# Decision for dispute CAC-UDRP-104395

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| Case number | CAC-UDRP-104395 |
| Time of filing | 2022-03-11 09:37:06 |
| Domain names | compass.computer |

## Case administrator

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

## Complainant

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| Organization | Compass Banca S.p.A. |

## Complainant representative

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| Organization | Barzanò & Zanardo Milano S.p.A. |

## Respondent

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| Name | Steve Quinn |

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 trademarks consisting of the term “COMPASS” in particular the EUTM COMPASS® (figurative) N° 000295642 filed on June 11, 1996 and registered since July 18, 2000 in class 36 and the EUTM COMPASS® (word) N° 007458466 filed on December 12, 2008 and registered since July 7, 2009 in class 36.

FACTUAL BACKGROUND

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

The Complainant was founded in 1960 in Milan, and is an Italian credit institution, part of the Mediobanca group. The Complainant has over 260 points of sale in Italy and specializes in consumer credit, including personal and finalized loans, credit cards and salary backed loans.

The Complainant is one of the main Italian companies active in its sector.

The Complainant owns several COMPASS trademarks. The Complainant has not asserted that it owns any domain names

using the COMPASS denomination.

On February 19, 2022, the Respondent Steve Quinn, an individual located in the United States, registered the disputed domain name <compass.computer>. The disputed domain name is identical to the Complainant's COMPASS trademarks.

The Respondent has no rights in the disputed domain name. The Respondent is authorized to use Complainant's trademark, or is there any other association between the Complainant and Respondent.

The disputed domain name was registered for the sole scope of misleading potential consumers, to tarnish the Complainant's reputation and to prevent the Complainant from reflecting its trademark in the corresponding domain name.

The disputed domain name resolves to a registrar parking page containing pay-per-click links. The content of the pay-per-click links is related to the Complainant's business. The Respondent cannot avoid responsibility for the content on the disputed domain name, even if such content is generated by a third party and the Respondent does not profit therefrom.

The above facts asserted by the Complainant are not contested by the Respondent.

According to the information on the case file, the Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

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 not, 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

THREE ELEMENTS COMPLAINANT MUST ESTABLISH UNDER THE POLICY

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark 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.

Accordingly, the onus is on the Complainant to make out its case. Past UDRP panels have consistently held that a complainant must establish all three elements of the Policy before any order can be made to transfer a domain name. Whilst panelists may undertake limited factual research into matters of public record (WIPO Overview 4.8), this does not mean that they should do most of the "legwork" to establish the parties' allegations and/or available defenses.

Under paragraph 15 of the Rules, a panel's assessment is generally made on the basis of the statements and the evidence presented in the complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed (WIPO Overview 4.3).

A respondent's default does not automatically result in the transfer of the domain name to the Complainant (WIPO Overview 4.3: "Noting the burden of proof on the complainant, a respondent's default (i.e., failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. In cases involving wholly unsupported and conclusory allegations advanced by the complainant, or where a good faith defense is apparent (e.g., from the content of the website to which a disputed domain name resolves), panels may find that – despite a respondent's default – a complainant has failed to prove its case.").

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term COMPASS (or its transliteration) for banking and financial matters in class 36. The Complainant's trademarks were registered prior to February 19, 2022, the creation date of the disputed domain name. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. As such, the Panel finds that the Complainant possesses rights in its COMPASS trademark.

The TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0). Accordingly, the gTLD <.computer> may be disregarded in determining whether the disputed domain name is identical or confusingly similar to the Complainant's trademark. Because the Complainant's trademark and the material part of the disputed domain name are identical - i.e. both are COMPASS - therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain name is identical or confusingly similar to Complainant's mark.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The second element of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests in the disputed domain name. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the domain name; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

Nevertheless, the burden of proof still remains with the Complainant to make out its prima facie case to a balance of probabilities standard; see, for example, CAC Case No. 102263, Intesa Sanpaolo S.p.A. v Ida Ekkert. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

In the present case, the Complainant asserts that the Respondent is not commonly known by the disputed domain name, is not in any way related to the Complainant, nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. Further, the Complainant submitted evidence that the Respondent does not own any trademarks that could grant him rights in the disputed domain name. This has not been contested by the Respondent. Instead, the Respondent has not responded in any form and thus has failed to rebut the Complainants claims by providing any information and/or evidence whatsoever that could have shown that he has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

Therefore, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The third element requires Complainant to show that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. This bad faith requirement is stated in the conjunctive, that is, a complainant must establish - on the balance of the probabilities - both registration and use in bad faith. Hallmark Licensing, LLC v. EWebMall, Inc., Case No. D2015-2202 (WIPO, February 12, 2016) (“The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.”).

It is well-established that to prove bad faith the Complainant needs to demonstrate targeting by the Respondent and in the present dispute such proof of targeting is absent. Because trademarks can co-exist across jurisdictions and classes of goods, the mere fact that a domain name is identical to a third-party trademark does not prevent such domain names from being registered nor are such registrations automatically considered to be in bad faith (see WIPO Overview 3.2.3).

In the present proceeding, there is no compelling evidence the Respondent intended to take unfair advantage of the Complainant’s trademarks in any way or somehow had the Complainant in mind when he registered the disputed domain name.

The Complainant asserts that its trademark is well-known. However, the Complainant did not provide evidence to support such a claim pertaining to the reputation of its trademark. Further, the Complainant has not submitted any circumstances or evidence that could give rise to actual or constructive knowledge about Complainant’s COMPASS trademark on the part of the Respondent, such as active registration and/or use of the trademark in the U.S. (where the Respondent is located) or any kind of advertising or online presence in that territory. The is no indication that an internet search of the term “Compass” or “Compass Computer” would lead to results pointing to the Complainant. In Scott Dylan v K-Ventures FZE, WIPO Case No. D2021-2977, the panel in that case rejected the complainant’s claim of targeting in part because the domain name contained a descriptive term <caribou.com>. The same logic must be applied to the instant proceeding.

In this case, the denomination “COMPASS” is a dictionary word which has an ordinary meaning, and is not per se associated with the Complainant. Even considering the Complainants prior European trademark, the Complainant has not established that the Respondent was or should have been aware of a trademark protected in Europe and in business only in Italy for services in class 36. As noted above, no substantive evidence of fame or reputation of Complainant’s mark was offered by the Complainant. Accordingly, there is no evidence on the record that the Respondent was aware of the Complainant and its trademarks.

The Complainant asserts that the Respondent "could not ignore" Complainant's European trademark(s), when he registered the disputed domain name. The Panel is not persuaded on this point, since the Complainant failed to provide any evidence that the Respondent was, or should have been aware of its trademark. Rather, the Complainant asserts that because the sponsored pay-per-click links included on the website associated with the disputed domain name were related to the Complainant's industry, this should lead to a finding that the disputed domain name was registered in bad faith. On this issue, Complainant concedes that the content of the pay-per-click links is generated by a third party and further concedes that it is possible the Respondent does not directly profit from such content. While it is well-established that a registrant cannot absolve himself of responsibility for the content of the website associated with his domain name because he has "control" thereof, it does not logically follow that a registrant has bad faith at the time of registration, merely because subsequent to registration, third party auto-generated content on the website potentially intrudes on trademark rights. As mentioned above, the Policy requires that a complainant must prove both registration and use in bad faith and in this situation there is no evidence that supports a finding of bad faith registration.

Previous UDRP decisions confirm that in the absence of targeting, there can be no bad faith of the respondent, see e.g.: BlankPage AG v. Waleed Altywaijri, WIPO Case No. D2012-2189 ("Is there anything to suggest that the Respondent was even aware of the existence of the Complainant when he registered the Domain Name? Again, the Panel has no information on the topic"); iEnterprises, Holdings, LLC v. Private Domain CAC Case No. 103374 ("the ICRM acronym is not unequivocally associated with the Complainant and is subject to a wide range of interpretations and uses. As indicated above, the Respondent is not targeting the Complainant or its trademark"); Kracie Holdings, Ltd. v. Kelly Franznick CAC Case No. 102970 ("The disputed domain name…redirects to a parking page with pay-per-click links some related to the Complainant and its activities"…"Based on the facts and the evidence provided by the Complainant, the Respondent must not necessarily have been aware of the Complainant when registering the disputed domain name.") and GROUPE CANAL + v. Danny Sullivan CAC Case No. 102809 ("Although no Response has been filed, the burden of proof rests with the Complainant…").

The Complainant claims that the Respondent's "sole scope" for registering the disputed domain name was to mislead potential consumers, to tarnish the Complainant's reputation and to prevent the Complainant from reflecting its trademark in the corresponding domain name. The Panel rejects these claims and finds it to be plausible that the domain was registered for another purpose, particularly in light of the following factors:

i. the nature of the domain name and the trademarks – the disputed domain name consists of the dictionary word "Compass" and the gTLD <.computer>, and neither denomination nor the combination of terms is associated exclusively or primarily with the Complainant's trademarks;

ii. the trademark is not well-known - there was no evidence submitted of any reputation and/or popularity of Complainant's trademarks;

iii. the content of the website – while it may be argued that there is some relation between the content of the website of the Respondent and the activities of the Complainant and its trademarks, such content was generated by a third party rather than the Respondent. In this instance the pay-per-click link content is insufficient, absent other relevant factors, to give rise to a finding that the disputed domain name was primarily registered for the purpose of misleading potential consumers (see, for example, Kracie Holdings, Ltd. v. Kelly Franznick CAC Case No. 102970);

iv. no other indicia generally suggest that the respondent was targeting the Complainant – in particular considering the parties which are located in different geographic regions, i.e. the US and Italy. There is no evidence that the Respondent was somehow aware of the Complainant and its "COMPASS" trademarks;

v. absence of tarnishment – no evidence was submitted of any false or defamatory content pertaining to Complainant (see WIPO Overview 3.12);

vi. lack of prevention of the reflection the Complainant's mark in the domain name – no evidence of a pattern of such

conduct on behalf of the Respondent was submitted (see WIPO Overview 3.1(ii)).

(D) REVERSE DOMAIN NAME HIJACKING

Under Paragraph 1 of the Rules, "Reverse Domain Name Hijacking" (RDNH) is defined as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name." Paragraph 15(e) of the Rules provides that if "the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding."

Previous panels have held that such a finding is justified only in rare cases, such as instances where a complainant proceeds despite the fact that it knew or should have known that it did not have a colorable claim under the Policy. See Karma International, LLC v. David Malaxos, FA 1822198 (Forum Feb. 15, 2019) (finding RDNH where complainant lacked trademark rights, came into being long after domain name was registered, and had made prior unsolicited offer to purchase domain name).

Here, the Complainant successfully made out its case with respect to the first two elements of the Policy, and had at least a colorable - if insufficiently supported by the evidence - claim under the Policy for the third element. Therefore, the Panel finds that the instance case does not constitute an abuse of the administrative proceedings and does not find RDNH.

(E) FINAL CONCLUSIONS

The Complainant has made claims of bad faith registration and use which are not sufficiently or adequately supported by the evidence submitted. Although no Response has been filed, considering that the burden of proof rests with the Complainant and that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”, for the reasons outlined above, the Panel finds that the Complainant has not prevailed on the elements of the paragraph 4(a) (iii) of the Policy and, therefore, rejects the Complaint.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **COMPASS.COMPUTER**: Remaining with the Respondent

## PANELLISTS

| Name | **Claire Kowarsky, LL.M** |
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DATE OF PANEL DECISION 2022-04-13

Publish the Decision