

ADMINISTRATIVE PANEL DECISION

Tokio Marine Seguradora S.A. v. Julio Cesar Silva
Case No. D2023-4433

1. The Parties

Complainant is Tokio Marine Seguradora S.A., Brazil, represented by Opice Blum, Brazil.

Respondent is Julio Cesar Silva, Brazil.

2. The Domain Name and Registrar

The disputed domain name <tokiomarineoficial.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2023. On October 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 26, 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 (NameSilo, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on October 27, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on October 30, 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 Respondent of the Complaint, and the proceedings commenced on November 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 29, 2023.

The Center appointed Gabriel F. Leonardos as the sole panelist in this matter on December 4, 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



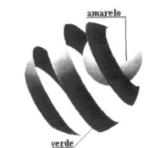
Complainant is Tokio Marine Seguradora S.A. ("Tokio Marine"), a Brazilian insurance company controlled by Tokio Marine Holdings, Inc. ("Tokio Marine Holdings") founded in Tokio in 1879, owner of the trademarks TOKIO MARINE and TOKIO MARINE SEGURADORA. Complainant claims that Tokio Marine Holdings licensed a Tokio Marine trademark to Complainant and authorized Complainant to defend Tokio Marine Holdings' rights in this procedure, supported by the documents Annexes 5.1 and 5.2 to the Complaint.

Complainant operates a website using the domain name <tokiomarine.com.br> in which promotes and offers its services, registered on May 16, 2000.

According to the document submitted by Complainant (Annex 5.1 to the Complaint), the trademark registration of Tokio Marine Holdings licensed to Complainant can be found below:

Registration No.	Trademark	Jurisdictions	International Class	Registration Date
827939213	 (TOKIO MARINE SEGURADORA)	Brazil	36	February 20, 2018

Some other examples of Tokio Marine Holdings' trademark registrations can be found below:

Registration No.	Trademark	Jurisdictions	International Class	Registration Date
822078597		Brazil	36	December 20, 2005
822078600		Brazil	36	December 20, 2005
824312384		Brazil	36	February 03, 2009

The disputed domain name was registered on May 31, 2023, and, according to the evidence submitted by Complainant, was used to resolve automatically to <tokiomarineoficial.com.br>, which appears to simulate the Brazilian Top-Level Domain ".br", which was offering alleged vehicle auctions and displaying Complainant's logo. The disputed domain name currently resolves to an error webpage without content.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends that the disputed domain name is confusingly similar to the registered trademark TOKIO MARINE, since it fully incorporates Complainant's trademark TOKIO MARINE.

Complainant affirms that the disputed domain name uses the trademark TOKIO MARINE in its entirety followed by the term "oficial", which means "official" in Portuguese – which would not avoid a confusingly similarity between the disputed domain name and Complainant's official channels.

Therefore, according to Complainant, the disputed domain name is confusingly similar with Complainant's trademark TOKIO MARINE, fulfilling paragraph 4(a)(i) of the Policy and paragraphs 3(b)(viii) and 3(b)(ix)(1) of the Rules.

In addition, Complainant states that Respondent would not have any rights or legitimate interests in respect of the disputed domain name, nor is Respondent commonly known by the disputed domain name. Further, Respondent has not been authorized, or licensed to use Complainant's trademark TOKIO MARINE as a domain name nor is Respondent associated with Complainant.

Complainant observes that Respondent would have registered the disputed domain name for the purpose of exploiting Complainant's rights and well-known reputation of the TOKIO MARINE trademark, using Complainant's logo on the website according to the Complaint, for which consumers are led to believe that there would be a link between Complainant and Respondent, which would not constitute a *bona fide* offering of goods and services, nor represent a legitimate noncommercial or fair use of the disputed domain name.

This way, Complainant states that no legitimate use of the disputed domain name could be reasonably claimed by Respondent, thus paragraph 4(a)(ii) of the Policy and paragraph 3(b)(ix)(2) of the Rules have been fulfilled.

Finally, Complainant states that (i) Respondent was well aware of the existence of the trademark TOKIO MARINE, and is intentionally diverting customers into the website hosted by the disputed domain name through the confusion caused by the unauthorized use of the trademark TOKIO MARINE on the Internet; and (ii) the website which purports from the disputed domain name showcased Complainant's logo and advertises fraudulent vehicle auctions replicating Complainant's trademark – which led Complainant to the conclusion that the disputed domain name would potentially mislead consumers to fraudulent schemes.

Thus, according to Complainant, the requirements for the identification of a bad faith registration and use of the disputed domain name have been fulfilled, pursuant to paragraph 4(b)(iv) of the Policy.

Accordingly, Complainant requests transfer of the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

To succeed in a UDRP complaint, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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 burden of proving these elements is upon Complainant.

Respondent had 20 days to submit a response in accordance with paragraph 5(a) of the Rules and failed to do so. Paragraph 5(f) of the Rules establishes that if a respondent does not respond to the complaint, in the absence of exceptional circumstances, the panel's decision shall be based upon the complaint.

A. Identical or Confusingly Similar

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 Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "oficial") may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel notes that the term "oficial" translates to "official" in Portuguese.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds that Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that Complainant suspects that the disputed domain name was used for a fraudulent vehicle auction scheme to obtain payments and financial information from Internet users. Panels have held that the use of a domain name for illegal activity (e.g. impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Respondent has not used the disputed domain name in the context of a *bona fide* that could demonstrate legitimate interests, since the evidence shows that the confusingly similar disputed domain name resolved at the time of filing the Complaint to a website that at minimum unfairly auction vehicles on the reputation of Complainant's mark and logo, and moreover is likely to trick the visitor into believing it would be related to Complainant's business as seen on Complaint. Furthermore, the composition of the disputed domain name, wholly incorporating the Complainant's trademark with the term "oficial", carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that Respondent has registered the disputed domain name that fully incorporates Complainant's well-known trademark TOKIO MARINE, plus – as explained above in 6.A – the addition of the term "oficial" meaning "official" in Portuguese, which does not accurately disclose Respondent's lack of any relationship to Complainant. The Panel finds that it was duly demonstrated that Respondent was aware of Complainant's rights to the trademark TOKIO MARINE at the time of the registration – as Complainant enjoys a worldwide reputation with the use of the referred trademark and Complainant evidenced the use of the TOKIO MARINE logo by Respondent on the website which resolved to the disputed domain name.

The Panel concludes the registration and use is in bad faith under paragraph 4(b) of the Policy as the disputed domain name creates a 4(b)(ii) pattern of bad faith conduct; and 4(b)(iv) intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the complainant's mark.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity (here, claimed fraudulent vehicle auctions) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Moreover, the Panel refers to the UDRP decision in *Jeunesse Global Holdings, LLC and Jeunesse Brasil Comercial Ltda v. Cleverson Santos Pires, Permuta Livre*, WIPO Case No. [D2019-2931](#) (<naaraoficial.com>), as can be verified below:

"The Panel finds it is highly unlikely that the Respondent had no knowledge of the NAÄRA products at the time of registration of the disputed domain name. On the contrary, the evidence shows that the Respondent was likely deliberately trying to create confusion with the Complainants' trademark.

The Panel acknowledges that Jeunesse Global Holdings and Jeunesse Brasil Comercial are widely known companies and believes the disputed domain name may cause confusion, since its feature, namely "naaraoficial", reproduces not only the NAÄRA trademark, but is also followed by the word "oficial" indicating that the website is "official" by Jeunesse – which is not true."

The Panel finds that the circumstances of the present case allows a finding of bad faith in the registration and use of the disputed domain name, considering that (i) Respondent would likely obtain commercial gain by using the trademark TOKIO MARINE in its entirety, and supposedly offering vehicle auction services at the disputed domain name – likely in connection to a fraudulent scam; (ii) the provision of false and/or misleading information on Respondent's website by displaying Complainant's logo; and (iii) the trademark TOKIO MARINE is well known internationally and Complainant operating an almost identical domain name, merely including the term "oficial" meaning "official" in Portuguese, such that Respondent most likely knew (or should have known) of its existence, taking advantage of the confusion caused on the public by its use in the disputed domain name.

Moreover, the Panel finds it relevant that Respondent has not provided any evidence of good faith registration or use, or otherwise participated in this dispute. Complainant has put forward serious claims regarding the apparent bad faith use of the disputed domain name that the Panel would expect any legitimate party would seek to refute.

Based on the available record, the Panel finds that Complainant has established the third 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 <tokiomarineoficial.com> be transferred to Complainant.

/Gabriel F. Leonardos/

Gabriel F. Leonardos

Sole Panelist

Date: December 18, 2023