

ADMINISTRATIVE PANEL DECISION

Arezzo Indústria e Comércio S.A. v. Daniel Santos
Case No. D2022-4198

1. The Parties

The Complainant is Arezzo Indústria e Comércio S.A., Brazil, represented by Baril Advogados Associados, Brazil.

The Respondent is Daniel Santos, Brazil.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 4, 2022. On November 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 8, 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 (Registration Private) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 11, 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 November 17, 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 November 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 12, 2022. The Respondent sent an informal communication to the Center on November 22, 2022. On November 22, 2022, the Center sent the Parties a Possible Settlement email. On December 13, 2022, the Center notified the Parties of the Commencement of Panel Appointment Process.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on December 16, 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 a leading leather products manufacturer in Brazil, founded in 1972, counting with more than 700 stores and present in all 27 Brazilian states.

The Complainant holds trademarks, including AREZZO, SCHUTZ, ANACAPRI, ALEXANDRE BIRMAN, MYSHOES, CAROL BASSI as well as AREZZO & CO. It is the owner, amongst others, of the following trademark registrations:

- Brazilian registration No. 903251710 for the word mark AREZZO & CO., filed on December 24, 2010, registered on June 17, 2014 in class NCL(9) 18;
- Brazilian registration No. 903251728 for the word mark AREZZO & CO., filed on December 24, 2010, registered on June 17, 2014 in class NCL(9) 25;
- Brazilian registration No. 903264188 for the word mark AREZZO E CO., filed on January 4, 2011, registered on June 17, 2014 in class NCL(9) 18;
- Brazilian registration No. 903264269 for the word mark AREZZO E CO., filed on January 4, 2011, registered on June 17, 2014 in class NCL(9) 25;
- Brazilian registration No. 903264404 for the word mark AREZZO E CO., filed on January 4, 2011, registered on June 17, 2014 in class NCL(9) 35;
- Brazilian registration No. 903264455 for the word mark AREZZO AND CO., filed on January 4, 2011, registered on June 17, 2014 in class NCL(9) 18; and
- Brazilian registration No. 903264498 for the word mark AREZZO AND CO., filed on January 4, 2011, registered on June 17, 2014 in class NCL(9) 25.

The disputed domain name <arezzoco.com> was registered on July 18, 2022, and currently resolves to a blank page whose header reads "For Sale". In the past it has been used in connection with a pornographic website (Annex 9 to the Amended Complaint).

5. Parties' Contentions

A. Complainant

The Complainant asserts to have been founded in 1972 by the brothers Anderson and Jefferson Birman, having become a leader in the footwear, bags and female accessories sectors in Brazil and enjoying an excellent reputation before customers and the market in general; manufacturing 15 million products each year and counting with 681 stores in Brazil and 13 stores in other countries.

The Complainant further asserts that the disputed domain name is confusingly similar with its AREZZO & CO trademark, prior domain name registration (for <arezzoco.com.br>, which is used to disclose information on franchises and services to investors) and tradename.

In addition to that, the Complainant argues that the disputed domain name was used in connection with a website broadcasting pornographic content which may cause serious damage to the Complainant's well-known trademark.

As to the Respondent's lack of rights or legitimate interests, the Complainant further contends that there is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or

services, neither that the Respondent has been commonly known by the disputed domain name, or, that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the trade name and the registered marks at issue.

Lastly, the Complainant alleges that the disputed domain name was registered and is being used in bad faith given the well-known status of the Complainant's AREZZO and AREZZO & CO. trademarks and the use of the disputed domain name in connection with a pornographic website.

B. Respondent

The Respondent sent an informal message to the Center on November 22, 2022, stating: “[h]ello, you can transfer the domain to the complainant, we dont want it anymore”

No further communication or formal reply was further submitted by the Respondent.

6. Discussion and Findings

Firstly, the Panel has to address the Respondent's acceptance as to the voluntary transfer of that disputed domain name without findings of fact or conclusions as to the merits of the case under the UDRP.

A panel may at its discretion order the transfer of the domain name if the respondent has given its unambiguous consent to transfer without findings under the Policy, paragraph 4(a). WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.10. Some panels have declined to grant a remedy solely on the basis of respondent's consent where the complainant objects or because the panel finds a broader interest in reaching a substantive determination.

In the present case, considering all the circumstances of the present case including the fact that the Complainant did not request the suspension of the proceeding to explore settlement options, the Panel will proceed to a decision on the merits, and analyze the three requisite elements under paragraph 4(a) of the Policy which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

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

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present so as to have the disputed domain name transferred to it according to paragraph 4(a) of the Policy.

A. Identical or Confusingly Similar

The Complainant has established rights in the AREZZO and AREZZO & CO. trademarks.

The disputed domain name reproduces the Complainant's AREZZO trademark entirely and a dominant feature of the AREZZO & CO. trademark. 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 the complainant's trademark and the disputed domain name”. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly

similar to that mark for purposes of the UDRP ([WIPO Overview 3.0](#), section 1.7).

The Panel therefore finds that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are

(i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed 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 (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or

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

In that sense, the Complainant indeed has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name which has been used in relation to the broadcasting of pornographic content and presently appears to be passively held and offered for sale.

Furthermore, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name, corroborate the Panel's finding of the absence of rights or legitimate interests.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found when "(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other 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 the Respondent's website or location".

In the present case, the Respondent's conduct, while having used the disputed domain name in connection with a website broadcasting pornographic content, created a likelihood of confusion with the Complainant's well-known mark and potential tarnishment of such relevant trademark.

Past UDRP panels have already dealt with the question of whether the "passive holding" of a domain name could constitute bad faith. Section 3.3 of the already quoted [WIPO Overview 3.0](#) states that "[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put".

In the present case, the present passive holding of the disputed domain name by the Respondent amounts to the Respondent acting in bad faith, given that the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name. In addition to that, it is not possible to conceive of any plausible actual or contemplated active use of the inherently misleading disputed domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

For the reasons stated above, the Respondent's conduct amounts, in this Panel's view, to bad faith registration and use of the disputed domain name.

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 <arezzoco.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: January 4, 2023