

Decision for dispute CAC-UDRP-104127

Case number	CAC-UDRP-104127
Time of filing	2021-11-05 09:06:01
Domain names	cosmoprofeurasia.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	BolognaFiere Cosmoprof S.p.A
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Complainant representative

Name	Niccolò Ferretti
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Respondent

Organization	Imperial education
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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 is the licensee of several trademark registrations for the sign "Cosmoprof", specifically:

- International Trademark Registration No. 0981689, registered on July 24, 2008 for products/services in classes 16, 35, 41 of the Nice Classification;
- European Union Trademark Registration No. 001050483, "Cosmoprof", filed on January 22, 1999 and registered on January 12, 2001 for services in classes 35, 41 and 42;
- European Union Trademark Registration No. 001323831, "Cosmoprof hair fashion", filed on September 27, 1999 and registered on November 30, 2000 for services in classes 35, 41 and 42;
- International Trademark Registration No. 1574658, WECOSMOPROF (fig), registered on September 9, 2020 for services in classes 35, 41 and 42;
- European Union Trademark Registration No. 002392504, "Cosmoprof", filed on September 28, 2001 and registered on July 7, 2009 for products class 16;
- Italian Trademark Registration No. 302005901352630, COSMOPROF, filed on October 21, 2005 and registered on November 11, 2008 for services in class 42;

- Italian Trademark Registration No. 302005901291117, COSMOPROF, filed on March 3, 2005 and registered on November 7, 2008 for products in class 16;
 - Italian Trademark Registration No. 301995900469408, "Cosmoprof", filed on October 10, 1995 and registered on May 27, 1998 for services in class 42;
 - International Trademark Registration No. 1063244, COSMOPROF MADE IN BEAUTY, registered on November 17, 2010 for services in classes 35 and 41;
 - Italian Trademark Registration No. 302002901006003, Looks by COSMOPROF (fig), registered on April 10, 2006 for products/services in classes 16 and 36; and
 - Italian Trademark Registration No. 302005901345065, COSMOPROF THE BEAUTY EVENT (fig), registered on November 7, 2008 for products/services in classes 16, 35 and 41.
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FACTUAL BACKGROUND

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

The Complainant in the present proceedings is BolognaFiere Cosmoprof S.p.A., an Italian company, part of the Group Fiere Internazionali di Bologna S.p.A. - Bolognafiere or, in abbreviated form, Bolognafiere S.p.A., with register office in viale della Fiera, 20, 40127, Bologna, holder of all the aforementioned trademarks.

In more than 50 years of history, the Complainant has built a standing reputation based on its expertise and the high level of services offered, by also being able to evolve and innovate over time, looking ahead to the future and investing toward the continuous improvement of the events organized.

In light of the Complainant's significant investments in R&D, marketing, sales and distribution channels, as well as the existence of a truly impressive client base for these events, "Cosmoprof" has become a worldwide well-known trademark in its field.

Cosmoprof by BolognaFiere Cosmoprof is the most important trade fair in the world, encompassing all the core players of the beauty industry, from raw materials to finished products. Over the course of the 50 years since its beginning, the success and expectations for the event have steadily increased.

Furthermore, for the past editions, all the initiatives within BolognaFiere Cosmoprof have been aimed at underlining the organizers' commitment to ensure the sustainability of the event.

Every year, Cosmoprof represents an unmissable event for operators in the cosmetics sector, not only to establish their presence on the market and making themselves known to a very large pool of potential clients, but also to intercept new market trends and be ready to respond to changing customer demands.

Today, Cosmoprof is a vast global phenomenon, made of: 5 Cosmoprof worldwide branded shows, 25 international beauty events, 54 years of know-how in the beauty trade shows business, 3 digital events, +10.000 exhibitors involved, 190 Countries of origin, +500.000 professionals engaged and 80 USD mln of total revenues in 2018.

In order to further protect the "Cosmoprof" trademark also on Internet, the Complainant has registered many domain names, comprising the trademark "Cosmoprof", under several different TLDs.

The Complainant is present online also through the popular social medias: LinkedIn (<https://www.linkedin.com>), YouTube (<https://www.youtube.com>), Facebook (<https://www.facebook.com>) and Instagram (<https://www.instagram.com>).

The website <https://www.cosmoprof.com/> is the official website of the Complainant.

With surprise and great disappointment, on October 2021, the Complainant became aware that, on July 14, 2021 the Respondent had registered the domain name <cosmoprofeurasia.com >, without the Complainant's authorization.

A. The domain name is identical or confusingly similar to the trademarks in which the Complainant has rights (UDRP Rules, Article 3(b)(ix), Policy, Paragraph 4 (a))

The disputed domain name registered by the Respondent, <cosmoprofeurasia.com>, is identical, or at least confusingly similar, to the trademarks "Cosmoprof", on which the Complainant, as licensee, has rights. In particular, analyzing both the signs, they appear different for the presence, in the contested domain name, of the term 'eurasia'.

In terms of similarity, it is well established that the addition of a generic or descriptive term to a sign on which a Complainant has rights is often not an obstacle to a finding of confusing similarity.

Indeed, the descriptive term ('eurasia') increases the confusing similarity, as it recalls the Complainant's zone of business.

A helpful set of examples of this phenomenon is set out in a decision of a CAC's Panel in respect of .eu (interpreting in this context a comparable requirement as under the UDRP): Case 06295 <BENEFITCOSMETICS.EU>.

The addition of the generic word 'eurasia' does not alter the fact that the disputed domain name is confusingly similar to the Complainant's registered trademarks (CAC Case No. 100667), and it is therefore not sufficient to avoid the risk of similarity (CAC Case No. 101024).

Moreover, many UDRP decisions have established that a disputed domain name is identical or confusingly similar to a Complainant's trademarks when the disputed domain name incorporates the Complainant's trademark or the principal part thereof in its entirety.

The disputed domain name "cosmoprofeurasia.com" incorporates the entire trademarks of the Complainant, i.e. "Cosmoprof".

In light of the foregoing, it is clear that the domain name is identical / confusingly similar to Complainant's trademarks according to Article 3 (b)(ix) UDRP Rules.

B. The Respondent has no rights or legitimate interests in respect of the domain name(s)

(UDRP Rules, Article 3(b)(ix), Policy, Paragraph 4 (a))

It is well-established case-law that the burden of proving the absence of the Respondent's rights or legitimate interests in respect of the domain name lies with the Complainant. However, it is a well-settled principle that the satisfaction of this burden is unduly onerous, since proving a negative fact is logically less feasible than establishing a positive fact.

Accordingly, it is sufficient for the Complainant to produce prima facie evidence in order to shift the burden of proof on to the Respondent.

The Respondent is not a licensee, nor an authorized agent of the Complainant, nor it has been, in any other way, authorized to use the Complainant's trademarks. The Respondent has no relationship with the Complainant (CAC Case No. 101024).

The Complainant has not licensed or otherwise permitted the Respondent to use its trademarks or register the disputed domain name incorporating its mark. In particular, it is important to note that the Respondent has never registered "cosmoprofeurasia" as a trademark, but it has only created the disputed domain name in order to mislead the public.

In the absence of any license or permission from the Complainant to use its trademarks, no bona fide or legitimate use of the domain name could reasonably be claimed by the Respondent, that therefore lacks any rights or legitimate interests in the disputed domain name.

For all the above-mentioned reasons, the Respondent is not making a legitimate non-commercial use or a fair use of the disputed domain name without the intent of commercial gain, of misleadingly diverting consumers or tarnishing the trademark of the Complainant.

In addition, the Respondent is not commonly known by the domain name as an individual, business or other organization, and "Cosmoprof" is not the family name of Respondent.

For all of the foregoing reasons, the Complainant concludes that Respondent has no rights or legitimate interests in respect of the domain name pursuant to Article 3 (b) (ix) of the UDRP Rules.

C. The domain name was registered or is being used in bad faith

(UDRP Rules, Article 3(b)(ix), Policy, Paragraph 4 (a))

In light of the use of the trademarks "Cosmoprof" for many years, the amount of advertising and successful events organized, the intensive use of the trademarks worldwide, the Respondent could not have ignored the existence of the Complainant's trademarks, with which the domain name is confusingly similar.

In this regard, the registration of the contested domain name made by the Respondent, even though the previous acknowledgement of the Complainant's trademarks, testifies Respondent's bad faith (CAC Case No. 103490).

In adding, as prior panels have held, the incorporation of a famous mark into a domain name that redirects to commercial links may be evidence of bad faith registration and use (CAC Case No. 102647).

At the moment the website related to the contested domain name is active and redirects to a "parked page" where is shown a directory with different related searches, as "Cosmoprof Beauty Supply", "Beauty Store"; "Sell on Google Shopping"; "Business"; "Online Dropshipping Business" and "Map", all ending in unacted pages. Not only the website is active but it has changed its directory showing different related searches, as "Listed Products Online"; "Professional Employers Organization"; "Online Dropshipping Business"; "Google Business Analyst Certification"; "Call Center Chat Software" and "Double Chin Coolsculpting Price".

By using the domain name for a website promoting the Complainant's products or name and services not related to

Cosmoprof, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Pursuant to paragraph 4(b)(iv), this is evidence of the registration and use of the domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy.

The Complainant submits that the above-mentioned requirements are all clearly met in the case at hand. Under these circumstances, considering also the identity / confusing similarity of the disputed domain name with the trademarks "Cosmoprof", as well as with the Complainant's main domain name <cosmoprof.com>, the Complainant finds that there would be no reasonable grounds for the Respondent to argue that, through the disputed domain name, it was intending to pursue a legitimate activity.

Moreover, given the reputation of the Complainant, it is obvious that the registration of a domain name, in clear violation of its rights, has the sole intention of misleading the public, creating confusion between the domain names and the trademarks used by BolognaFiere Cosmoprof S.p.A..

It is clear that the purpose that led the Respondent to register the domain name was primarily to disrupt the business of BolognaFiere Cosmoprof S.p.A. and Fiere Internazionali di Bologna S.p.A. - Bolognafiere or, in abbreviated form, Bolognafiere S.p.A, the leader company in the sector: the Respondent did not intend to use the domain name in connection with any legitimate purpose (such as an offer of bona fide goods or services, or a legitimate non-commercial / fair use), but has only used the domain name as part of a fraudulent scheme.

In view of the above, the Respondent has clearly registered and used the disputed domain name in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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).

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).

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).

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

I. RIGHTS

The disputed domain name is confusingly similar to the Complainant's registered trademarks since it reproduces the Complainant's licenced mark 'COSMOPROF', merely adding the geographical term "Eurasia" at the end.

II. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any response. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the domain name in dispute.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D20020856:

“As mentioned [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed domain name, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists.” WIPO Case No. D20020273 <sachsenanhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

Furthermore, currently the domain name in dispute is redirected to a parking website containing links to beauty and shopping websites, the main activity of the Complainant, therefore clearly trying to impersonate the Complainant. Obviously, this use cannot be considered as legitimate.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

III. BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant’s allegations and evidence with regard to the Respondent’s registration and use of the disputed domain name in bad faith.

The Complainant has filed evidence of the well-known character of the COSMOPROF trademark and fair for cosmetic and beauty activities. The disputed domain name resolves to a parking with links to such activities. Consequently, it seems clear that the Respondent is trying to impersonate the Complainant and that the Respondent registered the domain name for this fraudulent purpose.

Paragraph 4(b) (iii) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or of a product or service on its website or location.

As mentioned in *Andrey Ternovskiy dba Chatroulette v. Alexander Ochki*, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see *AT&T Corp. v. Amjad Kausar*, WIPO Case No. D2003-0327)."

It has, therefore, been satisfactorily demonstrated to the Panel that the disputed domain name has been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. COSMOPROFEURASIA.COM: Transferred

PANELLISTS

Name	José Ignacio San Martín
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DATE OF PANEL DECISION 2021-12-07

