

ADMINISTRATIVE PANEL DECISION

TEX COURIER S.A. v. boy boy, total conecta
Case No. D2024-3749

1. The Parties

The Complainant is TEX COURIER S.A., Brazil, represented by Salusse, Marangoni, Parente e Jabur Advogados, Brazil.

The Respondent is boy boy, total conecta, Brazil.

2. The Domain Name and Registrar

The disputed domain name <totalconecta.com> is registered with Squarespace Domains II LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 13, 2024. On September 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 16, 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, total conecta") and contact information in the Complaint. The Center sent an email communication to the Complainant on September 17, 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 amendment to the Complaint on September 19, 2024.

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 Respondent of the Complaint, and the proceedings commenced on September 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 13, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 15, 2024.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on October 18, 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 Brazilian company that has been operating in the logistics and transportation services for over 30 years.

The Complainant owns a large portfolio of TOTAL trademarks in Brazil, including the Brazilian Trademark Registration No. 780347951, registered on March 20, 1984.

The Complainant also owns trademark registrations for TOTAL EXPRESS in Brazil, such as the Brazilian Trademark Registration No. 827496745, registered on November 20, 2007.

The disputed domain name was registered on August 10, 2024.

The Panel accessed the disputed domain name on February 26, 2024, when it was not pointing to any active website, but just to message informing that the page “has been reported for potential phishing”. The Complainant brought evidence that the disputed domain name was recently linked to a website that reproduced the Complainant’s official website “totalconecta.totalexpress.com.br”, as well as the Complainant’s trademark and logo, requiring the Internet users to provide personal data in order to supposedly monitor the delivery of their packages.

5. Parties’ Contentions

A. Complainant

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

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name reproduces the Complainant’s TOTAL trademark in its entirety with the addition of the term “conecta” (“connects” in English language), making reference to the Complainant’s online tracking services available at the subdomain <totalconecta.totalexpress.com.br>. The composition chosen by the Respondent clearly characterizes an intentional reproduction of the Complainant’s trademark, thus being confusingly similar therewith. The likelihood of confusion is evident, given that Internet users will immediately associate the disputed domain name with the Complainant’s services and prior trademarks and domain name, believing that they relate to the same company, and that the products and services that might be eventually offered by the Respondent under the disputed domain name originate from the same source, what is not true.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not entitled to any trademark, trade name or any other right relating to the disputed domain name. The Respondent has not been authorized by the Complainant to use the TOTAL and TOTAL EXPRESS trademarks and there is no business relationship between the Complainant and the Respondent. The Respondent has used the disputed domain name to impersonate the Complainant and seeking to defraud customers of the Complainant. The Respondent is not known by the disputed domain name, as is evidenced from searches conducted using its name in addition with the disputed domain name which exclusively shows as results websites and pages related to the Complainant.

- The disputed domain name was registered and is being used in bad faith. The disputed domain name consists of a clear-cut reproduction of the Complainant's TOTAL trademarks, and online tracking service for costumers and commercial partners. The Respondent has no rights or legitimate interests in respect of the disputed domain name, and the registration and use of the disputed domain name have been made by the Respondent in clear bad faith in an attempt to impersonate the Complainant and defraud Customers of the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (i) the disputed domain name is 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 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.

Annex 6 to the Complaint shows valid registrations of TOTAL and TOTAL EXPRESS trademarks obtained by the Complainant in Brazil, respectively in 1984, and 2007.

The trademark TOTAL is wholly encompassed within the disputed domain name, together with the suffix "conecta" and the generic Top-Level Domain ("gTLD") ".com".

Although such additions may bear on assessment of the second and third elements, the Panel finds that the use of the term "conecta" 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.

It is also well established that the addition of a gTLD, such as ".com", is typically disregarded when determining whether a domain name is confusingly similar to a complainant's trademark as such is viewed as a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.1.

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.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondents 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 have 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.

The Panel finds no indication that the Respondent is commonly known by the disputed domain name.

Also, the Complainant has asserted that the Respondent is not an authorized representative, nor have obtained any permission for such reproductions of trademarks.

Considering the composition of the disputed domain name, which consists of a reproduction of the Complainant's trademarks and subdomain <totalconecta.totalexpress.com.br>, along with the content on the webpage associated with the disputed domain name, the Panel finds that the disputed domain name carries a risk of user confusion.

Also, Panels have held that the use of a domain name for illegal activity (here, claimed impersonation and potential phishing) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used 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.

The disputed domain name includes the trademark TOTAL and was used to imitate an internal subdomain and webpage of the Complainant's official website, trying to impersonate the Complainant to require Internet users to provide personal data. At the time of this Decision, there is a phishing alert related to the Respondent's website.

Therefore, the Panel concludes that it is not feasible that the Respondent was not aware of the Complainant's trademark and that the registration of the disputed domain name was a mere coincidence.

From the Panel's search, the disputed domain name does not currently resolve to any active website.

However, UDRP panels have frequently found that the apparent lack of so-called active use of a domain name (passive holding) does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and *Polaroid Corporation v. Jay Strommen*, WIPO Case No. [D2005-1005](#).

The evidence brought by the Complainant suggests that the Respondent is intentionally attempting to attract, through the registration and use of the disputed domain name, the Complainant's customers, for commercial gain and/or to commit fraud, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website.

Therefore, having reviewed the record, the Panel finds the registration and use of the disputed domain name 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 name <totalconecta.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: November 1, 2024