

ADMINISTRATIVE PANEL DECISION

Distribuidora Automotiva S.A. v. Jeff T Muzzy, Black Moon Designs
Case No. D2023-5318

1. The Parties

The Complainant is Distribuidora Automotiva S.A., Brazil, represented by Newton Silveira, Wilson Silveira e Associados – Advogados, Brazil.

The Respondent is Jeff T Muzzy, Black Moon Designs, United States of America (“United States”), represented by John Berryhill, Ph.D., Esq., United States.

2. The Domain Name and Registrar

The disputed domain name <pitstop.com> is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 21, 2023. On December 22, 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 registrant and contact information for the disputed domain name which differed from the named Respondent (Perfect Privacy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 2, 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 2, 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 9, 2024. In accordance with the Rules, paragraph 5, the due date for the Response was set to January 29, 2024. On January 15, 2024, Respondent opted for the mandatory extension in accordance with the Rules, paragraph 5, and the due date was set to February 2, 2024. The Response was filed with the Center on February 2, 2024.

The Center appointed Andrea Mondini, Wilson Pinheiro Jabur, and David H. Bernstein as panelists in this matter on March 1, 2024. The Panel finds that it was properly constituted. Each member of 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 Brazilian company active in the field of the distribution of automotive parts. Under the trademark PIT STOP, the Complainant operates as an associative network in the independent auto parts replacement market in Brazil.

The Complainant asserted several Brazilian trademark registrations comprising the element "PIT STOP". The earliest trademark registration asserted by the Complainant is the design mark PIT STOP AUTO CENTER (Brazilian registration no. 818826347) filed on September 28, 1995, and registered on March 2, 2004, in international class 12.

Although not mentioned in the Complaint, the Respondent also has cited another of the Complainant's trademark registrations: the word mark PIT STOP (Brazilian trademark registration no. 817424679), filed on July 22, 1993, and registered on April 2, 2002.

The Complainant further holds the domain name <pitstop.com.br>, which was registered on July 16, 1997.

The Respondent, Mr. Jeff Muzzy, is a software engineer. Blackmoon Designs is a Washington corporation of which the sole governor is Mr. Jeff Muzzy.

The disputed domain name was registered on July 5, 1994.

According to the evidence submitted with the Complaint, the disputed domain name currently resolves to a registrar parking page with geo-targeted advertising of automotive products.

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 as follows:

The Complainant is one of Brazil's leading auto parts distribution groups and has been operating in the Brazilian market since 1922.

The disputed domain name is identical to the PIT STOP trademark in which the Complainant has rights, because it incorporates this trademark in its entirety.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The trademark PIT STOP has been extensively used to identify the Complainant and its services in the Brazilian automotive parts market. The Respondent has not been authorized by the Complainant to use this trademark, and there is no evidence of the Respondent's use, or demonstrable preparation to use, the disputed domain name in connection with a bona fide offering of goods and services. To the contrary, the disputed domain name resolves to a website with links, in the Portuguese language, to third-party sites engaged in activities covered by the Complainant's trademarks, specifically automotive parts and accessories targeted at the Brazilian market.

The disputed domain name was registered with the intention of attracting Internet users to links that promote products competing with those of the Complainant, creating a risk of confusion with the customers of the Complainant for commercial gain. The non-use of a domain name (including a blank page or “coming soon” page) does not preclude a finding of bad faith under the doctrine of passive holding.

B. Respondent

In its Response, the Respondent contends the following:

This dispute involves a dictionary word domain name, which was registered by the Respondent on behalf of his employer, Microsoft, on July 5, 1994. After Microsoft no longer needed the disputed domain name, Respondent subsequently used the domain to publish an online auto racing magazine and information resource for local auto racing events. The Respondent states that his registration of the disputed domain name predates all of the trademark registrations asserted by the Complainant, of whom the Respondent has never heard prior to this dispute. The Complainant provides no explanation of why it has not even contacted the Respondent in the nearly 30 years since the Respondent registered the disputed domain name.

The Respondent acknowledges that the first criterion does not require senior rights and therefore the Respondent does not dispute that the disputed domain name is identical or confusingly similar to the Complainant's trademark. However, the Respondent disputes that the Complainant has been operating in the Brazilian market for over a century, by stating that the earliest corporate record for the Complainant is of February 12, 1990, and that on its website, the Complainant states that it was founded in 1998, i.e., even after the registration of the disputed domain name.

The Respondent states that he has a considerable background as a software engineer. Blackmoon Designs is a Washington corporation of which the sole governor is Mr. Jeff Muzzy. Mr. Muzzy has had sole control of the disputed domain name since registering it in 1994.

In 1994, the Respondent was a Senior Systems Engineer with Microsoft Corporation. Microsoft was at that time considering development of a competitive service offering to AOL. To provide part of the test environment for the services (later launched as “MSN”), the Respondent reserved and paid for the disputed domain name under the alias “MOSRESEARCH” on July 5, 1994. [Note that the Response actually references July 5, 2004, but the Panel believes that to be a typographical error, and that the Respondent meant to say that he registered the disputed domain name in 1994.]

The Respondent states that “[w]hen the [disputed domain] name was no longer being used for its original purpose, [the] Respondent continued to personally maintain the disputed domain name and to pay the renewals for purposes relating to why Respondent chose ‘PITSTOP’.” The Respondent goes on to say that he had the intention of launching an online service for car racing sport in which the Respondent and his father had a longstanding shared passion. The Respondent submitted exhibits showing his activity as a race car driver since 1991; Archive.org extracts document the use of the disputed domain name for an online auto racing website between 1999 and 2008. The articles published under the disputed domain name, and the inclusion of Respondent's disputed domain name in the National Speedway Directory and the corresponding corporate identity show bona fide use of the disputed domain name prior to the present dispute.

Notably what does not appear in the Archive.org history is anything having to do with auto parts in Brazil. After the Respondent discontinued his online auto racing website, the Respondent simply pointed the disputed domain name to a default server page in the event there were any interest in reviving the name at a later time. In sum, the Respondent submits that the disputed domain name was registered in July 1994 prior to any notice of a dispute, in demonstrable preparations for a bona fide use, and was then in fact used for the bona fide operation of an entirely US-focused auto racing website for a decade.

The Respondent also asserts that he did not register the disputed domain name in bad faith. The Complainant does not advance a single reason to believe that the Respondent, upon registering the disputed

domain name in July 1994, should have known of the Complainant or, for that matter, should have known that PIT STOP was used – among thousands of other uses – for an auto parts business in Brazil. The Complainant does not show ownership of any enforceable rights or widespread reputation when the Respondent registered the disputed domain name. Instead, the Complainant asserts a trademark registration which issued in 2002 based on an application filed in 1993. Hence, at the time when the disputed domain name was registered in 1994, there was no enforceable trademark right, even in Brazil. The notion that the Respondent would have gone out of his way in 1994 to register a domain name corresponding to a pending Brazilian trademark application is “absurd”, since neither the Brazilian trademark database nor the Complainant were online at that time.

After having discontinued the car racing site in 2008, the Respondent merely maintained “this valuable short dictionary word name” in its domain registration account. The Respondent contends that he did not use the disputed domain name in bad faith because he was not aware that Network Solutions commandeered the resolution of unused names to a registrar parking page with geo-targeted advertising.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to the 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

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 Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The mark PIT STOP is reproduced within the disputed domain name.

The addition of the generic Top-Level Domain (“gTLD”) “.com” in the disputed domain name is a standard registration requirement and as such may be disregarded under the confusing similarity test under the Policy, paragraph 4(a)(i). See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds 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.

The Panel notes that the Response states the disputed domain name was initially registered for a project in the context of the Respondent’s work as a software engineer, as is reflected in the oldest WHOIS record listing the corporate address for Microsoft. The Response then states that “[w]hen the [disputed domain] name was not used for its original purpose, [the] Respondent continued to personally maintain the domain name and to pay the renewals for purposes relating to why Respondent chose ‘PITSTOP’.” This formulation appears to imply both that the disputed domain name was potentially registered at the request of or for the

benefit of his then-employer, but also that the Respondent registered the disputed domain name from the outset for a car-themed purpose. It is also not entirely clear when the disputed domain name would have passed from one purpose to the other, and when the registrant became the sole registrant (as opposed to the Admin/Tech contact, but not the Registrant); the next WHOIS record provided shows this to be in 2013. Ultimately however, given that the Respondent incorporated Pitstop.com Inc. as Washington corporation in August 1999, there is sufficient corroborating evidence of the fact that the Respondent's a bona fide / non-infringing use of the disputed domain name between 1998 and 2008, as a racing car online resource. The Panel finds that the latter use is sufficient to establish rights or legitimate interests.

Accordingly, the Complainant has failed to establish the second element of the Policy.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Respondent makes a compelling case for not being aware of the Complainant and its trademark at the time of registration of the disputed domain name. The Complainant does not advance a single reason to believe that the Respondent, based in the United States, at the time of registering the disputed domain name in July 1994, should have known of the Complainant or, for that matter, should have known that PIT STOP was used for an auto parts business in Brazil. The Panel also notes that none of the Complainant's trademark registrations predates the registration of the disputed domain name (although at least one of the registrations was merely a pending application at that time). Therefore, the Panel finds that the disputed domain name was not registered in bad faith.

In light of this finding, there is no need to decide the issue whether the disputed domain name was used in bad faith.

Based on the available record, the Panel finds that the Complainant has not established the third element of the Policy.

D. Reverse Domain Name Hijacking

Although the Respondent did not expressly request a finding a reverse domain name hijacking ("RDNH"), it is a Panel's obligation to consider whether such a finding is appropriate. Rules, paragraph 15(e). On balance, the Panel declines to award RDNH here. At the time of the Complaint, the Respondent was concealing his identity behind a privacy shield. That prevented the Complainant to investigate the Respondent and ascertain his potential rights and legitimate interests and his potential bad faith use and registration of the disputed domain name. Such a privacy shield also can hide the effective date on which a Respondent acquired or registered the disputed domain name. The Complainant had a good faith basis to be concerned when it saw its trademark being used as a domain name for pay-per-click advertising by an unnamed entity; the greater clarity that has emerged since the privacy shield was lifted and since the Respondent explained his history with the disputed domain name does not undermine the bona fide of the Complainant's initial concerns.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrea Mondini/
Andrea Mondini
Presiding Panelist

/Wilson Pinheiro Jabur/
Wilson Pinheiro Jabur
Panelist

/David H. Bernstein/
David H. Bernstein
Panelist
Date: March 14, 2024