

Decision for dispute CAC-UDRP-104515

Case number	CAC-UDRP-104515
Time of filing	2022-04-25 09:03:50
Domain names	cosmoprof-lasvegas.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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	Sensations Marcom Pvt. Ltd
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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 asserts that it is part of the group Fiere Internazionali di Bologna S.p.A – BolognaFiere or in abbreviated form, BolognaFiere S.p.A.

The Complainant further asserts that it is the licensee of several trademark registrations for the sign “Cosmoprof” including the following:

- International Trademark Registration No. 0981689, registered on July 24, 2008 for the 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 the classes 35, 41, 42 of the Nice Classification;
- European Union Trademark Registration No. 001323831, “Cosmoprof hair fashion”, filed on September 27, 1999 and registered on November 30, 2000 for the classes 35, 41 and 42 of the Nice Classification;

- International Trademark Registration No. 1574658, registered on September 9, 2020 for the classes 35, 41 and 42 of the Nice Classification;
- European Union Trademark Registration No. 002392504, "Cosmoprof", filed on September 28, 2001 and registered on July 7, 2009, for the class 16 of the Nice Classification;
- Italian Trademark Registration No. 302005901352630, filed on October 21, 2005 and registered on November 11, 2008, for the class 42 of the Nice Classification;
- Italian Trademark Registration No. 302005901291117, filed on March 3, 2005 and registered on November 7, 2008 for the class 16 of the Nice Classification;
- Italian Trademark Registration No. 301995900469408, "Cosmoprof", filed on October 10, 1995 and registered on May 27, 1998 for the class 42 of the Nice Classification;
- International Trademark Registration No. 1063244, registered on November 17, 2010, for the classes 35 and 41 of the Nice Classification;
- Italian Trademark Registration No. 302002901006003, registered on April 10, 2006 for the classes 16 and 36 of the Nice Classification;
- Italian Trademark Registration No. 302005901345065, registered on November 7, 2008 for the classes 16, 35, 41 of the Nice Classification.

On the evidence, it appears to the Panel that the owner of the abovementioned trademarks is Fiere Internazionali di Bologna S.p.A. which is also the owner of numerous Top Level Domain Names as adduced in its evidence including:

- <cosmoprof-asia.cn>
- <cosmoprof-asia.com.cn>
- <cosmoprof-bologna.com>
- <cosmoprofshowlasvegas.com>

Relevantly, the Complainant, as distinct from its group Fiere Internazionali di Bologna S.p.A. is the owner of other Top Level Domain Names including:

- <cosmoprof-asean.com>
- <cosmoprof-asean.id>
- <cosmoprof-asean.it>
- <cosmoprof-asean.my>
- <cosmoprof-asean.org>
- <cosmoprof-asean.ph>
- <cosmoprof-asean.sg>
- <cosmoprof-asean.vn>

The Complainant asserts that it is present online through social medias in LinkedIn, YouTube, Facebook, and Instagram.

The Complainant's official website www.cosmoprof.com/en as asserted is listed in the Complainant's evidence as owned by Fiere Internazionali di Bologna S.p.A., ie BolognaFiere S.p.A..

FACTUAL BACKGROUND

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

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.

The Respondent registered the disputed domain name <cosmoprof-lasvegas.com> on January 28, 2022, which is resolved to and webpage with an "Index of/" without any content.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is 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.

The question here is whether the disputed domain name is confusingly similar to the trademark "Cosmoprof" with the addition of the hyphen "-" and the descriptive term "lasvegas" after the trademark "Cosmoprof".

The disputed domain name <cosmoprof-lasvegas.com> clearly incorporates the entire trademark "Cosmoprof".

It is now well established that the addition of a generic or descriptive terms to a sign on which a complainant has rights is often not an obstacle to a finding of confusing similarity.

The Panel considers that the addition of the term "-lasvegas" does not alter the disputed domain name being confusingly similar to the trademark "Cosmoprof". The addition of the said term would likely suggest to consumers a geographical connection of "lasvegas" to the true owner of the trademark "Cosmoprof" and its other top level domain name by reference to "Cosmoprof". Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark "Cosmoprof".

The ultimate question is whether the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

In its Amended Complaint dated April 26, 2022, the Complainant asserts that it is the licensee of the trademark "Cosmoprof".

The Panel accepts the proposition stated by the panel in DigiPoll Ltd v Raj Jumar WIPO Case No D2004-0939 that "it is sufficient if the complainant has what the law recognises as 'rights' in the trademark, even if such rights fall short of actual ownership. Such a right will often arise from a licence granted by the legal owner of the trademark to another party so that

the latter may use the mark. Moreover, as such rights are contemplated by trademark legislation and are well recognized, there is no reason why they should not constitute 'rights' within the meaning of paragraph 4(a)(i) of the Policy. It is also clear that the complainant need not be the only person or entity with rights in the trademark. This aspect is sometimes expressed by saying that the rights that must be established in the complainant need not be exclusive rights. See also Levine, GM, "Domain Name Arbitration, Second Edition pp. 515 to 517.

The Panel considers that a complainant need not establish that it is the owner of the trademark but could establish an interest or a right in a trademark. In the absence of such proof a complaint risks being denied. See *NBA Props, Inc. v Adirondack Software Corp* WIPO Case No. D2000-1211; *Shopware AG v Laurent Bernardin* WIPO Case No. D2013-0536.

Accordingly, in order for the Panel to examine the merits of this Complaint, it must decide whether the Complainant has established such an interest, i.e. that it has rights in the trademark "Cosmoprof". The Panel considers that it will be so satisfied if the Complainant can show a sufficient link between itself and the owner of the trademark, Fiere Internazionali di Bologna S.p.A., i.e. BolognaFiere S.p.A., which the Complainant asserts that it is part of the group.

The Complainant has now submitted further evidence within the time stated by the Panel's direction. The Respondent has not filed any further administrative compliant response.

The Panel concluded, in light of the omission, that there was a need for the Complainant to provide what documentary evidence there was in support of its assertion as licensee of Fiere Internazionali di Bologna S.p.A., i.e. BolognaFiere S.p.A. or having the right to make the Complaint.

Accordingly, the Panel decided that this was an appropriate case, pursuant to Rule 12, to request further statements and documents from the Complainant and the Respondent should have the opportunity to reply to whatever further statements and documents the Complainant submits.

The Panel therefore issued an administrative proceeding direction on May 30, 2022 to put that request into effect and to elicit any further evidence that the Complainant relies on to establish its right as licensee of the trademark "Cosmoprof" and/or its right to make the Complaint.

The Complainant has now submitted further evidence within the time stated by the Panel's direction. The Respondent has not filed any further administrative compliant response.

The further evidence provided by Fiere Internazionali di Bologna S.p.A – BolognaFiere or in abbreviated form, BolognaFiere S.p.A. declared that the Complainant is the authorised licensee of the trademark "Cosmoprof" and is also authorised to initiate proceedings to enforce the protection of the said trademark.

The Panel accepts the further evidence as showing that the Complainant is invested with the right to protect the rights of Fiere Internazionali di Bologna S.p.A., i.e. BolognaFiere S.p.A. from the Respondent as an unauthorized third party. See *American Family Health Services Group LLC v Logan* FA 220049.

The Panel considers that this evidence, in the absence of the owner of the trademarks also been joined as a complainant to the proceeding to establish a link between them, is sufficient to satisfy paragraph 4(a)(i) of the Policy. Contrast *Anthony Hopkins and The Trustees of The Samson Holding Trust, dated December 12, 2005 v. Private Whois Service c/o anthonyhopkins.com* FA 337181 where the panel found a sufficient nexus or link between the owner of the trademark and the licensee (as Complainants) to be treated as a single entity in that proceeding.

See also *Digipoll Ltd v Raj Kumar* WIPO Cas No D2004-0939; *HQUK Limited v Head Quarters* WIPO Case No D2003-0942; *Miele Inc v Absolute Air Cleaners and Purifiers* WIPO Case No D2000-0756.

In light of the further evidence presented by the Complainant, to which there was no reply by the Respondent, the Panel is satisfied that the Complainant has established that it has rights in the trademark "Cosmoprof" and accordingly, paragraph

4(a)(i) of the Policy is satisfied.

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.

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

In support of this ground, the Complainant makes three contentions:

First, the Respondent is not a licensee nor authorized agent of the Complainant nor it has been, in any other way, authorized to use the Complainant's trademark. The Respondent has no relationship with the Complainant.

Secondly, the disputed domain name is not used and has not been used since its registration. Such circumstance contended by the Complainant confirms that the Respondent has no demonstrable plan to use the disputed domain name and has not since its registration.

The Panel accepts that the lack of use of the disputed domain name by the Respondent is an important indicator of the absence of legitimate interests by the Respondent but not conclusive.

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

The Respondent has not filed any administrative compliant response to the Amended Complaint. As such, the Complainant's evidence is uncontradicted.

The Panel is prepared to accept the inference that the Respondent has not used nor intends to use the disputed domain name.

Accordingly, the Panel is prepared find the Respondent has no right or legitimate interests in the disputed domain name.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name have been registered and are being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The evidence shows that "Cosmoprof" is a well-known trademark.

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

The Panel notes that the reference to the "Complainant's trademarks" must be taken to mean that of Fiere Internazionali di Bologna S.p.A., ie BolognaFiere S.p.A., to which the Complainant is part of the group and has rights to the trademark under

the Policy.

Accordingly, the Panel finds it is inconceivable that the Respondent would have registered the disputed domain name without being aware of the Complainant's legal rights.

Use in bad faith

The Panel has already referred to the uncontradicted facts set out in the Amended Complaint and accepts the evidence and contention that the disputed domain name resolves to a webpage without any substantial content.

The Complainant contends the website related to the disputed domain name is not active, nor it has been used in connection with an active website, but it is passively held, as per the so called 'passive holding doctrine'.

The Complainant further contends that the circumstance that <cosmoprof-lasvegas.com> resolves to an inactive website, leads to a finding of bad faith.

In this regard, the Complainant contends that factors that have been considered relevant in applying the passive holding doctrine, giving close attention to all circumstances of the Respondent's behavior, include: (i) the degree of distinctiveness or reputation of the Complainant's mark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the Respondent's concealing its identity or use of false contact details, and (iv) the implausibility of any good faith use to which the domain name may be put.

The Panel accepts, as uncontroverted, each of the matters contended by the Complainant by reference to the evidence it has adduced and finds that Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would be legitimate.

The Panel accepts the proposition that the incorporation of a well-known trademark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

The Czech Arbitration Court has also provided written notice of the Complaint to the Respondent with no administratively compliant responses made in respect to any good faith use of the disputed domain name.

This conduct, the bona fides of which are clearly left unexplained by the Respondent, is in the Panel's view evidence of bad faith. See WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC; Forum Case No. FA 1623939, Citigroup Inc. v. Kevin Goodman.

In the circumstances, the Panel finds it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would be legitimate.

The Panel, therefore, concludes that the Respondent's holding of the disputed domain name in this case satisfies the requirement that the disputed domain name is being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain name and its use were in bad faith.

PROCEDURAL FACTORS

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieved actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On May 17, 2022 the CAC by its Nonstandard Communication stated as follows (omitting irrelevant parts):

- "- That the written notice of the Complaint was returned back to the Czech Arbitration Court as undelivered;
- As far as the e-mail notice is concerned, the CAC received a confirmation that the e-mail sent to postmaster@cosmoprof-lasvegas.com was returned back undelivered.

- The e-mail notice was also sent to piyush@sensations.co.in, but CAC never received any proof of delivery or notification of undelivery.

No further e-mail address could be found on the disputed site. The Respondent never accessed the online platform."

Notification of administrative proceedings direction

On May 30, 2022 the Panel sent a request to the parties by Nonstandard Communication as follows (omitting irrelevant parts):

"Pursuant to rules 10 and 12 of the UDRP Rules, the Panel requests the Complainant (BolognaFiere Cosmoprof S.p.A.) provide any further documents evidencing its credential as the licensee of FIERE INTERNAZIONALI DI BOLOGNA S.P.A. - BOLOGNAFIERE O IN FORMA ABBREVIATA BOLOGNAFIERE S.P.A. The Respondent (Sensations Marcom Pvt. Ltd) is afforded the opportunity to provide any response limited to the Panel's request.

The Panel directs:

1. The Complainant submit any response by no later than 2pm on Wednesday June 1, 2022.
2. Any response by the Respondent be submitted by no later than 2pm on Friday June 3, 2022.
3. The Panel's decision be published on Monday June 6, 2022."

On May 31, 2022 the Complainant provided further evidence as directed by the Panel.

The Respondent has not provided any further administrative complaint response.

Given the reasonable measures employed by CAC as set out in the above Nonstandard Communications, the Panel is satisfied that CAC has discharged this responsibility.

PRINCIPAL REASONS FOR THE DECISION

The Complainant is the licensee of the trademark "Cosmoprof" owned by Fiere Internazionali di Bologna S.p.A – BolognaFiere or in abbreviated form, BolognaFiere S.p.A.. It is part of the BolognaFiere S.p.A. group. The Complainant is also the holder of or entitled to use domain name by reference to the "Cosmoprof" trademark which is used in connection with its goods or services for a considerable time. It is a well-known trademark.

The Respondent registered the disputed domain name on January 28, 2022. The disputed domain name has the addition of

the term “-lasvegas.com” at the end of the Complainant’s trademark which is incorporated in its entirety.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent has failed to file any administratively compliant response.

For the reasons articulated in the Panel’s reasons above, the Complainant has satisfied the Panel of the following:

- (a) The disputed domain name is confusingly similar to the trademark “Cosmoprof” to which the Complainant has rights;
- (b) The Respondent has no rights or legitimate interests in respect of the disputed domain name;
- (c) The disputed domain name has been registered and are being 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. COSMOPROF-LASVEGAS.COM: Transferred

PANELLISTS

Name	Adjunct Prof William Lye, OAM QC
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DATE OF PANEL DECISION 2022-05-30

Publish the Decision