Decision for dispute CAC-UDRP-100384

Case number	CAC-UDRP-100384
Time of filing	2013-10-30 16:17:40
Domain names	AERMACCHI.COM , AERMACCHIMILANO.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	FINMECCANICA S.p.A.

Complainant representative

Organization	desimone & partners

Respondent

Organization	GRUPO CANOSCI SL

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

Complainant holds trademark registrations for AERMACCHI and AERMACCHI MILANO.

In addition, Complainant has shown that the AERMACCHI name has been used as a trademark for planes at least since the year 1957.

Complainant's trademark rights long predate the creation date of the disputed domain names that were respectively registered on September 26, 2007 and on December 15, 2009.

FACTUAL BACKGROUND

Aermacchi is one of the oldest trademarks in the world aviation and aircraft business.

The original Macchi company, founded by Eugenio Macchi on May 1, 1913 in Varese, produced a famous line of high-speed flying-boats and seaplanes. Since then, the company has built over 7,000 aircraft including about 2,000 trainers for more than 40 countries. It was acquired by Finmeccanica in 2003 and now operates as a wholly-owned subsidiary of Alenia

Aeronautica. In 2006 it achieved 297 million Euros in sales.

Aermacchi is a well-known trademark, very famous in the aircraft sector. This circumstance was confirmed by the Court of Barcelona that in its decision issued on November the 10th 2008 has stated that AERMACCHI is a very famous trademark.

Aermacchi was the aircraft manufacturing company of the Aeronautica Macchi group and is today controlled by Finmeccanica S.p.A.,i.e. the Complainant.

The Respondent, Grupo Canosci SL, is Spanish whereas its founder Mr. Guido Canosci is Italian from Busto Arsizio (Varese).

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

Complainant affirms that:

Aermacchi is one of the oldest trademarks in the world aviation and aircraft business.

Aermacchi is a well-known trademark, very famous firstly in the aircraft sector (as it was the original field of interest and is now the actual sector of business), but also in the motorcycle sector, where they had a successful joint venture with Harley Davidson.

AERMACCHI is a well known name also on the internet as shown by the searches carried out in different languages which demonstrates the considerable number of entries in relation to Spain Germany UK and of course Italy

Aermacchi was the aircraft manufacturing company of the Aeronautica Macchi group and is today controlled by Finmeccanica S.p.A.. The plants at the Venegono (in the Varese area) airfield occupy a total area of 274,000 m2 (2,949,300 sq ft), including 113,000 m2 (1,216,300 sq ft) of covered space. The flight test center has a covered space of 5,100 m2 (54,900 sq ft) in a total area of 28,000 m2 (301,400 sq ft).

Since 1960, 2,000 Aermacchi (airplane) trainers have been bought by 40 countries.

Reputation of the mark is widespread everywhere, especially in Europe, despite the fact that Aermacchi’s kind of business is certainly a business where clients are either state administrations or very rich people.The Complainant points out that it is quite astonishing to find how the trademark is so popular and well recognized (especially over the web) notwithstanding the fact that it does not distinguish mass production goods.Part of this reputation is also due to the Frecce Tricolori (“the Tricolor Arrows”), the precision aerobatic demonstration team of the Italian Air Force that flies Aermacchi.

As regards the legal grounds Complainant claims:

1. that the disputed domain names, aermacchi.com and aermacchimilano.com, are identical to Complainant’s trademarks AERMACCHI and AERMACCHI MILANO.

2. that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Respondent is not known as Aermacchi and it is called CANOSCI Group. It is running a web site without any authorization or licence from the legitimate trademark owner.

The Respondent is running the Aermacchi web site through the contested domain names in order to divert users from Finmeccanica and Aermacchi sites to its own. The Respondent is doing that by inducing users into thinking that there is a connection or reference between the offered products on the Respondent’s web site with those more famous of Aermacchi.

There is no evidence that the Respondent is commonly known by the disputed domain name. As stated the Respondent has not been licensed or otherwise authorized to use any of the Complainant's trademarks or to apply for or use any domain name incorporating such trademarks.

The Respondent's community trademark registration for AERMACCHI MILANO in class 14, was cancelled following the decision of the OHIM Board of Appeal (February 25, 2013), where it was found that Canosci acted in bad faith when it filed the trademark AERMACCHI MILANO in class 14.

3. The disputed domain names have been registered and are being used by the Respondent in bad faith.

As to bad faith registration, when registering the disputed domain names, the Respondent was necessarily aware of the Complainant's well-known business and reputation in its specific sector.

The Respondent has intentionally sought to use the Complainant's marks in the disputed domain names to attract Internet users to websites and other on-line locations for commercial gain by confusing consumers as to sponsorship of the website. This constitutes bad faith within the meaning of paragraph 4(b) (iv) of the Policy. (WIPO Case No. D2000-1495, America Online, Inc. v. John Zuccarini).

The Respondent has also shown in its history a tendency to register famous trademarks of others. Besides AERMACCHI Respondent, Canosci, tried to register as a community trademark the ASTON MARTIN name and the Wheel Design similar to that one of Rotary. Both Aston Martin Lagonda and Rotary filed oppositions and the Respondent's trademark application was refused. The Respondent registered also the trademark AUSTONI Milano 1928.

The Complainant underlines that this is a sort of bad faith pattern applicable at the trademark level.

Even after the Board of Appeal decision in which the community trademark registration AERMACCHI was cancelled for bad faith, the Respondent is still the proprietor of the contested domain names and registered a new Spanish trademark AERMACCHI MILANO in the name of a person clearly connected with Grupo Canosci.

This is also clear proof of the persistent intention of the Respondent to own trademark and domain names comprising the AERMACCHI famous trademark.

RESPONDENT:

In brief Respondent affirms:

- that "they are Italian", and "they come from the Lombardy Region" of which Milan is the capital.

- that Grupo Canosci SL Director was born in Busto Arsizio (Varese), 16 km north of Milan, and that he has always lived in Lombardy and Milan.

- that Alenia Aermacchi is based in Venegono inferiore (Varese) and not Milan .

- that the real name of the Complainant is ALENIA AERMACCHI and not only AERMACCHI.

- that web designers use airplanes, cars and trucks just as a decorative element. There was therefore no meaning behind the use of an airplane image on Respondent's website.

In order to rebut the Complainant's claims the Respondent points out that:

The trademark "Austoni Milano 1928" bears no relation to the current issue and was duly registered and named after the Director's deceased mother, Mrs. Giuseppina Austoni, born in 1928 in Milan.

When Respondent's trademark was created, Alenia Aermacchi had no trademark registered.

To show a legitimate right to the disputed domain names the Respondent mainly relies on:

1) the copy of a Spanish trademark AERMACCHI filed in March 2013 and registered in July 2013 at OEPM Spain.

2) the assertion that the name Aermacchi was chosen after the nickname of the deceased father of the Company's Director.

RIGHTS

Paragraph 4(a) of the Policy lists three elements that Complainant must prove to merit a finding that the domain name registered by the Respondent be transferred to the Complainant:

The first element to prove is that the domain names are identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights;

Identical or Confusingly Similar

Complainant has established that it has prior rights in the trademarks AERMACCHI and AERMACCHI MILANO.

This Panel agrees with the Complainant's thesis and numerous previous decisions, which affirmed that the gTLD .com is a technical need and therefore the comparison between the disputed domain names and Complainant's trademarks must be done without considering the gTLD .com.

As a result, it clearly appears that in the present case the disputed domain names are identical to Complainant's trademarks.

This Panel therefore finds that the first requirement of paragraph 4(a) of the Policy is satisfied.

NO RIGHTS OR LEGITIMATE INTERESTS

The second element that Complainant must prove is that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Complainant must show that Respondent has no rights or legitimate interests in respect of the disputed domain names. Respondent in a UDRP proceeding does not assume the burden of proof, but may establish a right or legitimate interest in a disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy:
a) that before any notice to the respondent of the dispute, he or she used or made 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;
b) that the respondent is commonly known by the domain name, even if he or she has not acquired any trademark rights; or
c) that the respondent is making a legitimate, non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

To show a legitimate right to the disputed domain names the Respondent mainly relies on:

1) the fact that the name Aermacchi was chosen after the nickname of the deceased father of the Company's Director.

2) the copy of a Spanish trademark AERMACCHI MILANO La Gioielleria Tecnica and device filed in March 2013 and granted in July 2013 at OEPM Spain, registration number M 3068367.

As regards the first point, which was moreover not documented, this Panel is of the opinion that this simple allegation cannot be considered as proof of a legitimate interest in the disputed domain names.

As regards the second point, namely the Respondent's claim that it has rights or legitimate interests in the disputed domain names because it registered the trademark AERMACCHI in Spain in 2013, the Panel notes that: a) the registration data from the certificate of registration indicates that the registration was issued in July 2013 in the name of Canosci Pascual, Alberto David; b) the Respondent has not presented evidence that trademark rights in Spain arose at an earlier date; and c) the Respondent has not explained nor documented the existence of any relationship between Grupo Canosci and Canosci Pascual, Alberto David justifying the reason why this Panel should consider the Respondent to be the owner of the above indicated Spanish trademark registration.

In fact, although there is homonymy between the family name Canosci and the Respondent's company name Grupo Canosci SL, the holder of the trademark appears to be a physical person, i.e. Canosci Pascual, Alberto David. Therefore, without any explanation and even less documents showing that the Respondent is the effective holder of the Spanish trademark, this Panel finds that the Respondent, Grupo Canosci SL, has not shown to have trademark rights in a name corresponding to the disputed domain names.

Finally, for the sake of completeness, this Panel agrees with previous panels' opinion that affirms that while it is reasonable to presume that a party owning rights in a trademark has been known by the trademark, and thus by an identical domain name, this presumption is not conclusive. It is sometimes the case that a domain name registrant has registered a trademark in circumstances indicating that the registrant was seeking to take unfair advantage of the owner of previously existing trademark rights. In this sense e.g. Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com” WIPO Case No. D2000-0847 and Chemical Works of Gedeon Richter Plc v. Covex Farma S.L. WIPO Case No. D2008-1379.

In the present case it appears that:

1. The Respondent, although it is a Spanish company, affirmed to come from Italy and specifically from Busto Arsizio that is in the Varese area, namely the same area where the Complainant has been operating since the beginning of the last century and is extremely renowned. The Respondent was therefore certainly aware of the Complainant's trademarks when the trademark in Spain was registered.

2. The Respondent registered the disputed domain names well before requesting the trademark registration in Spain (i.e. in March 2013);

3. The Respondent, Grupo Canosci SL, was already found by the OHIM Board of Appeal to have requested the community trademark AERMACCHI MILANO in bad faith. In fact, this trademark following the request of invalidation promoted by the Complainant, was afterwards cancelled with the motivation that it was filed in bad faith.

Therefore, it is this Panel's opinion that even in the case that the Respondent is indeed the holder of the Spanish trademark, the facts at stake would anyway indicate that the Respondent registered the trademark AERMACCHI in Spain to facilitate taking unfair advantage of the Complainant's previously existing trademark rights in AERMACCHI. Thus not proving a legitimate rights to the disputed domain name with respect to paragraph 4(a)(ii) of the Policy.

For all the above, the Respondent does not appear to hold a valid trademark registration corresponding to the disputed domain names.

On the contrary, this Panel finds that the Complainant has made out a prima facie case and, thus, that the Respondent has no connection or affiliation with the Complainant that has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant’s trademarks. The Respondent does not appear to make any legitimate noncommercial or fair use of the disputed domain names, nor any use in connection with a bona fide offering of goods or services for the reasons described in section 6.C below. Whereas, it appears that Respondent used the disputed

domain names in order to divert users from Finmeccanica and Aermacchi sites to its own. The Respondent is doing that by inducing users into thinking that there is a connection or reference between the Respondent's web site and Complainant's Aermacchi web site. The Respondent does not appear to have been commonly known by the disputed domain names.

Accordingly, the Panel finds that the Complainant has satisfied the burden of proof with respect to paragraph 4(a)(ii) of the Policy.

BAD FAITH

The third and final element that the Complainant must prove is that the domain name has been registered and is being used in bad faith.

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
i) circumstances indicating that the holder has registered or has acquired the domain names primarily for the purpose of selling, renting, or otherwise transferring the domain name registrations to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain names; or
ii) the holder has registered the domain names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
iv) by using the domain names, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's web site or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the holder's web site or location or of a product or service on the holder's web site or location.

Accordingly, for a Complainant to succeed, the Panel must be satisfied that the domain name have been registered and are being used in bad faith.

Considering the fame of the Complainant's trademarks and activity especially in the Varese area, the Panel finds that the Respondent was aware of the Complainant's trademarks when it registered the disputed domain names. The Panel, in accordance with previous decisions issued under the UDRP, is of the opinion that actual knowledge of the Complainant's trademarks and activities at the time of the registration of the disputed domain names may be considered an inference of bad faith (See Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226 and Sony Kabushiki Kaisha (also trading as Sony Corporation) v. Inja, Kil WIPO Case No. D2000-1409. "It is inconceivable that the Respondent could make any active use of the disputed domain name without creating a false impression of association with the Complainant. The Respondent was not authorized by the Complainant to use neither its mark nor the disputed domain name".

It is the Panel's view that the Respondent's assertions that the name AERMACCHI was chosen after the nickname of the deceased father of the Company's Director is not credible. As well it is not credible that Respondent's registration of the trademark Austoni Milano 1928 was named after the Director's deceased mother, Mrs. Giuseppina Austoni, born in 1928 in Milan. Assertions were not documented.

As regards the Respondent's use of the disputed domain names, it appears that the Respondent's website was used in order to divert users from Finmeccanica and Aermacchi sites to its own. The Respondent has been doing that by inducing users into thinking that there is a connection or reference between the Respondent's web site and the Complainant's Aermacchi web site. By so deflecting Internet users, the Respondent has shown bad faith registration and use of the disputed domain names that clearly falls within the example given in paragraph 4(b)(iv) of the Policy.

Finally, this Panel noting the Respondent's attempts to register the trademarks A M Aston Martin, Austoni Milano 1928 and AERMACCHI, agrees with the OHIM Board of Appeal in its decision of February 25, 2013 when it affirmed that: "The filing of other marks under dubious circumstances or appearing as a misappropriation of other trader's goodwill is a strong

indication that at least the present mark was applied for in bad faith".

As well, this Panel agrees with the Complainant's opinion, that the registration of third parties' trademarks is a sort of bad faith pattern applicable at the trademark level and therefore sees in it a further inference of the Respondent's bad faith in registering the disputed domain names.

For all the foregoing reasons the Complainant has, to the satisfaction of the Panel, shown that the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

Preliminary Matters - Procedural aspect

Supplemental filings

Given the proceeding's aim of an expeditious settlement of disputes, the UDRP does not provide the parties with any right to reply, unless the panel requests, in its sole discretion, further statements or documents from either of the parties pursuant to paragraph 12 of the UDRP Rules.

Opinions differ as to whether and under what conditions the Panel can take into account unrequested additional submissions. Despite the wording of paragraph 12 of the UDRP Rules, "the Panel may request", the majority of the panels refer to the general requirement of procedural fairness and assume that unrequested submissions by the complainant can be taken into account by the panel, depending on the circumstances, if the additional submission concerns questions that were not known before the filing of the complaint or if objections have been raised by the respondent that were not foreseeable when the complaint was filed.

This Panel finds it is appropriate for a panel to consider the circumstances of each case before deciding whether to admit unsolicited additional submissions or not. In the present case, the Supplemental Filings are not justified since no proper reason and/or exceptional circumstance was advanced. In fact, both the Complainant and the Respondent did not point to any exceptional circumstances necessitating further submissions. Instead, Complainant and Respondent, appear to have submitted additional filings just to reciprocally rebut the assertions made by the other party.

The Panel has however noted the informal (non standard) communications from the Complainant and the Respondent, and even if the Supplemental Filings would have been accepted, this would not have altered the outcome of this case.

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has established that it is the owner of several trademark registrations for AERMACCHI and AERMACCHI MILANO. The Panel notes that the Complainant's trademark rights predate the creation date of the disputed domain names. The disputed domain names are identical to the Complainant's trademarks. Many UDRP decisions have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety. The addition of the generic top Level Domain ".com" is a technical element insufficient to avoid a finding of confusing similarity. The Panel finds that the Complainant has proven that the disputed domain names are confusingly similar to the Complainant's trademarks.

In the opinion of the Panel the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain names.

The Panel also finds that the disputed domain names have been registered and are being used in bad faith by the Respondent. This is particularly true as the Respondent intentionally attempts to attract, for commercial gain, Internet users

to its website by creating a likelihood of confusion with the trademarks of the Complainant as to the source, sponsorship, affiliation, or endorsement of its website or of a product on its website or location.

In addition, the Panel finds that, due to the fame of the Complainant's trademarks and activity especially in the Varese area, the Respondent was aware of the Complainant's trademarks when it registered the disputed domain names. The Panel, in accordance with previous decisions issued under the UDRP, is of the opinion that actual knowledge of the Complainant's trademarks and activities at the time of the registration of the disputed domain names may be considered an inference of bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **AERMACCHI.COM** : Transferred
2. **AERMACCHIMILANO.COM**: Transferred

PANELLISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2013-11-28

Publish the Decision