

ADMINISTRATIVE PANEL DECISION

Vannucci Importação Exportação e Comercio de Autopeças Ltda v. Jose Antonio Constancio Junior, Mercebenz
Case No. D2024-2469

1. The Parties

The Complainant is Vannucci Importação Exportação e Comercio de Autopeças Ltda, Brazil, represented by Salusse, Marangoni, Parente e Jabur Advogados, Brazil.

The Respondent is Jose Antonio Constancio Junior, Mercebenz, Brazil.

2. The Domain Names and Registrars

The disputed domain names <grupovannucci.com> and <indvannucci.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 June 18, 2024. On June 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 18, 2024, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 24, 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 amendment to the Complaint on June 25, 2024.

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 June 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 18, 2024.

The Center appointed Mario Soerensen Garcia as the sole panelist in this matter on July 24, 2024. 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

Vannucci Importação, Exportação e Comercio de Autopeças Ltda., the Complainant, was established in January 1993 and it is related to heavy-duty vehicle parts market, in Brazil.

The Complainant is the owner of Brazilian Trademark registrations for VANNUCCI, covering goods and services related to retail and manufacturing of vehicles parts and components, namely:

Registration no. 828246220 for VANNUCCI & design, in class 12, registered on April 1, 2008.

Registration no. 825283140 for VANNUCCI & design, in class 35, registered on September 8, 2009.

The Complainant is the owner the domain names <grupovannucci.com.br> and <indvannucci.com.br>, respectively registered on November 26, 2010, and October 10, 2002.

The Respondent was identified as Jose Antonio Constancio Junior, from the “Mercebenz” organization.

The disputed domain names <grupovannucci.com> and <indvannucci.com> were both registered on March 30, 2017, and resolve to parking webpages, displaying pay-per-click (“PPC”) hyperlinks. The disputed domain name <indvannucci.com> resolves to a webpage disclosing links related to the Complainant’s activities in the field of vehicles parts and accessories.

According to the documents presented by the Complainant with the Complaint, in 2018 the Complainant filed a lawsuit against Mercebenz Distribuidora before the State Court of São Paulo. The Defendant in that case was condemned to pay moral damages due to the non-authorized association with the Complainant’s trademark and unfair competition caused by the disputed domain names.

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 names.

The Complainant argues that the disputed domain names <grupovannucci.com> and <indvannucci.com> are identical to the trademark VANNUCCI and to the domain names owned by the Complainant.

The disputed domain names resolved to parking webpages, displaying PPC hyperlinks, and links related to the Complainant’s activities in the field of vehicles parts and accessories.

There is no evidence that the Respondent has made demonstrable preparations to use the disputed domain names for legitimate purposes, nor is there any evidence that the Respondent is using the disputed domain names in connection with a bona fide offering of goods and services.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names. That being the case, the Complainant finds that the disputed domain names are used to take unfair advantage of the Complainant’s rights for commercial gain, since Internet users and the Complainant’s clients would inevitably associate the content related to the disputed domain names with the Complainant’s prior trademarks.

Moreover, the Complainant stresses that the Respondent is not commonly known by the name “vannucci.”

According to the Complainant, it has prior rights over the trademark VANNUCCI, and has not authorized the registration and the use of the disputed domain names, nor the use of its trade name and trademarks by the Respondent.

The Respondent is not affiliated to or authorized by the Complainant to use or register the disputed domain names.

The Complainant’s intellectual property rights for VANNUCCI trademarks predate the registration of the disputed domain names.

The Complainant also argues that the Respondent was aware of the Complainant’s rights and has clearly registered the disputed domain names to target the Complainant’s trademark, and that the registration of the disputed domain names were conducted in bad faith.

The Complainant requests the transfer of the disputed domain names.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain names are identical or confusingly similar to the trademarks or service marks 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 are 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 its trademark VANNUCCI for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The Panel notes that the compositions of the disputed domain names being almost identical to the Complainant’s previous domain names <grupovannucci.com.br> and <indvannucci.com.br> and carry a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds the second element of the Policy has been established.

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.

In the present case, the Panel notes that at the time the disputed domain names were registered, the Respondent was clearly aware of the VANNUCCI trademarks as the Complainant’s trademark registrations as well as its domain names predate the registration date of the disputed domain names.

The composition of the disputed domain name suggests affiliation with the Complainant as it incorporates the Complainant’s VANNUCCI trademarks entirely with the additional terms “ind” and “grupo”, and are almost identical to the Complainant’s previous domain names <grupovannucci.com.br> and <indvannucci.com.br> . Moreover, according to the disclosed evidence, the websites to which the disputed domain names resolve contain third-party commercial advertising links, suggesting to the Panel that the Respondent has intended to create a likelihood of confusion and to mislead Internet users for commercial gain.

The Panel finds that the Complainant has established the third element 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 <grupovannucci.com and <indvannucci.com> be transferred to the Complainant.

/Mario Soerensen Garcia/

Mario Soerensen Garcia

Sole Panelist

Date: August 7, 2024