

ADMINISTRATIVE PANEL DECISION

Asia Consulting Development Ltd. v. Domain Admin, Whois protection, this company does not own this domain name s.r.o / John Obeye, Domain may be for Sale, Check afternic.com
Case No. D2022-0478

1. The Parties

The Complainant is Asia Consulting Development Ltd., Colombia, represented by Serna Abogados, Colombia.

The Respondent is Domain Admin, Whois protection, this company does not own this domain name s.r.o, Czech Republic / John Obeye, Domain may be for Sale, Check afternic.com, Czech Republic.

2. The Domain Name and Registrar

The disputed domain name <negociosleonisa.com> (the “Disputed Domain Name”) is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 10, 2022. On February 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 17, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 17, 2022, 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 February 18, 2022. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on February 28, 2022.

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 March 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 23, 2022.

The Center appointed Nick J. Gardner as the sole panelist in this matter on March 29, 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 Rules, paragraph 7.

On April 20, 2022, the Panel issued a first Procedural Order (the "First Procedural Order") the substantive parts of which read as follows:

Background

The Panel has reviewed the Complaint and the amendments to the Complaint. It appears to the Panel that a number of queries or inconsistencies arise in relation to the following areas.

Domain Names/Respondent Identity

The Complaint as originally filed identified Gransy s.r.o. as the Respondent. The Panel is not clear as to why that was the case given that Gransy s.r.o. is the Registrar of the Disputed Domain Name. The Panel notes the Complainant has identified regtons.com as the relevant Registrar but it appears to the Panel that this is merely a trading name used in relation to the Internet presence of Gransy s.r.o.

The Registrar subsequently identified the Registrant of the Disputed Domain Name as John Obeye and the Registrant organisation as Domain may be for Sale, Check afternic.com. The Complainant filed an amendment to the Complaint which, as the Panel understands it, sought to add John Obeye as an additional Respondent but in respect of a different domain name, namely <negosiosleonisa.com> [note the different spelling]. The amendment appears to maintain the case against Grancy s.r.o. as the Respondent in relation to the Disputed Domain Name.

The amendment also contained screen captures of webpages which appear to show three further domain names available for sale namely <negosioleonisa.com>, <negosioleonisacom.com> and <negocioleonisa.com.co>. The amendment does not explain the relevance of these further domain names. The Panel also notes the Complaint also refers at section VI(B) to another domain name <negocioleonisa.com> but the Panel has been unable to follow what the Complainant says is the relevance of this domain name.

Trade Mark Registrations

The Complainant has exhibited a number of trade mark registrations it relies upon. However not all of these are in the name of the Complainant. Some are in the name of Confecciones Leonisa SA, and one is in the name of Leonisa SA. The relationship between these companies and the Complainant has not been explained.

Bad Faith Issues

The Panel has found it difficult to follow the Complainant's present case on bad faith issues which appears to relate to issues concerning the Registrar rather than the registrant, and which appears to take no account of the nature of the webpage to which the Disputed Domain Name resolves.

Procedural Order

The Panel directs that on or before April 30, 2022 the Complainant clarify its case in terms of which domain names are the subject of the Complaint and who it says the relevant Respondent is in respect of each such

domain name. If so advised the Complainant may choose to proceed by way of a further amendment to the Complaint in the present administrative proceeding (to be filed on or before April 30, 2022) or commencing additional administrative proceedings in respect of any domain name not currently the subject of the present proceeding (to be filed at any later date of the Complainant's choosing). The Complainant's attention is drawn to the provisions of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (available on WIPO's website) at sections 4.11 and 4.12 as to relevant factors to be considered in determining how to proceed. If the Complainant seeks to add additional domain names to the present Complaint the Center shall seek appropriate registrar verification details in respect of such domain names. If such verification identifies registrant details that differ from those alleged by the Complainant then the Complainant shall be offered the opportunity to further amend its Complaint and shall be allowed a further seven days to do so.

The Panel also directs that on or before April 30, 2022 the Complainant explain more clearly (1) the nature of the Complainant's business and the connections between the Complainant and Confecciones Leonisa SA, and Leonisa SA.; and (2) its case on bad faith in relation to all relevant Respondents.

Any Respondent identified by the Complainant in any further filing shall be entitled to file a response to the Complainant's filing in reply to this Procedural Order. In this regard, the Panel will issue a second procedural order providing further instructions, and giving any Respondent identified by the Complainant a period for the submission of such response.

The Panel will communicate to the Parties the new due date to render its decision in due course. The Panel reserves the right to amend any of the above dates or time limits as necessary and to give further directions as appropriate".

On May 3, 2022, the Complainant lodged further submissions pursuant to the First Procedural Order. The relevant information in these submissions is set out in the remainder of this decision. The Panel also treats them as amending the Complaint in relation to questions of respondent identity and the domain name in issue.

On May 4, 2022, the Panel issued a second Procedural Order (the "Second Procedural Order") the substantive parts of which read as follows:

"Pursuant to its general powers under UDRP Rules Paragraphs 10 and 12 Panel issues the following Order to the Respondent.

The Respondent is given until May 11, 2022, to submit any filing in relation to the Complainant's filing on April 29, 2022.

The due date for the decision is extended to May 13, 2022".

No further submission was filed by the Respondent.

4. Factual Background

The relevant facts as set out in the Complaint and clarified by the Complainant's submissions pursuant to the First Procedural Order are as follows.

A company called CONFECCIONES LEONISA SA was incorporated in Columbia in 1956. In 2008, it changed its name to LEONISA S.A. In 2012 it was merged by operation of law into a company which subsequently changed its name to SOCIEDAD DE COMERCIALIZACION INTERNACIONAL LEONISA S.A. - C.I LEONISA S.A. and then again changed its name in 2017 to SOCIEDAD DE INTERNACIONAL GIRDLE & LINGERIES.A.S. - C.I. G&LINGERIE S.A.S. That company subsequently assigned all its trademarks to the Complainant ASIA CONSULTING DEVELOPMENT LTD which is a company incorporated in the British

Virgin Islands, United Kingdom.

In accordance with the position noted in paragraph 4.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the Panel has performed limited factual research to assist it in further clarifying matters relied upon by the Complainant.

As the Panel understands it all of the above companies are in effect under common ownership or control and are involved in the manufacture and sale of lingerie under the brand name LEONISA.

The Complainant owns a number of registered trademarks for LEONISA in various jurisdictions throughout the world including in a number of South American countries – see for example Bolivian trademark 94016A registered on January 24, 2015. These trademarks are referred to in this decision as the LEONISA trademarks.

The Disputed Domain Name was registered on April 19, 2017. The Panel's research indicates it resolves to a website which contains pay-per-click ("PPC") links which appear likely to be automatically generated.

There is no evidence that the term LEONISA has any meaning save in relation to the Complainant and its associated companies and their lingerie products.

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarized as follows.

The Disputed Domain Name is identical or confusingly similar to the Complainant's LEONISA trademark. It says the word "negocios" is a generic expression of a general activity, but does not explain what the word means – the Panel's own enquiries indicate it is the Spanish word for "business".

The Respondent has no rights or legitimate interests in the term "leonisa".

The Disputed Domain Name was registered and is being used in bad faith. The Complainant's case is expressed as follows:

"What circumstances serve as proof that a domain name has been registered and is being used in bad faith?"

Paragraph 4.b of the UDRP provides the following examples of circumstances that the administrative group of experts has considered evidence of bad faith registration and use of a domain name:

i) Circumstances indicating that the domain name has been registered or acquired primarily for the purpose of selling, renting, or otherwise assigning the domain name registration to the plaintiff, who is the owner of the trademark or to a competitor of that claimant for a certain value that exceeds the various costs that are directly related to the domain name;

In view of the above, in this case it appears that the registrar reported on February 17, 2022 that the domain NEGOCIOSLEONISA.COM registered by John Obeye through his organization, appeared as: "DOMAIN MAY BE FOR SALE", a fact that fits precisely in the aforementioned circumstance.

Additionally, and based on the foregoing, it can be affirmed that it is possible to apply literal iii) consisting of having registered the domain name fundamentally in order to disrupt the commercial activity of the owner of the trademark. Proof of this can be seen by the panel when it opens the defendant's website with the domain NEGOCIOSLEONISA.COM

But it can also be stated that the use made by the defendant has ‘intentionally attempted to attract, for profit, Internet users to his own site or any other online site, creating the possibility of confusion with the trademark of the plaintiff, with its own web page or with the products or services that appear on the owner’s website, which is the case contained in literal 4 of the policy”.

A. Respondent

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

6. Discussion and Findings

Preliminary Matters

The Panel notes that no communication has been received from the Respondent. However, given that the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent’s failure to file any Response. While the Respondent’s failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent’s default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has rights in the LEONISA trademark. The Panel finds the Disputed Domain Name is confusingly similar to this trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “[...] when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is the distinctive part of a disputed domain name, the disputed domain name is considered to be confusingly similar to the registered mark (*DHL Operations B.V. v. DHL Packers*, WIPO Case No. [D2008-1694](#)).

It is also established that the addition of a term (such as here “negocios” meaning in English “business”) to a domain name does not prevent a finding of confusing similarity under the first element (*PRL USA Holdings, Inc. v. Spiral Matrix*, WIPO Case No. [D2006-0189](#)).

It is also well established that the generic Top-Level Domain (“gTLD”), in this case “.com”, does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

Accordingly, the Panel finds that the Disputed Domain Name is identical to the Complainant's trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

(i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the LEONISA trademark. The Complainant has prior rights in the LEONISA trademark, which precede the registration of the Disputed Domain Name. The Complainant has therefore established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); and *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish his rights or legitimate interests in the Disputed Domain Name. Accordingly, the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Panel concludes that paragraph 4(b)(iv) of the Policy applies here, as the Disputed Domain Name is likely to attract Internet traffic because of confusion with the Complainant's mark, and presumably either the Respondent, or some other party, derives commercial gain as a result. The website linked to the Disputed Domain Name comprises a series of PPC links to other third-party websites. The Panel infers that some consumers, once at this website will follow the provided links and "click through" to other sites which offer products some of which may compete with those of the Complainant. The Respondent presumably earns "click-through" linking revenue as a result. The Panel infers the website is automatically generated. This does not however matter. It is well established that where a domain name is used to generate revenue in respect of "click-through" traffic, and that traffic has been attracted because of the domain name's association with the Complainant's trademark, such use amounts to use in bad faith, see for example *Shangri-La International Hotel Management Limited v. NetIncome Ventures Inc.*, WIPO Case No. [D2006-1315](#); *Owens Corning v. NA*, WIPO Case No. [D2007-1143](#); *McDonald's Corporation v. ZusCom*, WIPO Case No. [D2007-1353](#); *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. [D2007-1912](#); and *Rolex Watch U.S.A., Inc. v. Vadim Krivitsky*, WIPO Case No. [D2008-0396](#).

See also [WIPO Overview 3.0](#) section 3.5:

"Can third-party generated material 'automatically' appearing on the website associated with a domain name form a basis for finding bad faith?"

Particularly with respect to 'automatically' generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links *ipso facto* vest the respondent with rights or legitimate interests).

Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith."

Moreover, the Panel notes that the Complainant's trademark LEONISA is distinctive and predates the registration of the Disputed Domain Name. In the circumstances of this case, the Panel finds that the Respondent most likely knew of the Complainant's trademark and registered the Disputed Domain Name in order to take unfair advantage of the Complainant's trademark.

Accordingly, the Panel finds the Respondent has registered and used the Disputed Domain Name in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 <negociosleonisa.com> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: May 13, 2022