

ADMINISTRATIVE PANEL DECISION

D.E Cafés do Brasil Ltda. and Jacobs Douwe Egberts BR, Comercialização de Cafés Ltda. v. Davi Livia, Ruan Cardoso, Antonio Caleb, and info ofertas
Case No. D2024-3733

1. The Parties

The Complainants are D.E Cafés do Brasil Ltda., Brazil, and Jacobs Douwe Egberts BR, Comercialização de Cafés Ltda., Brazil, represented by Ploum, Netherlands (Kingdom of the).

The Respondents are Davi Livia, Brazil, Ruan Cardoso, Brazil, Antonio Caleb, Brazil, and info ofertas, Brazil (collectively, the “Respondent”).

2. The Domain Names and Registrar

The disputed domain names <pilaoquiz.site>, <quiz-cafepilao.site>, <quiz-pilao.online>, <quiz-pilao.shop>, and <quizpilao.site> are registered with Hostinger Operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2024. On September 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 17, 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 (UNKNOWN) and contact information in the Complaint.

The Center sent an email communication to the Complainant on September 17, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaints for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amended Complaint on September 19, 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 September 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 13, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 14, 2024.

The Center appointed Alvaro Loureiro Oliveira as the sole panelist in this matter on October 17, 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

The Complainants are D.E. Cafés do Brasil Ltda and Jacobs Douwe Egberts BR Comercialização de Cafés Ltda, private limited liability companies having their registered office in Sao Paulo, Brazil. The Complainants are part of Jacobs Douwe Egberts, which in turn is part of JDE Peet's, one of the largest pure play coffee and tea companies, headquartered in the Netherlands (Kingdom of the).

The Complainants' coffee and tea portfolio is available in over 100 countries around the world and consists of many worldwide well-known household trademarks including JACOBS, TASSIMO, MOCCONA, SENSEO, L'OR, and PILÃO.

The Complainants own several trademark registrations for PILÃO, among which the following ones:

- Brazil trademark registration No. 810036541 for PILÃO, registered on February 5, 1985;
- Brazil trademark registration No. 811065081 for PILÃO, registered on June 12, 1984;
- Portugal trademark registration No. 492353 for PILÃO, granted on March 7, 2012;
- Brazil trademark registration No. 826405525 for "PILÃO" (design), registered on August 14, 2007.

The Complainants also own domain names consisting of "pilao", including the domain names <cafepilao.com.br>, registered on June 25, 2001, and <pilao.com.br>, registered on April 2, 2009. The Complainant has provided evidence in support of the above.

The disputed domain name <quiz-pilao.online> was registered on July 25, 2024, and the disputed domain names <pilaoquiz.site>, <quizpilao.site>, <quiz-cafepilao.site> and <quiz-pilao.shop> were registered on July 26, 2024.

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.

Notably, the Complainant states that the disputed domain names are confusingly similar to its trademark PILÃO.

Indeed, all disputed domain names incorporate the PILÃO Trademark in its entirety, to which the Respondent has added the generic and/or descriptive term "quiz". Therefore, all disputed domain names are a variation of the mark PILÃO together with the word "quiz", sometimes with the addition of the generic term "site" or the word "cafe", which is Portuguese for "coffee".

The Complainants argue that the disputed domain names are under common control and thus addresses the Respondent in the singular. The Complainants assert that the Respondent has no rights or legitimate

interests in respect of the disputed domain names since it has not been authorized by the Complainants to register the disputed domain names or to use its trademark within the disputed domain names, it is not commonly known by the disputed domain names and it is not making either a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names.

Before starting this Complaint, the Complainants tried to contact the Respondent in an attempt to settle the matter. As the contact details were under a privacy shield, the Registrar informed the Complainants that it would be able to find the contact information of the Registrant in question via a determined website. Nevertheless, the Respondent never responded to these letters.

The disputed domain names were registered between July 25 and 26, 2024 and are currently inactive. However, there is evidence that the Respondent activated mail exchange records for the disputed domain names.

In sum, the Complainants allege that the registration and use of the disputed domain names is intentional to mislead Internet users, that it is clear that the Respondent has no rights or legitimate interests in the disputed domain names, and that the disputed domain names were registered and are being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1. Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition \("WIPO Overview 3.0"\)](#), section 4.11.2.

As regards common control, the Panel notes that the Complainants filed an amended Complaint on September 19, 2024, demonstrating that the registrants are in fact the same entity and/or that all domain names are under common control, noting the registration dates, composition of the disputed domain names, and other factors.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

6.2. Substantive Issues

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

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 3.0](#), section 1.7.

The disputed domain names are confusingly similar to the PILÃO trademark, as such mark is entirely incorporated in all of the disputed domain names.

The Complainant has presented evidence of ownership of the trademark PILÃO, as well as of its renown.

In each of the disputed domain names, the mark is easily recognizable, despite the addition of other terms, such as "quiz" and "cafe".

In any event, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element. [WIPO Overview 3.0](#), section 1.8.

It is also well established that the generic Top-Level Domain ("gTLD"), such as ".online", ".site", and ".shop", may be disregarded in the assessment of the confusing similarity between the disputed domain name and the Complainant's mark. [WIPO Overview 3.0](#), section 1.11.1.

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

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 Panel understands that the mark PILÃO is naturally associated with the Complainants, since it is not only registered as a mark in its name, but also has been used to identify the products by the Complainants for decades in Brazil.

Hence, the Panel considers that the Respondent, in all likelihood, could not be unaware of the mark PILÃO, and its direct relation to the Complainants – particularly considering that the Complainants and the Respondent are based in Brazil.

The Respondent has not submitted a response to the Complaint. Also, there is no evidence that the Respondent has any authorization to use the Complainant's trademark or to register domain names containing the Complainants' trademark PILÃO, nor evidence that the Respondent is commonly known by the disputed domain names.

Besides, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names.

The Complainants have not authorized the Respondent to use its mark PILÃO or register domain names incorporating the mark. Additionally, there is no evidence that the Respondent is commonly known by the disputed domain names or has made a bona fide or noncommercial fair use of any of the disputed domain names.

The Panel further notes that the disputed domain names do not resolve to active websites.

The Panel is satisfied that the Complainants have made a prima facie case of the Respondent's lack of rights or legitimate interests in the disputed domain names. This has not been rebutted by the Respondent.

Thus, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain names. For this reason, the Panel believes that the Complainants have satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

It is clear to the Panel that the Respondent has registered the disputed domain names with the purpose of taking unfair advantage of the Complainants' mark.

The Panel finds that the disputed domain names were likely registered to mislead consumers, noting the composition of the disputed domain names and the reputation of the Complainant's trademark PILÃO in Brazil.

The disputed domain names resolved to inactive webpages. The non-use of some of the disputed domain names does not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Moreover, the activation of MX records in these circumstances, carries a risk that the confusingly similar disputed domain names may be used for fraudulent purposes.

All the points above, including the lack of any response or objection to the Complainant's serious contentions regarding fraud risk, lead to the conclusion by this Panel that the Respondent was fully aware of the Complainants when registering the disputed domain names and that the Respondent registered and is using the disputed domain names in bad faith.

The Panel finds that the Complainants have also 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, <pilaoquiz.site>, <quiz-cafepilao.site>, <quiz-pilao.online>, <quiz-pilao.shop>, and <quizpilao.site>, be transferred to the Complainant.

/Alvaro Loureiro Oliveira/

Alvaro Loureiro Oliveira

Sole Panelist

Date: October 31, 2024