Panel Decision for dispute CAC-ADREU-007703

Case number	CAC-ADREU-007703
Time of filing	2020-02-06 18:05:45
Domain names	ROCCOBAROCCO.eu

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Barocco Roma srl

Respondent

Name	Virginie Trottier

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

There are no other legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is BAROCCO ROMA SRL, ROCCO BAROCO, an Italian fashion company created by Rocco Barocco. Mr. Barocco was born Rocco Muscariello and started creating clothes under the Rocco Barocco name in 1968. He established his namesake brand, RoccoBarocco, in 1977, designing and selling ready-to-wear clothes for women, men, and children. He celebrated in 2018 the 50th anniversary of his company with a fashion show at the Archaeological Museum of Naples, the city of his birth, which featured models spanning a half-century.

RoccoBarocco clothes have been featured in fashion magazines, and actresses and television personalities have been wearing ROCCOBAROCCO CLOTHES. Mr. Barocco also designed the uniform of the female members of the Carabinieri police corps.

The Complainant is the owner of several registered trademarks such as:

- The international trademark “ROCCOBAROCCO” n°483398 registered on February 29, 1984 and duly renewed since then;
- The EU trademark “ROCCOBAROCCO” n°574251, filed on December 24, 1996, registered on December 17, 1998 and duly renewed since then;
- The EU trademark “RB ROCCOBAROCCO” n°4088829 filed on October 26, 2004 and registered on October 20, 2008 and duly renewed since then.

The Complainant submitted as evidence of the Italian Trademark Registration ROCCOBAROCCO number 321101 a certificate of the Italian Minister of Development, issued on June 12, 2019, in Italian without translation to English. Article A 3 (c) of ADR Rules provides that all documents relating to the ADR Proceeding have to be in the language of the ADR Proceeding (or accompanied by a translation into that language) or in a different requested language if the Complainant proves in his submission that the Respondent has adequate knowledge of such different language. The Panel may disregard documents submitted in other languages than the language of the ADR Proceeding without requesting their translation. The purpose of such language rule is to keep both parties in equal footing.

Therefore, the Panel decides to disregard the above-mentioned certificate. The Panel was not able to find the Italian Trademark Registration ROCCOBAROCCO number 321101 in the WIPO global brand database either.

The Complainant indicated in his Complaint that his official website is <roccobarocco.it>, but did not provide further information about it,

such as the date of registration of the <roccobarocco.it> domain name. As Paragraph B 7 (a) of the ADR Rules expressly allows panels to conduct independent investigations at their own discretion, the Panel verified that the Complainant indeed owns the <roccobarocco.it> domain name first registered on February 2, 2002 and duly renewed since then.

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

A. COMPLAINANT

The Complainant considers that the disputed domain name <roccobarocco.eu> is confusingly similar to its "ROCCOBAROCCO" and "RB ROCCOBAROCCO" trademarks. The Complainant argues that the disputed domain name is identical to its registered trademarks, and that it incorporates them in their entirety, without any additional element to differentiate the disputed domain name from the Complainant's trademarks.

The Complainant argues that the "ROCCOBAROCCO" mark is fanciful and that it is the name under which the designer of ROCCOBAROCCO is known, that the "Barocco" surname is not common as there are only approximately 624 persons in the world with such a surname and, therefore, it is unlikely that the disputed domain name was registered by a registrant having "Barocco" as a surname, and that such homonymy is unlikely to be coincidental.

The Complainant alleges that the Respondent has no right or legitimate interests in the disputed domain name. The Complainant states that he is not aware of any other undertaking, organization or natural person that is commonly known by the name "roccobarocco.eu", that the Respondent's email address does not contain the term "RoccoBarocco", that the ROCCOBAROCCO trademark is only registered by the Complainant, and that the Respondent has not been authorized by the Complainant to use its trademark.

The Complainant also argues that the disputed domain name has not been used in connection with the offering of goods and services, or preparation thereof, prior to any notice of an alternative dispute resolution procedure. Instead, the name is being used in connection with a parking page featuring pay-per-click links and where the disputed domain name is offered for sale.

The Complainant also states that the pay-per-click links on the website towards which the disputed name is pointing are related to the Complainant's activities, and that, therefore, Internet users interested in the Complainant's products may be diverted to third party websites, with the result that the number of visitors to the Complainant's official website <roccobarocco.it> would decline.

The Complainant also states that the page towards which the disputed domain name is pointing offers the domain name for sale and that, when the Complainant offered to buy it for a price equivalent to the cost of registering and renewing the domain, the Respondent quoted a much higher price as a counteroffer.

The Complainant finally alleges that the disputed domain name was registered in bad faith, and with the intent to confuse and to divert the Complainant's current or potential clients to third party websites, and that bad faith is also shown by the particularly high amount quoted as a price of the domain name.

B. RESPONDENT

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

DISCUSSION AND FINDINGS

In consideration of the Factual Background, the Parties' Contentions stated above and its own web searches, the Panel comes to the following conclusions:

Paragraph B 7 (a) of the Rules provides that the Panel "shall conduct the ADR Proceeding in such manner as it considers appropriate in accordance with the Procedural Rules. The Panel is not obliged, but is permitted at its sole discretion, to conduct its own investigations on the circumstances of the case."

Pursuant to ADR Rules paragraph B 11 (d) "Basis for decision",

"The Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves

(1) in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated that:

(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or European Union law and either

(ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii) The domain name has been registered or is being used in bad faith".

A. The disputed domain name is identical or confusingly similar to Complainant's trademarks

Article 21 (1) of COMMISSION REGULATION (EC) No 874/2004 requires that the Complainant shows that the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or European Union law.
The Complainant has duly shown valid trademark rights for the signs "ROCCOBAROCCO" and "RB ROCCOBAROCCO".

First, the disputed domain name <roccobarocco.eu> fully incorporates the Complainant's trademark ROCCOBAROCCO. Also, aside from the Top-Level Domain (TLD) <.eu>, the disputed domain name is identical to the Complainant's domain name <roccobarocco.it>.

Second, it is commonly established that the addition of the TLD<.eu> must disregarded when comparing the trademark and the disputed domain name. See for example Bayer AG v. Zheng Qingying, CAC 4661: "The top level domain <eu> should be left out of the comparison, as this part is technically required." See also Jack Wolfskin Ausrüstung für Draussen GmbH & Co. KGaA v. THD Concept, CAC 5235, <jackwolfskin.eu>: "the top-level domain "(dot)eu" must be disregarded when comparing trademarks and domain names, due to its importance, acknowledged by the market, as an essential component of a domain name."

The Panel finds that the disputed domain name <roccobarocco.eu> is confusingly similar to the Complainant's trademarks "ROCCOBAROCCO" and "RB ROCCOBAROCCO".

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service trademark in which the Complainant has rights. The requirement of Paragraph B11(d)(1)(i) of the ADR Rules is therefore met.

B. The disputed domain name has been registered without rights or legitimate interests in the name

Article 21 (1)(a) of COMMISSION REGULATION (EC) No 874/2004 requires that the Complainant show that the disputed domain name has been registered without rights or legitimate interests in the name.
The Complainant is required to make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the prima facie case is successful, then the burden of proof shifts to the Respondent.

The Complainant contends that it did not grant any authorization to the Respondent to use its trademark, and that the Respondent is not affiliated to it. The Complainant has no activity or business in common with the Respondent. Furthermore, the Complainant contends that it did not grant any license or authorization to the Respondent. Thus, the Complainant considers that the Respondent has no right or legitimate interest to use its trademark.

Panel finds that the Respondent has no right or legitimate interests in the sign "ROCCOBAROCCO", which is a fanciful mark, the name of the Complainant and the chosen name of the Complainant's head designer, under which he is publicly known for more than 50 years. Also, while the Respondent registered the domain name anonymously, the identity of the Respondent has been revealed by the registrar upon filing of this case. The Respondent's name is "Virginie Trottier". While this may not be the true identity of the Respondent, since the mailing address indicated is obviously false, as "90032" is not a zip code for Strasbourg, France, the fact that "Virginie Pottier" may not be the Respondent is irrelevant, as it is enough to state that the Respondent's name is not Rocco Barroco or a variation thereof.

Likelihood of confusion can easily occur when searching for the Complainant's official website, since only the TLD differs from the Complainant's domain name <roccobarocco.it> and the Respondent's domain name <roccobarocco.eu>.
The disputed domain name is pointing to a parking page with pay-per-click links in relationship with the Complainant and the Complainant's activities ("RoccoBarocco", "RoccoBarocco Bags"), and with the Complainant's competitors ("Moschino Bags"). As such, Internet users may be drawn to competitors' products mistakenly believing them to be associated with the Complainant.
Moreover, the fact that the disputed domain name points to a parking page with pay-per-click links and offering the domain name for sale further shows that the Respondent intends to sell the domain name rather than using it for his own legitimate purposes. See for

example ABAT AG vs. Georg Gottfried, CAC 3976. See also Benefit Cosmetics LLC, Christophe LeBoterff v. Domain Master, CAC 6295: ("Providing links to other commercial web-sites unrelated to the Respondent's business in this way does not amount to a genuine offering of goods and services and does not generate rights or legitimate interests.")
Panel finds that the Respondent lacks rights and legitimate interests in the disputed domain name. The Respondent's use does not constitute a bona fide offering of goods and services nor a legitimate non-commercial or fair use.

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name. The requirement of Paragraph B11(d)(1)(ii) of the ADR Rules is therefore met.

C. Bad faith

Article 21 (1)(b) of COMMISSION REGULATION (EC) No 874/2004 requires that the Complainant show that the disputed domain name has been registered or is being used in bad faith. The aforementioned regulation request only one of the requirements to be fulfilled. The Panel nevertheless assessed both legitimate interest in the domain name and bad faith use or registration.

The issue of whether the Respondent had knowledge of the Complainant and its ROCCOBAROCO trademark, when he registered and used the disputed domain name is relevant to the finding of bad faith. See for example Alterian Technology Limited v. Paul McGowan, CAC 4296.

The Complainant registered its official domain name many years ago and has used the sign "ROCCOBAROCCO" for many years, and many times, before the Respondent registered the disputed domain name. Given the fact that the Complainant has been using the ROCCOBAROCCO trademark for many years, that the designer of the goods has been known as Rocco Barocco for more than 50 years, that the name Rocco Barocco is not common, as only a few hundred people have been found to have "Barocco "as their surname, that the disputed domain name points to a parking page with commercial links referring to the Complainant and the Complainant's goods, the Respondent could not have ignored the Complainant's existence.

It is the Panel's view that the Respondent had the Complainant and the Complainant's trademarks in mind when he registered the disputed domain name, and that he selected this domain name to take advantage of the Complainant's reputation and good will.

The Respondent intentionally used the Complainant's trademark "ROCCOBARROCCO" to divert Internet users to his own website featuring pay-per-click links in relationship with the Respondent and the Respondent's activities.

The Panel finds this fact enough to declare that that the domain name was used to attract Internet users by creating a likelihood of confusion with the Complainant's trademarks, for either direct or indirect commercial gain of the Respondent. The Panel finds that such use shows bad faith and the intention to create a risk of confusion.

Also, the disputed domain name is offered for sale on the parking page. When the Respondent made an offer to buy the domain name for 90 Euros, the Respondent made a counteroffer for 7,000 Euros, which far exceeds the cost of registering and renewing the domain name. As such it appears that the Respondent registered the domain name to resell it for a price far exceeding the cost of registration and renewal, which is indicative of bad faith.

The Complainant has shown that the domain name was registered in bad faith and thus the burden of proof shifts to the Respondent. However, the Respondent has not come forward with any justification for his selection and registration of the disputed domain name, as he failed to respond to the Complainant's contentions. This lack of response is usually perceived by Panels as an indicative element of bad faith. See Statoil ASA v. Johnsons Associates, WIPO case No. D2015-0043: "the fact that no response to the Complaint has been filed indicate that the Respondent has registered and is using the disputed domain name in bad faith".

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name was registered and is being used in bad faith. The requirement of Paragraph B11(d)(1)(iii) of the ADR Rules is therefore met.

DECISION

Having established all three elements prescribed by the COMMISSION REGULATION (EC) No 874/2004, the Panel concludes that relief shall be granted, without prejudice to a future judicial decision.

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the ADR Rules, the Panel orders that the domain name <roccobarocco.eu> be transferred to the Complainant.

PANELISTS

Name	Nathalie Dreyfus

DATE OF PANEL DECISION 2020-02-05

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: [ROCCOBAROCCO.EU]

II. Country of the Complainant: [ITALY], country of the Respondent: [FRANCE]

III. Date of registration of the domain name: [27 October 2011]

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. [word] trademark registered in [Italy], reg. No. [321101], for the term [ROCCOBAROCCO], filed on [14 September 1979], registered on [14 March 1980] in respect of goods and services in classes [9,14,18,20,24,25,42]
2. [word] International trademark designating [Austria, Bosnia and Herzegovina, Benelux, Switzerland, Germany, Egypt, Spain, Croatia, Monaco, Montenegro, North Macedonia, Serbia and Slovenia], reg. No. [483398], for the term [RB ROCCOBAROCCO], filed on [29 February 1984], registered on [29 February 1984] in respect of goods and services in classes [3, 9, 14, 18, 19, 25,35]
3. [word] CTM, reg. No. [574251], for the term [ROCCOBAROCCO], filed on [01 March 1999], registered on [24 December 1996] in respect of goods and services in classes [3, 9, 14, 18, 19, 25, 41]
4. [word] CTM, reg. No. [4088829], for the term [RB ROCCOBAROCCO], filed on [26 October 2004], registered on [20 October 2008] in respect of goods and services in classes [3, 9, 14, 18, 19, 25, 35]
5. geographical indication:
6. designation of origin:
7. unregistered trademark:
8. business identifier:
9. company name:
10. family name:
11. title of protected literary or artistic work:
12. other:

V. Response submitted: [No]

VI. Domain name/s is/are [identical] to the protected right/s of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. [No]
2. Why:

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. [Yes]
2. Why:

IX. Other substantial facts the Panel considers relevant:

X. Dispute Result: [Transfer of the disputed domain name]

XI. Procedural factors the Panel considers relevant:

XII. [If transfer to Complainant] Is Complainant eligible? [Yes/No]