

ADMINISTRATIVE PANEL DECISION

Pingo Doce - Distribuição Alimentar S.A. v. Lucas Parker, Lojas Caxiense
Case No. DEU2022-0029

1. The Parties

The Complainant is Pingo Doce - Distribuição Alimentar S.A., Portugal, represented by Meisser & Partners AG, Switzerland.

The Respondent is Lucas Parker, Lojas Caxiense, Austria.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <pingodoce.eu> is the European Registry for Internet Domains ("EURid" or the "Registry"). The Registrar of the disputed domain name is GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 29, 2022. On August 29, 2022, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On September 2, 2022, the Registry 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on September 9, 2022, providing the registrant and contact information disclosed by the Registry, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on September 9, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the "ADR Rules") and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the "Supplemental Rules").

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 16, 2022. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was October 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on.

The Center appointed Edoardo Fano as the sole panelist in this matter on November 7, 2022. 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 ADR Rules, Paragraph B(5).

The language of the proceeding is English, being the language of the Registration Agreement, as per Paragraph A(3)(a) of the ADR Rules.

4. Factual Background

The Complainant is a Portuguese supermarket chain owning several trademark registrations for PINGO DOCE, among which the following ones:

- International Trademark registration designating the European Union Registration No. 1023949 for PINGO DOCE, registered on September 4, 2009;
- Portuguese Trademark Registration No. 429492 for PINGO DOCE and design, registered on June 2, 2008.

The Complainant provided evidence in support of the above.

The disputed domain name was registered by the Respondent on March 27, 2022, and it resolves to a Registrar's webpage in which the disputed domain name is offered for sale. However, the Complainant was able to provide evidence that prior to the Complaint the website at the disputed domain name was referring to the Complainant by reproducing the Complainant's trademark and design.

On April 28, 2022, the Complainant's legal representatives sent a cease-and desist letter to the Respondent, to which the Respondent replied on June 8, 2022, stating to be willing to receive an offer for the disputed domain name. On June 9, 2022, the Complainant's legal representatives wrote to the Respondent offering to pay the out-of-pocket costs for the transfer of the disputed domain name. The Respondent did not reply and on August 29, 2022, the disputed domain name was offered for sale in the Registrar's webpage at GBP 18,356.00.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is identical to its trademark PINGO DOCE, as the disputed domain name entirely incorporates the Complainant's trademark.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since the latter resolved to a website referring to the Complainant by reproducing the Complainant's trademark and design.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademark PINGO DOCE is distinctive and known. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain name and it is using it primarily for attracting Internet users, for commercial gain, by creating a likelihood of confusion with the Complainant's services and, upon the correspondence between the parties, for the purpose of selling it to the Complainant.

B. Respondent

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

6. Discussion and Findings

As stated in paragraph A(1) of the ADR Rules “[the] ADR Rules are applicable to domain name disputes where the domain name has been registered under the .eu Top Level Domain”.

In order to succeed in its Complaint, the Complainant is required under Paragraph B(11)(d)(1) of the ADR Rules to demonstrate the following:

(i) that the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national law of a Member State and/or European Union law; and either

(ii) that the disputed domain name has been registered by the Respondent without rights or legitimate interests in the name; or

(iii) that the disputed domain name has been registered or is being used in bad faith.

(i) Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

The Panel finds that the Complainant is the owner of the European Union Trade Mark PINGO DOCE and that the disputed domain name is identical to the trademark PINGO DOCE.

It is well established in decisions under the ADR Rules that the country-code Top-Level Domain (“ccTLD”) “.eu” is typically ignored when assessing the similarity between a trademark and a domain name.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is identical to the Complainant’s trademark, pursuant to Paragraph B(11)(d)(1)(i) of the ADR Rules.

(ii) Rights or Legitimate Interests

The Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the disputed domain name was used for a website referring to the Complainant by reproducing the Complainant’s trademark and design.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain name, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

The Panel could not find any evidence by referring to the examples listed in Paragraph B(11)(e) of the ADR Rules that:

(i) prior to commencing this proceeding the Respondent has used the disputed domain name in connection with the offering of goods or services or has made demonstrable preparations to do so; or that

(ii) the Respondent as an undertaking, organization or natural person has been commonly known by the disputed domain name; or that

(iii) the Respondent is making a legitimate and noncommercial or fair use of the disputed domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or European Union law.

On the contrary, the use of the disputed domain name for a website in which the Complainant’s trademark and design is reproduced is likely to create confusion with the Complainant’s trademark as to the disputed

domain name's source, sponsorship, affiliation or endorsement.

The Panel therefore finds that Paragraph B(11)(d)(1)(ii) of the ADR Rules has been satisfied.

(iii) Registered or Used in Bad Faith

According to Article 21(1) of the Regulation and Paragraph B(11)(d)(1) of the ADR Rules (ii) lack of rights or legitimate interests and (iii) registration or use in bad faith are alternative requirements. The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name and therefore there is no need to consider also the bad faith element.

In any case, the Panel finds that the use of the disputed domain name as described above is an evidence of bad faith registration and use, pursuant to Paragraph B(11)(d)(1)(iii) of the ADR Rules.

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name <pingodoce.eu> be transferred to the Complainant.¹

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: November 8, 2022

¹ As the Complainant Pingo Doce - Distribuição Alimentar S.A. is located in Portugal, a Member State of the European Union, it satisfies the general eligibility criteria for registration of the disputed domain name set out in Article 3 of Regulation (EU) 2019/517. Therefore, the Complainant is entitled to request the transfer of the disputed domain name.