Decision for dispute CAC-UDRP-103082

Case number	CAC-UDRP-103082
Time of filing	2020-05-29 08:34:40
Domain names	RIOCASAMIA.COM

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Kemeco S.r.l.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	hakem kartal

OTHER LEGAL PROCEEDINGS

The Panel is not ware about other legal proceedings concerning the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant is KEMECO S.r.l, an Italian company created in the 1970s and is a worldwide producer and distributor of cleaning products.

Complainant owned several RIO CASAMIA registered trademarks over the world, including:
- The international trademark RIO CASAMIA n° 658283, of May 28, 1996, duly renewed since then;
- The Italian trademark RIO CASAMIA n° 634406, of February 12, 1992, granted on November 21, 1994, duly renewed since then;
- The EU trademark RIO CASAMIA n° 000416156, of December 27, 1996, granted on November 26, 1998, duly renewed since.

Complainant is highly visible on the Internet, particularly on Youtube, where its advertising campaigns presented by actors and actresses are broadcast and seen by hundreds of thousands of consumers.

Respondent is Hakem Kartal, located in Turkey.

Respondent registered the disputed domain name <riocasamia.com> on October 14, 2019.

FACTUAL BACKGROUND

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

THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is a leading Italian company operating in the production and commercialization of cleaning products, established by its founder, Mr Pietro Murania, in the 70's of the last century.

After the very first model of cleanser had been put into the market (with the name "Rio Azzurro WC"), in 1991 the Complainant became famous in many countries for the cleanser line "RIO" and – in particular – for "RIO CASAMIA", the first perfumed ammonia-based cleanser which quickly revealed itself as a huge commercial success for Kemeko, a point of reference for consumers in all Europe.

The name "RIO CASAMIA" (meaning "RIO MY HOME from Italian") is a reference of this product's versatility, as "RIO CASAMIA" can be used on all kind of surfaces without danger.

Thanks to a massive TV advertising campaign started in 1987 (and well-remembered by the Italian audience as of this day, because of the renown actors and actresses involved), the "RIO" line got a considerable feedbacks from consumers.

As can be noted in the Youtube links https://www.youtube.com/ https://www.youtube.com/ https://www.youtube.com/ and https://www.youtube.com/ famous personalities such as Iva Zanicchi and Iggy Azalea are only few of the main characters in the TV spots for "RIO CASAMIA", seen by hundreds of thousands consumers on the popular internet video platform.

In 2019, over 8.400.000 items of "RIO CASAMIA" have been sold by the Complainant, meaning 36,5% of the OVERALL Italian cleanser production. "RIO CASAMIA" is widely commercialized through the main chains of the large-scale retail trade. See, as Annex A, some further information about "RIO CASAMIA" and the Complaint's business.

On October 14, 2019, the Respondent registered the disputed domain name RIOCASAMIA.COM.

It is more than obvious that the domain name at issue is identical to "RIO CASAMIA", as it exactly reproduces such trademark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME

The Respondent has no rights on the disputed domain name, and any use of the trademark "RIO CASAMIA" must be authorized by the Complainant. Nobody has been authorized or licensed by the above-mentioned company to use the domain name at issue.

The domain name at stake does not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as "RIOCASAMIA".

Lastly, we do not find any fair or non-commercial uses of the domain name at stake (see the contested domain name's home - page).

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The domain name RIOCASAMIA.COM was registered and is used in bad faith.

The Complainant's trademark "RIO CASAMIA" is distinctive and well known all around the world. The fact that the Respondent has registered a domain name that is confusingly similar to it indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. In addition, if the Respondent had carried even a basic Google search in respect of the wordings "RIO CASAMIA", the same would have yielded obvious references to the Complainant. The Complainant submits, as Annex D, an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant's trademark on the part of the Respondent. Therefore, it is more than likely that the domain name at issue would not have been registered if it were not for Complainant's trademark. This is a clear evidence of registration of the domain name in bad faith.

In addition, the contested domain name is not used for any bone fide offerings. More particularly, there are present circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name (par. 4(b)(i) of the Policy).

It has been already noted that the domain name redirects to a parking page in which the same is offered for sale for the amount of USD 990,00.

First of all, it must be underlined that several WIPO decisions ascertained how "Although Respondent's offer of the disputed Domain Name for sale was not made specifically to Complainant or its competitor, offers for sale to the public may nevertheless constitute evidence of bad faith under the Policy" (United Artists Theatre Circuit Inc. v. Domains for Sale Inc., WIPO Case No. D2002-0005, March 27, 2002).

In this regard, it shall also be taken into account that "Offers to sell to the public at large domain names that are identical or confusingly similar to marks of others may constitute bad faith […] This is based on the nonexhaustive character of the express list of bad faith factors in paragraph 4(b) of the Policy, and the lack of a justification for awarding financial gain to persons for the mere act of registration of the marks of others": see, for example, United Feature Syndicate, Inc. v. All Business Matters, Inc. (aka All Business Matters.com) and Dave Evans (WIPO Case No. D2000-1199); Alloy Rods Global, Inc. v. Nancy Williams (WIPO Case No. D2000-1392); Dell Computer Corporation v. Alex and Birgitta Ewaldsson (WIPO Case No. D2000-1087); eBay Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd. (WIPO Case No. D2000-1463).

Lastly, it is also true that "The sole fact that the disputed domain names have been registered by a person that does not use them but publicly offers them for rent or sale is the most perfect evidence of a bad faith activity in prejudice of Internet community and of the owner of the trademarks used as domain names" (TV Globo Ltda. v. Radio Morena, WIPO Case No. D2000-0245).

There is something more. Paragraph 4(b) of the Policy also provides a non-exhaustive list of circumstances that can constitute evidence of a Respondent's bad faith in registering and using a Domain Name. In particular, the consensus view of WIPO UDRP panellists is that bad faith may in, some cases, be found in other conducts carried out by a domain name holder. Panels have tended to make such findings in circumstances in which, for example, a complainant's mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the Complainant's trademark rights.

As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademarks. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which does exactly correspond to the Complainant's trademarks and that result so similar to the Complainant's domain names currently used by the latter to provide online banking services for its clients.

In the light of the above, the present case completely matches to the above requirements: "The Panel accepts the

Complainant's submissions that […] it is not possible for the Respondent to have been unaware of the Complainant's […] brand and associated trademarks prior to registering the Domain Name. As a consequence, the Panelist finds that in registering the Domain Name, the Respondent was aware of the Complainant's […] brand and associated trademarks. Given the above information […] the Panelist can find no plausible circumstances in which the Respondent could legitimately use the Domain Name" (see Microsoft Corporation v. Superkay Worldwide, Inc. - Case No. D2004-0071).

Likewise, it is not possible for the Panelist to "conceive a plausible situation in which the Respondent would have been unaware of this fact at the time of registration". (Telstra Corporation Limited v. Nuclear Marshmallows - WIPO Case No. D2000-0003). On the contrary, the contested domain name "is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith" (Veuve Clicquot Pnsardin, Maison Fondée en 1772 v. The Polygenix Group Co. - WIPO Case No. D2000-0163). Besides, "It is not likely that any trader would choose a name including the trademark […] if not to create an impression of association with the Complainant" (Benetton Group S.p.A. v. Azra Khan - Case No. D2002-0810).

It should be also noted that the disputed domain name has been registered the exact same day (few hours later) of the Complainant's fresh new EU trademark application no. 018137297 "RIO CASAMIA". This is not a coincidence, as it is highly probable the Respondent received (or was aware of) our insider information concerning the Complainant's imminent trademark filing. This suggest opportunistic bad faith (see Ezcommerce Global Solutions v. Alphabase Interactive WIPO Case D2002-0943).

Lastly, it shall be underlined that – on December 16, 2019 – the Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the contested domain name to their client. The Respondent's never replied to such communication.

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Firstly, Complainant alleges that the disputed domain name is virtually identical to its RIO CASAMIA trademark.

Therefore, Complainant considers the domain name to be virtually identical to its trademarks rights.
Thus, Complainant believes that Respondent owns the disputed domain name with the intent to exploit its goodwill.

Secondly, Complainant alleges that Respondent has no rights nor legitimate interests in the disputed domain name, in view of Complainant's rights in the sign RIOCASAMIA. It adds that Respondent has not been authorized by nor affiliated to Complainant. Complainant did not grant any license nor authorization to Respondent.
Complainant considers that Respondent does not use the domain name in a fair or non-commercial manner.

Furthermore, Complainant argues that Respondent is not known under the disputed domain name.

Thirdly, Complainant considers that the disputed domain name has been registered and is being used in bad faith. It alleges that Respondent has registered the disputed domain name that is identical to its trademark, having the knowledge of Complainant's existence at the time of the registration.

Complainant points that a simple search on Google search for the wording "RIO CASAMIA" directly makes reference to Complainant. Furthermore, it alleges that its trademarks are well known all around the world. Thence, Complainant argues

the disputed domain name would not have been registered if it was not to attempt Complainant's trademark.

Therefore, it also alleges that Respondent does not use the disputed domain name for any bona fide offering of goods and services but has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant or to a competitor. As evidence, the disputed domain name redirects to a parking page on which it is offered for sale for the amount of USD 990,00.

RESPONDENT:

Respondent did not reply to Complainant's contentions.

RIGHTS

In consideration of the Factual Background, the Parties' Contentions stated above and its own web searches, the Panel comes to the following conclusions:

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 10 (a) of the Rules provides that the Panel "shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

A. The domain name is identical or confusingly similar to Complainant's trademarks

Paragraph 4(a)(i) of the Policy requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or European Union law.
Complainant has duly shown its registered trademark rights in the sign "RIO CASAMIA ", which largely predate the disputed domain name's registration.

Firstly, the disputed domain name <riocasamia.com> reproduces the RIO CASAMIA trademark almost identically. Furthermore, Panel finds that the representation of the trademark without space between the words "rio" and "casamia" is insignificant and does not challenge the risk of confusion. Previous Panels already stated on this point : See for example BOLLORE v. Donald Shillam, CAC case No. 102031 "The Panel finds that the Disputed Domain Name is nearly identical with the Complainant's BOLLORE LOGISTICS trademarks since the deletion of the letter "S" of the word "LOGISTICS" and the deletion of the space between two words of the trademark, which is actually obligatory in domain names, is not sufficient to vanish the similarity."

Secondly, the Panels usually consider, in assessing the existence of a likelihood of confusion with the trademark, that the gTLD in the domain name has to be disregarded, since it is exclusively technical (See e.g. Inspiration GI GmbH v. Valentin D. Vlasov, CAC case No. 101939).

To the satisfaction of the Panel, Complainant has shown that the disputed domain name is confusingly similar to a trademark or service trademark in which it has rights. The requirement of Paragraph 4(a)(i) of the Policy is, therefore, met.

NO RIGHTS OR LEGITIMATE INTERESTS

B. The domain name has been registered without rights or legitimate interests in the name

Pursuant Paragraph 4(a)(ii) of the Policy, the Complainant is required to prove that the disputed domain name has been registered without rights or legitimate interests in the name.
Complainant is required to make a prima facie case demonstrating that Respondent lacks the rights and legitimate interests

in the disputed domain name. If the prima facie case is successful, then the burden of proof shifts to Respondent.

Complainant has duly demonstrated that Respondent has never been authorized by any license to register the disputed domain name or to use the "RIO CASAMIA" sign. It further alleges that Respondent is not known by the name <riocasamia.com>

The Panel finds that Complainant has made a prima facie case having duly shown that Respondent has no right nor legitimate interests in the “RIO CASAMIA” sign.

In addition, it is generally considered by the Panel that the Respondent's failure to respond to the Complainant's assertions is an evidence that Respondent has no right or legitimate interest in the disputed domain name. See for example O'Neill Brand S.à r.l v.s Pan Chen CAC case No 102363 “The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.”

Panel, therefore, finds that Respondent has no rights nor legitimate interests in the disputed domain name.

To the satisfaction of the Panel, Complainant has proven that Respondent has no rights or legitimate interests in respect of the disputed domain name. The requirement of Paragraph 4(a)(ii) of the Policy is, therefore, met.

BAD FAITH

Pursuant Paragraph 4(a)(iii) of the Policy, the Complainant is required to prove that the disputed domain name has been registered or that is being used in bad faith.

Firstly, Complainant has duly shown the reputation of its trademarks and its existence in the cleaning product’s field activity under the name RIO CASAMIA.

Panel considers that Respondent could not have ignored Complainant’s trademark when registering the disputed domain name. A simple internet search on the sign “RIO CASAMIA” displays many results related to Complainant. Having the disputed domain name been registered in 2019, Respondent could not have ignored Complainant’s existence.

Therefore, it is clear that Respondent registered the disputed domain name in bad faith, being fully aware of Complainant’s existence and Complainant’s rights in the “RIO CASAMIA” sign.

Secondly, Complainant has duly proven that Respondent is using the disputed domain name in bad faith. In fact, Respondent reproduces the “RIO CASAMIA” sign in a nearly identical way in the disputed domain name, in order to create a risk of risk of consumer confusion. Panel, therefore, considers Respondent tried to benefit from Complainant’s reputation.

Furthermore, the disputed domain name points to a parking website which offers the disputed domain name for sale for the amount of USD 990,00. It is clear that it is using the domain name in bad faith and with the intention to disturb Internet users and Complainant’s customers for commercial gain. See, for example, CAC Case No. 102374 : “Respondent’s use of the disputed domain name for a parking page is in itself sufficient to support a finding of bad faith use as Respondent is intentionally attempting to attract Internet users to its website for commercial gain, and is thus creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent’s website, in accordance with paragraph 4(b)(iv) of the Policy”. See also, CAC Case No. 102047: In addition, offers to sell to the public at large domain names that are identical or confusingly similar to marks of others may constitute bad faith.

Panel, therefore, finds that the disputed domain name is being used in bad faith.

Thirdly, Complainant’s Attorneys sent a cease and desist letter to Respondent on December 16, 2019, requesting the transfer of the disputed domain name to their client. However, Respondent never replied to such communication. It also shows that Respondent could not have ignored Complainant’s existence.

Therefore, Panel finds that it can be legitimately considered that the disputed domain name was registered and is used in bad faith.

To the satisfaction of the Panel, Complainant has proven that the disputed domain name was registered and is being used in bad faith. The requirement of Paragraph 4(a)(iii) of the Policy is therefore met.

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

Having established all three elements required by the Rules, the Panel concludes that relief shall be granted, without prejudice to a future judicial decision.

For all the foregoing reasons, the Panel orders the domain name <riocasamia.com> to be transferred to Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **RIOCASAMIA.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2020-07-10

Publish the Decision