Decision for dispute CAC-UDRP-104369

Case number	**CAC-UDRP-104369**
Time of filing	**2022-02-22 09:48:04**
Domain names	**NOVATEXITALIA.INFO**

Case administrator

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

Complainant

Organization	**Novatex Italia S.p.A.**

Complainant representative

Organization	**Perani Pozzi Associati**

Respondent

Organization	**Barryj ltd**

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 owner of a number of trade marks for NOVATEX including, by way of example, European Trade Mark, registration number 18015877, in classes, 16, 17 and 22, registered on June 12, 2019.

FACTUAL BACKGROUND

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

The Complainant is a company based in Italy which manufactures net wraps for use in crop baling farming equipment and sells them into local and international markets. The Complainant's brand is NOVATEX and, in addition to its trade marks for NOVATEX, it owns and operates many domain names which include its mark, including <novatexitalia.it>, <novatexitalia.kr> and <novatexitalia.tw>.

The disputed domain name was registered on February 15, 2022. It does not resolve to an active website. However, the disputed domain name has been used to send a phishing e-mail to a customer of the Complainant using e-mail addresses which are very similar to e-mail addresses of two of the Complainant's employees.

The disputed domain name is confusingly similar to a trade mark in which the Complainant has rights in that it reproduces the Complainant's NOVATEX mark and adds the word "italia".

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent correspond to the name of the Respondent nor is it commonly known by the disputed domain name. Moreover, the Respondent is not making a fair or non-commercial use of the disputed domain name nor using it in connection with a bona fide offering of goods and services.

The Respondent has registered and is using the disputed domain name in bad faith. The fact that the disputed domain name is confusingly similar to the Complainant's well-known mark suggests that the Respondent was, as at the date of registration, aware of the Complainant's mark and its registration in these circumstances is in bad faith. The fact that the disputed domain name does not resolve to an active website does not prevent a finding of bad faith use under the doctrine of passive holding. The Respondent most likely registered the disputed domain name for the purpose of phishing, as evidenced by the fact that one of the Complainant's customers has received a phishing e-mail from the address of the disputed domain name. Use of the disputed domain name for fraudulent purposes clearly establishes bad faith use.

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

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following three elements in order to succeed in its Complaint:

(i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

Rights

The disputed domain name includes the Complainant's NOVATEX mark, in full and without alternation, and adds to it the word, "italia". This additional word does not serve to distinguish the disputed domain name from the Complainant's mark. The Panel accordingly finds that the disputed domain name is confusingly similar to the Complainant's NOVATEX trade mark.

Rights and legitimate interests

The Policy sets out at paragraph 4(c) examples of circumstances, without limitation, by which a respondent may demonstrate rights or legitimate interests in a disputed domain name. These are, in summary: (i) if the respondent has been using the domain name in connection with a genuine offering of goods and services or has made demonstrable preparations to do so; (ii) if the respondent has been commonly known by the domain name; or (iii) if the respondent has been making a legitimate noncommercial or fair use of the domain name.

The use by the Respondent of the disputed domain name for the purpose of illegal activity, namely sending phishing e-mails, does not amount to a bona fide offering of goods and services and cannot confer rights or legitimate interests on the Respondent; see COMPAGNIE DE SAINT-GOBAIN v BENOIT BAZIN, CAC Case No. 102002. Nor does such use comprise a legitimate noncommercial or fair use of the disputed domain name. Moreover, there is no evidence that the Respondent has been commonly known by the disputed domain name.

The Complainant having made out a prima facie case in relation to the second element, the burden of proof shifts to the Respondent to rebut it. In the absence of any response by it to the Complaint, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Bad faith

The only known use to which the disputed domain name has been put has been to send a phishing e-mail to a customer of the Complainant which, having regard to its confusing similarity with the Complainant's mark and the many other similar domain names which the Complainant uses, was evidently intend to suggest to the recipient that it came from the Complainant. It is reasonable to suppose that the disputed domain name was registered for the purpose to which it has been put and that the sending of such an e-mail by the Respondent is not an isolated occurrence.

Paragraph 4(b)(iv) of the Policy provides that registration and use of a domain name will be considered to be in bad faith a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. Earlier decisions under the Policy have clarified that use of a domain name for purposes other than hosting of a website may constitute bad faith and accordingly paragraph 4(b)(iv) is construed accordingly; see, for example, Pepsico, Inc. v Allen Othman, CAC Case No. 102380. The disputed domain name has been registered and used in order to send phishing e-mails intended to mislead the recipients that they have been sent by employees of the Complainant for the purpose of defrauding them. This comprises paradigm bad faith registration and use within the circumstance set out at paragraph 4(b)(iv) of the Policy. In that the Respondent has been using the disputed domain name, for the purposes of obtaining commercial gain, by creating a likelihood of confusion between the Complainant's mark and the disputed domain name; see, for example ArcelorMittal (SA) v Adam New, CAC Case No. 102146.

The Panel accordingly finds that the disputed domain name was both 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. **NOVATEXITALIA.INFO**: Transferred

PANELLISTS

Name	**Antony Gold**

DATE OF PANEL DECISION 2022-03-29

Publish the Decision