

## **ADMINISTRATIVE PANEL DECISION**

Compa, LLC v. MEGAN PROBST, GRADCAPPLE  
Case No. D2024-1921

### **1. The Parties**

Complainant is Compa, LLC, United States of America (“United States”), represented by Marval O’Farrell & Mairal, Argentina.

Respondent is Megan Probst, Gradcapple, United States.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 7, 2024. On May 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 8, 2024, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on May 10, 2024, 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 May 14, 2024.

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 May 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 6, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 7, 2024.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on June 17, 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 limited liability company (LLC) organized in the State of Delaware, United States. Complainant developed and operates three luxury hotel properties located in Buenos Aires (Argentina), Miami, and Miami Beach (United States). Complainant's hotel properties, each using the name FAENA in combination with a geographic term and other identifiers, are the recipients of major internationally-recognized travel awards, including from Condé Nast Traveler and Forbes Travel Guide.

Complainant is the owner of a substantial number of registrations for the word, and word (and design mark, FAENA, including: on the register of the Instituto Nacional de la Propiedad Industrial (INPI) of Argentina, word mark registration number 2,683,687, registered (notified) on October 29, 2014, in international class (IC) 43; and on the Principal Register of the United States Patent and Trademark Office (USPTO), word mark registration number 4,678,498, registered on January 27, 2015, in ICs 43 and 37; and word mark registration number 5,423,668, registered on March 13, 2018, in IC 33. Complainant has provided evidence of additional trademark registrations for FAENA listed on the WIPO Global Brand Database, including for countries in Latin America and Europe.

According to the Registrar's verification, Respondent is registrant of the disputed domain name. According to the Whois database, the disputed domain name was registered on October 17, 2023. There is no indication on the record of this proceeding that any party other than Respondent has owned or controlled the disputed domain name since its initial registration.

The disputed domain name has been parked on a Registrar free parking page ("forma gratuita por cortesia Goddady.com") that includes several pay-per-click ("PPC") links that are associated with the Miami, Florida area (i.e., "Condos Brickell", "Brickell", and "Brickell Miami"). There is no other evidence of use of the disputed domain name on the record of this proceeding.

According to publicly available information, Respondent is the owner of a well-known real estate group in Miami ("The Probst Group"). Respondent has offered "Faena Hotel Residences" as part of its brokerage services.

There is no evidence on the record of this proceeding of any commercial or other relationship between Respondent and Complainant.

#### **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.

Complainant alleges that it owns rights in a trademark and that the disputed domain name is confusingly similar to that trademark.

Complainant argues that Respondent lacks rights or legitimate interest in the disputed domain name because: (1) Complainant has not licensed or otherwise authorized Respondent to use its trademark in the disputed domain name; (2) there is no evidence that Respondent has been commonly known by the disputed domain name; (3) Respondent not used the disputed domain name in connection with a bona fide

offering of goods or services, or made demonstrable preparations to do so; (4) Respondent has not made a legitimate noncommercial or fair use of the disputed domain name, and; (5) Respondent has sought only to take commercial advantage of Complainant's prior rights in its trademark.

Complainant contends that Respondent registered and is using the disputed domain name and bad faith because: (1) Complainant's mark is well-known and Respondent must have been aware of its mark when it registered the disputed domain name (incorporating geographic locations where Complainant does business); (2) the terms added to Complainant's trademark in the disputed domain name signify that Respondent was aware of Complainant's business; (3) Respondent is the owner of a well-known real estate group in Miami which is closely related to Complainant's business; (4) in all likelihood Respondent's primary motivation for registering the disputed domain name was to earn advertising revenues through PPC links on a parking page; and (5) Respondent for commercial gain has attempted to attract Internet users to its website by creating confusion as to Complainant acting as the source, sponsor, affiliate, or endorser of Respondent's website.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain name to Complainant.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical addresses provided in its record of registration. Courier delivery was successfully completed. There is no indication of difficulty in transmission of email notification to Respondent. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (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.

### **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.

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 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 “residences” and “miami”, 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 name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Although the overall burden of proof in UDRP proceedings is on 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 Respondent. As such, where Complainant makes out a prima facie case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on Complainant). If Respondent fails to come forward with such relevant evidence, Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds 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.

Respondent has used the disputed domain name solely in connection with a free parking page provided by the Registrar. That free parking page includes PPC links to geographic areas (i.e., “Brickell”) and property (i.e., “condos”), that are relevant to Complainant’s business. As such, the parking page might divert Internet users from Complainant to potentially competitive links. The parking page legend suggests that it may not provide PPC revenues to Respondent. Whether it does or not, direction to the parking page does not constitute a bona fide use of the disputed domain name such as to establish rights or legitimate interests. Effectively Respondent has not made active use of the disputed domain name, and such non-use does not establish right or legitimate interests.

Given that Respondent, according to information provided by Complainant, is a real estate brokerage service in the South Florida area, the Panel might surmise that Respondent had in mind when registering the disputed domain name to refer Internet users to its brokerage services for listings involving Complainant’s properties. There is no evidence that Respondent has so used the disputed domain name, and Respondent has not responded to the Complaint to attempt to justify its use of Complainant’s trademark. It is not for the Panel to speculate as to whether Respondent might have met fair use criteria had it provided a justification. The possibility that Respondent somehow might have made fair use of Complainant’s trademark under appropriate circumstances is not in itself sufficient to establish rights or legitimate interest as fair use justifications are highly contextual. See *Four Seasons Hotels Limited v. George Thomas, George Thomas Real Estate*, WIPO Case No. [D2018-0337](#) and *Starwood Hotels & Resorts Worldwide Inc. v. Frank Dossa*, WIPO Case No. [D2008-1812](#) (both finding in favor of trademark owner).

Because Respondent’s use of the disputed domain name in connection with a PPC page does not in the case circumstances establish rights or legitimate interests, and because Respondent has failed to respond to the Complaint with any attempt to justify its registration and use, the Panel determines that Complainant has established that Respondent has not established rights or legitimate interests.

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.

Respondent was manifestly aware of Complainant and its trademark when it registered the disputed domain name. Complainant's trademark is distinct and well-known in the hotel and travel industry. Complainant operates hotel properties in the Miami area and the disputed domain name specifically incorporates "miami". Complainant has provided evidence that Respondent listed a condominium for sale in one of Complainant's properties on its brokerage website.

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 found that the non-use of a domain name (including a blank or parking page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Respondent has used the disputed domain name in connection with a parking page that includes certain PPC links that might divert Internet users from Complainant and its business. It is not clear that such use has been for Respondent's commercial gain, e.g., it is not clear that the parking page provided by the Registrar involves PPC payment to Respondent as it is specifically denominated by the Registrar as a "free" parking page; nor does a PPC page seem likely to have been Respondent's primary motivation in registering the disputed domain name.

Respondent has not provided an explanation or justification for its registration and use of the disputed domain name. The disputed domain name incorporates Complainant's distinctive and well-known trademark in a way intended to be associated with Complainant. Respondent as a real estate broker might fairly use Complainant's trademark in a web page listing of a particular property in a complex operated by Complainant because this might be a reasonable way to convey the location of that property to potential buyers. This does not give Respondent a fair use right to use Complainant's trademark in a way that is generally drawing Internet users to Respondent and its brokerage services by reference to Complainant's business (i.e., "FAENA residences Miami"). The most plausible reading of the disputed domain name is that Respondent is acting as an authorized agent of Complainant in marketing properties (or indeed, on its face, that Respondent is in fact Complainant – which is plainly not the case). There is no indication that this is the case. As such, a general fair use claim by Respondent – who has its own "Compass" and/or "Probst Group" branded real estate company – would be overbroad. The construction of the disputed domain name, which draws solely on Complainant's mark without reference to Respondent's own mark/business, may well be misleading and disruptive to Complainant's business as Internet users seeking property from Complainant would be diverted to a channel through Respondent.

On balance, the Panel determines that the disputed domain name was registered and is being used by Respondent in bad faith because Respondent's actions are not merely nominative but are misleading and disruptive to Complainant's business, and they may be diverting Internet user traffic from Complainant to Respondent, or other competitors of Complainant, for commercial gain. Respondent moreover has not attempted to justify its registration and use of the disputed domain name.

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 <faenaresidencesmiami.com> be transferred to Complainant.

*/Frederick M. Abbott/*

**Frederick M. Abbott**

Sole Panelist

Date: July 1, 2024