Decision for dispute CAC-UDRP-101958

Case number	CAC-UDRP-101958
Time of filing	2018-04-13 12:53:47
Domain names	SPARCOWHEELS.COM

Case administrator

Name	Sandra Lanczová (Case admin)

Complainant

Organization	Sparco S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Organization	Magnesiumcom

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant Sparco S.p.A. is the owner of EU-Trademark “SPARCO” registered on 24. January 2001 (No. 000290726) as well as International-Trademark “SPARCO” registered on 12. July 1983 (No. 478132), both of which are registered amongst others for goods in nice classes 9, 12, 25 such as racing equipment.

FACTUAL BACKGROUND

As stated by the Complainant and undisputed by the Respondent, Complainant is a joint stock company registered in Italy, specialized in producing items for automobiles such as seats, wheels, harnesses, racewear and helmets. Founded in 1977, Complainant is one of the leading manufacturers of racing safety equipment and involved in sports car races via numerous sponsorings and distribution channels. The Complainant is continually building up its goodwill by intensive advertising campaigns around the world centered on the trademarks named above. Complainant has registered numerous domain names comprising the trademark “sparco” under several different TLDs, including, inter alia, sparco.it, sparco-official.com and sparco-wheels.com.

The disputed domain name “sparcowheels.com” has been registered with the Respondent on 29. May 2016. Respondent is

using the “sparcowheels.com” domain name to redirect users to the website “https://wheelsnews.com/”. The domain name wheelsnews.com is also registered in the name of the Respondent. On the corresponding website the Respondent is hosting banner-ads of and links to Complainant’s competitor SMW Engineering. A cease-and-desist-letter from the Complainant as of 15.03.2018 has been left unanswered by the Respondent.

On 13.04.2018 the Czech Arbitration Court (CAC) received the Complainant`s Complaint.

The Complainant requests the Panel to decide:

Transfer of the domain name “sparcowheels.com” to the Complainant.

PARTIES CONTENTIONS

A. Complainant

1. Identity or confusing similarity

With reference to paragraph 4(a)(i) of the Policy the Complainant states that the disputed domain name is confusingly similar to its trademark “sparco”. The Complainant refers on prior WIPO decisions Britannia Building Society v. Britannia Fraud Prevention (WIPO Case No. D2001-0505) and GA Modefine S.A. v. Mark O´Flynn (WIPO Case No. D2000-1424) when stating, that it is well established, that the mere addition of generic words to a trademark in domain names is insufficient to negate confusing similarity between a trademark and a domain name.
The addition of the generic term “wheels” in the case of the disputed domain name is furthermore problematic, as it refers to a business sector the Complainant is active in and thus is not negating but actually enhancing the confusing similarity between the trademark “sparco” and the disputed domain name.
The top level “.com” is merely instrumental to the use in Internet (e.g. FORUM case FA0008000095491, October 3, 2000) and not able to affect the confusing similarity between the trademark “sparco” and the disputed domain name.

2. No rights or legitimate interests of the Respondent

The Complainant states the Respondent does not have any rights or legitimate interest in the disputed domain name.
The Complainant contends that the Respondent does not carry out any activity for, nor has any business with the Complainant. Neither a license nor any authorization has been granted to the Respondent to make any use of the Complainant`s trademark, or apply for registration of the disputed domain name by the Complainant.
The Complainant assures that he knows of no evidence leading to Respondent being commonly known by the disputed domain name as an individual, business or other organization.
The Complainant contends that the Respondent has registered the disputed domain name – which is virtually identical to the Complainant’s domain name “sparco-wheels.com” – with the aim to prevent him to register it and in order to create a likelihood of confusion with the Complainant`s trademarks.
A use of the disputed domain name with a bona fide offering of goods or services cannot be detected. In fact the Respondent has used the disputed domain name to redirect users to websites advertising Complainant`s competitor SMW Wheels` products. The Respondent has also registered the domain name smwwheels.com, which leads the Complainant to the conclusion, that the Respondent is generating click-through revenues. Furthermore, the Respondent is actively seeking collaborations with other businesses for revenue.
In no occasion, the Respondent has installed a disclaimer, that there is no relationship between him and the redirected websites and the Complainant and its trademarks.

3. Registration and use in bad faith

The Complainant states that he has used the trademark “sparco” extensively and exclusively since 1977 and that the trademark has gained and now enjoys worldwide reputation through long established and widespread use in many countries of the world, for example also in Latvia, where the Respondent resides. Therefore, the Complainant concludes, that

Respondent must have been aware of the trademarks existence (see Ferrari S.p.A. v. Allen Ginsberg, WIPO Case No. D2002-0033).
This is underlined by the fact, that the Respondent has registered the disputed domain name, which is virtually identical to Complainant's domain name "sparco-weels.com". Furthermore, the Respondent owns the domain names "smw.com" and "smwwheels.com" that redirect to websites of a wheels manufacturer. Thus, it can be assumed that the Respondent is experienced in the relevant market of wheels manufacturers and therefore knows about the existence and importance of the Complainant and its trademark.
The registration of a domain name with the knowledge of the Complainant`s trademark is an evidence of bad faith (see inter alia Belstaff S.R.L. v jiangzheng ying, Case No. D2012-0793).
The Respondent also shows a habit of registering domain names containing the generic word "wheels" or "rims" with well-known trademarks mainly related to the automotive sector, which are then used to redirect the users to websites dedicated to promote SMW Wheels.
In conclusion, the Complainant conducts that the Respondent is acting in bad faith according to paragraph 4 (b) (iii) and (iv) of the UDRP Rules.

B. Respondent

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

I.
As the Respondent did not file an administratively compliant Response, pursuant to paragraph 14(b) of the Rules, the Panel may draw such inferences therefrom as it considers appropriate. Thus, the Panel accepts the contentions of the Complainant as admitted by the Respondent.

II.
The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to the Complainant`s trademarks (within the meaning of paragraph 4(a)(i) of the Policy).
The Panel agrees with the Complainant that the disputed domain name is identical to the Complainant`s trademarks. The disputed domain name wholly incorporates the trademark "sparco".
The disputed domain name directly and entirely incorporates the Complainant's "sparco" trademark, which is the most distinctive part of the disputed domain name.
The addition of the term "wheels" is in direct relation with market sector the Complainant is active in. The addition of the suffix "wheels" does therefore not operate to distinguish the disputed domain name from the "sparco" trademark in any significant way. Further, the top level domain ".com" is to be neglected in this assessment.

III.
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).

No arguments, why the Respondent could have own rights or legitimate interests in the disputed domain name are at hand. To the full satisfaction of the Panel the Complainant has shown that no case as listed in paragraph 5 of the UDRP Rules is relevant in this case. In particular, the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services as he is gaining revenue from redirecting users to other websites and is promoting SMW Wheels, a competitor of the Complainant. Further, the Respondent is not commonly known by the disputed domain name. Therefore, the Panel accepts the contentions of the Complainant that the Respondent has no such rights or legitimate interests in the disputed domain name.

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

The timing of the registration of the disputed domain name indicates Respondent`s bad faith in registering such domain name, as, at that time, the Complainant`s trademark “Sparco” was already known for decades and protected in several countries. The Panel has no reason to disbelieve the Complainant, when it argues that the Respondent knew the Complainant and its activities at the time of registration and sought to hinder the Complainant from registering the domain name itself and/or intentionally attempted to attract, for commercial gain, Internet users to his web site or other online location, by creating a likelihood of confusion with the Complainant's trademark.

There is no evidence that the Respondent has registered the disputed domain name freely and without reference to the Complainant`s trademarks. This is emphasized by the other domain names incorporating famous trademarks of automotive brands with the addition of the term “wheels” or “rims” registered by the Respondent.
According to paragraph 4(b)(i) of the Policy it shall also be seen as evidence for bad faith use if the Respondent registered the domain name in order to prevent the owner of the trademark from reflecting such mark in a corresponding domain name. With regard to the virtually similar domain name sparco-weels.com already held by the Complainant, the Panel holds the Respondent`s conduct to be the manifestation of use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SPARCOWHEELS.COM**: Transferred

PANELLISTS

Name	**Dominik Eickemeier**

DATE OF PANEL DECISION 2018-06-10

Publish the Decision