

ADMINISTRATIVE PANEL DECISION

Pacaembu Autopecas Ltda v. Graziela da Silva Joanini, R NOGUEIRA
Case No. D2024-1962

1. The Parties

The Complainant is Pacaembu Autopecas Ltda, Brazil, represented by Opice Blum, Brazil.

The Respondent is Graziela da Silva Joanini, R NOGUEIRA, Brazil.

2. The Domain Name and Registrar

The disputed domain name <pacaembudiesel.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 9, 2024. On May 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 11, 2024, 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 (Alibaba.com Singapore E-commerce Private Ltd.) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 13, 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 May 14, 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 May 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 6, 2024. On June 6, the Registrar sent an email communication to the Center emphasizing that they are only the registrar in this case, and has nothing to do with the Respondent. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 7, 2024.

The Center appointed Alvaro Loureiro Oliveira as the sole panelist in this matter on June 19, 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.

On July 5, 2024, the Complainant requested to add another domain name to the current proceeding, which was brought to the Panel's attention on July 8, 2024. The Panel notes that "[e]xcept in limited cases where there is clear evidence of respondent gaming/attempts to frustrate the proceedings (e.g., by the respondent's registration of additional domain names subsequent to complaint notification), panels are generally reluctant to accept such requests because the addition of further domain names would delay the proceedings (which are expected to take place with due expedition)." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.12.2.

Considering the late submission of the Complainant's request, and the additional domain name was registered prior to this proceeding, the Panel decides not to accept the Complainant's request. The Panel further notes that its declining would not prevent the filing of a separate complaint where such additional domain name may be addressed.

4. Factual Background

The Complainant Pacaembu Autopecas Ltda, a Brazilian company, enrolled before the Corporate Taxpayer ID (CNPJ/ME), having offices in the city of São Paulo, Brazil. The Complainant provides products and services associated with vehicle parts, encompassing heavy vehicles and "diesel" vehicles. important to note that the Complainant's official website is "pabu.com.br",

The Complainant owns prior rights in the PACAEMBÚ and PACAEMBU AUTOPEÇAS trademarks, namely Brazilian Registrations:

- 814142192, for PACAEMBÚ (design), granted on September 8, 1992, covering services from class 35;
- 823893804, for PACAEMBU AUTOPEÇAS (design), granted on November 22, 2011, covering services from class 37; and
- 823893812, for PACAEMBU AUTOPEÇAS (design), granted on October 13, 2015, covering goods from class 12.

Copies of these registrations is presented as Annex 4 of the Complaint.

The Complainant has also established rights in the mark PACAEMBÚ as the distinctive portion of their corporate name, Pacaembu Autopecas Ltda, since at least 1966.

The Complainant has established rights in the mark PACAEMBU, prior to the registration of the disputed domain name on December 20, 2023. The disputed domain name resolves to an active website that reflects the mark PACAEMBU and offers several goods and services identical to the ones sold and rendered by the Complainant. The referred website indicates false secure certificates related to payment methods, and uses the Complainant's name as well as the Taxpayer ID (CNPJ/ME) of one of the Complainant's branches. A copy of the website is shown by Annex 6 of the Complaint.

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 states that the disputed domain name is confusingly similar to the PACAEMBU trademark - in fact, the disputed domain name includes the trademark in its entirety, followed by the term "diesel", which has no effect whatsoever in distancing the disputed domain name from the registered trademark - and can be related to the consumers of the Complainant's current goods and services, as it refers to a type of fuel used. The Complainant also states that the disputed domain name is confusingly similar to the PACAEMBU AUTOPEÇAS trademark.

The Respondent has no rights nor legitimate interests in the disputed domain name, whereas the Respondent has not acquired any trademark rights with respect to the disputed domain name. As stated by the evidence presented, the registration and use of the trademarks PACAEMBU and PACAEMBU AUTOPEÇAS predates the registration of the disputed domain name in decades. Moreover, the Respondent is not commonly known by the disputed domain name. The Respondent has also not secured a license nor any other authorization from the Complainant to use the trademarks.

Further, the disputed domain name adopted by the Respondent – a reproduction of the Complainant's registered mark associated with a descriptive expression – shows a clear intention of misleading Internet users, as it links to a page impersonating the Complainant. The website uses a PACAEMBU DIESEL design mark, offers the same goods and services as the Complainant, and the Complainant's name and indicates the Taxpayer ID (CNPJ/ME) of one of the Complainant's branches as if it were the Respondent's. The Complainant underlines that the disputed domain name gives the impression that it is associated with the Complainant.

The Complainant also indicates that the Respondent registered and is using the disputed domain name in bad faith, as several of their regular customers complained about goods paid but not delivered, that were acquired directly from the website at the disputed domain name.

In sum, the Complainant alleges that it is clear that the Respondent has no rights or legitimate interests in the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

The Policy, in its paragraph 4(a), determines that three elements must be present and duly proven by a complainant to obtain relief. These elements are:

- i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- ii. the Respondent has no rights or legitimate interests in respect to 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 Complainant has presented consistent evidence of ownership of the trademark PACAEMBU, by presenting Brazilian registrations for it, as well as evidence of the use of the trademark.

The disputed domain name is confusingly similar to the PACAEMBU trademark, as the latter is entirely incorporated in the disputed domain name save for the accent, with the mere addition of the term "diesel". [WIPO Overview 3.0](#), section 1.7.

The addition of the term “diesel” in the disputed domain name does not prevent a finding of confusing similarity with the trademark because the trademark is clearly recognizable in the disputed domain name and as set out in the [WIPO Overview 3.0](#), section 1.8, the addition of other terms would not prevent a finding that a disputed domain name is confusingly similar to the relevant mark for purposes of the first element.

Lastly, the Panel notes that, in accordance with section 1.11.1 of the [WIPO Overview 3.0](#), the generic Top-Level Domain (“gTLD”), in this case “.com”, is in principle disregarded under the first element confusing similarity test.

Given the above, the Panel concludes that the disputed domain name is confusingly similar to the registered trademark of the Complainant.

B. Rights or Legitimate Interests

The Panel notes that the trademark PACAEMBÚ is widely known as identifying the Complainant’s activities, and that the Complainant did not license this to the Respondent.

Furthermore, the Respondent does not appear to be commonly known by the disputed domain name.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. In the absence of a Response, the Respondent has not rebutted such prima facie case.

The disputed domain name almost reproduces the Complainant’s mark PACAEMBÚ in its entirety, with the addition of the term “diesel”, which carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

In addition, the disputed domain name has been used to resolve to a website impersonating the Complainant by using the Complainant’s name and the Taxpayer ID (CNPJ/ME) of one of the Complainant’s branches, and has been used in connection with fraudulent activities directed towards customers who are looking for the Complainant’s products and/or services as asserted by the Complainant.

Panels have established that the use of a domain name for illegal activity (e.g., here claimed phishing and impersonation/passing off) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel, thus, finds for the Complainant under the second element of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent has probably registered the disputed domain name with the purpose of taking unfair advantage of the Complainant’s marks.

The composition of the disputed domain name points towards the Respondent’s likely intent to give an impression that the disputed domain name is associated with the Complainant. In the absence of any reasonable explanation for the selection of the disputed domain name by the Respondent, and in the circumstances of this case particularly the use of the Complainant’s name and the Taxpayer ID (CNPJ/ME) of one of the Complainant’s branches on the website at the disputed domain name, the Panel finds that the disputed domain name has been registered to target the Complainant and to take unfair advantage of the trademark owned by the Complainant.

According to the evidence provided in Annexes 6 and 7 to the Complaint, the disputed domain name has been used in connection with a website impersonating the Complainant and offering similar goods and services. In addition, the Complainant contends that several of their regular customers were misled by the webpage pretending to be the Complainant which has not been rebutted by the Respondent.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt “to attract, for commercial gain, Internet users to [the respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] website or location or of a product or service on [the respondent’s] website or location” is evidence of registration and use in bad faith.

Further, panels have held that the use of a domain name for illegal activity here, claimed phishing and impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Moreover, the Panel notes the reputation of the Complainant’s trademark PACAEMBÚ, the failure of the Respondent to submit a Response, and the implausibility of any good faith use to which the disputed domain name may be put considering the composition of the disputed domain name, support a finding of bad faith.

In the totality of the circumstances, the Panel finds the Respondent has registered and is using the disputed domain name 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 <pacaembudiesel.com> be transferred to the Complainant.

/Alvaro Loureiro Oliveira/

Alvaro Loureiro Oliveira

Sole Panelist

Date: July 12, 2024