

## **ADMINISTRATIVE PANEL DECISION**

D.E. Cafés do Brasil Ltda and Jacobs Douwe Egberts BR Comercialização de Cafés Ltda v. Domain Administrator; Claudia Silva, Minha loja; Wagner Alves, WAGNER; Milen Radumilo; Davi Lima; Maria Aparecida Pereira; Benedito e Jennifer Telas ME Empresa, Benedito e Jennifer Telas ME  
Case No. D2023-5290

### **1. The Parties**

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

The Respondents are Domain Administrator, Nigeria; Claudia Silva, Minha loja, Brazil; Wagner Alves, WAGNER, Brazil; Milen Radumilo, Romania; Davi Lima, Brazil; Maria Aparecida Pereira, Brazil; Benedito e Jennifer Telas ME Empresa, Benedito e Jennifer Telas ME, Brazil.

### **2. The Domain Names and Registrars**

The disputed domain names <cafePilao.store>, <pilaoLoja.online>, and <pilao.shop> are registered with Hostinger Operations, UAB; the disputed domain name <cafePillao.com> is registered with Tucows Inc.; the disputed domain name <cafePiIaobrasil.com> is registered with Porkbun LLC; the disputed domain name <cafePilao.me> is registered with CommuniGal Communication Ltd.; the disputed domain name <pilaoCafebrasil.com> is registered with GoDaddy.com, LLC. Hostinger Operations, UAB, Porkbun LLC, CommuniGal Communication Ltd., and GoDaddy.com, LLC are referred to hereinafter as the “Registrars”.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 20, 2023. On December 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 20 and 21, 2023, the Registrars transmitted by email to the Center its verification response registrant and contact information for the disputed domain names which differed from the named Respondent (unknown) and contact information in the Complaint.

The Center sent an email communication to the Complainants on December 22, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainants to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity.

The Complainants filed an amendment to the Complaint on December 22, 2023.

The Center verified that the Complaint together with the amendment to the 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 Respondents of the Complaint, and the proceedings commenced on January 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on January 24, 2024.

The Center appointed Edoardo Fano as the sole panelist in this matter on January 25, 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.

The Panel has not received any requests from the Complainants or the Respondents regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a) “to employ reasonably available means calculated to achieve actual notice to [the] Respondent”. Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a response from the Respondents.

The language of the proceeding is English, being the language of the Registration Agreements, as per paragraph 11(a) of the Rules.

#### **4. Factual Background**

The Complainants (referred to below as “the Complainant”) are D.E. Cafés do Brasil Ltda and Jacobs Douwe Egberts BR Comercialização de Cafés Ltda, both Brazilian companies which 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, based in the Netherlands (Kingdom of the). The Complainant owns several trademark registrations for PILÃO, among which the following ones:

- Brazilian Trademark Registration No. 810036541 for PILÃO, registered on February 5, 1985;
- Brazilian Trademark Registration No. 811065081 for PILÃO, registered on June 12, 1984;
- United States of America Trademark Registration No. 78555071 for PILÃO and design, registered on May 9, 2006.

The Complainant also operates on the Internet, owning several domain name registrations including the mark PILAO, among which <pilao.com.br> and <cafepilao.com.br>.

The Complainant has provided evidence in support of the above.

According to the Whois records, the disputed domain names were registered on the following dates: <cafepiilaobrasil.com> on November 2, 2023, <cafepilao.me> on November 27, 2023, <cafepilao.store> on November 7, 2023, <cafepillao.com> on October 23, 2023, <pilaocafebraasil.com> on October 18, 2023, <pilaoloja.online> on October 19, 2023, and <pilao.shop> on November 3, 2023. Before the Complaint was filed, according to the Complaint, all the disputed domain names redirected to websites (almost identical among each other and very similar to the Complainant’s official website) on which the Complainant’s

trademark, logo and copyrighted pictures were reproduced, allegedly marketing and selling PILÃO branded coffee products and impersonating the Complainant. At present, the disputed domain names <cafePilao.store>, <pilaoloja.online>, and <pilao.shop> are inactive; the disputed domain names <cafePilaobrasil.com>, <cafePillao.com>, and <pilaocafebrasil.com> redirect to potentially dangerous websites; and <cafePilao.me> resolves to a parking page with pay-per-click (“PPC”) links to third parties’ coffee related websites.

## **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 names.

Notably, the Complainant states that the disputed domain names are confusingly similar to its trademark PILÃO.

Further to section 6.1 below, the Complainant argues that the disputed domain names are under common control and thus addresses the Respondents in the singular. The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names since it has not been authorized by the Complainant to register the disputed domain names or to use its trademark within the disputed domain names, it is not commonly known by the disputed domain names and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names. All the disputed domain names were used by the Respondent to redirect to websites (almost identical among each other and very similar to the Complainant’s official website) in which the Complainant’s trademark, logo and copyrighted pictures were reproduced, allegedly marketing and selling PILÃO branded coffee products and impersonating the Complainant.

The Complainant submits that the Respondent has registered the disputed domain names in bad faith, since the Complainant’s trademark PILÃO is well known. Therefore, the Respondent targeted the Complainant’s trademark at the time of registration of the disputed domain names and the Complainant contends that the use of the disputed domain names to attract, for commercial gain, Internet users to the Respondent’s websites, creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s websites, qualifies as bad faith registration and use.

### **B. Respondents**

Apart from automatic replies indicating the close of the office from one of the Respondents, the Respondents have made no reply to the Complainant’s contentions and are in default. In reference to paragraphs 5(f) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) section 4.3.

## **6. Discussion and Findings**

### **6.1 Procedural issue - Consolidation of Multiple Respondents**

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other,

or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. [WIPO Overview 3.0](#), section 4.11.2.

As regards common control, the Complainant asserts that inter alia:

- all the disputed domain names follow a very similar naming pattern and resolved to almost identical websites;
- all the disputed domain names have been registered within a relatively short period of time, namely between October and November, 2023, and they have been all registered using the same two IP addresses;
- 6 out of 7 registrants has used the same email service provider.

Considering the above and in the absence of any objection from the Respondents regarding the Complainant's consolidation request, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party in terms of fairness and equity.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

## **6.2 Substantive Issues**

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are 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 names. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the 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 PILÃO, save for the accent on the letter "a", is reproduced within the disputed domain names. . Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms, here "café", "brasil", and "loja" (meaning "shop" in Portuguese), may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

As regards the disputed domain names <cafepiilaobrasil.com> and <cafepillao.com>, the Panel notes that this is a typical case of a deliberate misspelling of a mark (so-called “typosquatting”), by adding, deleting, substituting, or reversing the order of letters in a mark, where numerous UDRP panels in the past have found confusing similarity to be present. [WIPO Overview 3.0](#), section 1.9.

It is also well accepted that a generic Top-Level Domain (“gTLD”), in this case “.com”, “online”, “store”, and “shop”, and a country code Top-Level Domain (“ccTLD”), in this case “.me”, are typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1. 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 the respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible 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 names. 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 present record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

The Complainant asserts that it first learned about the online fraudulent activities, after receiving many different complaints about the website at the domain name <lojapilao.shop>. Consumers reached out to the Complainant both via phone and email believing that they ordered coffee products from the Complainant, without the actual products being delivered. Consumers expressed concerns as they had provided their credit card details as well as their personal information on this website in order to purchase the coffee products. The Complainant took the action by contacting the registrar to take down this website and then it filed a UDRP proceeding, *D.E Cafés do Brasil Ltda., Jacobs Douwe Egberts BR Comercialização de Cafés Ltda v. Rafeale de Carvalho Silva Consumers*, WIPO Case No. [D2023-4251](#), in which the panel ordered the transfer of the domain name to the Complainant.

Immediately after taking down the website at the domain name <lojapilao.shop>, a new website using another domain name incorporated the Complainant’s PILÃO trademark appeared, and this new website was almost identical to the website at the domain name <lojapilao.shop>. Again, the Complainant took down this new website. However, after that, another 12 domain names, including the disputed domain names in this case, were registered one by one due to the Complainant’s action to take down each website at a time. All 12 domain names, including the disputed domain names, have used the Complainant’s trademark and have resolved to websites almost identical among each other and very similar to the Complainant’s official website, purportedly offering for sale the same products as the Complainant and reproducing the Complainant’s trademark and logo on the website. The Complainant believes that the Respondent is involved in a large scale scam, trying to acquire personal information as well as personal bank account details from customers through impersonating the Complainant, to which the Respondent has not rebutted. Panels have held that the use of a domain name for illegal activity, here impersonation/passing off or fraudulent activities, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Despite the above, should the Complainant's products sold on the websites to which the disputed domain names were directing Internet users be genuine products, legitimately acquired by the Respondent, the question that would arise is whether the Respondent would therefore have any rights or legitimate interests in using the above disputed domain names that are confusingly similar to the Complainant's trademark in circumstances that are likely to give rise to confusion.

According to the current state of UDRP decisions in relation to the issue of resellers as summarized in the [WIPO Overview 3.0](#), section 2.8.1:

"[...] resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the 'Oki Data test', the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder;  
and
- (iv) the respondent must not try to 'corner the market' in domain names that reflect the trademark."

This summary is based on the UDRP decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Even if the products sold by the Respondent were the Complainant's genuine products, from inspection of the Respondent's websites, the Panel finds that the use of the Complainant's trademark and logo on the homepages, and the lack of any prominent and accurate disclaimer disclosing the lack of relationship with the Complainant would falsely suggest to Internet users, under the *Oki Data* principles (see above), that the websites to which the disputed domain names resolved are owned by the Complainant or at least somehow affiliated to the Complainant.

The Panel therefore concludes that the disputed domain names are not being used in connection with a *bona fide* offering of goods or services.

Moreover, the Panel finds that the composition of the disputed domain names <cafePilao.me>, <cafePilao.store>, <pilaocafebrasil.com>, <pilaoloja.online>, and <pilao.shop> carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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.

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.

In the present case, regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant's trademark PILÃO in the coffee field is clearly established, and the Panel finds that the Respondent knew of the Complainant and deliberately registered the confusingly similar disputed domain names, especially because the disputed domain names redirected to websites (almost identical among each other and very similar to the Complainant's official website) on which the Complainant's trademark, logo and

copyrighted pictures were reproduced, allegedly marketing and purportedly selling PILÃO branded coffee products.

The Panel further notes that the disputed domain names were also used in bad faith, since the Respondent was trying to impersonate the Complainant, likely in connection to a fraudulent scheme, with the purpose of intentionally attempting to create a likelihood of confusion with the Complainant's trademark as to the disputed domain names' source, sponsorship, affiliation or endorsement. [WIPO Overview 3.0](#), sections 3.1.4 and 3.4.

Furthermore, the Panel considers that the nature of the inherently misleading disputed domain names, which include the Complainant's trademark in its entirety with the mere addition of the terms "cafe", "brasil", and "loja" (meaning "shop" in Portuguese), and as regards the disputed domain names <cafepiilaobrasil.com> and <cafepillao.com> adding respectively a letter "i" and a letter "l" within the Complainant's trademark PILÃO, further supports a finding of bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

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 names <cafepiilaobrasil.com>, <cafepilao.me>, <cafepilao.store>, <cafepillao.com>, <pilaocafebrasil.com>, <pilaoloja.online>, and <pilao.shop> be transferred to the Complainant.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: February 8, 2024