

# WIPO Arbitration and Mediation Center

## ADMINISTRATIVE PANEL DECISION

### Concessionária do Aeroporto Internacional de Guarulhos S/A v. Perfect Privacy, LLC / Douglas Santanna, T-Systems do Brasil Ltda.

#### Case No. D2016-1105

##### 1. The Parties

The Complainant is Concessionária do Aeroporto Internacional de Guarulhos S/A of Guarulhos, Brazil, represented by Newton Silveira, Wilson Silveira e Associados - Advogados, Brazil.

The Respondent is Perfect Privacy, LLC of Jacksonville, United States of America / Douglas Santanna, T-Systems do Brasil Ltda. of São Paulo, Brazil.

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

The disputed domain name <gruairport.com> is registered with Register.com (the “Registrar”).

##### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 1, 2016. On June 2, 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 6, 2016 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 11, 2016.

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 the Respondent of the Complaint, and the proceedings commenced on June 13, 2016. In accordance with the Rules, paragraph 5, the due date for Response was July 3, 2016. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 4, 2016.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on July 13, 2016. 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 the company in charge of exploiting the São Paulo International Airport, established in 1985. The International Air Transport Association (“IATA”) assigned exclusively to the Complainant the international airport code “GRU” (<http://www.iata.org/publications/Pages/code-search.aspx>) which is largely used in the identification of the airport.

In addition to that the Complainant owns several Brazilian trademark registrations for the GRUAIRPORT trademark, amongst which:

- Trademark registration No. 905271408, filed on September 12, 2012 and registered on September 8, 2015, in international class 35;
- Trademark registration No. 905271513, filed on September 12, 2012 and registered on October 6, 2015, in international class 39.

The Complainant also owns the domain names <gru.com.br> registered on June 18, 2007 and <gruairport.com.br> registered on September 6, 2012.

The disputed domain name <gruairport.com> was registered on September 4, 2012. Currently no active webpage resolves from the disputed domain name.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant asserts that as of June 14, 2012, as an effect of the signing of the concession agreement between the Brazilian Federal Government and “GRUPAR Consortium”, the Complainant itself was founded and obtained the rights to exploit the International Airport of São Paulo which was inaugurated on January 20, 1985 in the city of Guarulhos.

IATA assigned exclusively to the Complainant the international airport code “GRU” (Annex 5 to the Complaint) which is largely used in the identification of the airport which receives monthly more than 20,000 flights and 3,000,000 passengers.

According to the Complainant the disputed domain name is identical to its various trademark registrations for GRUAIRPORT (Annex 6 to the Complaint) and was clearly created to take profit of the international airport code “GRU” which was exclusively assigned to the Complainant’s airport by IATA.

As to the lack of rights or legitimate interests in respect of the disputed domain name, the Complainant asserts that:

- (i) there is no evidence of the Respondent’s use of, or demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services;
- (ii) the Respondent as an individual, business or other organization has not been commonly known by the disputed domain name, and
- (iii) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

Moreover, the Complainant contends that its GRUAIRPORT trademark is so unique that the registration of the disputed domain name was done clearly in bad faith given the extent and well-known character of the Complainant’s trademark which the Respondent could not simply be unaware of. Furthermore, the disputed domain name has been passively held, what has already been found as an indication of bad faith use of domain names that consist of well-known trademarks.

Lastly, the Complainant argues that the use of a proxy/privacy registration service by the Respondent is an indicative of the Respondent’s bad faith, preventing interested parties to know its true identity and contact details.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

(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.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present so as to have the disputed domain name transferred to it, according to paragraph 4(i) of the Policy.

In accordance with paragraph 14(a) of the Rules, if the Respondent, in the absence of exceptional circumstances, does not submit a Response the Panel shall decide the dispute based upon the Complaint.

### **A. Identical or Confusingly Similar**

The Complainant has established rights in the GRUAIRPORT trademark, duly registered in Brazil.

The Panel notes that the registration date of the disputed domain name predates the filing date of the Complainant's trademark registrations in 8 days.

The Panel further notes that the International Airport of São Paulo, inaugurated in 1985, was initially administered by the Brazilian authorities and only in the year 2012 was taken over by a private company, the Complainant, with ample media coverage of this event. Moreover, and in addition to that, the use of the GRU acronym for the International Airport of São Paulo had been previously established by IATA and the Complainant owns the domain name <gru.com.br> which was registered in 2007.

In view of that the Panel is in accordance with the consensus ascertained in the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions](#), Second

Edition (“WIPO Overview 2.0”) that “the registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the UDRP” ([paragraph 1.4](#)).

The Panel thus finds that the disputed domain name <gruairport.com> merely reproduces the Complainant’s mark and, therefore, is identical or confusingly similar to the Complainant’s trademark. The first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate the Respondent’s rights to or legitimate interests in the disputed domain name. These circumstances are:

(i) before any notice of the dispute, the Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it has not acquired trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy or otherwise, any rights to and/or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden is still on the Complainant to first make a *prima facie* case against the Respondent.

In that sense, the absence of any indication that the Respondent owns registered trademarks or trade names corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent, corroborate the Panel’s finding of the absence of rights or legitimate interests.

Another element to consider is the fact that no active use of the disputed domain name appears to have taken place, which makes it even more difficult to

conceive which rights or legitimate interests the Respondent would have in a domain name that reproduces in its entirety the Complainant's trademark.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

### **C. Registered and Used in Bad Faith**

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant who is the owner of the trademark relating to the disputed domain name or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed 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 disputed domain name primarily for the purpose of disrupting the business of the Complainant; or

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

Past UDRP panels have already dealt with the question of whether the "passive holding" of a domain name could constitute bad faith. [Paragraph 3.2 of the WIPO Overview 2.0](#) states that "[...] panels have found that the apparent lack of so-called active use (*e.g.*, to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative

of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of its identity".

In the present case, the passive holding of the disputed domain name by the Respondent amounts to the Respondent acting in bad faith in view of the following circumstances:

(i) the Complainant's trademark relates to the international airport that services the city where the Respondent is located and, therefore, the Respondent could not allege being unaware of the Complainant and its trademark;

(ii) the Complainant's trademark is certainly well-known at least in São Paulo, where Respondent is located;

(ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name;

(iii) taking into account all of the above (as the panel did in *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#)), it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, "such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law" (see *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra*).

The fact that the registration of the disputed domain name predates in 8 days the date of filing of the Complainant's trademark does not change the Panel's conclusion of bad faith registration given that the use of the "GRU" acronym in connection with the international airport in the city of São Paulo, administered by the Complainant and identified by the trademark GRUAIRPORT, had long before been established by IATA, the international association that regulates air transport. The Panel further notes that the signing of the concession agreement which founded the Complainant took place on June 14, 2012, *i.e.*, before the registration of the disputed domain name. The Panel notes that such event had ample media coverage and finds that, given the overall circumstances of the case, it is plausible to find that the Respondent targeted the Complainant when registering the disputed domain name.

Also, the use of a privacy protection service by the Respondent contributes to a finding of bad faith since the Respondent has taken active steps to conceal its true identity, by choosing to operate under a privacy shield/privacy protection service.

As already mentioned, the Respondent did not file any formal response to the Complaint, failing thereby to invoke any circumstance which could demonstrate its good faith in the registration and use of the disputed domain name.

For the reasons stated above, the Respondent's conduct amounts, in this Panel's view, to bad faith registration and use pursuant to paragraph 4(a)(iii) 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, <gruairport.com>, be transferred to the Complainant.

Wilson Pinheiro Jabur

Sole Panelist

Date: July 22, 2016