It is unclear how Respondent Yuliani Llohis being the registrant of the disputed domain name <bullpadelusa.com> (as confirmed by the Registrar) is associated with the other Respondents except for the fact that the email address provided for the registrant of all the disputed domain names is the same (being the email address used by Roger Llohis to communicate with the Center in this proceeding). For the purposes of this decision, all Respondent entities will be called “the Respondent”.

The disputed domain names were all registered on December 21, 2018.

As at the date of this decision, all the disputed domain names divert to an online store located a <padelcart.com>. This online store is titled “Padel Cart” and advertises a range of paddle products, including rackets, balls, shoes and athletic wear (although at the date of this decision, only rackets appear to be available). The store has headings for a range of brands, including HawkPadel, Just Ten and Nox. The store also has a heading for BULLPADEL, but the page at this link states “No products were found matching your selection”.

5. Parties’ Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The BULLPADEL trademark is well-known. Some of the greatest players of paddle tennis use and promote BULLPADEL products. (The Complaint included substantial evidence regarding reputation of the BULLPADEL trademark.)

The Complainant owns registered trademarks for BULLPADEL and the BULLPADEL logo in several countries.

The disputed domain names include the BULLPADEL trademark and simply add a geographic term. The Complainant’s trademark is recognizable within the disputed domain names.

The Complainant conducted searches and was unable to find any trademarks owned by the Respondent Luzon Lighting Inc. containing BULLPADEL. The Respondent is not one of the Complainant’s official distributors and there has never been a business relationship between the Complainant and the Respondent.

The Complainant sent a warning letter to the Respondent on October 5, 2021. The Respondent did not reply to that letter. This is further evidence of the absence of any rights or legitimate interests in respect of the disputed domain names.

The Respondent has registered other domain names that include trademarks of competitors of the Complainant.

The disputed domain names redirect to a website selling products bearing the BULLPADEL trademark. The Respondent has attempted to create an impression among Internet users that the Respondent's website is related to the Complainant.

B. Respondent

In summary, the Respondent makes the following submissions:

The Respondent purchased the disputed domain names using its Padelcart or Amazon Padel account, and the disputed domain names are not associated with Luzon Lighting. Luzon Lighting is not the owner of the disputed domain names. Padelcart and Amazon Padel are registered doing-business-as names of Zytech Inc.

The Complainant's trademarks are not the same as the disputed domain names, and just consist of BULLPADEL.

The disputed domain names refer exclusively to the content of the webpages to which they redirect, namely BULLPADEL products. The Respondent has tried to boost sales of the Complainant's products.

The Respondent's website makes it clear that the Respondent is an authorized distributor of the Complainant.

The Respondent has not redirected customers to its website to set products from other brands.

The Respondent relies on the *Oki Data* case (cited in the decision below) and similar cases. Applying these criteria to the present case, the documentation provided by the parties does not reveal any reason for not considering the offer of products made by the Respondent through the disputed domain names to be legitimate and in good faith. Indeed, the disputed domain names give access to websites where genuine BULLPADEL products are specifically marketed, which in fact come from the Complainant. The evidence provided reveals the existence of a commercial relationship between the parties, by virtue of which the Respondent acquired the BULLPADEL products from the Complainant, which it subsequently marketed through the disputed domain names. From the way in which the corresponding webpages are structured, it is clear that the Respondent's websites are specifically intended for the sale of BULLPADEL products. Despite the fact that the webpages include a link that leads to the main website of the Respondent in which products of other brands are also sold, there is no specific and main intention of attracting the Internet public to these webpages, but rather it is a secondary link that responds to the usual uses in this type of webpage and that also helps to clarify that it is not the official page of the owner of the brand.

The Respondent provided a partial screenshot that suggests that the Respondent Padel Cart was listed on the Complainant's website as a distributor of the Complainant's products.

After the case was filed, the Respondent sent an email to the Complainant, copied to the Center, stating that the Respondent "still have some of your products" and images showing the Respondent selling or promoting BULLPADEL products.

The Respondent provided an invoice from the Complainant address to Zytech Inc. for approximately USD 15,000 of BULLPADEL products. This invoice is dated February 28, 2019.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain names are identical or confusingly similar to a trademark 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 names; and
- (iii) the disputed domain names have been registered and is being used in bad faith.

The onus of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

In the present case, all the disputed domain names are under common control. This is not in dispute. Moreover, all the disputed domain names were registered on the same date and divert to the same website. Accordingly, it is appropriate to consider all the disputed domain names in this decision.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant owns trademark registrations for BULLPADEL.

All the disputed domain names include the Complainant's BULLPADEL trademark in its entirety.

Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation, regardless of other terms in the disputed domain name. See, for example, *Consumer Reports, Inc. v. Wu Yan, Common Results, Inc.*, WIPO Case No. [D2017-0371](#); and *Captain Fin Co. LLC v. Private Registration, NameBrightPrivacy.com / Adam Grunweg*, WIPO Case No. [D2021-3279](#).

It is not a defence, as asserted by the Respondent, that the Complainant does not have trademark registrations that are identical to the disputed domain name. The test is "identical or confusingly similar".

The Panel concludes that the disputed domain names are confusingly similar to the Complainant's trademark.

The Complainant succeeds on the first element of the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain names.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in

connection with a *bona fide* offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or

(iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

As referred to above, one way in which rights or legitimate interests can be demonstrated is by the Respondent's *bona fide* use of the disputed domain names in connection with an offering of goods or services, before he received notice of the dispute (paragraph 4(c)(i) of the Policy).

The Respondent operates a business which sells the Complainant's products. The Respondent has not provided specific evidence of his affiliation with the Complainant, other than an invoice. Based on the information provided in the case file, it is unclear exactly what arrangement exist or have existed between the Complainant and the Respondent. The screenshot provided by the Respondent of the Complainant's website is not sufficient to clarify the nature of the relationship (as it is not clearly stated therein). The Respondent states: "It is true that the parties do not agree when it comes to qualifying their contractual relationship, since while the [Complainant] states that the [Respondent] is not its official distributor, the latter affirms that it is an authorized distributor." The Panel accepts, for the purposes of this analysis, that at one time the Respondent sold the Complainant's genuine products that the Respondent obtained from the Complainant.

It is generally accepted that use of a trademark within a domain name – with other terms appended to the trademark as within the domain name – by a reseller may be considered *bona fide* in certain circumstances. Those circumstances are set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*"), a case cited by the Respondent in the Response. In *Oki Data*, the Panel listed four factors, which if proven, can demonstrate that a reseller or distributor is making a *bona fide* offering of goods and services and thus has a legitimate interest in a domain name, namely:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the site to sell only the trade marked goods (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods);
- the site itself must accurately disclose the respondent's relationship with the trademark owner; and
- the respondent must not try to "corner the market" in all relevant domain names, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

Oki Data involved the use of a trademark within a domain name ("okidataparts") by an authorized reseller. However, even if the Respondent is not an authorized reseller for the Complainant, the *Oki Data* principles

have been applied to resellers who do not have a contractual relationship with a trademark owner (see, e.g., *DaimlerChrysler A.G. v. Donald Drummonds*, WIPO Case No. [D2001-0160](#); *Dr. Ing. h.c. F. Porsche AG v. Del Fabbro Laurent*, WIPO Case No. [D2004-0481](#); *Wahl Clipper Corporation v. T. Lanzaat*, WIPO Case No. [D2018-0877](#).)

As stated in *Pangaea Laboratories Ltd, Pacific Direct Intertrading Pty Ltd v. Astrix Pty Ltd*, WIPO Case No. [DAU2015-0013](#), “*Oki Data* is an exception to a general rule. The general rule is that it is generally not permissible to register a domain name that is the same as another’s trade mark rights, knowing of those trade mark rights, to seek traffic to a commercial website. *Oki Data* is a narrow exception to this rule for legitimate resellers, distributors and dealers. *Oki Data* is also subject to any agreement between the parties.”

In the present case, the Respondent sells or sold the Complainant’s goods and also competing goods on the same website. At the present time, all disputed domain names divert to this website. When entering any of the disputed domain names into a browser, the page returned advertises mostly NOX rackets, which compete with the Complainant’s BULLPADEL rackets.

At the bottom of the Respondent’s website, there is a long paragraph that states in part:

“We distribute from many manufacturers such as NOX, JustTen, HawkPadel and Bullpadel. We are constantly working to expand our range!”

The Response asserts that the disputed domain names resolve to pages of the Respondent’s website that only promote BULLPADEL products, but this is not in fact the current situation.

The Panel considers that the Respondent does not meet the *Oki Data* factors, in particular, that the respondent must use the site to sell only the trade marked goods.

Additionally, at the present time the Panel is unable to find any of the Complainant’s products currently available for sale on the Respondent’s website. When searching for BULLPADEL products on the Respondent’s website, the following message is displayed: “No products were found matching your selection”. Thus, at the present time, it appears that the Respondent is not actually selling the Complainant’s products, as required by the first *Oki Data* factor. Thus, the Respondent does not currently comply with this *Oki Data* factors. *Progeo Monitoring GmbH v. Clark Guinness*, WIPO Case No. [D2015-2163](#). Based on the evidence before the Panel, none of the circumstances listed in paragraph 4(c) apply in the present circumstances. Accordingly, the Panel finds that the Respondent has no rights or any legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain names in bad faith.

The Panel is of the view that the Respondent was aware of the Complainant and the BULLPADEL trademark when the disputed domain names were registered.

The disputed domain names divert to the Respondent’s online store.

The Complainant’s registration of the BULLPADEL trademark predates the registration of the disputed domain names, being the BULLPADEL trademark reproduced within the disputed domain names in its entirety (along with the geographical terms “US” and “USA”), and consequently easily associated with the Complainant. Considering the reputation of the BULLPADEL trademark and based on the evidence of reputation provided by the Complainant, including that the Respondent is selling both the Complainant’s goods and competitor goods, it is highly probable that the Respondent had knowledge of the BULLPADEL trademark at the time of registration of the disputed domain names, registering the disputed domain names precisely due to its similarity with the BULLPADEL trademark. Therefore, in these circumstances, where the

Respondent is offering competing products, it is open for the Panel to find that the Respondent is trading off the Complainant's trademark and registered and is using the disputed domain names in bad faith.

Further, the Complainant sent to the Respondent a cease-and-desist letter drawing the Respondent's attention to the Complainant's rights in the BULLPADEL trademark and seeking transfer of the disputed domain names to the Complainant. The Respondent's failure to respond to that letter further demonstrates the use in bad faith. *HDMI Licensing Administrator, Inc. v. S Kumar, Knoxed Limited*, Case No. [D2018-2514](#).

The Panel finds that the Respondent has intentionally attempted to attract for commercial gain Internet users to its website by creating likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website under paragraph 4(b)(iv) of the Policy.

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 names <americabullpadel.com>, <bullpadelusa.com>, <bullpadelus.com>, <usabullpadel.com>, and <usbullpadel.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: July 28, 2022