

ADMINISTRATIVE PANEL DECISION

D.E Cafés do Brasil Ltda., Jacobs Douwe Egberts BR Comercialização de Cafés Ltda v. Rafeale de Carvalho Silva
Case No. D2023-4251

1. The Parties

The Complainants are D.E Cafés do Brasil Ltda., Jacobs Douwe Egberts BR Comercialização de Cafés Ltda, Brazil, represented by Ploum, Netherlands (Kingdom of the).

The Respondent is Rafeale de Carvalho Silva, Brazil.

2. The Domain Name and Registrar

The disputed domain name <lojapilao.shop> is registered with HOSTINGER operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 12, 2023. On October 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 13, 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 Complainants on October 13, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on the same date.

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 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 7, 2023.

The Center appointed Mario Soerensen Garcia as the sole panelist in this matter on November 13, 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 Complainants are D.E. Cafés do Brasil Ltda. and Jacobs Douwe Egberts BR Comercialização de Cafés Ltda, private limited liability companies having their registered office in Sao Paulo, Brazil. The Complainants are part of Jacobs Douwe Egberts, which in turn is part of JDE Peet's, one of the largest pure play coffee and tea companies, headquartered in the Netherlands (Kingdom of the).

The Complainants' coffee and tea portfolio is available in over 100 countries around the world and consists of many worldwide well-known household trademarks including JACOBS, TASSIMO, MOCCONA, SENSEO, L'OR, and PILÃO.

The Complainants own several trademark registrations in multiple jurisdictions for the trademark PILÃO, including the following:

- Brazilian trademark PILÃO, No. 810036541, filed on February 10, 1981 and registered on February 5, 1985;
- Brazilian trademark PILÃO, No. 811065081, filed on January 10, 1983 and registered on June 12, 1884.

The Complainants also own domain names consisting of "Pilao", including the domain names <cafepilao.com.br>, registered on June 25, 2001, and <pilao.com.br>, registered on April 2, 2009.

The disputed domain name was registered on September 28, 2023, and before it was taken down by the Registrar, it resolved to a website allegedly marketing and selling PILÃO branded coffee products.

5. Parties' Contentions

A. Complainant

The Complainants argue that the disputed domain name entirely reproduces the Complainants' trademark PILÃO, in addition to the term "loja", which in Portuguese means "shop" and that the trademark PILÃO is recognizable within the disputed domain name.

Also, the Complainants mention that the term "loja" creates the impression that the disputed domain name resolves to an official online store from the Complainants and there is sufficient risk that Internet users would believe that there is a connection between the disputed domain name and the Complainants and/or their goods and services.

According to the Complainants, the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainants also inform that they have not authorized the use of their trademarks in the disputed domain name and that the Respondent did not make demonstratable use of the disputed domain name in connection with a *bona fide* offering of goods and services and, on the contrary, the Complainants have ascertained that the disputed domain Name is being used for fraudulent activities.

According to the Complainants, the customers who purchased PILÃO branded coffee via the website corresponding to the disputed domain name did not receive the coffee they paid for and the Complainants received a lot of calls/emails from concerned customers, complaining about the phishing activities of the Respondent and also asking whether the promotions were in fact accurate.

The Complainants add that they have tried to contact the Respondent but the contact information mentioned in the website belongs to a third-party. Since the Respondent provided false contact information, the Complainants contacted the Registrar to take down the website linked to the disputed domain name.

The Complainants mention that the PILÃO trademark is well known in the world and at least in the Portuguese speaking countries, reason why the Respondent registered the disputed domain name in bad faith, which was enhanced by the fact that the Respondent's website contained Portuguese language only, as well as the reproduction of several marks, including PILÃO.

The Complainant argues that reproducing famous trademarks in a domain name to attract Internet users to a website cannot be considered as fair use or use in good faith.

Further, the Complainants inform that the Respondent used a privacy protection service in an attempt to conceal its identity, which is another evidence of bad faith.

Finally, the Complainants request the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

As per paragraph 4(a) of the Policy, the Complainant must prove that:

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

A. Identical or Confusingly Similar

The evidence presented demonstrates that the Complainants are the owner of several trademark registrations for PILÃO around the world.

The disputed domain name incorporates the Complainants' trademark PILÃO almost in its entirety, and the addition of the term "loja" does not avoid confusing similarity between the disputed domain name and the Complainants' trademarks. The Complainants' PILÃO trademark is clearly recognizable in the disputed domain name.

As numerous prior UDRP panels have recognized, the incorporation of a trademark in its entirety or a dominant feature of a trademark is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Also, it is the general view among UDRP panels that the addition of merely dictionary, descriptive or geographical words to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP ([WIPO Overview 3.0](#), section 1.8).

The Panel finds that paragraph 4(a)(i) of the Policy has been proved by the Complainants, i.e., the disputed domain name is confusingly similar to the Complainants' trademarks.

B. Rights or Legitimate Interests

The Respondent has not submitted a response to the Complaint.

There is no evidence that the Respondent has any authorization to use the Complainants' trademark or to register domain names containing the trademark PILÃO.

There is no evidence that the Respondent is commonly known by the disputed domain name.

There is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name or that before any notice of the dispute the Respondent has made 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. Instead, the unrefuted evidence of the case indicates that the Respondent was using the disputed domain name for fraudulent activities.

[WIPO Overview 3.0](#) section 2.13.1.

Moreover, the construction of the disputed domain name itself, which includes the Complainants' trademark almost in its entirety with the additional term "loja", is such to carry a risk of implied affiliation that cannot constitute fair use.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(ii) of the Policy has been satisfied, i.e., the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The trademark PILÃO is registered by the Complainants in several jurisdictions and is considered as a well-known mark by the consumers in Brazil, where the Respondent is located. Also, the Complainants registered many distinct domain names consisting of the term "Pilao", including <pilao.com.br> and <cafePilao.com.br>. The trademark registrations owned by the Complainants predate the registration of the disputed domain name by decades.

The disputed domain name comprises the Complainants' mark PILÃO almost in its entirety in which the Respondent has no rights or legitimate interests, in addition to the term "loja" ("store", in English), which may indeed lead Internet users to believe that the website redirected by the disputed domain name refers to the Complainants' online official store.

The Complainants' PILÃO mark is well known and has a strong online presence in Brazil and the website related to the disputed domain name was developed in the Portuguese language with similar visuals to those used in the Complainants' official website, including the reproduction of the Complainants' design trademark and products, so it is unlikely that the Respondent was unaware of the Complainant's mark when it registered the disputed domain name.

It is clear for the Panel that when registering the disputed domain name, that the Respondent has intentionally targeted the Complainants' trademark in the disputed domain name to obtain undue financial advantage by impersonating the Complainants.

In addition, the unrefuted evidence indicates that the disputed domain name has been used to defraud the Complainants' customers.

The fact that the disputed domain name does not currently resolve to an active website does not prevent a finding of bad faith.

Moreover, the Respondent has chosen not to respond to the Complainants' allegations. According to the panel's decision in *The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. [D2009-0610](#), "[...] the failure of the Respondent to respond to the Complaint further supports an inference of bad faith".

For the above reasons, the Panel finds that the condition of paragraph 4(a)(iii) of the Policy has been satisfied, i.e., the disputed domain name has been registered and is being used in bad faith.

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, <lojapilao.shop> be transferred to the Complainant.

/Mario Soerensen Garcia/

Mario Soerensen Garcia

Sole Panelist

Date: November 27, 2023