

## **ADMINISTRATIVE PANEL DECISION**

### **GS1 Brasil Associação Brasileira de Automação v. Mundo do Código de Barras Case No. D2022-2723**

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

The Complainant is GS1 Brasil Associação Brasileira de Automação, Brazil, represented by Newton Silveira, Wilson Silveira e Associados - Advogados, Brazil.

The Respondent is Mundo do Código de Barras, Brazil.

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

The disputed domain name <gs1ean.org> is registered with NameCheap, Inc. (the “Registrar”).

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

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 26, 2022. On July 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 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 Complainant on August 1, 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 August 4, 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 August 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2022. On August 28, 2022, the Center received an email from the Respondent asking for an extension of the response period. Further emails were received from both Parties on August 31, 2022. The Center extended the due date for response to September 5, 2022. The Respondent filed a Response on September 5, 2022.

The Center appointed Mario Soerensen Garcia as the sole panelist in this matter on September 28, 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 GS1 Brasil Associação Brasileira de Automação, the Brazilian representative of GS1 AISBL, a Belgian independent neutral not-for-profit international organization and globally known for creating and administering EAN barcodes, that reflect a standard set by specific requirements shared among the national bodies that make up GS1 international. Each of the member organizations of GS1 International has a website associated with a domain name that incorporates the alphanumeric characters “gs1”.

The Complainant is the owner of many trademarks comprising the terms “GS1” and “EAN” in Brazil, including the following:

- Registration No. 825528798, for GS1 BRASIL, registered on June 5, 2007;
- Registration No. 913319309, for EAN-13, registered on January 8, 2019.

Also, the Complainant owns the domain name <gs1br.org>, registered on April 1, 2003.

The disputed domain name was registered on August 10, 2021.

#### **5. Parties' Contentions**

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

The Complainant argues that the disputed domain name is identical to the Complainant's registered trademarks, trade name and domain name, and creates confusion among Internet users as to the relation between the disputed domain and the Complainant's domain name <gs1br.org> that has existed since 2003. According to the Complainant, Internet users may certainly assume that the disputed domain name is associated or affiliated with or sponsored by the Complainant, which is not true.

In addition, the Complainant informs that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that it has never assigned and/or licensed the trademarks GS1 or EAN to the Respondent. Also, the Complainant states that “GS1” and “EAN” have no meaning, which means that the Respondent seeks to create the impression of an association with the Complainant.

Furthermore, the Complainant says that due to its reputation, there is no doubt that the Respondent has registered the disputed domain name intentionally in the most common and wanted generic Top-Level Domain. The Complainant points out that it was established in 1985.

As per the Complaint, the Respondent registered the disputed domain name to intentionally attract Internet users for a financial gain based on the confusion with the Complainant's trademarks and to establish a false impression of association with the Complainant.

The Complainant mentions and shows evidence that the disputed domain name resolves to a website that sells barcodes from the Complainant's GS1 system.

Finally, the Complainant requests the transfer of the disputed domain name.

## **B. Respondent**

The Respondent is an information technology consulting service provider and custom software developer and responded the Complainant's contentions by saying and showing evidence that it is owner of the software registration called "FONTE DE CÓDIGO DE BARRAS GS1 EAN13 – STSPRINT", duly registered by the Brazilian Patent and Trademark Office ("BPTO").

Also, the Respondent informs that its main website is "www.mundodocodigodebarras.com.br", which provides over 200 different products and services, including "barcode source GS1 EAN13".

The Respondent mentions that none of the Complainant's trademarks comprise the terms "GS1" and "EAN" together and that in 2015 the Complainant filed a lawsuit against the Respondent about this matter, which is still pending of decision. As per the Respondent, the true intention of the Complainant is not to question the use of trademarks and patents, but to have monopoly of the use of the bar code supply in Brazil.

In the response, the Respondent also explains that the Complainant provides the numeric prefix and the Respondent provides a software that transforms the prefix into the actual barcode, reason why there would be no confusion by the customers and no competition between the Complainant and the Respondent.

The Respondent adds that it is entitled to the use of the disputed domain name and that it was not registered in bad faith, since it has an operation in Brazil and owns its Computer Program duly registered at the BPTO.

## **6. Discussion and Findings**

As per paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

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

The evidence presented demonstrates that the Complainant is the owner of different trademarks comprising the terms "GS1" and "EAN" in Brazil, such as GS1 BRASIL and EAN-13. The Panel, therefore, finds that the Complainant has trademark rights for purposes of the Policy.

The disputed domain name is composed by the Complainant's trademarks in part, but this does not avoid confusing similarity between the disputed domain name and the Complainant's trademarks.

As numerous prior UDRP panels have recognized, the incorporation of a trademark in its entirety or a dominant feature of a trademark is sufficient to establish that a domain name is identical or confusingly similar to the complainant's registered mark. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that paragraph 4(a)(i) of the Policy has been proved by the Complainant, *i.e.*, the disputed domain name is confusingly similar to the Complainant's trademarks.

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

The Respondent has submitted a response to the Complaint informing and showing evidence that it is the owner of the Software Registration called "FONTE DE CÓDIGO DE BARRAS GS1 EAN13 – STSPRINT",

created on February 6, 1997 and issued by the BPTO on September 5, 2017.

This Panel finds that the fact that the Respondent owns a software registration named “Fonte de Código de Barras GS1 EAN13” meaning “source of barcodes GS1 EAN” does not mean that it has the right to use the operative parts of the Complainant’s trademarks (“GS1” and “EAN”) to create a domain name aiming to mislead users as to the source of the services provided there.

The Complainant stated in the Complaint that the Respondent has no authorization to use its trademarks or to register domain names containing parts of its trademarks.

There is also no evidence that the Respondent is commonly known by the disputed domain name. On the contrary, the Respondent informed, in the Response to this Complaint, that its “main website is “[www.mundocodigodebarras.com.br](http://www.mundocodigodebarras.com.br)”, which sells over 200 different products and services”.

There is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name or that before any notice of the dispute the Respondent has made 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. Instead, there is evidence that the Respondent has used the disputed domain name in connection with a website that even resembles the Complainant’s official website. Moreover, the construction of the disputed domain name itself is such to carry a risk of implied affiliation with the Complainant, which cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

For the above reasons, the Panel finds that the condition of paragraph 4(a)(ii) of the Policy has been satisfied.

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

The Complainant is the Brazilian representative of GS1 AISBL and owns the trademarks GS1 BRASIL and EAN-13 in Brazil, in addition to its domain name <gs1br.org>, which was registered in 2003 and operates its official website.

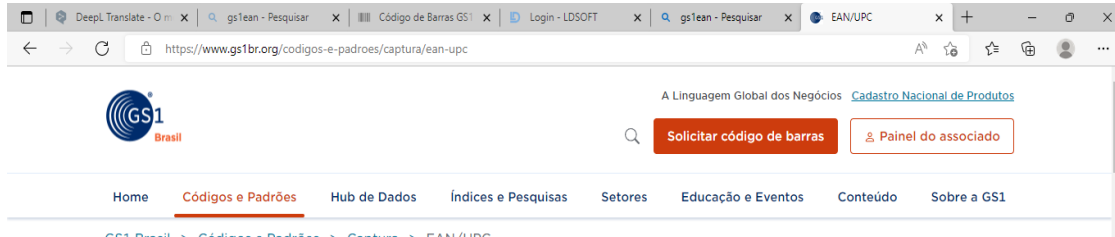
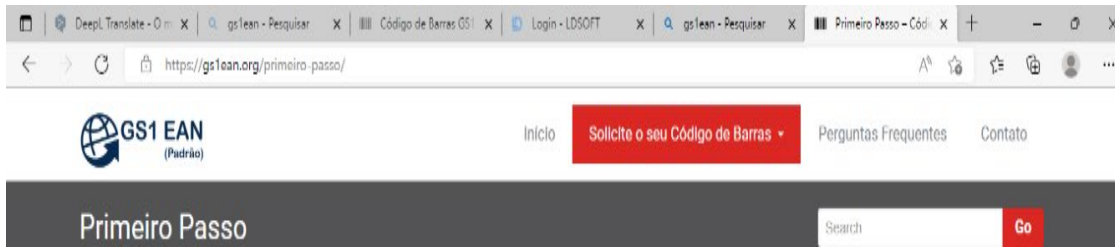
The disputed domain name is comprised of the terms “GS1” and “EAN”. Considering the Respondent’s business activity, it obviously knew of the Complainant’s mark before the registration of the disputed domain name.

The construction of the disputed domain name was not by coincidence and creates confusion for customers, since it actually makes it appear that the disputed domain name belongs to the Complainant.

The Complainant’s marks are reputed in its segment. Thus, a domain name that comprises such marks may be already suggestive of the Respondent’s bad faith.

Moreover, the Respondent informed that its main website is “[www.mundocodigodebarras.com.br](http://www.mundocodigodebarras.com.br)”. In this context, if “[www.mundocodigodebarras.com.br](http://www.mundocodigodebarras.com.br)” is already operating, this Panel finds that there is no other reason to create and use the disputed domain name comprising the operative parts of the Complainant’s trademarks and using visual properties resembling the Complainant’s official website, than to take any undue advantage.

Additionally, the visual properties of the Respondent’s website corresponding to the disputed domain name bring similar elements to the Complainant’s website, a fact that in association with the use of the terms “GS1” and “EAN”, makes consumers effectively confuse the two companies.



The above confirms that the disputed domain name was registered and has been used for commercial gain, by purposely creating a likelihood of confusion with the Complainant's trademarks and misleading Internet users to believe that the Respondent's website belongs to or is associated with the Complainant.

This Panel finds that the Respondent's intention of taking undue advantage of the Complainant's trademarks as described in paragraph 4(b)(iv) of the Policy has been demonstrated.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(iii) of the Policy has been satisfied, *i.e.*, the disputed domain name has been registered and is being used in bad faith.

## 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 <gs1ean.org> be transferred to the Complainant.

*/Mario Soerensen Garcia/*

**Mario Soerensen Garcia**

Sole Panelist

Date: October 12, 2022