

ADMINISTRATIVE PANEL DECISION

Hon Hai Precision Industry Co., Ltd. v. Mauricio Ruiz Diaz, Nineteen Solutions
Case No. D2023-3208

1. The Parties

The Complainant is Hon Hai Precision Industry Co., Ltd., Taiwan Province of China, internally represented.

The Respondent is Mauricio Ruiz Diaz, Nineteen Solutions, Paraguay.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 26, 2023. On July 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Privacy Protection, REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 8, 2023, 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 amendment to the Complaint on August 9, 2023.

The Center verified that the Complaint together with the amendment to 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 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 6, 2023. On August 24, 2023, the Center received an email communication from the Respondent confirming, on behalf of its client, that the website at the disputed domain name had been taken down. The Respondent did not submit any formal response.

The Center notified the commencement of panel appointment process on September 14, 2023. On the same day, the Respondent confirmed again that the website at the disputed domain name had been taken down. On September 18, 2023, the Center informed the Parties that if they would like to explore settlement discussions, the Complainant would need to submit a request to suspend the proceeding. However, the Complainant did not request for suspension.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on October 9, 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

Established in 1974, the Complainant is the manufacturer of electronics, and owns many trademark registrations for FOXCONN, such as United States of America trademark registration No. 3,251,122 registered on June 12, 2007, and International trademark registration No. 911316 registered on November 21, 2005.

The disputed domain name was registered on May 10, 2023, and resolves to a website displaying the Complainant's trademark, and purportedly offering for sale similar goods to those of the Complainant under the brand FOXCONN.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark. The disputed domain name incorporates the Complainant's trademark together with the term "brasil", which does not prevent a finding of confusing similarity. The webpage to which the disputed domain name resolves seems to offer products branded by the Complainant's trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant did not license the Respondent to use its trademark in the disputed domain name and it is not an authorized representative of the Complainant's products or services. The webpage to which the disputed domain name resolves displays the Complainant's trademark with its logo. This creates the impression that it is a webpage belonging to the Complainant. The webpage seems to offer products for Apple-branded products. There is no *bona fide* offering of products or services.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Respondent must have been aware of the Complainant's trademark as the Complainant is the biggest iPhone maker and the Respondent's website offers goods for Apple branded products. The Respondent uses the Complainant's trademark on social media. The mere registration of a domain name that is identical or confusingly similar to a well-known trademark by an unaffiliated entity can of itself create a presumption of bad faith.

B. Respondent

On August 24, 2023, the Respondent sent an email communication to the Center indicating:

"[O]n behalf of my client, I'm here to inform that we went on to take the website down. As of the social media mentioned, they're outside of my control (I'm just the webmaster) but I have informed my client about that too. Please advise me if this issue is resolved."

On September 14, 2023, the Respondent sent another email communication stating that the website had been taken down.

6. Discussion and Findings

6.1 Preliminary Issues

A. Respondent's Identity

On August 24, 2023, the Respondent sent an email communication to the Center which appears to indicate that it registered the disputed domain name for a client (the "beneficial holder"), and on behalf of its client, it confirmed that the website had been taken down. On the same day, the Center acknowledged receipt of this email communication indicating that the Registrar had confirmed that the Respondent is listed as the registrant of the disputed domain name, that the Respondent may forward the Notification of the Complaint, the Complaint and its corresponding Annexes to the individual if the Respondent considers that it may have an interest in the proceeding, and that the Panel will make a determination on the Respondent's assertions. The Center did not receive any communication from the beneficial holder.

The Panel notes that paragraph 1 of the Rules defines Respondent as "the holder of a domain-name registration against which a complaint is initiated".

The Panel further notes as stated in a previous UDRP decision *Bryan Cave Leighton Paisner LLP v. Job*, WIPO Case No. [D2020-0592](#), "[...] in certain circumstances, especially when (i) the identity of the beneficial holder is disclosed, (ii) the beneficial holder submits arguments explaining its position, or (iii) the relationship between the registrant of the domain name and the beneficial holder is clear, panels would normally consider any submission by the beneficial holder (and, obviously, the submissions by the registrant) in reaching their decisions (including for the purposes of the determination of the respondent's identity) [...]."

Considering the circumstances of this proceeding, in particular, the silence of the beneficial holder, the Panel finds in the present case there is no evidence on the existence and nature of any relationship between the listed registrant and the beneficial holder which would allow the Panel to consider that the beneficial holder should be treated as a further Respondent.

Further, the Panel also agrees that "[t]he existence of a beneficial holder should not serve generally to renege on the obligations and responsibilities that a registrant of a domain name has by virtue of its registration. The Panel considers that if the disputed domain name is not being used by the registrant itself, the registrant should adopt such measures that are necessary to tend to ensure the proper and *bona fide* use of its registered domain name (for example via contractual obligations in a license to use the disputed domain name) and should not turn a blind eye or expect a disclaimer of its responsibility merely because of the use is being carried out by a beneficial holder and not the registrant itself." See *Bryan Cave Leighton Paisner LLP v. Job*, *supra*.

In light of the above, the Panel considers appropriate to find that "Mauricio Ruiz Diaz, Nineteen Solutions" is the Respondent in this proceeding.

B. Taken Down of the Website at the Disputed Domain Name

The Respondent sent two email communications stating that the website had been taken down and the Parties were given an opportunity to settle the dispute but such settlement did not occur. The Respondent's confirmation to take down the disputed domain name is ambiguous in respect of the Respondent's position as to the allegations made by the Complainant, and if the Respondent is willing to transfer the disputed domain name to the Complainant. Therefore, the Panel has decided to issue a substantive decision on the merits. See section 4.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

6.2 Substantive Issues

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for FOXCONN. The Panel is satisfied that the Complainant has established its ownership of the trademark FOXCONN.

The disputed domain name incorporates the Complainant's trademark FOXCONN in its entirety. It is established by prior UDRP panels that when a domain name incorporates a complainant's registered trademark, such incorporation is sufficient to establish identity or confusing similarity for the purposes of the Policy even if other terms are added as part of the disputed domain name, *e.g.*, *Oki Data Americas, Inc v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*").

The addition of the geographical term "brasil" ("brazil" in Portuguese) does not alter the fact that the disputed domain name is confusingly similar to the Complainant's trademark. The generic Top-Level-Domain ".com" can be ignored when assessing confusing similarity as it is viewed as a standard registration requirement.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production of evidence shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not licensed by the Complainant to use its trademark and the Respondent is not an authorized representative of the Complainant's products. Therefore, the Complainant has established a *prima facie* case, and the burden of production on this element shifts to the Respondent to show that it has rights or legitimate interests.

According to the Policy, the use of the disputed domain name would be legitimate if it is used in connection with a *bona fide* offering of goods or services. The website to which the disputed domain name resolves purportedly offers products under the Complainant's trademark. Therefore, there may be an argument that the disputed domain name is being used in connection with a *bona fide* offering of products. In line with the *Oki Data* test, a number of requirements have to be met (see *Oki Data, supra*):

- (i) "Respondent must actually be offering the goods or services at issue";
- (ii) "Respondent must use the site to sell only the trademarked goods";
- (iii) "The site must accurately disclose the registrant's relationship with the trademark owner"; and
- (iv) "The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name".

The Panel finds that at least the requirement No. 3 above has not been met in this case. Therefore, it is the Panel's view that the requirements of the *Oki Data* test have not been met.

Further, the composition of the disputed domain name is inherently misleading as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. Therefore, such composition cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

Moreover, the Respondent has itself taken down the website to which the disputed domain name resolves, and did not assert having any legitimate rights or interests.

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

There are indications that the disputed domain name was registered and is being used in bad faith. The Respondent clearly knew of the Complainant's business and trademark as the disputed domain name resolves to a website offering the products under the Complainant's trademark. The nature of the disputed domain name suggests affiliation with the Complainant as it incorporates the Complainant's trademark and the Complainant's trademark is a fanciful word that has no dictionary meaning. The display of the Complainant's trademark with logo reinforces the impression that the disputed domain name is affiliated with the Complainant. The disputed domain name was registered almost twenty years after the registration of the Complainant's trademark.

The nature of the disputed domain name suggests affiliation with the Complainant as it incorporates the Complainant's trademark in full. The use of the geographical term "brasil" ("brazil" in Portuguese) reinforces the impression that the disputed domain name is the Complainant's website for the Brazilian market. The use of the Complainant's trademark with logo on the website to which the disputed domain name resolves reinforces such impression. As such, the disputed domain name suggests false affiliation with the Complainant in order to attract Internet users for commercial gain. Such conduct falls squarely within the meaning of paragraph 4(b)(iv) of the Policy, and accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy, *i.e.*, the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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 name <foxconnbrasil.com> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: October 23, 2023