

**Decision for dispute CAC-UDRP-103836**

Case number	<b>CAC-UDRP-103836</b>
Time of filing	<b>2021-08-12 09:55:30</b>
Domain names	<b>giacominiarmenia.com</b>

**Case administrator**

Organization	<b>Denisa Bilík (CAC) (Case admin)</b>
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**Complainant**

Organization	<b>Giacomini S.p.A.</b>
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**Complainant representative**

Organization	<b>Convey srl</b>
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**Respondent**

Name	<b>Zaven Lalayan</b>
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## 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 Complainant has evidenced to be the owner, inter alia, of the following trademark registration:

International trademark registration (word mark) No. 701923 "GIACOMINI", granted on July 16, 1998, and duly renewed, with protection, inter alia, for the territory of Armenia.

## FACTUAL BACKGROUND

The Complainant, Giacomini S.p.A. is a company headquartered in San Maurizio d'Opaglio, NO (ITALY) and known as a leading company in the production of components and systems for plumbing fixture fittings with a turnover of 200 million of which more than 80% comes from foreign markets. The Complainant manufactures and offers radiator systems, valves, manifolds, boiler room components, oil filters, solar thermal systems, and thermal energy metering systems.

The Complainant was founded in 1951 by Alberto Giacomini as a small manufacture workshop producing brass taps and ten years later the first European Distribution Branch was set up in Waldbröl in Germany. In the 1970s three more branches were established in Belgium, France, Switzerland to strengthen the Complainant' position on the European market and the company

evolved from simply being a manufacturer of individual components to a supplier of integrated systems.

In the 1990s the company increased its international position with new branches in Spain, Portugal and Central Europe.

A zero emission Hydrogen boiler was presented to public during the 2006 Winter Olympic Games in Turin based on a patented method for burning hydrogen and for its production in an integrated system.

During the years, the Complainant has got an integrated quality, health and safety and environment certification in accordance the British Standards Institution (BSI) certification, UNE-EN ISO 9001, OHSAS 18001 and EN ISO 14001.

Nowadays, the Complainant has 3 Italian production facilities, 20 international subsidiaries, 900 employees and 70 tons of brass processed each day and, therefore, it is ranked among the world leaders for the production of heating, cooling and domestic hot water distribution components and systems, for use in residential, industrial and commercial settings.

Furthermore, the Complainant has been extensively using the “GIACOMINI” denomination on all internet environments including and not limited to the company’s official website [www.giacomini.com](http://www.giacomini.com) and the domain names <[giacomini.it](http://giacomini.it), [giacomini.cn](http://giacomini.cn), [giacomini.asia](http://giacomini.asia), [giacomini.ca](http://giacomini.ca), [giacomini.com.ar](http://giacomini.com.ar), [giacomini.hk](http://giacomini.hk)> (a list of Complainant’s domain names could be provided upon request) - and its official accounts on the major social networks such as Facebook, Instagram and Twitter.

In light of the Respondent’s registration in 2017 and use of the disputed domain name confusing similar to its registered GIACOMINI, the Complainant instructed its representative to address to the Respondent a cease and desist letter in order to notify him of the infringement of the Complainant’s trademark rights, requesting the immediate cease of any use, and the transfer, of the disputed domain name to the Complainant.

The cease and desist letter was therefore sent on April 01, 2021, to the disputed domain name owner’s known email address indicated in the website and in the Whois. The disputed domain name’s owner did not deem appropriate to answer.

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#### PARTIES CONTENTIONS

##### PARTIES' CONTENTIONS:

##### COMPLAINANT:

The disputed domain name registered by the Respondent is confusingly similar to trademarks in which Complainant has rights. The disputed domain name incorporates the whole of the Complainant’s trademark GIACOMINI and the fact that it includes non-distinctive elements such as a geographical indicator (“Armenia”) and the generic Top-Level Domain “.com” does not affect the confusing similarity.

The Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant’s trademarks. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain name. Upon information and belief, the Respondent is not commonly known by the disputed domain name as individual, business or other organization and its family name does not correspond to Complainant’s trademark GIACOMINI or the disputed domain name. The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before any notice of the dispute.

The registered trademark GIACOMINI has been used extensively and exclusively by the Complainant since 1951 (when the Complainant was established by Alberto Giacomini) and through long established and widespread use in many countries of the world, the aforesaid trademark of the Complainant enjoys worldwide reputation in the sector of components and systems for plumbing fixture fittings. The use of the disputed domain name in connection with a commercial website where the Complainant’s trademark is misappropriated and prima facie replicas of GIACOMINI products are offered for sale, clearly indicates that the Respondent’s purpose in registering and using the disputed domain name was to capitalize on the reputation of the Complainant’s trademark by diverting Internet users seeking GIACOMINI products to his website for financial gain, by

intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said web sites, according to paragraph 4(b)(iv) of the Policy. On the website corresponding to the disputed domain name, there is no disclaimer informing the users as to the Respondent's lack of relationship with the Complainant thus, the website creates the impression that the Respondent is an official dealer in Armenia.

Such use of the disputed domain name to promote and sell also products of the Complainant's competitors is a further circumstance supporting the evidences that the Respondent registered the disputed domain name to intentionally attempt to attract, for commercial gain, the Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation or endorsement of the Respondent's website or location, or of a product or service on the Respondent's website or location.

## RESPONDENT:

In the Response submitted on September 6, 2021, the Respondent stated the following:

"Hello,

I have received the complaint. I want to explain that I'm not the person that owns the domain. I'm a web developer that creates WordPress websites and hosts them in the domain that client requests. I understand that my client may have violated some rules. I did contact him and forward the content of the complaint, now I'm waiting for a response from him."

The CAC invited the Respondent to submit additional statements but the Respondent failed to communicate further in course of the proceeding.

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## 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).

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## 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).

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## 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).

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## 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.

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## PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain name <giacominiarmenia.com> is confusingly similar to the Complainant's "GIACOMINI" trademark, since the disputed domain name incorporates the Complainant's trademark in its entirety and the mere addition of the geographic term "Armenia" is not capable to dispel the confusing similarity arising from the Complainant's trademark's incorporation in the disputed domain name.

Therefore, the Complainant has established the first element under the Policy set forth by paragraph 4(a)(i).

Moreover, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent so far has neither made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering

of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name, nor is the Respondent commonly known thereunder.

As evidenced by the Complainant, the disputed domain name redirects to an active website at “www.giacominiarmenia” which prominently displays the Complainant’s official GIACOMINI logo without any authorization granted by the Complainant to do so, and also offers products, apparently in the Armenian language, which directly compete with those offered by the Complainant. Also, the case file does not indicate as to why the Respondent needed to rely on the Complainant’s GIACOMINI trademark as part of the disputed domain name unless in an attempt to somehow profit from the Complainant’s trademark’s undisputed reputation. Such doing business by the Respondent obviously neither qualifies as a bona fide nor as a legitimate non-commercial or fair use of the disputed domain name under the UDRP.

In this context, the Panel has certainly noted the Respondent’s allegations that it was not the owner of the disputed domain name, but that it had only registered it for some unknown third party who “may have violated some rules” by using the disputed domain name in the way described above. Such circumstances, however, are obviously not in contrast to find that the Respondent has no rights or legitimate interests in respect of the disputed domain name as set forth by paragraph 4(c) of the Policy.

The Panel, therefore, holds that the Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

Finally, given the undisputed reputation of the Complainant’s “GIACOMINI” trademark and given the fact that the disputed domain name is used to offer products directly competing with those of the Complainant, clearly indicates that either the Respondent had knowledge of the Complainant’s trademark at the time the disputed domain name was registered or that the Respondent was “willfully blind” in that respect while some third person instructing the Respondent to register the disputed domain name and using it ever since had such knowledge. Also, redirecting the disputed domain name to an active website at “www.giacominiarmenia” which prominently displays the Complainant’s official GIACOMINI logo without any authorization granted by the Complainant to do so, thereby offering competing products, is a clear demonstration that the disputed domain name aims at profiting from the Complainant’s trademark’s reputation in an unjustified way, e.g. by diverting Internet users seeking GIACOMINI products to the website under the disputed domain name for financial gain, and intentionally creating a likelihood of confusion with the Complainant’s GIACOMINI trademark as to the source, sponsorship, affiliation, or endorsement of such website and/or the goods offered or promoted through said website, and must, therefore, be considered as registered and being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. In this context, the Panel has also taken into account that while the Respondent claims in its Response of September 6, 2021, that it was not the owner of the disputed domain name, but that it had only registered it for some unknown third party who “may have violated some rules” by using the disputed domain name, Respondent still has failed to submit any evidence or at least to argue e.g. as to why it was not in a position to stop such possibly violating use of the disputed domain name and to put it to a good faith use instead. Therefore, Respondent has nothing brought forward that would allow this Panel to find for some good faith acting on the part of the Respondent instead of holding that the disputed domain name was registered and is being used in bad faith as set forth by paragraph 4(b) of the Policy.

Accordingly, the Panel finds that the Complainant has also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GIACOMINIARMENIA.COM**: Transferred

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## PANELLISTS

Name	<b>Stephanie G. Hartung, LL.M.</b>
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DATE OF PANEL DECISION 2021-09-21

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Publish the Decision

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