

## **ADMINISTRATIVE PANEL DECISION**

Grupo Rotoplas, S.A.B. de C.V. v. Fernando Dorantes  
Case No. D2023-4901

### **1. The Parties**

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

The Respondent is Fernando Dorantes, Mexico.

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

The disputed domain name <rotoplastienda.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, 2024.

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

The 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 the 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 September 21, 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 currently directs to a site that displays the following: "OPTIMUS STRETCH CEILINGS", and apparently promotes stretch ceilings in Prague, Czech Republic.

Complainant filed UDRP legal proceedings regarding the domain name <rotoplas.mx.com> on November 24, 2023 and another similar Complaint was filed in *Grupo Rotoplas, S.A.B. de C.V. v. Fernands Martinez Lopez*, WIPO Case No. [D2023-4900](#). The Panel notes that there are similarities between the Respondent in the case in reference and *Grupo Rotoplas, S.A.B. de C.V. v. Fernands Martinez Lopez*, WIPO Case No. [D2023-4900](#), such as: i) Fernando and Fernands, first names of the Respondents in the two UDRP proceedings, ii) the registrant share the same street and number address (Anahuac 91) and iii) the same Registrar NAMESILO, LLC, all those circumstances were not known to the Complainant at the time of filing UDRP legal proceedings.

#### 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 word "tienda" (Spanish term for "store"), circumstance that may create the illusion of a legitimate and real website of the rightful owner of the ROTOPLAS trademarks.

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 mere existence of a domain name like the disputed domain name causes confusion among the public. The Complainant contends that the disputed domain name clearly indicates an intention to imitate the Complainant and to attract Internet users to the portal, taking advantage of the possibility of confusion with the Complainant and its brand.

The Complainant also contends that there are multiple UDRP proceedings ongoing for the abusive registration of similar domain names and the evident similarity in the orthographic name, design, display, colors and appearance between the current disputed website and the previously known domain names only can indicate that they were created by the same person.

The Complainant is widely known in Mexico and abroad and it 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 term “tienda”, 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 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 *Xiaomi Inc. v. Renzo Cruz*, WIPO Case No. [D2023-3045](#), on the domain name <xiaomitiendaperu.com>; and *Samsung Electronics Co., Ltd. v. EAO Digital Solutions*, WIPO Case No. [D2012-0693](#), on the domain name <samsungtienda.com>.

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.

On the other hand, the Panel notes that the Respondent in this case, as well as in *Grupo Rotoplas, S.A.B. de C.V. v. Fernands Martinez Lopez*, WIPO Case No. [D2023-4900](#) appears to be the same person. Therefore, a pattern of conduct of registering abusive domain names incorporating third party trademarks in bad faith is established in terms of the [WIPO Overview 3.0](#), section 3.1.2.

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.

Furthermore, the current use of the disputed domain name to resolve to a website proposing competing services of what appears to be an official business in Czech Republic is a further element of bad faith of the Respondent, in an attempt by the Respondent to trade on the goodwill and reputation of the Complainant.

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 <rotoplastienda.com> be transferred to the Complainant.

*/Enrique Ochoa de González Argüelles/*  
**Enrique Ochoa de González Argüelles**  
Sole Panelist  
Date: January 29, 2024