

ADMINISTRATIVE PANEL DECISION

Grupo Rotoplas, S.A.B. de C.V. v. Oscar Garcia
Case No. D2023-4396

1. The Parties

The Complainant is Grupo Rotoplas, S.A.B. de C.V., Mexico, represented by Hurre Abogados, Mexico.

The Respondent is Oscar Garcia, Mexico.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 24, 2023. On October 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 24, 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 (information not available) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 25, 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 amended Complaint on October 28, 2023.

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 October 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2023. The Respondent sent an email communication to the Center on October 28, 2023. On November 24, 2023, the Center notified the Commencement of Panel Appointment Process.

The Center appointed Pedro W. Buchanan Smith as the sole panelist in this matter on November 30, 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

According to the information provided by the Complainant, and due to the fact that the same was not disputed by the Respondent, the following facts and circumstances are recognized within this proceeding:

The Complainant is a Mexican multinational public-traded company dedicated to the manufacturing of water storage and filtration tanks, also dedicated to creating solutions for storing, conveying, purifying, and treating water. It has presence in 13 Latin American countries and is currently positioned as the largest distributor of water storage products and derivatives in Mexico, as well as filtration systems in Mexico and worldwide.

The Complainant refers to the plastic water tank as its flagship product. The ROTOPLAS brand is recognized by 77% of tank consumers in Mexico. A significant part of its activity involves the production and distribution of water tanks and containers (known in Mexico as "*tinacos*"), as well as spare parts.

The Complainant is the owner of multiple registrations of trademarks consisting of or containing the famous ROTOPLAS mark. The various trademark registration certificates, issued by the Mexican Institute of Industrial Property (IMPI) of the Complainant cover an extensive range of goods and services on several trademark classes. Additionally, the IMPI issued the office action number M.F.275/2022(G-7)15876 on February 10, 2023 stating that ROTOPLAS is considered as a famous trademark, according with the Mexican Law, due to the well-known character of the mark in Mexico. As examples, the Complainant confirmed the following registrations in its Complaint:

- i) Trademark ROTOPLAS, Registration No. 640070, International Class 20 and Products covered: Furniture, mirrors, frames; products not included in other classes, made of wood, cork, cane, reed, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, sea foam, substitutes for all these materials or plastic materials, particularly valves made of plastic material, expressly excluding staves and crosspieces, registered on January 31, 2000;
- ii) Trademark ROTOPLAS, Registration No. 762776, International Class 6 and Products covered: Common metals and their alloys; metallic building materials; transportable metal constructions; metallic materials for railway tracks; non-electric metallic cables and wires; metal locks and hardware; metal tubes; safes; metal products not included in other classes; minerals, particularly metal valves, expressly excluding metallic construction materials such as scaffolding, curtains, gratings, windows, and doors, registered on September 27, 2002;
- iii) Trademark ROTOPLAS and design, Registration No. 987561, International Class 6 and Products covered: Common metals and their alloys; metallic building materials; transportable metal constructions; metallic materials for railway tracks; non-electric metallic cables and wires; metal locks and hardware; metal tubes; safes; metal products not included in other classes; minerals, including metal water containers (water tanks), metal water conduits, float valves, and multi-connectors made of metallic materials, registered on May 31, 2007;

iv) Trademark ROTOPLAS and design, Registration No. 988272, International Class 20 and Products covered: Furniture, mirrors, frames; products not included in other classes, made of wood, cork, cane, reed, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, sea foam, substitutes for all these materials or plastic materials, particularly valves made of plastic material, expressly excluding staves and crosspieces, registered on June 19, 2007;

v) Trademark ROTOPLAS and design, Registration No. 991776, International Class 11 and Products covered: Devices for lighting, heating, steam production, cooking, refrigeration, drying, ventilation, water supply, and sanitary purposes; particularly, pipes, water tanks, water containers, filters, and accessories for them, registered on July 9, 2007.

According to the information provided, the disputed domain name is confusingly similar to the aforementioned trademarks, all of which are owned by the Complainant. It is important to mention that ROTOPLAS never uses the name “ventas” or its translation to the English word “sales” within its products.

The Complainant has prior rights over the ROTOPLAS mark, at least since January 31, 2000, as indicated by the registration date in the above mentioned Mexican Trademark Registration Certificate number 640070.

The Complainant is the owner of the domain name <rotoplas.com> a legitimate website where the services and products offered under the ROTOPLAS brand are displayed in full right. Attached to the Complaint is the registration information for this website, its link, and the legitimate ownership of such website dating back to April 24, 2000.

The disputed domain name <rotoplasventas.net> was registered on August 25, 2023 and even though it currently redirects to an inactive page, it used to resolve to a website offering products and solutions for storing, conducting, purifying, and treating water and displaying the ROTOPLAS brand.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the ROTOPLAS trademark due to the fact that the trademark ROTOPLAS is completely included in the disputed domain name, therefore, the similarity between the mentioned trademarks and the disputed domain name is duly demonstrated.

The Respondent has no rights or legitimate interests in relation to the disputed domain name due to the fact that it is not a licensee or an authorized distributor of the goods or services of ROTOPLAS.

The Respondent is not commonly known by the name or trademark ROTOPLAS, so there is no reason to believe that the use of the disputed domain name can be attributed to any individual without commercial activities related to ROTOPLAS or its products. The Respondent has no relationship or authorization from the Complainant to use their trademark.

The Respondent offers a fraudulent distribution of the Complainant's goods and services and does not display any license agreement. Although currently inactive, the disputed domain name was being used to illicitly sell counterfeit products displaying the ROTOPLAS brand.

The disputed domain name has been used solely for speculative purposes and to the detriment of the prestigious ROTOPLAS trademark, without any other reason that would lead to the conclusion that the Respondent has prepared to use the disputed domain name in connection with a good faith offering of goods or

services of any kind, it should also be noted that the Respondent is trying to sell goods and services of the ROTOPLAS company inferring that they are the legitimate site of the Complainant, which indicates bad faith.

There is no *bona fide* distribution or commercialization of goods that would lead to the conclusion that these services constitute noncommercial use, or that the disputed domain name is used without the intention of obtaining commercial gain to deceptively divert consumers or tarnish the relevant trademark ROTOPLAS.

The disputed domain name was registered and is being used to mislead the consuming public to illicitly buy counterfeit products, services, or goods and to engage in false advertising of the brand ROTOPLAS and thus, the registration and use of the disputed domain name is in bad faith.

It is important to mention that the current finding of bad faith in this case aligns with previous UDRP decisions , which have established precedents and serve as references.

Specifically, in cases on bad faith due to trademark awareness such as *Grupo Rotoplas, S.A.B. de C.V. v. Abraham Montes Cristo*, Case No. [D2019-0921](#), regarding intention to disrupt commercial activities, in *Grupo Rotoplas, S.A.B. DE C.V. v. Lucrecia Gomez Gomez*, Case No. [D2019-1919](#), trademark awareness, defrauding customer and creating false appearance that the website linked to the disputed domain was directly operated by the complainant, in *Grupo Rotoplas, S.A.B. De C.V. V. 1&1 Internet Inc. / Fernanda Montes, Franquicias De México S.A. De C.V.*, Case No. [D2020-1378](#), and regarding bad faith for registering a domain without a commercial relationship in *Grupo Rotoplas, S.A.B. de C.V. v. Domain Administrator, C/O InMotion Hosting, Inc.*, Case No. [D2022-3215](#).

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Panel considers that the Respondent, by registering the disputed domain name with the Registrar (an Internet Corporation for Assigned Names and Numbers (ICANN) – accredited registrar), agreed to be bound by all terms and conditions of the Registration Agreement, and any pertinent rule or policy, and particularly agreed to be bound by the Policy (incorporated and made a part of the Registration Agreement by reference), which mandates that proceedings be conducted according to the Rules and the selected administrative dispute resolution service provider's supplemental rules, in the present case being the Supplemental Rules. Therefore, the dispute subject matter of this proceeding is within the scope of the above-mentioned agreements and Policy, and this Panel has jurisdiction to decide this dispute.

Furthermore, the Panel considers that in the same manner, by entering into the above mentioned Registration Agreement, the Respondent agreed and warranted that neither the registration of the disputed domain name nor the manner in which it may intend to use such disputed domain name will directly or indirectly infringe the legal rights of a third party, and that in order to resolve a dispute under the Policy, the Respondent's registration services for the disputed domain name may be suspended, and the disputed domain name cancelled or transferred.

The Panel also particularly considers that it is essential to dispute resolution proceedings that fundamental due process requirements be met.

Such requirements include that the Parties and particularly the Respondent in this case be given adequate notice of proceedings initiated against them; that the Parties may have a fair and reasonable opportunity to respond, exercise their rights and to present their respective cases; that the composition of this Panel be properly made and the Parties be notified of the appointment of this Panel; and that both Parties be treated with equality in these administrative proceedings.

In the case subject matter of this proceeding, the Panel is satisfied that these proceedings have been carried out by complying with such fundamental due diligence requirements, and particularly concerning the Notification of the Complaint and the commencement of these proceedings giving the Respondent a right to respond.

Paragraph 4(a) of the Policy directs that the Complainant must prove the presence of each of the following elements: (i) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and (ii) that the Respondent has no rights or legitimate interests in respect of the domain name; and (iii) that the 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.

Based on the available record, the Panel finds 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 Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the very well-known ROTOPLAS mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, "ventas" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Furthermore, the addition of the generic Top-Level Domain ("gTLD") ".com" is just a necessary element required for the registration of a second level domain name and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, 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.

The Respondent has no rights or legitimate interests in relation to the disputed domain name due to the fact that is not a licensee or an authorized distributor of the good or services of ROTOPLAS. Furthermore, the Respondent is not commonly known by the name or trademark ROTOPLAS.

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 name. 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 name such as those enumerated in the Policy or otherwise.

This Panel finds, in general, from the information and facts that were analyzed and from the lack of evidence to the contrary, that there is no indication that the Respondent has any rights or legitimate interests in connection with the Complainant's ROTOPLAS trademark nor with the disputed domain name; that the disputed domain name is being used to intentionally misdirect to the Respondent's website visitors who attempt to visit the Complainant's website; that the Respondent has not used nor prepared to use the disputed domain name in connection with any good faith offering of goods or services as contemplated under paragraph 4(c)(i) of the Policy; nor that the Respondent is commonly known by the disputed domain name as contemplated under paragraph 4(c)(ii) of the Policy; nor that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain, but rather to misleadingly divert consumers or to tarnish the trademark or service mark at issue as contemplated under paragraph 4(c)(iii) of the Policy. Moreover, the Panel notes that the composition of the disputed domain name, which incorporates the Complainant's trademark with the addition of the term "ventas" ("sales" in Spanish), carries a risk of implied affiliation.

According to the unrebutted evidence of the Complainant, the website at the disputed domain name was used to offer for sale ROTOPLAS products. The Panel cannot determine if the products are counterfeit. Nevertheless, the lack of any disclaimer on the website at the disputed domain name as to the registrant's relationship with the trademark owner or the lack thereof, would falsely suggest to Internet users that the website to which the disputed domain name resolved is owned by the Complainant or at least affiliated to the Complainant (see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and [WIPO Overview 3.0](#), section 2.8.1).

Based on the available record, 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.

Considering the notoriety of the Complainant's ROTOPLAS mark in Mexico, where both Parties are located, and that the disputed domain name incorporates the Complainant's well-known ROTOPLAS mark in its entirety with the addition of the term "ventas" ("sales" in Spanish), the Panel finds that the Respondent must have been aware of the Complainant's ROTOPLAS mark when it registered the disputed domain name.

In the present case, the Panel notes that the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark, and furthermore, trying to sell goods and services of the Complainant inferring that they are the legitimate site of the Complainant.

The Panel furthermore finds, from the information and facts that were analyzed, and from the lack of evidence to the contrary, that the registration of the Domain Name <rotoplasventas.net> by the Respondent is in bad faith, in particular but without limitation, pursuant to paragraph 4(b)(iv) of the Policy, in view of the fact that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trademark ROTOPLAS, as to the source, sponsorship, affiliation or endorsement of the website "www.rotoplas.com".

The change of use of the disputed domain name to an inactive website does not prevent a finding of in bad faith.

Based on the available record, 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 name <rotoplasventas.net> be transferred to the Complainant.

/Pedro W. Buchanan Smith/

Pedro W. Buchanan Smith

Sole Panelist

Date: December 14, 2023