

ADMINISTRATIVE PANEL DECISION

Grupo Rotoplas, S.A.B. de C.V. v. Fernands Martinez Lopez
Case No. D2023-4900

1. The Parties

The Complainant is Grupo Rotoplas, S.A.B. de C.V., Mexico, represented by Hurre Abogados, Mexico.

The Respondent is Fernands Martinez Lopez, Mexico.

2. The Domain Name and Registrar

The disputed domain name <rotoplasmx.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 November 24, 2023. On November 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 28, 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 and contact information in the Complaint (PrivacyGuardian.org llc). The Center sent an email communication to the Complainant on November 28, 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 November 29, 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 December 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 5, 2023.

The Center appointed Enrique Ochoa de González Argüelles as the sole panelist in this matter on January 15, 2024. 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 a Mexican multinational traded company dedicated to creating solutions for storing, conveying, purifying, and treating water.

It is headquartered in Mexico City and trades in Latin American countries (Argentina, Brazil, Chile, Costa Rica, El Salvador, Guatemala, Honduras, Nicaragua, Panama, Peru, and Uruguay) and in the United States of America.

The Complainant is the owner of ROTOPLAS trademark, which is the subject of several registrations in Mexico, among others (subsequently "ROTOPLAS trademarks"):

- ROTOPLAS with registration number 640070 in class 20, registered on January 31, 2000, and with full force and effect until June 11, 2026.
- ROTOPLAS with registration number 762776 in class 6, registered on September 27, 2002, with full force and effect until June 11, 2026.

Recently, the Mexican Trademark Office (Instituto Mexicano de la Propiedad Industrial) awarded ROTOPLAS the distinction of "famous trademark" in terms of the Mexican legal framework.

The Complainant is the holder and uses the domain name <rotoplas.com>.

The Respondent registered the disputed domain name on October 19, 2023. At the time of filing the Complaint, the disputed domain name resolved to a website impersonating the Complainant and mimicking its trademarks and official website. The disputed domain name does not currently resolve to an active content and displays the following:

"Account Suspended
This Account has been suspended.
Contact your hosting provider for more information."

5. Parties' Contentions

A. Complainant

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

Notably, the Complainant contends the following:

The disputed domain name is confusingly similar to the ROTOPLAS trademarks, as the term "rotoplas" is fully included in the disputed domain name, as well as the letters "mx", which refer to Mexico.

The Respondent is targeting the Mexican Market using the good name of the Complainant to confuse the customers of the ROTOPLAS trademarks by only adding the letters "mx" referring to Mexico.

The disputed domain name has been used for the fake sale of solutions for storing, conducting, purifying, and treating water.

The Respondent has no rights nor legitimate interests in relation to the disputed domain name as same is not a licensee or an authorized distributor of the goods or services identified with the ROTOPLAS trademarks.

The disputed domain name has been used solely for speculative purposes and to the detriment of the prestigious ROTOPLAS trademarks, consequently in bad faith.

The Respondent is not commonly known by the name “rotoplas”.

The Respondent has no relationship nor authorization from the Complainant to use the ROTOPLAS trademarks.

The Complainant contends that the mere existence of a domain name like the disputed domain name, causes confusion among the public and that the Respondent's intention is to pass off as the Complainant in an attempt to obtain undue commercial gain.

The Complainant is widely known in Mexico and abroad and the ROTOPLAS trademark is considered as “famous” in Mexico. Therefore, based on all the information provided earlier, it is highly unlikely that the Respondent, at the time of acquiring the disputed domain name, was unaware of infringing upon the trademark. Thus, the registration was made in bad faith.

B. Respondent

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

6. Discussion and Findings

Due to the lack of response from the Respondent, the undersigned allows the possibility of considering certain such assertions by the Complainant as it deems reasonable, in terms of section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

On the other hand, it should be noted that in order to claim the disputed domain name, the Complainant must satisfy the following elements: (1) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and (2) the Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name; and (3) the disputed domain name should be considered as having been registered and being used in bad faith.

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 the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of the ROTOPLAS trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel notes that the disputed domain name includes the trademark ROTOPLAS in its entirety, and even with the addition of the letters “mx”, the trademark ROTOPLAS is recognizable within the disputed domain name, which causes it to be confusingly similar to the ROTOPLAS Trademarks.

Furthermore, as decided in previous cases, the addition of the generic Top-Level Domain (“gTLD”) “.com” is irrelevant to the make a comparison between signs for the purposes of the first element, as set out in section 1.11.1 of the [WIPO Overview 3.0](#).

For better reference see *Grupo Rotoplas, S.A.B. DE C.V. c. Jesús Alberto Noé Castilla, Semanares*, WIPO Case No. [D2022-4678](#); and *Grupo Rotoplas, S.A.B. de C.V. v. JESUS SALVARRRN*, WIPO Case No. [D2023-3310](#), on the domain names <rotoplas-mx.com> and <rotoplas-mexico.com>, respectively.

Consequently, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

As mentioned above, the Complainant argued that the Respondent had no rights or legitimate interests with respect to the disputed domain name, and in the absence of a response, this circumstance was not refuted.

Paragraph 4(c) of the Policy provides a list of circumstances in which the 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 the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the 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.

Panels have held that the use of a domain name for illegal activity as applicable to this case: sale of counterfeit goods or illegal rendering of services, 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.

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 the Respondent was aware of the existence of the Complainant and its activities before the registration of the disputed domain name, provided that:

- The Complainant is a very well-known company, and holder of the ROTOPLAS trademarks which predate over two decades the registration of the disputed domain name.
- The disputed domain name was registered to attract Internet users for commercial gain deceiving them to the Respondent’s website, by creating a likelihood of confusion with the ROTOPLAS trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website as per paragraph 4(b)(iv) of the Policy.
- The Respondent did not file a response and did not evidence having rights in the disputed domain name.

Panels have held that the use of a domain name for illegal activity as applicable to this case (sale of counterfeit goods or illegal rendering of services, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

In addition, the current non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

The Panel finds that the 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 <rotoplasmx.com> be transferred to the Complainant.

/Enrique Ochoa de González Argüelles/

Enrique Ochoa de González Argüelles

Sole Panelist

Date: January 29, 2024