Decision for dispute CAC-UDRP-100864

Case number	CAC-UDRP-100864
Time of filing	2014-10-15 16:33:30
Domain names	AERMACCHIGIOIELLI.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Finmeccanica - Società per Azioni

Complainant representative

Organization	desimone & partners

Respondent

Organization	Contact Privacy Inc. Customer 0136162044

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant owns, inter alia, the registered European Community trademark no. 5496328 “AERMACCHI” with a priority date of 24 November 2006, which is protected for various goods and services in classes 9, 12, 13, and 37.

Complainant also owns the registered Italian trademark no. 1328540 “AERMACCHI” with a priority date of 15 April 2008, which is protected, inter alia, for "jewellery" and other goods in class 14.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

"Aermacchi" is one of the oldest trademarks in the world aviation and aircraft business. The original Macchi company, founded by Eugenio Macchi on 1 May 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 under the name Alenia Aermacchi. In 2006 it achieved 297 million Euros in sales.

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

At the time the Complaint was filed the whois record for the disputed domain name showed "Contact Privacy Inc. Customer 0136162044" as domain name registrant. At the subsequent registrar verification the whois record had been modified and stated "Ana Pascual Carreras" with a street address in Tenerife and the email address "sales@canosci.com" as the registrant. Complainant had previously been involved in two trademark related disputes with a company Grupo Canosci S.L., which had operated under the same street address and used the same email address as the registrant (as confirmed by the registrar verification). Root cause of both previous disputes was Grupo Canosci S.L.' use of the brand "AERMACCHI MILANO" for jewellery products. One of the cases lead to the CAC UDRP decision no. 100384 (https://udrp.adr.eu/adr/decisions/decision.php?dispute_id=100384), in which the Panel had accepted the complaint and decided to transfer the domain names "AERMACCHI.COM" and "AERMACCHIMILANO.COM" from Grupo Canosci S.L. to the Complainant. Complainant had also initiated invalidity proceedings with case no. R 2448/2010-4 before the Office for Harmonization in the Internal Market (OHIM), in which the Fourth Board of Appeal declared Grupo Canosci S.L.'s European Community trademark no. 6323422 "AERMACCHI MILANO" for various goods and services in classes 14, 18 and 35 to be invalid because it was applied for in bad faith.

PARTIES CONTENTIONS

The only response to the Complaint which the CAC has received was the following email of 27 October 2014 from "info@aermacchigioielli.com" to the CAC's case administrator:

"Dear Lada
I think the site is online, but the office was closed from several months and the site, we think, will expire on 12/02/2014.
All people have changed the job, the office was closed and we don't want problems.
I'll say anyway to the old computer technician ,to cancel the old web-page, don't worry.
You can close the web page without any problems.
Many thanks and sorry for the trouble
Best regards"

Apart from this email, no administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is confusingly similar to the trademarks cited above in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

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. This particularly applies to respondent's use of a proxy registration service, which is generally accepted as being no obstacle to a UDRP decision (cf. section 4.9 of the WIPO Overview 2.0, http://www.wipo.int/amc/en/domains/search/overview/index.html#49).

PRINCIPAL REASONS FOR THE DECISION

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1) The disputed domain name is confusingly similar to the Complainant's registered trademark "AERMACCHI" for it fully incorporates the aforementioned trademark, merely adding the term "GIOIELLI" which in fact in Italian stands for "jewellery". The Panel concludes that adding such a descriptive term for the products which Respondent originally promoted via the disputed domain name does not distinguish the disputed domain name from the Complainant's trademarks.

2) Regarding Respondent's lack of rights or legitimate interests in respect of the Domain Name Complainant has made the allegation and has put forward what Complainant can in support, namely that Respondent has no rights to the names "AERMACCHI" (or "AERMACCHIGIOIELLI") of which Complainant is aware. The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. The Respondent has made no attempt to do so. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name (cf. WIPO Case No. D2004-0110 <belupo.com>; WIPO Case No. D2001-0121 <julianbarnes.com>).

3) For the Complainant clearly demonstrated that the reputation of its trademark is widespread the Panel concludes that by the time of the registration the Respondent was aware or should have been aware of the Complainant rights. Therefore, the Respondent has, by using the domain name, intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site, by creating a likelihood of confusion with Complainant's "AERMACCHI" mark as to the source, sponsorship, affiliation, or endorsement of Respondent's "AERMACCHI MILANO" jewellery products. The same likelihood of confusion was thereby caused as to the source, sponsorship, affiliation, or endorsement of Respondent's web site on which Respondent promoted these "AERMACCHI MILANO" jewellery products (cf. paragraph 4(b)(iv)of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AERMACCHIGIOIELLI.COM**: Transferred

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2014-11-27

Publish the Decision