

ADMINISTRATIVE PANEL DECISION

YPF S.A. v. Gaston Chaves

Case No. D2022-3238

1. The Parties

The Complainant is YPF S.A., Argentina, represented by Berken IP, Argentina.

The Respondent is Gaston Chaves, Uruguay.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 31, 2022. On September 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 1, 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 September 9, 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 September 14, 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 11, 2022.

The Center appointed Luca Barbero as the sole panelist in this matter on November 3, 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 an Argentine energy company founded in 1922, and dedicated to the exploration, exploitation, distillation, distribution and production of electric energy, gas, oil and hydrocarbon derivatives and the commercialization of fuel, lubricants, fertilizers, agriculture, plastics and other products and services related to the industry.

The Complainant provides its products and services in more than 1500 service stations distributed all across Argentina.

The Complainant runs a loyalty program named “Serviclub”, that rewards its members with exclusive benefits and products in a variety of areas, such as tourism, entertainment, and shopping, among others.

The Complainant is the owner, amongst others, of the following trademark registrations including the term “Serviclub”:

- Argentina trademark registration No. 2804519 for SERVICLUB (figurative mark), first filed on July 2, 1999, and registered on November 27, 2000, in class 16;
- Argentina trademark registration No. 2804520 for SERVICLUB (figurative mark), first filed on July 2, 1999, and registered on November 27, 2000, in class 35;
- Argentina trademark registration No. 2804521 for SERVICLUB (figurative mark), first filed on July 2, 1999, and registered on November 27, 2000, in class 36;
- Argentina trademark registration No. 2894869 for SERVICLUB YPF (word mark), first filed on September 7, 1994, and registered on May 8, 1996, in class 16;
- Argentina trademark registration No. 2894630 for SERVICLUB YPF (word mark), first filed on September 7, 1994, and registered on May 8, 1996, in class 35;
- Argentina trademark registration No. 2894629 for SERVICLUB YPF (word mark), first filed on September 7, 1994, and registered on May 8, 1996, in class 36;
- Argentina trademark registration No. 2894628 for SERVICLUB YPF (word mark), first filed on September 7, 1994, and registered on May 8, 1996, in class 41;
- Argentina trademark registration No. 2807795 for SERVICLUB YPF (word mark), first filed on September 7, 1994, and registered on May 31, 1995, in class 42.

The Complainant is also the owner of the domain name <serviclub.com.ar>, registered on October 14, 1998 and used by the Complainant to promote its Serviclub loyalty program and offer products and services under the trademarks SERVICLUB and SERVICLUB YPF.

The disputed domain name <serviclubargentina.com> was registered on September 24, 2019 and is pointed to a website displaying the Complainant’s trademark, providing information about the Complainant’s loyalty program.

5. Parties’ Contentions

A. Complainant

The Complainant contends that disputed domain name is confusingly similar to the trademark SERVICLUB in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the geographical term “Argentina” and the generic Top-Level Domain “.com”.

The Complainant points out that the use of a geographical reference in the disputed domain name only serves to further exacerbate the association with the Complainant since the Complainant is based in Argentina.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent is not commonly known by the disputed domain name, is in no way affiliated with the Complainant and has not been authorized to register or use the disputed domain name in any way.

The Complainant further states that the Respondent purposely intended to mislead consumers by deceiving them into assuming that the disputed domain name and the correspondent website belong to the Complainant.

With reference to the circumstances evidencing bad faith, the Complainant highlights that the Respondent not only used the Complainant's trademark in the disputed domain name but also published information on the Complainant's well-known Serviclub program.

The Complainant also notes that the website at the disputed domain name includes a link to the Complainant's official website at <serviclub.com.ar>.

Moreover, the Complainant underlines that the disputed domain name also contains a "comments" section, where users, who are led to believe the website is associated to the Complainant, can ask questions and leave comments. The Complainant points out however, that in some cases they receive no response whilst in other cases the responses received appear to come directly from the Complainant.

The Complainant thus contends that consumers can easily be misled into believing that the website belongs to the Complainant, and consequently could be disappointed when receiving no answer to their doubts or even incorrect answers, especially where the Complainant cannot guarantee that the content of the website is correct or up to date.

The Complainant also add that at the bottom of the website at the disputed domain name the following legal notice is displayed: "Copyright © 2022 2022 YPF SERVICLUB ARGENTINA".

The Complainant concludes that, from the content of the website to which the disputed domain name resolves, there are no doubts that the Respondent knew of the Complainant and its trademark at the time of registering the disputed domain name and submits that, consequently, 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

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint 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." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademarks SERVICLUB and SERVICLUB YPF based on the trademark registrations cited under section 4 above.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between a complainant's trademark and the disputed domain name to assess whether the trademark is recognizable within the disputed domain name (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Moreover, as found in a number of prior cases decided under the Policy and indicated in section 1.8 of the [WIPO Overview 3.0](#), where a trademark is recognizable within a domain name, the addition of generic, descriptive or geographical terms does not prevent a finding of confusing similarity under the first element. Furthermore, the Top-Level Domain is commonly disregarded under the first element confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#)).

In the case at hand, the Complainant's trademark, consisting of the term "Serviclub", is entirely reproduced, and clearly recognizable, in the disputed domain name. The mere addition of the geographical term "Argentina" is not sufficient to prevent a finding of confusing similarity.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent's rights or legitimate interests in respect of the domain name according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the complainant show a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production on the respondent. If the respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not having submitted a Response, has failed to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy. Moreover, it has been repeatedly stated that when a respondent does not avail himself of its right to respond to a complaint, it can be assumed in appropriate circumstances that the respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, there is no indication before the Panel that the Respondent is commonly known by the disputed domain name or a name corresponding to the disputed domain name.

The Panel also notes that the website at the disputed domain name includes a disclaimer, in which it is established that the website is not an official channel of the company YPF and that the mission is to inform about the benefits to its partners. However, the Panel finds that the fact that the disclaimer is not prominent and the information appears to come from the Complainant creates a risk of confusion. The fact that the website at the disputed domain name includes links to the Complainant's official website at <serviclub.com.ar> reinforces such finding.

In addition, the composition of the disputed domain name, comprising the Complainant's trademark with the addition of the term "Argentina" carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

The Panel finds that, i) in light of the prior registration and use of the trademarks SERVICLUB and SERVICLUB YPF in connection with the Complainant's loyalty program and the related products and services, also online via the Complainant's official website "www.serviclub.com.ar", and ii) considering that the disputed domain name incorporates the Complainant's trademark with the addition of the geographical term "Argentina", where the Complainant is located and operates, the Respondent was more likely than not aware of the Complainant's trademark at the time of the registration of the disputed domain name.

Furthermore, the circumstance that the disputed domain name has been pointed to a website featuring the Complainant's trademark and publishing information regarding the Complainant's loyalty program with direct links to the Complainant's official website, demonstrates that the Respondent was indeed well aware of the Complainant and its trademark.

The disputed domain name contains the heading "YPF Serviclub Argentina" that provides information on the Complainant's Serviclub loyalty program. Although the disputed domain name includes a notice stating that the mission is to inform the users about the Complainant's Serviclub loyalty program and it is not related to the Complainant's official channel, the overall circumstances of this case point to the Respondent's bad faith and the mere existence of a disclaimer cannot cure such bad faith. The disputed domain name adds the term "Argentina" to the Complainant's mark and creates a risk of confusion because of the legal notice at the bottom of the website "Copyright © 2022 YPF SERVICLUB ARGENTINA". See section 3.7 of [WIPO Overview 3.0](#) and *YPF S.A. v. Christian Sarapa, Chrisos*, WIPO Case No. [D2019-1775](#).

The Panel also finds that the Respondent's use of the disputed domain name in connection with a website providing information and links to the Complainant's products services creates a risk of confusion with the Complainant and its trademarks.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to 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 <serviclubargentina.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: December 7, 2022