

ADMINISTRATIVE PANEL DECISION

Grupo ROTOPLAS, S.A.B. DE C.V. v. juan jose salvadoreno
Case No. D2023-4039

1. The Parties

The Complainant is Grupo ROTOPLAS, S.A.B. DE C.V., Mexico, represented by Hurrle Abogados, Mexico.

The Respondent is juan jose salvadoreno, Mexico.

2. The Domain Name and Registrar

The disputed domain name <rotoplasdistribuidormx.com> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 29, 2023. On September 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 2, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant information differing from the Respondent initially named in the Complaint (WHOISTRUSTEE.COM LIMITED) and providing the contact information for the disclosed Respondent. The Center sent an email communication to the Complainant on October 3, 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 October 4, 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 October 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 31, 2023.

The Center appointed Reynaldo Uriaga Escobar as the sole panelist in this matter on November 8, 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 proceeding is conducted in English, this being the language of the disputed domain name's registration agreement, as confirmed by the Registrar.

4. Factual Background

The Complainant is a Mexican multinational company that provides individual and integrated solutions for storing, carrying, and treating water.

The Complainant is well known in Mexico for manufacturing and distributing under its ROTOPLAS mark water reservoir tanks for residential and industrial use.

In addition to Mexico, the Complainant operates in Latin America and the United States of America.

The Complainant holds, *inter alia*, the following ROTOPLAS trademark registrations in Mexico:

- Reg. No. 640070 in class 20, registered on January 31, 2000;
- Reg. No. 762776 in class 6, registered on September 27, 2002;
- Reg. No. 987561 in class 6, registered on May 31, 2007;
- Reg. No. 988272 in class 20, registered on June 19, 2007;
- Reg. No. 991776 in class 11, registered on July 9, 2007.

On February 10, 2023, the Mexican Institute of Industrial Property issued a declaration of fame for the ROTOPLAS trademark under case file M.F.275/2022(G-7)15876.

The Respondent registered the disputed domain name on August 15, 2023, which it used to host a website impersonating the Complainant and falsely offering the Complainant's products and services.

5. Parties' Contentions

A. Complainant

The Complainant submits that:

- (i) ROTOPLAS is regarded as a famous mark in Mexico, which is the maximum protection afforded by Mexican law to a trademark;
- (ii) The disputed domain name fully incorporates the ROTOPLAS mark, thus creating confusing similarity with the said mark;
- (iii) The term "distribuidor", which is the Spanish equivalent for "dealer", misleads the Internet users into thinking that the Respondent's website is a legitimate portal for dealers of ROTOPLAS products in Mexico;
- (iv) The disputed domain name resolves to a website falsely offering ROTOPLAS products and services to the general public;
- (v) The Respondent is not authorized by the Complainant to use the ROTOPLAS trademark;

- (vi) The Respondent uses the disputed domain name to defraud consumers with ROTOPLAS products that they will never receive;
- (vii) ROTOPLAS is immediately associated with water tanks, and water purification products manufactured by the Complainant;
- (viii) The Respondent has used the disputed domain name to falsely advertise the Complainant's ROTOPLAS mark;
- (ix) The Respondent offers ROTOPLAS products in a fraudulent manner accepting advance payments from customers;
- (x) The Respondent falsely presents itself as the Complainant on the website to which the disputed domain name resolves, creating the false appearance that the website was being operated by the Complainant.

B. Respondent

The Respondent did not submit a Response to the Complaint.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed in this administrative proceeding, the Complainants must prove that:

- (i) the disputed domain name is identical or confusingly similar to trademarks or service marks 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 was registered and is being used in bad faith.

These elements are discussed in turn below. In considering these elements, paragraph 15(a) of the Rules provides that the Panel shall decide the Complaint on the bases of statements and documents submitted and in accordance with the Policy, the Rules, and any other rules or principles of law that the Panel deems applicable.

A. Identical or Confusingly Similar

The first element has a low threshold merely serving as a gateway requirement under the Policy. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), elucidating that "the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name".

The disputed domain name fully encapsulates the mark ROTOPLAS, which in and of itself is sufficient to demonstrate confusing similarity with the Complainant's registered (and famous) mark despite the addition of "distribuidor"¹, a usual designation in commerce, and "mx", a geographical term. See section 1.8 of the [WIPO Overview 3.0](#) (where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive, geographical, meaningless, or like terms would not prevent a finding of confusing similarity under the first element).

¹ Term in Spanish that translates into English as distributor.

The Panel therefore holds that the disputed domain name is confusingly similar to the ROTOPLAS registered marks in which the Complainant has rights.

The Complaint passes muster under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The second element under the Policy is that the Respondent has no rights or legitimate interests in respect of the disputed domain name (Policy, paragraph 4(a)(ii)). Paragraph 4(c) of the Policy provides that “any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent’s] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you [the respondent] of the dispute, your [the respondent’s] use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [the respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you [the respondent] have acquired no trademark or service mark rights; or
- (iii) you [the respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

As noted in section 2.1 of the [WIPO Overview 3.0](#), the onus is on the Complainants to establish the absence of the Respondent’s rights or legitimate interests in the disputed domain names. However, because of the inherent difficulties in proving a negative, the consensus view is that the Complainant needs only put forward a prima facie case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that prima facie case (see also, e.g., World Wrestling Federation Entertainment, Inc. v. Ringside Collectibles, WIPO Case No. [D2000-1306](#)).

As alleged by the Complainant and corroborated by the record, the disputed domain name resolved, until recently, to an active website passing off as the Complainant’s official website, and falsely offering ROTOPLAS products with a view to defrauding the consuming public.

These unlawful purposes preclude the Respondent from accruing rights or legitimate interests within the realm of the Policy. See section 2.13.1 of the [WIPO Overview 3.0](#) (the use of a domain name for illegal activity, including impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent).

The Panel thus finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant has fulfilled the second limb of Policy, paragraph 4(a).

C. Registered and Used in Bad Faith

Pursuant to Policy, paragraph 4(a)(iii), in order to be granted relief, the Complainant must show that the disputed domain name was registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets forth the following non-exhaustive grounds of bad faith registration and use:

“(i) circumstances indicating that you [the respondent] have registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 your [the respondent's] documented out-of-pocket costs directly related to the domain name; or

(ii) you [the respondent] have registered the 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 you [the respondent] have engaged in a pattern of such conduct; or

(iii) you [the respondent] have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you [the respondent] have intentionally attempted to attract, for commercial gain, Internet users to your [the respondent's] 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 your [the respondent's] website or location or of a product or service on your [the respondent's] website or location."

In the Policy context, bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1 of the [WIPO Overview 3.0](#).

As explained in section 4 supra, the Complainant owns Mexican trademark registrations for ROTOPLAS, all of which predate the Respondent's registration of the disputed domain name.

Moreover, on February 10, 2023, ROTOPLAS was officially acknowledged as a famous mark in Mexico, meaning that said mark is known by the majority of the Mexican consumers.²

The Panel finds that, by misappropriating the Complainant's famous mark to include it in the disputed domain name, and by using the latter to deceive and scam Internet users, the Respondent is deemed to have registered in bad faith and used in bad faith, the disputed domain name. See *Grupo Rotoplas, S.A.B. de C.V. v. JESUS SALVARRRN*, WIPO Case No. [D2023-3310](#) (the panel considers that the registration and use of the disputed domain name <rotoplas-mx.com> was in bad faith since the respondent misappropriated a domain name that widely reproduces a well-known trademark in Mexico like ROTOPLAS to impersonate the complainant for undue commercial gain).

All these circumstances, taken together, persuade the Panel that the disputed domain name was registered in bad faith and is being used in bad faith.

The Complainant has discharged its burden in relation 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 domain name <rotoplasdistribuidormx.com> be transferred to the Complainant.

/Reynaldo Uriaga Escobar/

Reynaldo Uriaga Escobar

Sole Panelist

November 28, 2023

² This in accordance with article 190 of Mexico's Federal Law for the Protection of Industrial Property.