

Decision for dispute CAC-UDRP-104831

Case number	CAC-UDRP-104831
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Time of filing	2022-09-07 11:09:17
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Domain names	cosmoprof.space
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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

Name	Gor Nazaryan
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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 to be a licensee of several trademark registrations for the name “Cosmoprof” including the following ones:

- International trademark registration No. 0981689 from on July 24, 2008 in classes 16, 35, 41 of the Nice Classification;
- European Union trademark registration No. 001050483, “Cosmoprof”, from January 22, 1999 in classes 35, 41, 42 of the Nice Classification;
- European Union trademark registration No. 001323831, “Cosmoprof hair fashion”, from September 27, 1999 in classes 35, 41 and 42 of the Nice Classification;
- International trademark registration No. 1574658 from on September 9, 2020 in classes 35, 41 and 42 of the Nice Classification;
- European Union trademark registration No. 002392504, “Cosmoprof”, from September 28, 2001 in class 16 of the Nice Classification;
- Italian trademark registration No. 302005901352630 from October 21, 2005 in class 42 of the Nice Classification;
- Italian trademark registration No. 302005901291117 from March 3, 2005 in class 16 of the Nice Classification;
- Italian trademark registration No. 301995900469408, “Cosmoprof”, from October 10, 1995 in class 42 of the Nice Classification;
- International trademark registration No. 1063244 from November 17, 2010, in classes 35 and 41 of the Nice Classification;
- Italian trademark registration No. 302002901006003 from April 10, 2006 in classes 16 and 36 of the Nice Classification; and
- Italian trademark registration No. 302005901345065, from November 7, 2008 in classes 16, 35, 41 of the Nice Classification.

FACTUAL BACKGROUND

According to the facts included in the complaint, the Complainant belongs to an Italian Group Fiere Internazionali di Bologna S.p.A. - Bolognafiere or, in abbreviated form, Bolognafiere S.p.A, who licensed all the trademarks listed above to the Complaint. The Complainant itself is a well-established Italian organizer of trade fair shows dedicated to beauty industry.

The Complainant owns an important domain names portfolio containing the name “Cosmoprof” and asserts that it is present online through social medias in LinkedIn, YouTube, Facebook, and Instagram.

The disputed domain name <cosmoprof.space> was registered on 20 February, 2021, and is not currently used in connection with any goods or services as it results in an inactive webpage.

No information is known about the Respondent Mr. Nazaryan Gor who registered the disputed domain name <cosmoprof.space> under a privacy protection service.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Respondent sent several e-mails to the CAC but has never replied the compliant. The Respondent accessed the platform after the lapse of period for submitting Response.

PARTIES CONTENTIONS

COMPLAINANT:

Identical or confusingly similar

The Complainant asserts that the disputed domain name <cosmoprof.space> and the registered trademark of which the Complainant is an authorized licensee are confusingly similar.

Particularly, the Complainant contends that the disputed domain name <cosmoprof.space> contains the main element of the trademark family, i.e. the word “Cosmoprof” and considers the disputed domain name and the registered trademarks confusingly similar.

No rights or legitimate interests

The Complainant asserts that that the Respondent is not commonly known by the disputed domain name or a name corresponding to the disputed domain name, nor that the Respondent is making any businesses with the Complainant or the trademark owner. Moreover, the Complainant states that the Respondent has no rights or legitimate interests in respect of the domain name <cosmoprof.space> and is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

According to the Complainant, neither license nor authorization has been granted to the Respondent to make any use of the registered trademarks containing the word “Cosmoprof” or apply for registration of the disputed domain name by the Complainant.

Registered and used in bad faith

As far as bad faith registration is concerned, the Complainant asserts that the name “Cosmoprof” has been widely used and is well-known, so that the Respondent certainly had full knowledge of the rights over the name “Cosmoprof” at the time of the disputed domain name’s registration.

Moreover, the Complainant contends that, despite that the disputed domain name has not been used until now, and refers to the e-mail communication with the Respondent in which the Respondent is offering him sale of the disputed domain name <cosmoprof.space> together with a similar domain name <cosmoprof.am> for EUR 50,000. Therefore, according to the Complainant the current inactive use is a clear case of use of the domain name in bad faith.

Thus, according to the Complainant, the Respondent registered the disputed domain name <cosmoprof.space> and is using it in bad faith.

RESPONDENT:

Several e-mails have been sent by the Respondent to the CAC but no formal reply to the complaint was received.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark 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 15 of the Rules states that the Panel decides a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel draws such inferences therefrom as appropriate.

In the present case, the Respondent has not submitted any administratively compliant Response and consequently has not contested any of the contentions made by the Complainant.

The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidences provided in support of them.

1. In previous UDRP decisions, Panels have found that Complainant has protectable rights in the trademarks "Cosmoprof". See *BolognaFiere Cosmoprof S.p.A. v. Sensations Marcom Pvt. Ltd*, CAC Case No. CAC-UDRP-104515 (25 April, 2022).

In the case referred above, the Panel issued an administrative proceeding direction to request the Complainant 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 submitted further evidence within the time stated by the Panel's direction. 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 authorized licensee of the trademarks "Cosmoprof" and is also authorized to initiate proceedings to enforce the protection of the said trademarks.

Based on the previous recent decision of the CAC, the Panel accepts the Complainant's assertion that it is the licensee of registered trade mark rights in the term "Cosmoprof" which grants him sufficient entitlement to take action to protect the licensed mark and start this administrative proceeding against the Respondent.

As far the similarity test, the Panel finds that the disputed domain name <cosmoprof.space> is visually, conceptually and phonetically very similar with the registered trademarks in which the Complainant proved having rights, given that the disputed domain name includes entirely the main distinctive element of the family of the registered trademarks "Cosmoprof".

Moreover, the addition of a different TLD ".space", which would usually be disregarded as it is a technical requirement of registration, do not alter the overall very similar impression the disputed domain name and the registered trademark produce.

Accordingly, the Panel considers that the disputed domain name and the registered trademark in which the Complainant has the rights are confusingly similar and infers that paragraph 4(a)(i) of the Policy is satisfied.

2. According to the Complainant's contentions and evidences submitted within this proceeding, which were not disputed, the

Respondent does not appear to be in any way related to the Complainant's business, does not act as the agent of the Complainant, and has not been authorized to use a trademark "Cosmoprof", or any combination of such trademark.

Furthermore, the disputed domain name <cosmoprof.space> resolves currently in an inactive webpage. Therefore, it is reasonable to infer that the Respondent does not have any legitimate interest in the disputed domain name and rather reserves the disputed domain name for his possible own commercial gain by trying to sell the domain name to the Complainant for extremely elevated price.

Consequently, and in the absence of a Response, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, so that the requirements of paragraph 4(a)(ii) of the Policy are met.

3. As to the bad faith at the time of the registration, the Panel finds that, in light of the high grade of similarity between the disputed domain name and the trademark family containing the name "Cosmoprof", the Respondent was more likely to be aware of the Complainant's rights over the name trademark "Cosmoprof" at the time of the registration of the disputed domain name.

Indeed, by choosing and registering the disputed domain name which represents a confusingly similar or almost identical version of trademarks that are already registered by third person, the Respondent is likely to act in bad faith by deliberately introducing slight deviations into registered and known trademarks for its future potential commercial gain.

Furthermore, the Complainant notes that the disputed domain name does not resolve to any web site or other on-line presence, nor appears to have been used so far. In this regard, prior Panels have discussed the passive holding of domain names (e.g. in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003) and found that the passive holding itself can constitute bad faith use.

The Panel recalls that „*the relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith*”. (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003)

The particular circumstances of this case allow the Panel to infer that this is the case when the inactivity of the domain name holder could be considered as a bad faith use, given that:

- the trademark "Cosmoprof" is registered in several countries;
- the disputed domain name includes entirely the distinctive element "Cosmoprof" which is common and most distinctive element of all registered trademarks in which the Complainant has acquired rights;
- the Respondent has taken active steps to hide its identity;
- the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name;
- the Respondent has offered the disputed domain name to a Complainant for sale for an extremely high purchase price.

Taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate.

In light of these particular circumstances, the Panel concludes that the Respondent's passive holding of the domain name in this particular case satisfies the requirement of paragraph 4(a)(iii) that the domain name "is being used in bad faith" by Respondent.

Accordingly, the Panel finds that the Complainant has satisfied 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. **cosmoprof.space**: Transferred

PANELLISTS

Name	Hana Císlarová
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DATE OF PANEL DECISION 2022-10-16
