

## **ADMINISTRATIVE PANEL DECISION**

### **Barceló Corporación Empresarial, S.A. v. Vinicius Barbosa dos Santos Case No. D2023-2662**

#### **1. The Parties**

The Complainant is Barceló Corporación Empresarial, S.A., Spain, represented by Clarke, Modet & Co., Spain.

The Respondent is Vinicius Barbosa dos Santos, Brazil.

#### **2. The Domain Name and Registrar**

The disputed domain name <viajerosbarcelo.com> (the “Disputed Domain Name”) is registered with DropCatch.com LLC (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 22, 2023, 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 (Unknown) and contact information in the Complaint.

The Center sent an email communication to the Complainant on June 23, 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 June 26, 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 June 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 18, 2023.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on July 24, 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**

The Complainant, Barceló Corporación Empresarial, is part of the Barceló Group, a vertically integrated tourism group which has a hotel, and a travel division.

The Complainant holds various registered trade marks consisting of, or including, the terms “barceló” and “viajes”, such as the following:

- European Union Trade Mark (“EUTM”) registration No. 005957717 depicted below, registered on June 9, 2008 in classes 36, 39 and 43:



- BARCELÓ BUSINESS TRAVEL, EUTM registration No. 005957519, registered on April 16, 2008 in classes 36, 39 and 43;
- BARCELÓ VIAJES, Brazilian trade mark No. 829150382 registered on December 8, 2009 in class 39.

Albeit not included in the Complaint, the Panel was also able to find trade mark registrations for the sole term “barcelo”, such as the following:

- BARCELO, EUTM registration No. 006084222, registered on June 9, 2008 in classes 39, 41 and 43.

The Complainant’s group operates globally through its network of hotels, travel agencies and tour operators, and online via its official websites linked to various domain names such as <barcelo.com>.

The Disputed Domain Name was registered on December 22, 2020. According to the Complainant’s evidence, the Disputed Domain Name resolved to a website with pornographic content. The Disputed Domain Name currently resolves to a parking page.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant considers the Disputed Domain Name to be identical or confusingly similar to trade marks in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant claims that i) the Respondent has never been known by the Disputed Domain Name, ii) the Respondent has not acquired trade mark rights on the corresponding name, and iii) the Respondent has no relation to the Complainant nor has the Complainant given its permission to use its name and its trade marks and/or any other word that lends itself to confusion with them.

Moreover, in the Complainant's view, the Respondent registered the Disputed Domain Name to attract Internet traffic to promote pornography, which does not qualify as *bona fide* use.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant, the Respondent must have known of the Complainant's trade marks when registering the Disputed Domain Name. The Complainant claims that the Respondent is damaging the reputation of the Complainant's trade marks by providing a porn site linked to the Disputed Domain Name. In the Complainant's view, the fact that the Disputed Domain Name is confusingly similar to its highly distinctive and well-known trade marks amounts to opportunistic bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out his case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. The standard of proof is the balance of probabilities (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The Disputed Domain Name is identical or confusingly similar to a trade mark 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 Panel will therefore deal with each of these requirements.

### **A. Identical or Confusingly Similar**

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there are trade marks in which it has rights. The Complainant's BARCELO and related trade marks have been registered and used in connection to its hotel and travel business.

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trade mark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the disputed domain name (see section 1.7 of the [WIPO Overview 3.0](#)).

The Disputed Domain Name matches the Complainant's BARCELO trademark except for the addition of the term "viajeros". Where the relevant trademark is recognizable within the disputed domain name, the addition

of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the [WIPO Overview 3.0](#)).

Moreover, the Panel finds that the Disputed Domain Name is also confusingly similar to the Complainant's BARCELÓ VIAJES trade mark because of the similarity between the terms "viajeros" and "viajes".

Additionally, it is well established that generic Top-Level Domains, here ".com", may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which a complainant has rights.

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainant's BARCELO and BARCELÓ VIAJES trade marks.

## **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel observes that the Respondent does not appear to be commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trade mark or service mark rights (there being no Response or evidence of any such rights). According to the information confirmed by the Registrar, the Respondent is named "Vinicius Barbosa dos Santos". There are no indications that a connection between the Complainant and the Respondent exists or existed.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Name incorporates the Complainant's BARCELO trade mark in its entirety and simply adds the Spanish term "viajeros", which means "travellers". As mentioned above, the Panel finds that the Disputed Domain Name is also confusingly similar to the Complainant's BARCELÓ VIAJES trade mark. Given the Complainant's activities in the travel business, the Panel finds that the Disputed Domain Name carries a risk of implied affiliation with the Complainant.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

According to the Complainant's evidence, the Disputed Domain Name appeared to refer to a website with pornographic content. Given that the Disputed Domain Name incorporates the Complainant's BARCELO mark in its entirety and based on a *prima facie* assessment, the Panel does not find the Respondent's use of the Disputed Domain Name to host an adult-content website to be a *bona fide*, legitimate noncommercial or fair use (see, e.g., *Strellson AG v. Camus Deff*, WIPO Case No. [D2022-4498](#); *AREVA Société Anonyme à Directoire et Conseil de Surveillance v. wangyongqiang*, WIPO Case No. [D2016-1100](#); *MatchNet plc v. MAC Trading*, WIPO Case No. [D2000-0205](#)). The fact the Disputed Domain Name currently resolves to a parking site has no incidence on the aforementioned findings.

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

### **C. Registered and Used in Bad Faith**

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name has been registered and is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exhaustive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 website or location or of a product or service on the website or location.

In the present case, the Panel finds it more likely than not that the Respondent was aware of the Complainant and its rights in the BARCELO and related marks when it registered the Disputed Domain Name. Various marks of the Complainant predate the registration of the Disputed Domain Name by more than a decade, including in Brazil where the Respondent is located. Moreover, the Disputed Domain Name combines the Complainant's BARCELO mark with a descriptive term directly related to the Complainant's area of business.

Although the Complainant provided no evidence regarding the reputation of its mark, limited factual research enabled the Panel to confirm the online presence of the Complainant's mark. The Disputed Domain Name includes the Complainant's mark in its entirety without any reasonable and/or verifiable justification. The Panel finds that the Respondent's awareness of the Complainant's trade mark rights at the time of registration suggests bad faith.

By directing Internet users to a website offering adult content, the Panel finds it more likely than not that the Respondent intentionally aimed to attract Internet users to visit this website for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location and of the products advertised on the website.

Moreover, in the Panel's view, there is a risk of tarnishment of the Complainant's marks by suggesting a connection between the Complainant's marks and adult content (see *Strellson AG v. Camus Deff*, WIPO Case No. [D2022-4498](#); *NFON AG v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / John Smith, NC*, WIPO Case No. [D2021-3744](#)).

The Panel observes that the Disputed Domain Name currently resolves to a parking page. In the Panel's view, the Respondent's passive holding of the Disputed Domain Name does not prevent a finding of bad faith given i) the confusing similarity of the Disputed Domain Name with the Complainant's distinctive trade mark, ii) the Respondent's lack of any right or legitimate interests in the Disputed Domain Name and iii) the implausibility of any good faith use to which the Disputed Domain Name may be put (see section 3.3 of the [WIPO Overview 3.0](#)).

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the Disputed Domain Name has been registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last element 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 <viajerosbarcelo.com> be transferred to the Complainant.

*/Flip Jan Claude Petillion/*

**Flip Jan Claude Petillion**

Sole Panelist

Date: August 8, 2023