Decision for dispute CAC-UDRP-101626

Case number	CAC-UDRP-101626
Time of filing	2017-09-14 09:29:00
Domain names	coesiapro-spa.com

Case administrator

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

Complainant

Organization	Coesia S.p.A.

Complainant representative

Name	Antonio Zama

Respondent

Name	Jakob Schopenhauer

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of many trademark registrations consisting of or containing the term „COESIA“, in particular European Union word mark no. 004285037 registered on 24/04/2006 for goods and services in classes 7, 35 and 42 and also European Union figurative mark no. 004285078 registered on 03/03/2006 for goods and services in classes 7, 35 and 42 and European Union figurative mark no. 013610621 registered on 30/06/2015 where the term COESIA is registered in stylized letters, that are also used in the websites www.coesia.it and www.coesia.com (created on 9/08/2004 and on 17/03/2012 respectively).

FACTUAL BACKGROUND

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

The Complainant claims to be a well-known group of innovation-based industrial and packaging solutions companies operating globally with its headquarter in Bologna, Italy. Coesia Group was created around the company G.D taken over at the end of the 1930s. Coesia companies essentially operate in three main business lines: advance automated machinery and

packaging materials, industrial process solutions and finally precision gears. Over its long history, Coesia has continuously increased its global presence and as of 2017 the group has 89 operating units (52 of which with production facilities) in 32 countries, a turnover in 2016 of 1,457 million Euro and over 6,000 employees. Moreover, Coesia group consists of 17 companies. The Complainant contends that it has been using its trademarks “Coesia” for many years in connection with its core business and that thanks to the success and leader position achieved in the segments in which it operates, its trademarks are globally well-known.

The Disputed Domain Name <coesiapro-spa.com> was created on 2/07/2017 and – according to the Complainant’s non contested allegations – it resolves to a website having some pages displaying a logo identical to the Complainant’s figurative trademark “Coesia” and further pages containing false/misleading information.

The Complainant finally contends that on July 12, 2017 it sent a cease and desist letter through its attorneys, to the Respondent asking for the transfer of the Disputed Domain Name, but the Respondent did not reply.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Name is identical or confusingly similar to a trademark or service mark 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 Disputed 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 Disputed 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.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the Disputed Domain Name <coesiapro-spa.com> is confusingly similar to the Complainant’s trademark and company name. Many Panels 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. This is the case in the case at issue where the Complainant’s registered trademark “COESIA” is fully included in the Disputed Domain Name. Moreover, it consists of the trademark COESIA followed by the term “pro”, a hyphen and the term “spa” (a generic reference to the Italian Company legal form “Societá per Azioni”), which is applicable as descriptive term of the Complainant (that has its headquarter in Italy) and is likely to increase the confusing similarity between the trademark and the Disputed Domain Name <coesiapro-spa.com>.

2. In the absence of any Response, or any other information from the Respondent indicating the contrary, the Panel further holds that the Complainant successfully presented its prima facie case and that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

In particular, the Respondent is not affiliated with nor authorized by the Complainant in any way, and he is not related in any way to the Complainant's business. In addition, the Respondent is not commonly known by the Disputed Domain Name. Finally, the Complainant has demonstrated that the website to which the Disputed Domain Name resolves displays the Complainant's trademarks. Such use can neither be considered as bona fide offering of goods or services nor a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0", point 2.5) a respondent's use of a domain name will basically not be considered "fair" if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry. Furthermore, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see WIPO Overview 3.0 at point 2.5.1).

This in the case at issue where the Disputed Domain Name <coesiapro-spa.com> consists of the trademark COESIA followed by the term "pro", a hyphen and the term "spa" (a generic reference to the Italian Company legal form "Societá per Azioni"). This composition carries a high risk of implied affiliation and suggests sponsorship or endorsement by the Complainant.

3. Finally, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.

The Respondent has intentionally registered the Disputed Domain Name which totally reproduces the Complainant's trademark COESIA. By the time the Disputed Domain Name was registered, it is unlikely that the Respondent did not have knowledge of the Complainant's rights on its trademarks. The Complainant also proved that the Respondent is using the Disputed Domain Name to lead to a page, that displays Complainant's trademarks in relation to products and services that are similar to the Complainant's core business (for which its registered trademarks are used).

These facts, including the failure to submit a response also confirm that the Disputed Domain Name is used to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's 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 the Respondent's web site or location, or of a product or service on the Respondent's web site or location.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **COESIAPRO-SPA.COM**: Transferred

PANELLISTS

Name	**Dr. Federica Togo**

DATE OF PANEL DECISION 2017-10-24

Publish the Decision