

ADMINISTRATIVE PANEL DECISION

Alpargatas S.A. v. Meilly Katherinne Sanchez Ramon, Pera Colombia SAS
Case No. D2023-0926

1. The Parties

The Complainant is Alpargatas S.A., Brazil, represented by Murta Goyanes Advogados, Brazil.

The Respondent is Meilly Katherinne Sanchez Ramon, Pera Colombia SAS, Colombia, represented by Romario Mario Silvera Carreño, Colombia.

2. The Domain Names and Registrar

The disputed domain names <alpargatascolombia.com> and <alpargatas.com.co> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 1, 2023. On March 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 3, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 7, 2023 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 March 10, 2023.

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 March 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 6, 2023. The Response was filed with the Center on April 6, 2023.

The Center appointed Edoardo Fano as the sole panelist in this matter on April 27, 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

The language of the proceeding is English, being the language of the Registration Agreements, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is Alpargatas S.A., a Brazilian company operating in the footwear field and owning several trademark registrations for ALPARGATAS, including the following:

- Brazilian Trademark Registration No. 003157989 for ALPARGATAS and design, registered on October 5, 1955;
- Brazilian Trademark Registration No. 003222349 for ALPARGATAS, registered on January 17, 1976;
- Colombian Trademark Registration No. 434206 for ALPARGATAS and design, registered on September 27, 2011.

The Complainant also operates on the Internet, owning several domain name registrations for ALPARGATAS, including <alpargatas.com> and <alpargatas.com.br>.

The Complainant provided evidence in support of the above.

The Respondent is Pera Colombia SAS, a Colombian company operating in the footwear and swimsuits fields with the trademark PERA.

According to the Whois records, the disputed domain names <alpargatascolombia.com> and <alpargatas.com.co> were both registered on November 28, 2022 and they both redirect to the Respondent's website "www.peracolombia.com", in which the same type of products as the Complainant's are offered for sale.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain names are confusingly similar to its trademark ALPARGATAS, as they both wholly incorporate the Complainant's trademark, one of them with the addition of the geographic term "colombia".

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names since it has not been authorized by the Complainant to register the disputed domain names or to use its trademark within the disputed domain names, it is not commonly known by the disputed domain names and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names: the disputed domain names are redirecting to the Respondent's website "www.peracolombia.com", in which the same products as the Complainant's are offered for sale, with the aim to divert consumers and/or to capitalize on the Complainant's notoriety.

The Complainant submits that the Respondent has registered the disputed domain names in bad faith, since the Complainant's trademark ALPARGATAS is distinctive and well-known. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain names and the Complainant contends that the use of the disputed domain names with the purpose to sell the same products

as the Complainant's and attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark as to an affiliation between the Respondent and the Complainant, qualifies as bad faith registration and use.

B. Respondent

The Respondent states that the disputed domain names have been registered as a reference to the type of shoes it manufactures, namely "alpargatas" ("espadrilles" in English) and their country of production, namely Colombia: in support of the descriptiveness of the word "alpargatas" in Spanish, the Respondent is quoting the definition of the RAE (Royal Spanish Academy) "From the tree hisp. alparġát, pl. from parġa; cf. covers. Canvas footwear with esparto or hemp soles, which are secured by simple adjustment or with straps", and of the Cambridge Dictionary "A shoe that is made from strong cloth, with a sole (= bottom part) made from rope", asserting that this kind of shoe exists since at least 1322.

The Respondent considers the Complainant's trademark ALPARGATAS to be a weak trademark since it consists of a generic, descriptive element, and the Respondent asserts that the Complainant cannot therefore prevent third parties from using said element.

The Respondent submits that the disputed domain names have been registered for the descriptive meaning of the term "alpargatas" and not with the purpose to generate confusion with the Complainant's trademark.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark ALPARGATAS and that the disputed domain names are confusingly similar to the trademark ALPARGATAS.

The disputed domain name <alpargatascolombia.com> incorporates the Complainant's trademark combined with the term "colombia". The Panel notes that it is now well established that the addition of other terms (whether descriptive, geographical terms, letters, or otherwise) to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark. The additional term does not therefore prevent the disputed domain name <alpargatascolombia.com> from being confusingly similar to the Complainant's trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

It is also well accepted that a generic Top-Level Domain and a country code Top-Level Domain, in this case ".com" and ".co", are typically ignored when assessing the confusing similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain names are confusingly similar to the Complainant's trademark, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain names.

The Respondent may establish rights or legitimate interests in the disputed domain names by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

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

(ii) you (as an individual, business, or other organization) have been commonly known by the domain names, even if you have acquired no trademark or service mark rights; or

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

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain names according to paragraph 4(a)(ii) of the Policy is potentially quite difficult, since proving a negative circumstance is generally more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names in order to shift the burden of production to the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain names 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 Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not using the disputed domain names for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services. The disputed domain names are redirecting to the Respondent’s website “www.peracolombia.com”, in which the same type of products as the Complainant’s are offered for sale.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain names.

The Respondent has presented evidence of legitimate interests in the disputed domain names by stating that the term “alpargatas” is the Spanish generic term of the type of shoes the Respondent manufactures and sells, called “espadrilles” in English, and “colombia” is the country in which its business is developed.

The Panel finds both in dictionaries and in the use in commerce that the Spanish term “alpargatas” does correspond to the common Spanish name of the kind of shoes manufactured and sold by both the Complainant and the Respondent, as the translation of the English “espadrilles”.

In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights: the Panel deems that, by redirecting the disputed domain names to its website “www.peracolombia.com”, in which “alpargatas” shoes are offered for sale with the trademark PERA, the Respondent has legitimate interests in the disputed domain names, that is their use in their descriptive dictionary meaning. The fact that the Respondent’s website includes other type of products is not sufficient to make a finding that the Respondent lacks rights or legitimate interests, noting that the website includes “alpargatas”. The content of the Respondent’s website,

while clearly of a commercial nature, does not reflect any reference or clear connection to the Complainant (nor reproduce the Complainant's logo). The Panel finds it credible that the Respondent registered the disputed domain names due to the dictionary meaning of their terms, and considers that the Respondent is using them in connection with their dictionary meaning (at least in a sufficient extent).

The Panel therefore concludes that the disputed domain names are being used in connection with a *bona fide* offering of goods or services.

In light of the above, the Panel finds that the Complainant has failed to prove that the Respondent has no rights or legitimate interests in respect of the disputed domain names, in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

In order to succeed, the Complainant must establish that all three elements of the Policy are present cumulatively, and the Panel has already found that the Respondent does have rights or legitimate interests in respect of the disputed domain names.

Even though it is not therefore necessary to proceed to determine bad faith registration and use of the disputed domain names, the Panel deems that the Respondent has likely registered the disputed domain names based on the descriptive meaning of the term "alpargatas", and therefore not targeting the Complainant's trademark. The Panel finds that the Respondent's use of the disputed domain names is not in bad faith either, since they are used for their descriptive meaning in order to redirect Internet users to the Respondent's official website, in which this type of products are offered for sale with the Respondent's trademark PERA, without references to the Complainant, and therefore without creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

The Panel therefore finds that the Complainant has failed to prove that the disputed domain names have been registered and are being used in bad faith, according with paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: May 8, 2023