

ADMINISTRATIVE PANEL DECISION

Procaps S.A. v. Thomas Guldager

Case No. D2022-4174

1. The Parties

The Complainant is Procaps S.A., Colombia, represented by Muñoz Abogados S.A.S., Colombia.

The Respondent is Thomas Guldager, United States of America (“U.S.”).

2. The Domain Name and Registrar

The disputed domain name <procapgroups.com> is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed in Spanish with the WIPO Arbitration and Mediation Center (the “Center”) on November 3, 2022. On November 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 7, 2022, 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 in English and Spanish to the parties on November 8, 2022 regarding the language of the proceeding, as the Complaint has been submitted in Spanish and the language of the registration agreement for the disputed domain name is English. The Respondent did not comment on the Language of Proceedings.

The Center sent an email communication to the Complainant on November 8, 2022 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 translated into English on November 17, 2022.

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 November 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 12, 2022.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on December 15, 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.

4. Factual Background

The Complainant is a developer of pharmaceutical and nutraceutical solutions, medicines, and hospital supplies.

The Complainant is the owner of several PROCAPS (and design) trademark registrations in Colombia, including registration Nos. 225417, 225416, 282312 and 282314, covering products and services in classes 3, 5, 42 and 44, respectively.

In addition, the Complainant registered the following domain names, all of them related to the PROCAPS trademarks:

- <procapsgroup.com>
- <procaps.com.co>
- <procapslaboratorios.com>
- <grupoprocaps.com>

The disputed domain name was registered on June 4, 2022, and resolves to an inactive site.

5. Parties' Contentions

A. Complainant

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the disputed domain name is confusingly similar to the PROCAPS trademark registrations of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the disputed domain name.

Third, the Complainant submits that the disputed domain name was registered and is being used in bad faith.

With respect to bad faith, the Complainant states that:

- the disputed domain name is currently being used to create emails accounts, in order to scam people by contacting them and posing as official members of the Complainant, since the disputed domain name is identical to the Complainant trademark, only deleting the "s" letter from the PROCAPS trademark.
- as the disputed domain name above mentioned is almost identical to the trademarks that the Complainant has registered in Colombia, because it contains the word "Procap", Internet users are in high

risk of confusion and fraud, since they could attribute it to the official Procaps company, which is the owner of the trademark but the disputed domain name does not lead to any of its official web pages.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which a complainant must satisfy in order to succeed. The Complainant must satisfy that:

- (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

The first element that the Complainant must establish is that the disputed domain name is identical or confusingly similar to the Complainant's trademark. The Complainant holds several valid trademark registrations for PROCAPS.

The disputed domain name contains almost entirely the trademark PROCAPS (without an "s") of the Complainant with the addition of the term "group". Since the trademark of the Complainant is included in the disputed domain name without the final letter "s", this is sufficient to establish that the disputed domain name is confusingly similar to the Complainant's trademark. The addition of other terms does not prevent a finding of confusing similarity under the first element.

The Panel finds the first element of the Policy has therefore been met.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the disputed domain name:

- "(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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 or service mark at issue."

There is no evidence of the existence of any of those rights or legitimate interests in this case.

The Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or its trademarks. The Complainant has prior rights in the trademarks, which precede the Respondent's registration of the disputed domain name.

Moreover, the Complainant has asserted that at the time of filing the Complaint, the disputed domain name was being used to create email accounts, in order to scam people by contacting them and posing as official members of the Complainant. The Panel cannot confirm this, since no evidence was provided in relation to these allegations. Nevertheless, given the circumstances, it is the view of the Panel, that the inactive use of the disputed domain name by the Respondent does not qualify as a *bona fide* offering of products or services.

The Complainant has therefore established a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and thereby shifted the burden to the Respondent to produce evidence to rebut this presumption. The Respondent has failed to rebut the Complainant's *prima facie* case.

Therefore, the Panel finds that the Complainant has satisfied the second requirement of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove both that the disputed domain name was registered and used in bad faith.

The Complainant's allegations with regard to the Respondent's registration and use of the disputed domain name in bad faith have been considered by the Panel. The Respondent has not contested these allegations.

There is no doubt that the Respondent was aware of the Complainant's trademark when it registered the disputed domain name given that at the time of filing the Complaint, the Complainant owned the domain name <procapsgroup.com>.

The disputed domain name resolves to an inactive page. Previous UDRP panelists have found that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the WIPO Overview of Panel Views on Selected UDRP Questions, Third Edition).

The Panel finds the following factors relevant in applying the passive holding doctrine: (i) the high degree of distinctiveness or reputation of the Complainant's mark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the implausibility of any good faith use to which the disputed domain name may be put.

Therefore, the Panel concludes that the Complainant has made out its case that the disputed domain name was registered and used in bad faith and has satisfied the third limb of the Policy, under paragraph 4(a)(iii).

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 <procapgroups.com> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: December 30, 2022