

ADMINISTRATIVE PANEL DECISION

Petróleo Brasileiro S.A. - Petrobrás v. Glauco Ninomiya
Case No. D2023-0184

1. The Parties

The Complainant is Petróleo Brasileiro S.A. - Petrobrás, Brazil, represented by Vaz e Dias Advogados & Associados, Brazil.

The Respondent is Glauco Ninomiya, Brazil.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 13, 2023. On January 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 17, 2023, 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 January 18, 2023, providing the registrant and contact information disclosed by the Registrar, and requesting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on January 19, 2023.

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”).

The Respondent sent an informal email to the Center on January 24, 2023, expressing his intention to cooperate and cancel the registration of the disputed domain name.

The Center sent an email to the Complainant informing that pursuant to the Rules, paragraph 17, a UDRP proceeding may be suspended to implement a settlement agreement between the Parties. On January 26, the Complainant has expressed that it has no intention to settle.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 19, 2023. No formal Response was filed.

The Center appointed Erica Aoki as the sole panelist in this matter on March 6, 2023. 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 publicly held corporation founded in 1953 that operates in an integrated and specialized manner in the oil, natural gas, and energy industry.

The Complainant is currently one of the world's leaders in the development of advanced technology for oil exploration in deep and ultra-deep waters, being known as a multinational company of renown and recognition worldwide.

The Complainant owns more than forty trademark registration for PETROBRAS and its variations filed at the Brazilian Patent and Trademark Office since the 1950s (in addition to several other registrations for different marks), including a trademark registration that obtained a well-known trademark status in 2012. One of these registrations is the No. 002709007 registered on July 12, 1962.

The Complainant also owns several domain names in Brazil and abroad, such as the domain name <petrobras.com> registered on March 5, 1996.

The disputed domain name was registered on March 03, 2022 and resolves to a Registrar page offering it for sale. The Complainant has submitted evidence that it was offered for sale to the Complainant via email.

5. Parties' Contentions

A. Complainant

The Complainant is a publicly held corporation that operates in an integrated and specialized manner in the oil, natural gas, and energy industry, recognized worldwide for oil and natural gas exploration and production technology in ultra-deep waters.

The Complainant's investments totalize USD 8,8 billion with a Net Revenue of BRL 452,668 million and a Net Profit of BRL 106,668 million.

The Complainant was founded on October 3, 1953 and is the legitimate owner of numerous trademarks and domain names registrations bearing the word PETROBRAS in Brazil and abroad.

The Complainant contends that the disputed domain name reproduces the mark PETROBRAS in its entirety and thus is confusingly similar to the Complainant's trademark, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. The Respondent sent an informal email to the Center on January 24, 2023, expressing his intention to cooperate and cancel the registration of the disputed domain name.

6. Discussion and Findings

The Complainant is required to establish the requirements specified under paragraph 4(a) of the Policy:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in respect of which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Based on the facts presented by the Complainant, this Panel finds that the Complainant has established its rights in PETROBRAS trademark through registration and use. The Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark, as the disputed domain name includes the Complainant's mark in full, with only the addition of the word "digital", which does not prevent a finding of confusing similarity (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

B. Rights or Legitimate Interests

The Panel finds the following on record in this proceeding under the Policy:

The Respondent did not make any affirmative attempt to show any rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy indicates that a registrant may have a right or legitimate interest in a domain name if it uses the domain name in connection with a *bona fide* offering of goods or services prior to notice of the dispute. In this regard, the Respondent is in no way connected with the Complainant and has no authorization to use any of the Complainant's trademarks.

There is no evidence on record that the Respondent is or was commonly known by the disputed domain name as an individual, business, or other organization.

There is no evidence on record that 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 Complainant's trademark. On the contrary, the disputed domain name was offered for sale to the Complainant. Moreover, the Panel finds that the composition of the disputed domain names carries a high risk of implied affiliation (see section 2.5.1 of the [WIPO Overview 3.0](#)).

Thus, the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Panel therefore finds that the Complainant has established an un rebutted *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, under the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

This Panel concludes that the Respondent has registered the disputed domain name to sell it back to the Complainant.

The Complainant's trademark was registered before the registration of the disputed domain name, and it is evident from the Respondent's use of the disputed domain name that the Respondent knew of the Complainant's PETROBRAS trademark when registering the disputed domain name.

Furthermore, the Complainant's PETROBRAS trademark is distinctive and unique to the Complainant and has a formal recognition as a well-known trademark. It is therefore beyond the realm of coincidence that the Respondent chose the inherently misleading disputed domain name without the intention of invoking a misleading association with the Complainant.

The Panel finds that it is most likely that the Respondent was aware of the Complainant's rights in the PETROBRAS trademark at the time the disputed domain name was registered, indicating that such registration was made in bad faith.

Accordingly, and as also supported by the Panel's findings above under the second element of the Policy, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith under the Policy, 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 <petrobras.digital> be cancelled.

/Erica Aoki/

Erica Aoki

Sole Panelist

Date: March 20, 2023