Decision for dispute CAC-UDRP-102498

Case number	CAC-UDRP-102498
Time of filing	2019-05-22 09:01:05
Domain names	albertoponticelli.com

Case administrator

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

Complainant

Name	Alberto Ponticelli

Complainant representative

Name	Giorgio Ponticelli

Respondent

Name	Cupita Cupiti

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant indirectly but clearly claims that he has unregistered trademark rights, arising from the alleged reputation/use in the Italian market and worldwide of his name “Alberto Ponticelli”, at least since the last decade of the previous century (1990s). The Complainant does not presently own any registered trademark for the mark “Alberto Ponticelli”.

FACTUAL BACKGROUND

According to the Complainant’s allegations, which have not been refuted by the Respondent, the Complainant is an Italian comic book artist and visual artist. He seems to be well-known in the field of comic books.

The Complainant does not own any trademarks, but merely uses his own name in the marketplace. He allegedly owns (through a privacy company) a related domain name <alberto-ponticelli.com> since February 27, 2019.

The disputed domain name <albertoponticelli.com> was registered on February 2, 2019 by the Respondent, after the Complainant had failed to renew it in his name, last December 2018.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends, in the sense of paragraph 4(a) of the Policy, that the Disputed domain name is confusingly similar to his name / unregistered trademark; that the Respondent lacks rights or legitimate interests in the Disputed domain name, and; that the Disputed domain name has been registered and is being used in bad faith.

For all these reasons, the Complainant requests that the Disputed domain name is transferred to him.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

In general, the Panel remarks that the Complaint has not been filed by the representative in the usual format of a classic UDRP Complaint. However, the Panel, within the spirit of fairness, will adapt the arguments of the Complainant in a way as to classify them as per the normal threefold test of paragraph 4(a) of the Policy.

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). The disputed domain name consists of the Complainant's whole name / unregistered trademark (ALBERTO PONTICELLI). The Panel, based on the evidence provided by the Complainant, has been convinced of the latter’s reputation in the field of comic books and, consequently, of sufficient use in commerce, so as to create unregistered trademark rights to the benefit of the Complainant. It is, nonetheless, highly recommended that the Complainant applies for trademark protection, as soon as possible, in order not to face similar risk in the future.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the complainant to establish a prima facie case that the respondent lacks rights or legitimate interests in the Domain Name to shift the burden of proof to the respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the ALBERTO PONTICELLI name / unregistered trademark in a domain name, and that it had never licensed its name / unregistered trademark to the Respondent.

Furthermore, the Respondent has not demonstrated any use of the disputed domain name in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain name.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the reputation of the Complainant's name / unregistered trademark ALBERTO PONTICELLI and the fact that the disputed domain name fully incorporates these words, it is evident that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's name / unregistered trademark. The registration as domain name of a third party's well-known trademark (even if unregistered) with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name – thanks to its high SEO value – resolves to a misleading website, with quite a few links towards commercial websites of a completely different field (betting / gambling), a fact that harms the good reputation of the Complainant. This fact is to be combined with the full incorporation of the Complainant’s reputable name / unregistered trademark in the disputed domain name. For this Panel, same as for many previous panels, such misleading behaviour clearly amounts to use in bad faith. Consequently, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate.
Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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

The disputed domain name wholly incorporates the Complainant's reputable name / unregistered trademark. The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's name / unauthorized trademark in the disputed domain name, and the Complainant never licensed its name / trademark to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's reputable name / unregistered trademark. His use of the disputed domain name is in bad faith, as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALBERTOPONTICELLI.COM**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2019-07-02

Publish the Decision