Decision for dispute CAC-UDRP-103334

Case number	CAC-UDRP-103334
Time of filing	2020-10-27 09:34:32
Domain names	alberghiconfindustria.com

Case administrator

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

Complainant

Organization	Confederazione Generale dell'Industria Italiana - CONFINDUSTRIA
Organization	Associazione Italiana Confindustria Alberghi

Complainant representative

Organization	Barzanò & Zanardo Roma S.p.A.

Respondent

Name	Stefan Paraniac

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The First Complainant, Confederazione Generale dell'Industria Italiana (Confindustria) owns a number of trade marks consisting of the name CONFINDUSTRIA, including the European word and device mark CONFINDUSTRIA and design, EUTM registration number 003701588, registered on 5 August 2005, in international classes 16, 35, 36, 38, 41 and 42; and the Italian word mark CONFINDUSTRIA, registration number 687899, first registered on 20 September 1996 and renewed on 14 April 2014 under registration number 1590934, in international classes 16, 35, 36, 38, 41, and 42.

In addition, the First Complainant owns the domain name <confindustria.it>, registered on 22 May 1996, which is connected to the principal website of the First Complainant. The First Complainant asserts that it owns many other domain names but has not adduced evidence of ownership of any other domain names.

The Second Complainant, Associazione Italiana Confindustria Alberghi (AICA), owns the domain name <alberghiconfindustria.it>, registered on 26 July 2012, which is connected to the Second Complainant's website. The Second Complainant is not itself said to be the owner of any trade marks. However, the Second Complainant is an effective member

of the First Complainant. The statutes/articles of association of the First Complainant provide at Article 6 under the heading "Mandatory requirements of membership in the association system" at lit. b. that: "[t]he Articles of Association of the Effective Members of Confindustria must necessarily foresee ... use of the confederation logo and of the other distinctive signs of the association system pursuant to the modalities included in the implementing regulation to these Articles of Association". The corresponding Implementing Regulation to the Articles of Association includes; in Chapter 1, paragraph 2, the obligation on members to: "[u]se of the confederation logo and of the other distinctive signs of the confederation system ... to explain the membership of Confindustria in compliance with its brand policies". The Second Complainant's own statutes/articles of association provide in Article 1 that: "The Association ... is a member of Confindustria and adopts its logo and other distinctive signs, assuming as such the role of national category member of the representation system of the Italian Industry, as defined in the Confederation's Articles of Association. In light of the above, Associazione Italiana Confindustria Alberghi acquires the consequent rights and obligations for itself and for its associates".

As a matter of the First Complainant's statutes/articles of association and the corresponding implementation regulations, in conjunction with the Second Complainant's own statutes/articles of association, the Second Complainant is therefore both obliged and entitled as an effective member of the First Complainant to use the First Complainant's trade marks. The Panel is therefore satisfied that both the First and the Second Complainant enjoy rights in the trade marks CONFINDUSTRIA as identified above within the meaning of paragraph 4(a)(i) of the Policy.

FACTUAL BACKGROUND

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

The First Complainant is the principal Italian association representing manufacturing and service companies in Italy, with a voluntary membership of more than 150,000 companies of all sizes, employing a total of 5,437,488 people. It is known in short as "Confindustria" and was founded in 1910 by a number of Italian entrepreneurs, who formed their own association to represent and safeguard the interests of industry. Since then, Confindustria has grown substantially and supports its members, and Italian industry in general, through activities such as lobbying, research and studies, conferences, education and training, finance and credit, legal support, negotiation of contracts with local unions, etc.

Confindustria is also the owner of a renowned private Italian university called “LUISS - Libera Università internazionale degli studi sociali” and of an editorial group named “Il Sole 24 Ore”, which operates through one of the most important national business newspapers (Il Sole 24 Ore) and national broadcasting radios (Radio 24) in Italy.

Confindustria operates through 217 local associations and sectoral associations and federations, trade associations and associate members. Confindustria also operates internationally through a network of foreign representations. Confindustria is represented at EU level by a delegation established in Brussels since 1959.

The Second Complainant was created in 2012 through the merger of Confindustria Alberghi and Confindustria AICA. It is one of the trade associations through which the First Complainant operates. This association represents more than 2,500 entities operating in the tourism and accommodation sectors and generating a turnover of over 5 billion Euros per year.

The Respondent is resident in Rimini, Italy, and, according to his LinkedIn profile, is a revenue manager at the National Hotel of Rimini. He registered the disputed domain name <alberghiconfindustria.com> on 30 July 2020. As at the date of the amended complaint and of this decision, the disputed domain name is inactive and resolves to a "403 error" page. There is no evidence before the Panel that the disputed domain name has ever been linked to an active website since it was registered.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainants have, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar

to a trade mark 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 Complainants have, 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 Complainants have, 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 complaint and amended complaint in these proceedings were filed jointly by the First and Second Complainants. Where multiple complaints are filed in a consolidated request, the Panel has discretion to accept the consolidated request where the criteria for consolidation as set out in paragraph 10(e) of the UDRP Rules are met.

The Panel is satisfied (i) that the consolidated complaint in these proceedings raises a common grievance by both Complainants and that registration of the disputed domain name affects both the First Complainant as trade mark owner and the Second Complainant as effective trade body member of the Frist Complainant, and therefore raises common issues; and (ii) that it would be equitable and procedurally efficient to permit consolidation, in particular, in circumstances where no administratively compliant response has been filed. It is therefore appropriate for these complaints to be consolidated and to proceed together. The Panel notes that this decision accords with the practice of panels in other similar UDRP cases (see, for example: CAC Case No 103338, Biofarma and Les Laboratoires Servier v. Ming Zhang <wehealth.city> et al; and CAC Case No 103360, Biofarma and Les Laboratoires Servier v. Oleksandr <wehealthbc.onliney> et al). Both Complainants have requested the transfer of the disputed domain name to the Second Complainant.

The Panel is therefore 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

With regard to the first UDRP element, the Panel finds that the disputed domain name <alberghiconfindustria.com> is, if not identical with, then at least confusingly similar to the First Complainant's trade marks CONFINDUSTRIA. Indeed, the disputed domain name incorporates the First Complainant's trade mark CONFINDUSTRIA in its entirety. The addition of the generic term “alberghi” (which means “hotels” in English) is not sufficient to alter the overall impression of the designation as being connected to the First Complainant’s trade marks and a finding of confusing similarity because it obviously alludes to the First Complainant as a trade body and to the Second Complainant’s effective membership of that trade body and mimics the Second Complainant’s principal domain name <alberghiconfindustria.it>. The Panel notes that the term “alberghi” is furthermore a direct reference to the Second Complainant’s field of activity as a representative organisation of more than 2,500 operators in the touristic and accommodation sectors. Rather than to prevent a likelihood of confusion between the disputed domain name and the Complainants, the CONFINDUSTRIA trade marks, and the Second Complainant’s associated domain name, the addition of the generic word “alberghi” therefore actually increases the likelihood of confusion by suggesting that the disputed domain name provides access to the website of the Second Complainant’s business. The Panel follows in this respect the view established by numerous other panels that a domain name that wholly incorporates a Complainant's trade mark may be sufficient to establish confusing similarity for the purposes of the UDRP (see, for example, WIPO Case No D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy <porsche-autopartes.com>).

With regard to the second UDRP element, there is no evidence before the Panel to suggest that the Respondent has made any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Neither is there any indication that the Respondent is making legitimate non-commercial or fair use of the disputed domain name. As at the time of the amended Complaint and of this decision, the disputed domain name resolves to a “403 error” page and is not being used for any active website. A lack of content at the disputed domain has in itself been regarded by other panels as supporting a finding that the Respondent lacked a bona fide offering of goods or services and

did not make legitimate non-commercial or fair use of the disputed domain name (see, for example, Forum Case No FA 1773444, Ashley Furniture Industries, Inc v. Joannet Macket/JM Consultants; and WIPO Case No D2000-1164, Boeing Co. v. Bressi). The Panel further finds that the Respondent is not affiliated with or related to the Complainants in any way and is neither licensed nor otherwise authorised by the Complainants to make any use of the First Complainant's trade marks or to apply for or use the disputed domain name. Finally, the Whois information also does not suggest that the Respondent is commonly known by the disputed domain name <alberghiconfindustria.com>. Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

With regard to the third UDRP element, the Complainants point out that the Respondent appears to be a revenue manager at the National Hotel of Rimini and therefore himself active in the hotel industry. The Panel agrees that it is difficult in those circumstances to believe that the Respondent was unaware of the First Respondent's trade marks and of the Second Respondent's use of those trade marks as a leading trade body for tourism and hotel businesses in Italy. Furthermore, the Panel notes that, if the Respondent had carried out a Google search for the term "alberghiconfindustria", the search results would have yielded immediate results related to the Second Complainant, its website at <alberghiconfindustria.it>, and its business and services. It is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical with or confusingly similar to the First Complainant's trade mark, and that he registered the disputed domain name in full knowledge of the First Complainant's trade mark and the Second Complainant's rights in those trade marks.

Furthermore, the disputed domain name is currently inactive. The Respondent has not demonstrated any activity in respect of the disputed domain name. It is difficult to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate on the grounds that it would constitute passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trade mark law under circumstances where that disputed domain name corresponds to the First Complainant's trade mark and is similar to the Second Complainant's domain name as currently used by the latter to promote and sell its services. Numerous other UDRP panels have taken the view, which this Panel shares, that the passive holding of a domain name with knowledge that the domain name infringes another party's trade mark rights may in itself be regarded as evidence of bad faith registration and use (see, for example, WIPO Case No D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; and WIPO Case No D2004-0615, Comerica Inc. v. Horoshiy, Inc.).

The Complainants suggest that a finding of bad faith is further supported by the fact that the Respondent has been a respondent in two previous domain name dispute resolution cases giving rise to decisions transferring the disputed domain names to the respective complainants, namely, WIPO CASE No D2019-2018 (<hotelbulgari.com>) and CRDD decision of 2 August 2019 (<bulgarihotel.it>, <bulgarihotels.it>, and <hotelbulgari.it>). In view of the circumstances already identified above as giving rise to a finding that the disputed domain name has been registered and is being used in bad faith, the Panel does not need to decide whether the Respondent's attempts to register domain names including the name BULGARI are sufficient to establish a pattern of bad faith conduct and abusive domain name registrations.

Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALBERGHICONFINDUSTRIA.COM**: Transferred

PANELLISTS

Name	**Gregor Kleinknecht**

2020-12-21

DATE OF PANEL DECISION 2020-12-31

Publish the Decision