

ADMINISTRATIVE PANEL DECISION

Partage Empreendimentos e Participações S.A. v. Ha Nguyen **Case No. D2022-4995**

1. The Parties

The Complainant is Partage Empreendimentos e Participações S.A., Brazil, represented by L.O. Baptista Advogados, Brazil.

The Respondent is Ha Nguyen, Viet Nam.

2. The Domain Names and Registrar

The disputed domain names, <arapiracagardenshopping.com>, <partagecampina.com>, <partagenatal.com>, <partageparauapebas.com>, <partageshoppingbetim.com>, <partageshopping.com>, <pocosdecaldasshopping.com>, and <shopping3americas.com>, are registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 27, 2022. On December 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 29, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 January 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 30, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on February 6, 2023. 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

According to the Complaint, the Complainant is the holding company of the Grupo Partage. The Grupo Partage is based in Brazil, where it engages in real estate and shopping mall development. The information in the Complaint is a bit confusing but it appears the Grupo Partage has 14 real estate developments in São Paulo with a total area of more than 500 million square meters. The Group's shopping arm also has 12 shopping malls located in major Brazilian cities, with another two being launched.

Nine of the shopping centers operate under names such as Partage Shopping Natal, Partage Shopping Parauebas, Partage Shopping Sao Gonçalo, Partage Shopping Campina Grande, Partage Shopping Betim. In addition, one of the shopping malls is called and marketed as Arapiraca Garden Shopping and another is Shopping 3 Américas.

The Grupo Partage operates a "master" website promoting its "shopping" businesses at <partageshopping.com.br>. The individual shopping malls also have associated websites associated with domain names registered in the .com.br domain space. For example, <partageshoppingbetim.com.br>, <partageshoppingarapiraca.com.br> and <partageshoppingpocos.com.br>. The Shopping 3 Americas mall, however, operates a website from <shopping3americas.com.br>.

The Complaint includes evidence that the Complainant, or members of its corporate group, own many registered trademarks in Brazil. For present purposes, it is sufficient to refer specifically to:

- (a) Brazilian registered trademark number 911372130, PARTAGE, which has been registered since July 24, 2018, in respect of services in International Class 35;
- (b) Brazilian registered trademark numbers 906975360 and 906975581, ARAPIRACA GARDEN SHOPPING and device, which have been registered since November 5, 2019, in respect of services in International Classes 35 and 36;
- (c) Brazilian registered trademark number 829640282, POÇOS DE CALDAS SHOPPING CENTER, which has been registered since September 28, 2010, in respect of services in International Class 35 (with a disclaimer of exclusive rights over the words "shopping center"; and
- (d) Brazilian registered trademark numbers 904235513, 914488996, 914489186, and 914489089, SHOPPING 3 AMERICAS and device, which have been registered since December 30, 2014, (in the case of Trademark No. 904235513) and May 7, 2019, in respect of services in International Classes 35, 36, and 41.

The dispute domain name <partageshopping.com> was registered on 1-Oct-2022.

The dispute domain name <partageshoppingbetim.com> was registered on 3-Oct-2022.

The dispute domain name <pocosdecaldasshopping.com> was registered on 27-Oct-2022.

The dispute domain name <shopping3americas.com> was registered on 28-Oct-2022.

The dispute domain name <partageparauapebas.com> was registered on 28-Oct-2022.

The dispute domain name <arapiracagardenshopping.com> was registered on 29-Oct-2022.

The dispute domain name <partagecampina.com> was registered on 29-Oct-2022.

The dispute domain name <partagenatal.com> was registered on 29-Oct-2022.

The Respondent is offering each of the disputed domain names "for sale" through the Name.com service for a price of USD 690. (By way of comparison, the Complainant recently secured three domain names in the

.com generic Top-Level Domain (“gTLD”), <partagemaraba.com>, <partagebrasil.com>, and <partagesaogonçalo.com>, for USD 74.83 each.)

When the Complaint was filed, at least one of the disputed domain names, <partagenatal.com>, resolved to a website of pornographic images with a message that the disputed domain name was for sale.

5. Discussion and Findings

No response has been filed. The Complaint and Written Notice have been sent, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules. Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct Whois details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present his or her case.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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 Registrar has confirmed that all the disputed domain names are registered in the name of the Respondent. Accordingly, the requirements of paragraph 3(c) of the Rules permitting a Complaint to relate to more than one domain name are satisfied.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of numerous registered trademarks including in particular those specifically identified in Section 4 above.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See *e.g.* WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the gTLD component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

The “Partage” disputed domain names

Disregarding the “.com” gTLD, five of the disputed domain names consist of the Complainant’s registered trademark, PARTAGE, and a descriptive or geographical term: “shopping”, “campina”, “natal”, “paraupebas” and “shopping betim”. As this requirement under the Policy is essentially a standing requirement, the addition of these terms does not preclude a finding of confusing similarity. See e.g. [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant’s trademark remains visually and aurally recognisable within each disputed domain name.

Accordingly, the Panel finds that each of these five disputed domain names is confusingly similar to the Complainant’s PARTAGE registered trademark.

The <arapiracagardenshopping.com> disputed domain name

In the present case, the Complainant’s Arapiraca Garden Shopping trademarks include a simple device element and emphasise the name “Arapiraca” over the other words.

In addition to the matters already referred to, however, it is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. Where the textual elements have been disclaimed in the registration or cannot fairly be described as an essential or important element of the trademark, however, different considerations may arise. See for example, [WIPO Overview 3.0](#), section 1.10.

As noted above, the device element is simple and does not dominate the verbal component of the trademark. Arapiraca is the name of a city in Brazil but Arapiraca Garden Shopping is the name of a privately owned and operated center. The words in the trademarks have not been disclaimed and are an essential element of the trademark. Accordingly, the Panel considers it appropriate to adopt the usual approach.

In these circumstances, the disputed domain name <arapiracagardenshopping.com> is identical to the Complainant’s registered trademark.

The <pocosdecaldasshopping.com> disputed domain name

The Complainant’s registered trademark number 829640282, POÇOS DE CALDAS SHOPPING CENTER, is a word mark. Exclusive rights over the words “shopping center” have been disclaimed.

Disregarding the gTLD, the disputed domain name <pocosdecaldasshopping.com> differs from the Complainant’s trademark by the omission of spaces and the word “Center”. Notwithstanding these differences, the Complainant’s trademark is clearly recognisable in the disputed domain name and, accordingly, the Panel finds this disputed domain name is confusingly similar to the Complainant’s registered trademark.

The <shopping3americas.com> disputed domain name

In the Complainant’s registered trademarks for SHOPPING 3 AMERICAS and device, the device element is prominent. The verbal element, however, is also prominent, appears to be distinctive and essential. For the reasons discussed in relation to the <arapiracagardenshopping.com> disputed domain name, therefore, the Panel also finds that the <shopping3americas.com> disputed domain name is identical to the Complainant’s registered trademarks.

Accordingly, the Panel finds that the Complainant has established that all the disputed domain names are either identical or confusingly similar to the Complainant's trademarks and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain names.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [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; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] 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 [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for the Complainant to raise a *prima facie* case against the Respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered all the disputed domain names well after the Complainant began using its trademarks and also after the Complainant had registered its trademarks.

The Complainant states that it has not authorised the Respondent to use the disputed domain names. Nor is the Respondent affiliated with the Complainant or the Grupo Partage in any way.

The disputed domain names are not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which any of the disputed domain names could be derived.

The use of the disputed domain name to offer it for sale and, pending that sale, displaying pornographic images does not qualify as a legitimate noncommercial or fair use for the purposes of paragraph 4(c)(iii) of the Policy.

Apart from the disputed domain name <partageshopping.com>, the disputed domain names do refer to a place. However, each place is a privately owned and operated center associated with the Complainant or its Grupo Partage. The word "Partage" in this context appears to be distinctive and each disputed domain name conveys a strong representation that it is associated with the person operating the center. That representation is false.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain names. The basis on which the

Respondent has registered the disputed domain names, therefore, calls for explanation or justification. The Respondent, however, has not sought to rebut that *prima facie* case or advance any claimed entitlement. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy in respect of each disputed domain name also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain names have been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g. *Bum World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Paragraph 4(b) identifies situations which may demonstrate that registration or use of a disputed domain name was not in bad faith under the Policy:

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of [the disputed] domain name in bad faith:

- (i) circumstances indicating that [the Respondent] has registered or [the Respondent has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] 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 [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or
- (ii) [the Respondent has] registered the [disputed] 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; or
- (iii) [the Respondent has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the [disputed] domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line 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] web site or location.

The instances of bad faith set out in paragraph 4(b) of the Policy are examples only, intended to illustrate types of conduct which is caught by the Policy. See *Do The Hustle, LLC v Tropic Web*, WIPO Case No. [D2000-0624](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

The registration of eight domain names over a period of less than one month which so closely resemble the names of the Complainant's shopping malls and the domain names registered by the Complainant in the .com.br domain provides a very strong inference that the Respondent was very well aware of the Complainant (or its group) and its shopping malls.

There is no information before the Panel about how much the Respondent paid to register each disputed domain name. The Panel notes, however, the price the Respondent actually paid would not necessarily be decisive as it could well reflect the perceived value of the disputed domain names through their association with the Complainant's trademarks.

More concretely, the Complainant has provided evidence of what may be considered the ordinary or “normal” costs incurred in registering a domain name in the .com gTLD, USD 74.83 each. The price the Respondent is seeking for each disputed domain name, USD 690, is almost ten times that price. The Panel considers therefore that the Complainant has successfully established the circumstances referred to in paragraph 4(b)(i) or, at the very least, circumstances closely analogous to those circumstances.

The use of the disputed domain names to resolve to a website featuring pornographic images could very well tarnish the trademark reflected in the disputed domain name and may also be seen as falling within the circumstances described in paragraph 4(b)(iii) above.

As a result, the Panel finds that the Complainant has established that the Respondent has registered and used each disputed domain name in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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 names, <arapiracagardenshopping.com>, <partagecampina.com>, <partagenatal.com>, <partageparauapebas.com>, <partageshoppingbetim.com>, <partageshopping.com>, <pocosdecaldasshopping.com> and <shopping3americas.com>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: February 20, 2023