

ADMINISTRATIVE PANEL DECISION

Estafeta Mexicana, S.A. de C.V. v. Registration Private /
Domains By Proxy, LLC / Chad Moston, Elite Media Group
Case No. D2022-3132

1. The Parties

The Complainant is Estafeta Mexicana, S.A. de C.V., Mexico, represented by Olivares & Cia, Mexico.

The Respondent is Chad Moston, Elite Media Group, USA¹.

2. The Domain Name and Registrar

The disputed domain name <estafetalo.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 24, 2022. On August 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 26, 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 August 26, 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 amended Complaint on August 31, 2022.

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”).

¹ At the time of filing the Complaint, the relevant Whois information showed a privacy service, “Registration Private, Domains By Proxy, LLC”; the Complainant filed an amended Complaint to add the Registrar confirmed underlying registrant, “Chad Moston, Elite Media Group, USA”. In the present circumstances, the Panel considers the Registrar-confirmed underlying registrant details of the disputed domain name to constitute the concerned Respondent at issue.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 21, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on September 27, 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.

4. Factual Background

The Complainant is the holder of the following trademarks:

Mexican trademark registrations number 529108 ESTAFETALO in International class 39, and number 2141226 ESTAFETALO (and Design) in International class 39, both covering services related to the packaging delivery industry. These registrations were granted respectively on August 26, 1996, and September 17, 2020.

The disputed domain name was registered on December 3, 2020.

5. Parties' Contentions

A. Complainant

The Complainant is one the leading packaging delivery companies in Mexico, with presence all around the world for more than 50 years through the ESTAFETA, ESTAFETA (and Design) and ESTAFETALO registered trademarks.

The disputed domain name is identical to the registered trademarks property of the Complainant, being the case that both are comprised of the term "estafetalo".

The Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name. There is no evidence of the Respondent's 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.

The disputed domain name currently resolves to a pay-per click page, containing a link which states: "buy this domain name" or in Spanish "comprar este dominio". This link resolves to the Registrar's website stating that the disputed domain was a premium domain name for sale allowing the possibility of auctioning the same at prices that far exceeds the Respondent's reasonable out-of-pocket expenses in connection with the original acquisition of the domain name.

The Complainant asserts that the Respondent must have been aware of the Complainant's trademark as the well-known ESTAFETALO mark has been in use for more than 20 years and the first registration of the trademark dates back to 1996.

The Complainant considers that the evidence establishes the purpose of the Respondent registering the disputed domain name was to sell it to the Complainant and that the price for the domain name far exceeded the Respondent's out of pocket expenses. Thus, the disputed domain name was registered and used in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in previous UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

- (i) the disputed domain name is identical 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; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has provided evidence of its rights in the trademarks ESTAFETALO on the basis of its multiple trademark registrations in Mexico. A trademark registration provides a clear indication that the rights in the trademark belong to the complainant (see section 1.2.1, of the [WIPO Overview 3.0](#)).

The disputed domain name incorporates the Complainant's mark in full. The Panel finds that the disputed domain name is identical to the Complainant's ESTAFETALO marks. The generic Top-Level Domain ("gTLD"), ".com", is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test..

The Panel is satisfied that the disputed domain name is identical to the Complainant's mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent, will lead to this ground being set forth.

Refraining from submitting any Response, the Respondent has brought to the Panel's attention no circumstances from which the Panel could infer that the Respondent has rights to or legitimate interests in the disputed domain name. The Panel will now examine the Complainant's arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain name. The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademarks in a domain name or in any other manner.

Furthermore, the disputed domain name has a link on top of the webpage redirecting Internet users to websites with sponsored links as well as to resolve to websites that state that the disputed domain name may be for sale, displaying a telephone number through which interested users may inquire about their purchase, without any disclaimer as to the relation with or authorization of the Complainant, exacerbating the user confusion as to the website's affiliation to the Complainant. Such use for deliberately attracting Internet users to its website in the mistaken belief that it is a website of the Complainant, or otherwise linked to or authorized by the Complainant supports a finding that the Respondent lacks rights to or legitimate interests in the disputed domain names.

In addition, the Panel finds that the disputed domain name carries a high risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Lastly, prior UDRP panels have held that the use of a complainant's mark to redirect users (*e.g.*, *vis-à-vis* the pay-per click links exhibited on the disputed domain name redirecting users to third-party commercial sites) would not support a claim to rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.5.3. Moreover, in the instance of this proceeding, some of the links (*e.g.*, "International Freight Shipping Quote" and "Same Day Delivery Courier Service") resolve Internet users to courier deals in direct competition with Complainant, illustrating the intent of Respondent to use the disputed domain name to capitalize on the reputation and goodwill associated with Complainant's trademark.

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b). The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith: (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location.

In the Panel's view, a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name. In this case, the Complainant submits that at the date of registration of the disputed domain name the Respondent would have had constructive, if not actual knowledge of the Complainant's mark ESTAFETALO. Furthermore, the disputed domain name redirects users to websites with sponsored links as well as to resolve to websites that state that the disputed domain name may be for sale, displaying an auction for a price that, more likely than

not, far exceeds the Respondent's reasonable out-of-pocket expenses in connection with the original acquisition of the domain name, without any disclaimer as to the relation with or authorization of the Complainant, exacerbating the user confusion as to the website's affiliation to the Complainant as well as the Respondent's bad faith.

The Complainant has alleged forcefully that the Respondent registered the disputed domain name in the manner of bad faith registration and use illustrated by paragraph 4(b)(i) of the Policy. Despite receiving such serious allegations, the Respondent has chosen to remain inexplicably silent.

Having regard to the circumstances, in particular the actual offer for sale of the disputed domain name in excess of likely out-of-pocket costs of registering it, and the Respondent's likely knowledge of the Complainant or the ESTAFETALO trademark when registering the disputed domain name, the Panel is satisfied that the Respondent must have registered the disputed domain name primarily for the purpose of selling them in the manner outlined in paragraph 4(b)(i) of the Policy.

The Panel accordingly finds the third limb of paragraph 4(a) established on the facts.

Consequently, the Panel finds that the disputed domain name was registered and used by the Respondent in bad faith within paragraph 4(a)(iii) 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, <estafetalo.com>, be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: October 11, 2022