

ADMINISTRATIVE PANEL DECISION

Botica Comercial Farmacêutica Ltda. v. Roberto Civile Rodrigues
Case No. DIO2022-0014

1. The Parties

The Complainant is Botica Comercial Farmacêutica Ltda., Brazil, represented Salusse, Marangoni, Parente e Jabur Advogados, Brazil.

The Respondent is Roberto Civile Rodrigues, Brazil.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint¹ was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 30, 2022. On March 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 1, 2022, the Registrar transmitted by email to the Center its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 April 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 18, 2022. The Respondent sent several informal emails to the Center on April 2, April 26, April 29, May 18, and May 19, 2022.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on June 3, 2022. 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.

¹ While the Complainant requests that the proceeding be conducted in Portuguese, having regard to the circumstances of this case the Panel determines that English be the language of the proceeding. See paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is part of the Boticário Group, leader of the Brazilian perfumery market, being the largest franchising network in Brazil and one of the largest franchising networks of perfumery in the world.

The Complainant's trademark O BOTICÁRIO is currently recognized as a highly-renown trademark by the Brazilian Patent and Trademark Office ("BPTO"), as well as it is the object of dozens of registrations in Brazil and in numerous countries around the world, since 1984 (Brazilian trademark registration No. 810975289, registered on November 20, 1984).

The Complainant also owns many domain names incorporating the word "boticario", including the domain names <boticario.com.br>, registered in 1996, and <boticario.com>, registered in 1998.

The Respondent is located in Brazil and registered the disputed domain name <oboticar.io> on October 18, 2019.

When the Panel tried to access the disputed domain name – on June 13, 2022 – there was no active web site, but only a *FortiGuard Intrusion Prevention* alert informing that "You have tried to access a web page that is in violation of your Internet usage policy". The Complainant provided evidence that the disputed domain name used to redirect to the Respondent's personal website.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name is identical to the highly-renown trademark O BOTICÁRIO and can be confused with the previous domain names incorporating such expression owned by the Complainant. The disputed domain name fully reproduces the Complainant's notorious trademark O BOTICÁRIO, causing a likelihood of confusion with said trademark and the other rights held by the Complainant, further endangering the Complainant's consumers, the general public and Internet users. The Respondent, knowing the relevance of the trademark O BOTICÁRIO and using his knowledge in IT, searched for the Top-Level Domain ("TLD") ".io" to register the domain name initiated by the radical "oboticar", so as to form, together with the sum of the expressions, "oboticar.io". As the Complainant's trademark is a widely used and highly-renown trademark in Brazil, worthy of special protection in all fields of activity, in addition to being registered and in use in dozens of countries, any use that the Respondent may make of the disputed domain name will mislead the consumer and inevitably be regarded as a violation of the Complainant's prior rights over the famous trademark O BOTICÁRIO.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The disputed domain name is being used merely as a way of redirecting Internet users to the Respondent's webpage available at "https://roberto.cr/", which provides a description of the activities provided by him, without any connection with the expressions "oboticar" or "oboticar.io". The Respondent does not have (nor could he have, as it would be in violation of the trademark O BOTICÁRIO) any application or trademark registration for expressions such as "boticar" and/or "o boticar" as well as there is no registration or pending application before the BPTO, in Brazil, where he is domiciled. The Respondent is not known by the disputed domain name, as is evidenced from searches conducted using his name in addition with the disputed domain name. Finally, it is worth noting that, from the webpage available at the domain name <roberto.cr>, there is no reference to the use of any expression corresponding to "boticar" and/or the like, corroborating with the lack of any legitimate interest in the use and maintenance of the disputed domain name by the Respondent.

The disputed domain name was registered and is being used in bad faith. The Respondent recently offered the disputed domain for sale to the Information Security Director of the Complainant, asking for the amount of BRL 100,000 – approximately USD 20,000. The Respondent himself recognizes the existence of the Complainant, to the extent that, in addition to offering his services as a technical consultant for the implementation of the disputed domain name by the Complainant, he mentions the fact that it could serve as a new store for “O Boticário”, *i.e.*, the Complainant. The Complainant sent a cease-and-desist letter to the Respondent requesting the abstention of use of the disputed domain name and the transfer of its ownership to the Complainant, the legitimate owner of the notorious trademark O BOTICÁRIO. The Respondent refused to comply with the requests. There is no interest on the Complainant’s side to negotiate with the Respondent, given that he demonstrated his intention to obtain unfair advantage with the sale of the disputed domain name for a substantial amount, in high excess of the out-of-pocket expenses incurred in registering and maintain the disputed domain name. Said intention is further reinforced by the successive messages exchanged between the Respondent and the Complainant’s employee, in which the Respondent, in addition to offering the disputed domain for sale, hinted that he would own other domain names. Moreover, the Respondent currently makes use of the disputed domain name as a way to divert the Complainant’s customers redirecting them to the webpage available at the domain name <roberto.cr>, in which the Respondent discloses his personal data and offer his IT services.

B. Respondent

The Respondent did not formally reply to the Complainant’s contentions.

However, on April 2, 2022, the Respondent sent a message to the Registrar of the disputed domain name and, on April 26 and 29, 2022, and on May 18 and 19, 2022, to the Center, basically offering the disputed domain name for sale.

6. Discussion and Findings

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

- (1) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (2) the respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

The Complaint’s Annexes prove that the Complainant has rights in the O BOTICÁRIO trademark since at least 1984.

The trademark is wholly encompassed in the disputed domain name. Previous panels have recognized that where the applicable TLD and the second-level portion of the domain name in combination contain the relevant trademark, panels may consider the domain name in its entirety for purposes of assessing confusing similarity. See *e.g.*, *project.me GmbH v. Alan Lin*, WIPO Case No. [DME2009-0008](#), <project.me>; and *Banco Bradesco S/A v. Paulo Araujo*, WIPO Case No. [DCO2010-0049](#), <brades.co>.²

Therefore, the Panel finds the disputed domain name to be in effect identical to the Complainant’s

² Given the similarities between the .IO Policy and the Uniform Domain Name Dispute Resolution Policy (“UDRP”), the Panel finds UDRP precedent to be relevant to this case.

trademark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation where a respondent can demonstrate a right or legitimate interest in a domain name by showing one of the following facts:

- (i) before receiving any notice of the dispute, the respondent used or made preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name without intent for commercial gain, to misleadingly divert consumers or to tarnish the trademark at issue.

The Panel has concluded that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed the trademark to the Respondent. The Respondent is not commonly known by the disputed domain name and the trademark in question is notorious in Brazil, which is where the Respondent is located.

While the Panel notes that the term “o boticário” is a dictionary word, panels have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent. In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights. See section 2.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). In this case, there is no evidence that the Respondent registered the disputed domain name based on its dictionary meaning. Indeed, the Complainant showed that the Respondent has used the disputed domain name to redirect Internet users to a webpage promoting his IT services, and that he has offered the disputed domain name for sale to the Complainant. Noting the foregoing and the status and fame of the Complainant’s trademark (recognized as a highly-renown trademark by the BPTO), the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Consequently, the Panel is satisfied that the Complainant has proven the second element of the Policy.

C. Registered or Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular but without limitation, shall be evidence of registration or use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) the Respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location.

The disputed domain name completely encompasses the Complainant's trademark O BOTICÁRIO.

When the disputed domain name was registered the Complainant's trademark O BOTICÁRIO was already unquestionably well-known in Brazil, what was even formally declared by the BPTO.

This notoriety was created with massive presence on the Brazilian media and decades of business operations through one of the largest franchise networks in the country.

Therefore, it is not feasible that the Respondent could have been unaware of the Complainant's reputation and business registering a domain name that exactly reproduces the Complainant's trademark.

In addition, the offer for sale of the disputed domain name to the Complainant, for valuable consideration, likely in excess of documented out-of-pocket costs directly related to the domain name, demonstrates awareness of the Complainant's brand and operations in the country, evidencing bad faith registration. Additionally, this intention of financial gain is also indicative of bad faith use of the disputed domain name.

The current lack of operation on the disputed domain name does not help the Respondent. Previous UDRP decisions have shown that the mere passive holding of a domain name may characterize bad faith in some cases. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Polaroid Corporation v. Jay Strommen*, WIPO Case No. [D2005-1005](#).

In the Panel's view, the circumstances that the Respondent is (a) not presently using the disputed domain name and (b) not at least providing justifications for the registration of a domain name comprising a notorious third-party trademark, certainly cannot be used in benefit of the Respondent in the present case.

Finally, in the Panel's view, (c) the fact that the disputed domain name was recently used to redirect Internet users to a webpage promoting his IT services supports a finding of bad faith.

Based on the foregoing, the Panel finds that the Respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has proven that the Respondent registered or used the disputed domain name in bad faith, satisfying 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 <oboticar.io> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: June 20, 2022