Panel Decision for dispute CAC-ADREU-004049

Case number	CAC-ADREU-004049
Time of filing	2007-01-19 14:33:09
Domain names	bormiolirocco.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	BORMIOLI ROCCO E FIGLIO SPA, Giovanni Angela

Respondent

Organization / Name	Inames UK

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

The Panel is not aware of any pending legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The domain name bormiolirocco.eu was registered on April 9, 2006 by Inames UK located at 119 Chapel Way, KT18 5TB Epsom Downs, Surrey, UK.

A. COMPLAINANT

The Complainant contends that the “domain name roccobormioli.eu” (rectius bormiolirocco.eu since the domain name mentioned by error in the text of the complaint is still available for registration) is likely to be confused with the ROCCO BORMIOLI trademarks in which the Complainant holds rights.
The Complainant informs the Panel that the company was founded in 1825 as a small company bearing the name of its founder and owner Mr. Rocco Bormioli and today is one of the leading companies in Italy.
The Complainant is the owner over fifty trademark registrations for the BORMIOLI ROCCO brand in more than seventy countries including the following trademarks:
- the Italian BORMIOLI ROCCO trademark granted for the first time with no. 336.850 on 28.5.1984 following application no. MO93C000208 filed on 10.9.1993, then again with application no. PR2004C000005 filed on 12.1.2004
- the international BORMIOLI ROCCO trademark no. 487.948, that constitutes a renewal of the identical trademark registered on 28.5.1984, extended to a large number of countries including Italy, Czech Republic and Slovakia and a further 40 countries many of which in Europe
- the community trademark 3606787 BORMIOLI ROCCO filed on 27.1.2004 and granted on 25.5.2005
The Complainant contends that the distinctive mark ROCCO BORMIOLI is also used in relation to web sites worldwide such as bormioliroccogroup.com, bormiolirocco.com, bormiolirocco.it, bormioliroco.net, bormioliroccoefiglio.com
The Complainant points out that the domain name bormiolirocco.eu was registered on April 6, 2006. The Registrant appears to be Inames UK Staff with principal office at 119 Chapel Way, KT18 5TB Epsom Downs, Surrey, UK. Il Registrant Inames UK Staff seems to be a subsidiary of Registrar Inames Co. Ltd. with principal office in Seoul, Republic of Korea.
The Complainant alleges that the Respondent has no right and legitimate interest in the name ROCCO BORMIOLI. The Complainant contests the fact that the Respondent registered the disputed domain name without having any right or legitimate interest in said name. Indeed the Respondent is not authorized or licensed to use the trademark of the Complainant, the Respondent is in no way connected to the Complainant and the Respondent does not appear to have any rights or legitimate interests in the name BORMIOLI ROCCO.
With reference to bad faith, the Complainant states that in the home page of the Respondent’s website, on the left hand side, above the sponsored links, there is the wording in Italian “richiedi informazioni riguardo questo dominio” (English translation: “request information regarding this domain”……) By clicking on this wording, the user accesses a form already set out for those interested in purchasing the

domain name.
The Complainant also contests the fact that the disputed domain name points to a web page that contains sponsored links, directing Internet users to websites selling i.a. various types of pornographic products.
The Complainant concludes that the domain name disputed has been registered and is firstly used to force the Complainant to purchase the same domain name (also only to prevent its own Bormioli Rocco trademark from being associated with a pornographic site) and, secondly, in order to benefit from the good reputation of the BORMIOLI ROCCO trademark to attract consumers who intend to reach the Complainant's site and who are directed to the on-line purchase of products sold by the sponsored sites.

B. RESPONDENT

Respondent did not reply to the Complaint and is in default.

DISCUSSION AND FINDINGS

The article 22 of the Regulation 874/2004 (hereinafter "the Regulation") states that an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21.
Article 21 (1) provides that a registered domain name shall be subject to revocation where the name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, and where:
(a) it has been registered by its holder without rights or legitimate interests in the name; or
(b) it has been registered or is being used in bad faith.

With reference to the first element, the Panel finds that the Complainant has proved its rights on the name BORMIOLI ROCCO within the meaning of the Article 10 (1) of the Regulation. Indeed the Complainant owns i.a the Italian trademark BORMIOLI ROCCO and the Community trademark BORMIOLI ROCCO.
With reference to the right or legitimate interest, the Article 21 (2) of the Regulations states that "a legitimate interest may be demonstrated where:
(a) prior to any notice of an ADR procedure, the holder of the domain name has used the domain name or a name corresponding to it in connection with the offering of goods or services or has made demonstrable preparation to do so;
(b) it has been commonly known by the domain name;
(c) it is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognised or established by national and/or community law.

There is no relation, disclosed to the Panel, between the Respondent and the Complainant and Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use Complainant's trademarks under any circumstance.
In the case at hand, the Respondent is in default and thus has not proved any right or legitimate interest. As stated in ADR Case N. 04040, "In the absence of a Response or any evidence showing a legitimate interest or fair use of the Domain Name by the Respondent, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name."
According to the Article 21(1) of the Regulation, the Complainant must prove that the disputed domain name has been registered by its holder without rights or legitimate interests in the name; or that it has been registered or is being used in bad faith. However, for the sake of completeness, the Panel will examine whether the contested domain name has been registered or is being used in bad faith.
Article 21 (3) (d) states that bad faith may be demonstrated where the domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognised or established by national law, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website.
The Panel finds the Article 21 (3) (d) to be applicable in this case since the disputed domain name was pointing to a sponsored pay per click web site aimed at directing visitors to competing third party commercial websites. The Panel notes that, at the time of the filing of the Complaint, the Respondent's website provided also links to porn websites. See i.a. ADR Case no. 2727.
Moreover the Panel finds that inserting a link in a prominent part of the home page redirecting the Internet users to a web page where it is stated "If you are interested in a possible purchase of this domain or would like to contact the owner, please fill in the following information and submit your message" is to be considered equivalent to an offer for sale. The Panel therefore finds that the Respondent registered the contested domain name also for the purpose of selling it. Such a conduct is an additional evidence of bad faith as set forth in the Article 21 (3 (a) of the Regulation (see i.a ADR Case n. 01644). .
In light of the above, the Panel concludes that the contested domain name has been used in bad faith.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name BORMIOLIROCCO be transferred to the Complainant

PANELISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2007-04-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is one of the largest glass manufactures in Italy. The Complainant contends that the domain name bormiolirocco.eu is likely to be confused with the ROCCO BORMIOLI trademarks in which the Complainant holds rights and that the Respondent has no right and legitimate interest in the name ROCCO BORMIOLI. With reference to bad faith, the Complainant states that in the home page of the Respondent's website, besides sponsored links is published a form set out for those interested in purchasing the domain name.
The Respondent registered domain name bormiolirocco.eu on April 6, 2006 and did not reply to the Complaint.

The Panel finds that the Complainant has proved trademark rights on the name BORMIOLI ROCCO within the meaning of the Article 10 (1) of the Regulation. The Respondent failed to provide grounds proving any legitimate interests it may have in registering and using the domain name.
As to the bad faith, the Panel finds the Article 21 (3) (d) to be applicable in this case since the disputed domain name was pointing to a sponsored pay per click web site aimed at directing visitors to competing third party commercial websites. The Panel regards the as additional circumstance evidencing bad faith a link published in a prominent part of the Respondent's home page, redirecting the Internet users to a form to submit a requests for the purchase of the domain name bormiolirocco.eu.
The Panel decided that the domain name bormiolirocco.eu shall be therefore transferred to the Complainant, in accordance with paragraph B12(b) and B(12)(c) of the ADR Rules.