

ADMINISTRATIVE PANEL DECISION

Instituto Presbiteriano Mackenzie v. Leilson moreira lima
Case No. D2024-2324

1. The Parties

The Complainant is Instituto Presbiteriano Mackenzie, Brazil, represented by Pinheiro, Nunes, Arnaud E Scatamburlo, Brazil.

The Respondent is Leilson moreira lima, Brazil, self-represented.

2. The Domain Names and Registrar

The disputed domain name <umackenzie.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 6, 2024. On June 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 10, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Whois Privacy Protection Foundation) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 18, 2024, 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 June 21, 2024.

The Center verified that the Complaint together with 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 Respondent of the Complaint, and the proceedings commenced on June 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 14, 2024. The Response was filed with the Center on June 24, 2024.

The Center appointed Mario Soerensen Garcia as the sole panelist in this matter on July 8, 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.

On July 8, 2024, the Complainant submitted to the Center, via email, an unsolicited Supplemental Filing in reply to the Response. On July 16, 2024, the Complainant sent to the Center an email communication, forwarding an email received from the Respondent on July 8, 2024, related to the disputed domain name.

4. Factual Background

The Complainant is Instituto Presbiteriano Mackenzie, an educational institution established more than 150 years ago and currently established in the city of São Paulo, State of São Paulo, Brazil. The Complainant has more than 30 thousand students enrolled in Mackenzie teaching units, 48 graduate courses and 55 specialization courses.

The Complainant is the owner of several trademark registrations for MACKENZIE, covering teaching and educational services, in Brazil and other South American countries, as follows:

- Brazilian Trademark MACKENZIE-M, No. 006228836, registered on February 10, 1976, in Class 41.10;
- Brazilian Trademark MACKENZIE, No. 819081469, registered on November 3, 1998, in Class 41.10;
- Brazilian Trademark MACKENZIE RIO, No. 900566914, registered on January 26, 2010, in Class 41.

The Complainant is also the owner of the domain name <mackenzie.com.br>, registered on November 6, 1998.

The Respondent was identified as Leilson Moreira Lima, with a physical address in Tocantins State, Brazil.

The disputed domain name <umackenzie.com> was registered on December 20, 2021, and resolves to a website, in the Portuguese language, offering educational services and courses in North America.

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.

The Complainant argues that the disputed domain name is identical or confusingly similar to the trademarks MACKENZIE.

The disputed domain name resolves to a website offering educational services and courses in North America, but the language offering those services are in Portuguese aimed to Brazilian students and also displaying an "M logo", which is confusingly similar to the Complainant's.

The Complainant adds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. That being the case, the Complainant finds that the disputed domain name is used to take unfair advantage of the Complainant's rights for commercial gain, since Internet users and the Complainant's clients would inevitably associate the content related to the disputed domain name with the Complainant.

According to the Complainant, it has prior rights over the trademarks MACKENZIE, and has not authorized the registration and use of the disputed domain name, nor the use of its trade name and trademarks by the Respondent.

The Respondent is not affiliated to or authorized by the Complainant to use or register the disputed domain name.

The Complainant's intellectual property rights for MACKENZIE trademarks predate the registration of the disputed domain name.

The Complainant also argues that the Respondent was aware of the Complainant's rights and has clearly registered the disputed domain name to exploit the reputation and goodwill of the Complainant's trademarks, and that the registration of the disputed domain name was conducted in bad faith.

Further, the Complainant informs that, in an attempt to solve the matter amicably, it sent a cease and desist letter to the Respondent, written in the Portuguese language, and received a response, written in Portuguese, declining the proposal for an amicable solution and also alleging false information, such as that they registered their mark in the United States of America and operate in that country.

Finally, the Complainant requests the transfer of the disputed domain name.

In reply to the Response, the Complainant submitted an unsolicited supplemental filing on July 8, 2024. This submission replied to contentions made in the Response, and largely repeats contentions already made in the Complaint. Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.6. Noting that unsolicited supplemental filings are generally discouraged and the lack of any exceptional reasons put forward by the Complainant to explain the need for a further submission, the Panel has declined to consider the supplemental filing for the purposes of the Decision. In any event, the Panel notes that the submission would not have impacted the outcome of the Decision if considered.

B. Respondent

The Respondent contends that the Complainant has not satisfied all the elements required under the Policy for a transfer of the disputed domain name, as the disputed domain name is used legitimately and noncommercially, and it has been used for purposes that do not compete with the Complainant. The Respondent adds that the disputed domain name was registered in good faith due to the absence of commercial or profit motive.

Moreover, the Respondent claimed that it has rights and legitimate interests in the disputed domain name, as it was used in connection with educational and cultural initiatives, without any intention of improperly benefiting from the Complainant's reputation.

Also, on July 8, 2024, the Respondent sent an email to the Complainant's representatives informing that it would amicably release the disputed domain name and would transfer it to the Complainant. Such communication from the Respondent was submitted by the Complainant to the Center on July 16, 2024.

However, the Respondent has not directly informed the Center about any intention to transfer the disputed domain name as of the date of this decision.

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to the trademarks or service marks in which the Complainant has rights; and
- (ii) the 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 the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

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 entirety of the mark MACKENZIE is reproduced and recognizable 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.

The Panel finds that the addition of the letter "u" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark 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 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 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.

Rather, and, contrary to the Respondent's unsupported contentions (see section 5.B. above), the Complainant has provided evidence that disputed domain name is not being used for a noncommercial activity, but rather the educational services apparently being offered by the Respondent are offered for sale in direct competition with the Complainant's services under its MACKENZIE trademark, while unfairly attempting to benefit from association with such trademark. Further, the Panel notes the website at the disputed domain name does not provide any disclaimer or explanation regarding the lack of relationship with the Complainant, an educational provider operating under the MACKENZIE trademark long before the Respondent's registration of the confusingly similar disputed domain name. Absent contrary evidence from the Respondent, and also noting the Panel's below bad faith discussion, the Panel finds that the Respondent is not making a bona fide offering of goods and services, nor a legitimate noncommercial or fair use of the disputed domain name, for the purposes of the Policy.

Moreover, the Panel notes the composition of the disputed domain name carries a risk of implied affiliation with 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.

In the present case, the Panel notes that at the time the disputed domain name was registered, the Respondent, more likely than not, was aware of the MACKENZIE trademark as the Complainant's trademark is well-known in Brazil, where the Respondent appears to be located, and the Complainant's trademark registrations, as well as its domain names, substantially predate the registration date of the disputed domain name.

The evidence presented in the Complaint also shows that the Complainant previously sent a cease and desist letter to the Respondent regarding the unauthorized use of its trademarks and that the Respondent replied to it with false allegations dismissing the possibility of any infringement.

Moreover, the website corresponding to the disputed domain name demonstrates that the Respondent presents itself as "University Mackenzie", while the Complainant is "Universidade Mackenzie" (the exact same meaning in Portuguese) and the marks and logos reproduced in such website are similar to those used and registered by the Complainant.

The Panel notes that the Respondent has clearly used the disputed domain name to offer competing services to the Complainant's, targeting Brazilian consumers, as the language displayed on the respective website is Portuguese, and also the services were charged in "Reais", the Brazilian currency. In this sense, the Panel finds that the Respondent has used the disputed domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark.

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 light of the above, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith.

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 <umackenzie.com> be transferred to the Complainant.

/Mario Soerensen Garcia/

Mario Soerensen Garcia

Sole Panelist

Date: July 22, 2024