Decision for dispute CAC-UDRP-102055

Case number	CAC-UDRP-102055
Time of filing	2018-06-20 09:11:43
Domain names	SPARCORACINGUSA.COM

Case administrator

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

Complainant

Organization	Sparco S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Organization	Grillstuff, LLC.

OTHER LEGAL PROCEEDINGS

There are no other legal proceeding that the Panel is aware of which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

United States Trade Mark Registration No. 1367444 SPARCO for various fire proof clothing in class 9.

FACTUAL BACKGROUND

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

The Complainant is a joint stock company registered in Italy, with subsidiaries in the U.S.A., Brazil and Tunisia. It is a manufacturer of racing equipment that was founded in 1977.

Currently, the Complainant company’s turnover exceeds 65 million Euro and it has approximately 900 employees. It services over 300 top motorsport teams racing in world championships.

The Complainant owns a number of trade marks containing, or consisting of, the word “SPARCO”, including in United States Trade Mark Registration No. 1367444 SPARCO for various fire proof clothing, including gloves, that has a registration date of October 29, 1985. It also claims to be the registrant of domain names containing the word SPARCO, including, but not

limited to, <sparcousa.com>, which has been registered since 2000.

According to the WHOIS extract for the disputed domain name the Respondent provided his name as Charlie James of Grillstuff LLC and his address as being in the United States of America. The disputed domain name was registered on 15 October 2009. At the time of filing the Complaint the disputed domain name did not resolve to a website. However in the past the disputed domain name has redirected to a website offering for sale performance apparel and accessories for vehicles and racing, including racing gloves. The Complainant provided two historical archived screenshots of this website. One from 8 December 2009 shows various racing apparel and accessories, such as racing gloves, for sale including those branded SPARCO and those branded with brands belonging to competitors of the Complainant.

On 7 May 2018 the Complainant wrote an e-mail to the Respondent asserting its rights in the SPARCO trade mark and requesting, amongst other things, a transfer of the disputed domain name to it. No response to this e-mail was received by the Complainant.

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

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

1) the domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and

2) the Respondent has no rights or legitimate interests in respect of the domain name; and

3) the domain name has been registered and is being used in bad faith.

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has numerous trademark registrations containing or consisting of the words SPARCO. The Panel notes in particular that the Complainant has evidenced rights in United States Trade Mark Registration

No. 1367444 SPARCO for various fire proof clothing in class 9, which predates the registration date of the disputed domain name by over two decades.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark SPARCO.

The next question is whether the disputed domain name is confusingly similar to the SPARCO trademark.

The Panel disregards the gTLD suffix ".com" for the purpose of this comparison. It also disregards the term USA, which is a clear geographic indicater and a reference to the Respondent's country of residence. However the Panel further notes that if such a suffixs were to add anything they would only make the disputed domain name more similar to the Complainant's <sparcousa.com> domain name that was first registered approximately 9 years before the disputed domain name and which has the same suffixs.

The purely descriptive term RACING also does nothing to reduce confusion. In fact, it also makes confusion more likely as all the goods for which the Complainant has a reputation in SPARCO according to the evidence submitted, as well as all the goods specified in its above mentioned United States Trademark Registration, can be described as relating to motor sport racing or vehicles.

The disputed domain name is confusingly similar to the SPARCO trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name according to the WHOIS extract is Charlie James of Grillstuff LLC. Neither this personal or company name bears any resemblance to "SPARCO". Further, the historical archived screenshots do not show a right or legitimate interest. Even if genuine branded goods of the Complainant were promoted and sold on such a site it is clear that numerous brands belonging to competitors of the Complainant were also promoted. Such evidence is not that of content which would indicate any right or legitimate interest in the disputed domain name.

The Respondent has no rights or interests in the disputed domain name.

BAD FAITH

The task of assessing if a Respondent has registered and used a domain name in bad faith is most certainly one which must observe the particular circumstances of the Respondent but it is also still an objective one. In the Panel's view what ought to asked is whether an objective and reasonable person in the position of the Respondent acting with proper and honest motive would refrain from registering and using the disputed domain name in the manner that the Respondent did.

In the present case an objective and reasonable United States resident acting with proper and honest motive would not seek to register the disputed domain name and use it in the manner that the Respondent did for two reasons:

(1). It is apparent from the screenshot dated 8 December 2009 that this is not a case in which the domain name has only been used for the sale of genuine SPARCO branded goods. That screenshot clearly shows the promotion of goods belonging to competitors of the Complainant. The likelihood of confusion for consumers is apparent and foreseeable. Such consumers be likely to assume the domain directs to a website where all the goods sold are associated with or sponsored by the Complainant. Clearly, it did not.

(2). The subsequent removal of the content referred to in the preceding paragraph does not cure the breach of the Policy. The previous website content is a clear indication that the Respondent initially registered the disputed domain name with knowledge of the Complainant's trademark and for the purpose of opportunistically profiting from the confusing similarity with that trademark. This opportunistic purpose cannot be said to simply disappear together with the disappearance of web content evidencing its existence. Such opportunism has been recognised as bad faith by numerous panels, the Panel refers to the commentary of the learned Gerald M Levine, Domain Name Arbitration, Legal Corner Press, 1st ed. 2015, pp. 258 to 259.

Finally, the Panel notes the Respondent failed to respond to the Complainant's email dated 7 May 2018 in which the Complainant asserted its rights in the SPARCO trademark and requested, amongst other things, a transfer of the disputed domain name to it. This non-response is not evidence of bad faith. If the Respondent had otherwise acted in good faith he would not be obliged to respond to such correspondence just as he is not obliged to file a Response to the present Complaint. However the fact he did neither of these things only reinforces the evidence mentioned above that indicates bad faith registration.

The disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SPARCORACINGUSA.COM**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2018-07-24

Publish the Decision