

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Legião Urbana Produções Artísticas Ltda. and Giuliano Manfredini v. Domain Admin, Epik.com Private Registration / Yoko Sayuri

Case No. D2013-1855

1. The Parties

Complainants are Legião Urbana Produções Artísticas Ltda. and Giuliano Manfredini, of Rio de Janeiro, Brazil, represented by Montauray Pimenta, Machado & Vieira de Mello, Brazil.

Respondent is Domain Admin, Epik.com Private Registration, of Bellevue, Washington, United States of America / Yoko Sayuri, of Tortola, British Virgin Islands, United Kingdom of Great Britain and Northern Ireland (“United Kingdom”).

2. The Domain Name and Registrar

The disputed domain name <renatorusso.com> is registered with Epik, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 30, 2013. On October 31, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 5, 2013, 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 Complainants on November 6, 2013 providing the registrant and contact information disclosed by the Registrar, and

inviting Complainants to submit an amendment to the Complaint. Complainants filed an amended Complaint on November 6, 2013.

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(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on November 11, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was December 1, 2013. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on December 3, 2013.

The Center appointed Roberto Bianchi as the sole panelist in this matter on December 6, 2013. 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

Renato Manfredini Júnior, known by the pseudonym Renato Russo, was a famous Brazilian singer and songwriter, and one of the founders of the rock band Legião Urbana in Brasilia in 1982. Renato Russo died in 1996. Legião Urbana was one of the most important rock bands in Brazil. The rock band remained active until 1996, and sold over 20 million albums. Still today, EMI Music sells a yearly average of 250,000 copies of Legião Urbana albums.

The first Complainant is Legião Urbana Produções Artísticas Ltda., a Brazilian company founded in 1987 to manage the activities and assets related to the rock band. The second Complainant, Giuliano Manfredini, the only son and heir of Renato Manfredini Júnior, is the main partner and administrator of the first Complainant.

The first Complainant owns the following Brazilian registrations for the trademark RENATO RUSSO:

- Reg. No. 813737168, Reg. Date July 25, 1989, filed on September 16, 1987, covering goods of International Class 9;
- Reg. No. 822180308, Reg. Date August 8, 2006, filed on November 8, 1999, covering services of International Class 38;
- Reg. No. 822180316, Reg. Date August 8, 2006, filed on November 8, 1999, covering services of International Class 41;
- Reg. No. 829943250, Reg. Date February 22, 2011, filed on August 25, 2008, covering phone sets in general, computer equipment such as pen drives, memory cards, audio books, song books, etc., of International Class 9; and
- Reg. No. 829943269, Reg. Date February 22, 2011, filed on August 25, 2008, covering musical instruments, their components and accessories, of International Class 9.

The disputed domain name was registered on December 6, 2012.

According to a printout dated October 30, 2013, submitted with the Complaint, the disputed domain name resolves to the “www.renatorusso.com” website. The website’s main page shows, under a legend stating “This premium domain name may be listed for sale. Click here to inquire”, the title “Renatorusso.com”. The web page lists the following “related links” (in Portuguese): “4Shared Download”, “Music”, “CDs Free Download,” “Free music for listening,” “Free Music Mp3”, “Music Sites”, “Free Games”, etc.

A similar content was found by the Panel during its independent visit to the “www.renatorusso.com” website conducted on December 16, 2013.

5. Parties’ Contentions

A. Complainants

In their Complaint, Complainants contend as follows:

The disputed domain name reproduces the entirety of the trademark RENATO RUSSO, in which the first Complainant holds rights, with the mere addition of the generic top-level domain (gTLD) “.com”, which is insufficient to escape a finding of confusing similarity. The disputed domain name also reproduces the artistic pseudonym “Renato Russo”, whose image rights are managed by the Second Complainant, Mr. Giuliano Manfredini. Therefore, Complainants have established the first element of the paragraph 4(a) of the Policy.

Respondent has no registration and/or application for the trademark RENATO RUSSO before the Brazilian Patent and Trademark Office. Complainants have no relationship whatsoever with Respondent and have never authorized Respondent to use the disputed domain name or any other domain name reproducing its trademark RENATO RUSSO. Complainants’ mark is very well known worldwide, and it has been registered and used much longer before Respondent registered the disputed domain name. Respondent is not commonly known or identified by the expression “Renato Russo”. The WhoIs records show that Respondent is “Epik.com Private Registration”. Respondent does not make a legitimate use of the disputed domain name. At the time this Complaint was filed, the disputed domain name was being used to host pay-per-click advertising websites that enable illicit download of songs and albums and, therefore, infringe Complainants’ copyrights. Thus, in view of the above, Complainants have established the second element of the paragraph 4(a) of the Policy.

The disputed domain name was registered and is being used in bad faith. When Respondent registered the disputed domain name, Complainants had long registered the trademark RENATO RUSSO. At the time the Complaint was filed, the disputed domain name was being used to host pay-per-click advertising websites that enable the illicit downloading of songs and albums, thus infringing Complainants’ copyrights. Offering links to infringing content is clearly not a legitimate or noncommercial use of the disputed domain name. This is clear evidence that Respondent acted in bad faith when registering and

using the disputed domain name, by intending to intentionally attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainants' trademark RENATO RUSSO. Complainants' trademark RENATO RUSSO is very famous worldwide, and specially in Brazil, where Complainants are located. It is clear that Respondent was aware of Complainants' rights in the trademark and artistic pseudonym RENATO RUSSO, when it registered and began using the disputed domain name.

B. Respondent

Respondent did not reply to Complainants' contentions.

6. Discussion and Findings

Under Policy, paragraph 4(a), a complainant must make out its case that:

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

With printouts of registration data taken from the database of the Brazilian Instituto Nacional da Propriedade Industrial (INPI), Complainants have shown to the satisfaction of the Panel that the first Complainant owns trademark rights in the RENATO RUSSO trademark. See section 4 above.

Since the disputed domain name consists of the RENATO RUSSO trademark in its entirety, only adding the “.com” gTLD, the Panel finds that the disputed domain name is identical to a mark in which Complainants have rights. Accordingly, the first requisite of the Policy is met.

B. Rights or Legitimate Interests

Complainants contend that Respondent has no registration and/or application for the trademark RENATO RUSSO before the Brazilian INPI. Complainants add that they have no relationship whatsoever with Respondent and have never authorized Respondent to use the disputed domain name or any other domain name reproducing its trademark RENATO RUSSO. Complainants also say that their mark is very well known worldwide, and it has been registered and used much longer before Respondent registered the disputed domain name. Complainants further state that Respondent is not commonly known by the expression “Renato Russo”, and that the WhoIs records show that Respondent is “Epik.com Private Registration”. Complainants conclude that Respondent does not make a legitimate use of the disputed domain name because at the time the Complaint was filed, the disputed domain name was being used to host pay-per-click advertising websites that enable illicit download of songs and albums and, therefore, infringe Complainants’ copyrights.

In the opinion of the Panel, these contentions and supporting evidence (none of which have been contested by Respondent), amount to a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name.

It is the consensus view of UDRP panels that once a *prima facie* case is made, a respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. See [paragraph 2.1. of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition](#) (“WIPO Overview 2.0”). Since Respondent is in default and has not submitted any comments or evidence whatsoever in its own favor, the Panel concludes that Respondent lacks any rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Complainants have shown that their first registration of the RENATO RUSSO trademark was obtained in 1987, while the disputed domain name was registered on December 6, 2012. Moreover, nearly all the “related links” listed on the website at the disputed domain name are related to music and music downloads, a fact that can only be explained because Renato Russo was a Brazilian musician, singer and

composer, and that Internet users might click on these links once they are arrived at the website attracted by the name of the well-known musician. Finally, the statements shown on this website that “a great name like RenatoRusso.com can pay for itself many times over”, and that “the premium marketplace at DomainNameSales.com only features rare and brandable names like RenatoRusso.com”, lead the Panel to conclude that Respondent, when it registered the disputed domain name, did not simply choose a name composed of the common Italian first name “Renato” and the also common “Russo” Italian family name, but aimed precisely at the well-known Brazilian artist. This means that Respondent, more likely than not, was aware of, and targeted, Complainants’ RENATO RUSSO trademark when it registered the disputed domain name, which indicates registration in bad faith.

As to use in bad faith, Complainants have shown that the website at the disputed domain name contains various links offering free music downloads. Although in the opinion of the Panel Complainants have not evidenced that these links “enable the illicit downloading of songs and albums, thus infringing Complainants’ copyrights”, as they contend in the Complaint, the Panel is satisfied that Complainants’ evidence at least does show that Respondent is using the RENATO RUSSO trademark to attract Internet users looking for content pertaining or related to the well-known Brazilian artist, to lure them into clicking on these related links to generate click-through income, and thus profiting from the confusion created among those Internet users. In this Panel’s assessment, this is sufficient proof of registration and use in bad faith of the disputed domain name pursuant to Policy, paragraph 4(b)(iv) (“by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”)

Accordingly, the Panel concludes that the third requirement of the Policy is met.

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 <renatorusso.com> be transferred to the first Complainant.

Roberto Bianchi

Sole Panelist

Date: December 16, 2013