Decision for dispute CAC-UDRP-102348

Case number	CAC-UDRP-102348
Time of filing	2019-03-13 12:17:41
Domain names	colmarit.com, colmarnegozio.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Manifattura Mario Colombo & C. Spa

Complainant representative

Organization	Convey srl

Respondent

Name	Gretchen Aquino

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various registered trade marks that comprise or incorporate the term "COLMAR". These include:

(i) European Union trade mark no. 014320261 dated 3 December 2015 in classes 3, 9, 18, 24, 25, 26, 28 for the term "Colmar" in stylised text; and

(ii) US trade mark no. 1417499 of 18 November 1986 in class 25 for the term "Colmar" in stylised text combined with a circular device.

FACTUAL BACKGROUND

The disputed domain names are referred to in this decision as the "Domain Names".

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

The Complainant is an Italian joint stock company founded in 1923 by Mario Colombo and his wife in Monza, Italy, as an innovative family business focusing on felt production and, at that time, the company name was Manifattura Mario Colombo & C.

During the 1930s the production of workwear became the priority of his company. Furthermore, a new treatment for the cotton was invented by Manifattura Mario Colombo & C.This new fabric was used by the first skiing pioneers.

To the end of the 1940s, when skiing became a new and trendy weekend pastime for Italians, Mario Colombo inspired by a meeting with the celebrated ski champion, Zeno Colò, came up with a new brand name "Colmar", which is the acronym of the name and the surname of the founder Mario Colombo. The company then turned its product expertise to the design, research and production of high-quality ski suits.

In 1948, the Complainant began its professional partnership with the FISI (the Italian Winter Sports Federation), which continued without interruption until 1992. Zeno Colò, Celina Seghi, Roland and Gustav Thoeni, Piero Gros, Paolo De Chiesa, Alberto Tomba, Deborah Compagnoni were all sponsored by the Complainant during their skiing careers. Nowadays, the Complainant is official supplier of the French Alpine Ski Team and sponsors some World Championship races, the French National Ski Cross Team and many young athletes such as Luca Tribondeau and Richard Amacker.

The Complainant began producing golf clothing in 2010.

Today the headquarters of the company remain in Monza, where business is carried out by around 250 of its employees as well as members from the third and fourth generations of the Colombo family.

In 2009 the Complainant launched of Colmar Originals, a more urban fashion and lifestyle-oriented offering, which features the original logo of the brand that pays tribute to the authentic urban and athletic soul of the company.

Colmar boasts many authorized resellers worldwide and 15 stores in total, including the most recent in London. In 2017 the Complainant had a turnover of €106 million and launched its new collection under the direction of Hood by Air's Shayne Oliver.

In addition to numerous registered trade marks, the Complainant registered several domain names consisting of or comprising the trademark COLMAR under several different TLDs, including <colmar.it>, which was registered on 9 December 1996. The corresponding web site www.colmar.it generates a significant number of visits by Internet users every day and is used by the Complainant to promote and also sell online its products.

The Complainant is also active on the main Social Media, like Facebook, Instagram, Twitter, Youtube and Linkedin. The Facebook fan page counts over 325.000 fans worldwide.

The Domain Names <colmarit.com> and <colmarnegozio.com> were registered without authorisation of Complainant, on November 30, 2018 The Domain Name colmarit.online was registered by the Respondent on 17 January 2019.

The Domain Names <colmarnegozio.com> and <colmarit.online> have been redirected to a web site in English offering for sale Complainant's counterfeiting products. The Domain Name <colmarit.com> is not currently redirected to an active web site, but prior to receipt of a cease and desist letter, it pointed to the same web site as the one corresponding to Domain Names <colmarnegozio.com> and <colmarit.online>.

As soon as the Complainant became aware of the Respondent's registration and use of the Domain Name, it instructed its representative to serve the Respondent with a cease and desist letter in order to notify it of the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer of, the Domain Name to the Complainant.

A cease and desist letter in respect of the Domain Names <colmarit.com> and <colmarnegozio.com> was sent by email, on

3 December 2018 to the corresponding Registrar and on 11 December 2018 to the corresponding hosting provider. For the Domain Name <colmarit.online> a cease and desist letter was sent to the corresponding Registrar on 22 January 2019. A further a cease and desist letter was sent to email address for the registrant indicated in the whois of the Domain Name <colmarnegozio.com> on 25 February 2019.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that each of the Domain Names 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 Domain Names (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 Names have been registered and are 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.

In this respect, the Panel accepts that the Complainant can seek transfer of the Domain Names in a single set of UDRP proceedings notwithstanding that the information provided by the Registrars in response to the Provider's verification request provides different registrant details.

In this respect the Panel accepts that:

(i) All three Domain Names incorporate the same mark;

(ii) The Domain Names <colmarnegozio.com> and <colmarit.online> redirected to the same web site;

(iii) The second level of each of the Domain Names <colmarit.online> and <colmarit.com> are identical;

(ii) In the past the three Domain Names all redirected to replicas of the same website;

(iii) All three Domain Names share the same hosting provider;

(iv) The Domain Names <colmarit.com> and <colmarnegozio.com> share the same registrar.

There is also the fact that in the case of the Domain Name <colmarit.online> continues to be registered in the name of a whois privacy shield and therefore the underlying registrant has not been disclosed.

In the circumstances, the Complainant has made out a prima facie case that the Domain Names are under common control and in the absence of any response or communication to the contrary from any person claiming to be the registrant of any of the Domain Names, the Panel accepts that this is the case. Further, it would be equitable and procedurally efficient to permit the requested consolidation.

PRINCIPAL REASONS FOR THE DECISION

The Complainant is the owner of various registered trade marks of which the text "Colmar" is the dominant element. The term "Colmar" appears in each of the three Domain Names, with (a) the most sensible reading of the Domain Names <colmarit.online> and <colmarit.com>, being the term "colmar" in combination with the term "it" (being the recognised 2 letter ISO code for Italy) and the ".com" and "online" top level domains; and (b) the most sensible reading of the Domain Name <colmarnegozio.com>, being the term "colmar" in combination with the term "negozio" (the Italian word for "shop") and the ".com" top level domain. This is sufficient for a finding of confusing similarity for the purposes of the Policy; see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the “WIPO Overview 3.0”).

The Complainant repeatedly contends that the Domain Names have all been used to further the sale of counterfeit goods. That may be so, although unfortunately no real explanation is offered in the Complainant as to why that is likely to be the case. However, the Complainant also contends that the website operation from the Domain Names reproduces the Complainant’s logos at the top of the homepage of its site and reproduces one of the Complainant's logos as part of the favicon of the website. The Panel accepts that this is correct. It also more generally accepts that by way of the website, the Respondent is seeking to falsely impersonate the Complainant for the purpose of selling goods under the Complainant's mark and that the Domain Names were all registered and have thereafter have been held or used with that purpose in mind. There is no right or legitimate interest in such activity, and the registration use and holding of the Domain Names for that purpose comprise registration and 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. **COLMARIT.COM**: Transferred
2. **COLMARIT.ONLINE**: Transferred
3. **COLMARNEGOZIO.COM**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2019-05-09

Publish the Decision