

Decision for dispute CAC-UDRP-104513

Case number	CAC-UDRP-104513
Time of filing	2022-04-25 09:07:25
Domain names	cosmoproflasvegas.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
--------------	---------------------------------

Complainant

Organization	BolognaFiere Cosmoprof S.p.A.
--------------	-------------------------------

Complainant representative

Name	Niccolò Ferretti
------	------------------

Respondent

Organization	Sensations Marcom Pvt. 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 relies on several registered trade marks in territories around the world which incorporate the denomination COSMOPROF including:

- International Trade mark Registrations "Cosmoprof" (e.g. No. 0981689, registered on July 24, 2008, and No. 1574658, registered on September 9, 2020);
- European Union Trade mark Registrations "Cosmoprof", (e.g. No. 001050483, registered on January 12, 2001; as well as EU TM No. 001323831, "Cosmoprof hair fashion", registered on November 30, 2000, and No. 002392504, "Cosmoprof", registered on July 7, 2009); and
- Italian Trade mark Registrations "Cosmoprof", registered since at least 1998 (e.g. No. 302005901352630, registered on November 11, 2008, No. 302005901291117, registered on November 7, 2008, No. 301995900469408, registered on May 27, 1998), among others.

FACTUAL BACKGROUND

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

The Complainant claims to be the licensee of several trade mark registrations for the denomination "COSMOPROF", including the trademarks identified above.

The Complainant in this current proceeding 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 registered office in viale della Fiera, 20, 40127, Bologna, holder of the relied upon trade marks.

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.

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 million of total revenues in 2018.

The Complainant and its corporate group have registered more than 90 domain names, incorporating the trade mark "Cosmoprof", under several different TLDs and variations including <cosmoprofshowlasvegas.com>. The website at <www.cosmoprof.com> is the official website of the Complainant.

The Respondent registered the domain name <cosmoproflasvegas > (the "disputed domain name") on 28 January 2022. At the date of the Complaint the website related to the disputed domain name was a parked page with generic content generated by the Registrar, GoDaddy.com, LLC.

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

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.

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

The Panel accepts the Complainant's assertion that it is the licensee of registered trade mark rights in the term COSMOPROF.

As noted in the recent decision CAC Case No 104121 concerning the same Complainant, "The Complainant has satisfied the Panel that it is the licensee of registered trade mark rights in the term COSMOPROF. Not only is this asserted without dispute, it is inherently likely to be correct in circumstances where another company in the group of companies to which the Complainant belongs, is the registered owner of those marks and the Complainant's corporate name includes the relevant term. An affiliate licensee is generally considered to hold sufficient rights in a trade mark for the purposes of the UDRP; as to which see section 1.4.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "WIPO Overview 3.0")."

Further, the panels in CAC Case No. 103933 and CAC Case No. 104127 also held that the same Complainant had rights in the COSMOPROF mark sufficient for standing under the first element of the Policy.

UDRP panels have held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011) („the mere addition of the words ‚Ninjago‘ and ‚Kai‘ is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant's trademark.“).

In the present case, the disputed domain name consists of the COSMOPROF trademark followed by the term "Las Vegas", a geographic term well connected with the business of the Complainant. In assessing confusing similarity, the Panel finds the disputed domain name is confusingly similar to the Complainant's trademark, as it incorporates the entirety of the COSMOPROF trademark, and differs from such mark merely by adding the geographic term "LAS VEGAS", as previously noted, a location that can be closely associated with the Complainant's business.

UDRP panels agree that 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).

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 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 by UDRP panels, 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; 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.).

However, the burden of proof still remains with the Complainant to make out its prima facie case on a balance of probabilities; 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, the Respondent bears no relationship to the Complainant, nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent has not responded in any form and thus has failed to provide any information and evidence whatsoever that could have shown that it 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. 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.”).

For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. Complainant submits the Respondent is not commonly known under the disputed domain name and that Respondent has never been authorized by Complainant to use the Complainant’s trademark(s) or register the disputed domain name. This prima facie evidence has not been challenged by the Respondent.

In the present case, the disputed domain name redirects to a registrar parking page. The Panel finds that the disputed domain name was registered more than three months ago and has not been used by the Complainant. It is inconceivable that the Respondent was not targeting the Complainant when the disputed domain name was registered, given the high profile of the COSMOPROF mark in the beauty industry and the fact that Las Vegas is a world-renowned destination for conferences and events, and therefore closely associated with the Complainant’s business.

Further, the Complainant asserts that the Respondent is “passively holding” the disputed domain name, a potential ground for a finding of bad faith. Factors relevant to the application of the passive holding doctrine include (i) the degree of distinctiveness of reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or provide any evidence of actual or contemplated good faith use, (iii) the respondent concealing its identity or use of false contact details, and (iv) the implausibility of any good faith uses to which the domain name may be put. In this case the aforementioned factors (i), (ii) and (iv) weigh strongly in the Complainant’s favour. First, the mark COSMOPROF is not a dictionary term, and with trademark applications dating back at least as far as 1995 has acquired considerable reputation in the beauty industry. Second, there has been no use of the disputed domain name nor any response from the Respondent, despite the opportunity to do so through these proceedings. Finally, the Panel cannot imagine a plausible good faith use of the disputed domain name, as it relates to the Complainant and its business of organizing major events for the beauty industry, including in Las Vegas. As such the Panel finds that there is sufficient evidence to warrant a finding of passive holding.

Therefore, in light of the above analysis, the Panel concludes that the Complainant made out its case that the disputed domain name was registered and is being used in bad faith, and thus has satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. COSMOPROFLASVEGAS.COM: Transferred

PANELLISTS

Name	Claire Kowarsky, LL.M
------	-----------------------

DATE OF PANEL DECISION 2022-05-20

Publish the Decision
