

Decision for dispute CAC-UDRP-104694

Case number	CAC-UDRP-104694
Time of filing	2022-09-14 09:11:51
Domain names	bocconibusineschool.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Università Commerciale Luigi Bocconi
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Complainant representative

Organization	Buzzi, Notaro e Antonielli d'Oulx
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Respondent

Organization	Nuova immagine s.c.a.r.l. Preposto Rag. Antonio Di Maggio
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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 is the owner of several trademark registrations for BOCCONI, including the following:

- European Union trademark registration No. 007487978 for BOCCONI (word mark), filed on December 22, 2008 and registered on June 9, 2009, in classes 9, 16, 25, 35, 36, 41, 42, 43 and 45;
- European Union trademark registration No. 007488042 for BOCCONI (figurative mark), filed on December 22, 2008 and registered on September 15, 2009, in classes 9, 16, 25, 35, 36, 41, 42, 43 and 45; and
- European Union trademark registration No. 007488018 for BOCCONI (figurative mark), filed on December 22, 2008 and registered on December 11, 2009, in classes 9, 16, 25, 35, 36, 41, 42, 43 and 45.

FACTUAL BACKGROUND

The Complainant was founded by Ferdinando Bocconi in 1902 in memory of his son Luigi Bocconi who died in the Battle of Adua in 1896.

Since 2007, the Bocconi University has established 20 permanent research centers and 4 project research centers, with

approximately 200 international publications and 300-400 national publications produced each year.

The Bocconi University is a member of the Offshoring Research Network and has recently implemented a project called "B4I Bocconi for Innovation", aimed at supporting innovative projects for enterprises and start-ups.

The Complainant over time has built a network of exchanges and relationships with academic and cultural institutions and is associated with the Partnership in International Management (PIM) and the Community of European Management Schools (CEMS), with a total of 170 partner universities in 48 countries around the world, with which it collaborates on research activities and joint educational projects.

The Complainant is also a member of international networks such as the Erasmus Student Network, and often sponsors numerous student activities, such as the Model United Nations (MUN, also known as Simulation UN), and the traditional mathematics championships.

The Complainant owns and operates the domain name <unibocconi.it>, registered on June 12, 2002, which it uses to promote its services under the trademark BOCCONI.

The disputed domain name <boconibusinessschool.com> was registered on October 18, 2021 and is currently pointed to a blank page. According to the screenshots submitted by the Complainant, the disputed domain name was previously pointed to a website offering training school for graduates, professionals and companies.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that disputed domain name <boconibusinessschool.com> is confusingly similar to the trademark BOCCONI in which the Complainant has rights, as it reproduces the trademark in its entirety with the mere addition of the descriptive terms "Business" and "school" and the generic Top-Level Domain ".com".

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent is not commonly known by the disputed domain name and has in no way been authorized or granted a license by the Complainant, to use the trademark BOCCONI.

The Complainant informs the Panel that, according to its searches on the commercial companies register, no results were found for either the Respondent's name according to the Whois records or the Respondent's Tax Identification Number C.F. 96525270581 and the "Fondazione Bocconi Business School", mentioned on the website to which the disputed domain name resolved.

Moreover, the Complainant submits that the Respondent is unlawfully using the trademark BOCCONI to designate a Data Protection Officer of the Respondent whose name does not coincide with that of the Respondent, but refers to another entity, called "Fondazione Bocconi Business School" for which no information was found.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering the disputed domain name was registered 12 years after the registration of the Complainant's trademark BOCCONI and that the content of the website to which the disputed domain name resolved is confusingly similar to that of the services provided by the Complainant, the Respondent could not have been unaware of the Complainant at the time of registering the disputed domain name and indeed registered the disputed domain name with the clear intention of creating a likelihood of confusion with the BOCCONI name and trademark.

The Complainant also emphasizes that, on the website "www.boconibusinessschool.it" – owned by the Respondent - to which the disputed domain name was redirected until it was challenged by the Registrar, the telephone number for customer

information was "+1 2534 4456 345", where the prefix +1 is for the United States although the 'school' promoted on the website was allegedly based in Rome.

The Complainant also states that, following the filing of an opposition procedure against <boconibusinessschool.it>, the disputed domain name was used for the Respondent's main website and the telephone number was changed with a toll-free number 800 864 734, to which, however - after a long wait accompanied by a musical tune - no one answers.

The Complainant also highlights that the picture of the school depicted on the Respondent's websites "www.boconibusinessschool.it", before, and "www.boconibusinessschool.com", then, is Queen's college in Oxford, where the Respondent appears to have no school facility.

The Complainant therefore contends that, considering all the foregoing factors, the Respondent appears to have deliberately chosen to use names, signs and images referable to specific entities that are in a position to rightfully claim a reputation in the field of training and education, which it clearly does not have.

The Complainant concludes that the Respondent registered the disputed domain name with the sole purpose of attracting, for illicit profit, internet users, by creating the likelihood of confusion with the Complainant's trademark, which constitutes an element indicating bad faith pursuant to Paragraph 4(a)(iii) of the Policy.

RESPONDENT:

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

1. The Panel finds that the Complainant has established rights over the trademark BOCCONI based on the trademark registrations cited above and the related trademark certificates submitted as annex to the Complaint.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark BOCCONI as it reproduces the trademark in its entirety with the mere addition of the descriptive terms "business" and "school" and the generic Top Level-Domain ".com", which are not sufficient to prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has made a prima facie case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain name could be inferred. Indeed, the Complainant stated that it has in no way authorized or granted a license to the Respondent to use the trademark

BOCCONI. In addition, there is no evidence that the Respondent might be commonly known by the disputed domain name.

In light of the prior use of the disputed domain name to redirect users to a website offering training school for graduates, professionals and companies, as shown by the screenshots submitted as annex to the Complaint, the Panel finds that the Respondent has clearly not used the disputed domain name in connection with a bona fide offering of goods or services or for a legitimate noncommercial or fair use, since such services are so obviously connected to the Complainant and its field of activity that the Respondent could have only acted with the sole intent of attracting users to its website by creating a likelihood of confusion and association with the Complainant and its trademark. Moreover, the disputed domain name itself, combining the Complainant's trademark with terms descriptive of the Complainant's business, carries a high risk of implied affiliation.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the prior registration and use of the Complainant's trademark BOCCONI in connection with the Complainant's educational services and the reputation acquired by the Complainant in its field over the years, the Respondent was very likely aware of the Complainant's trademark at the time of registering the disputed domain name.

Indeed, the Respondent's redirection of the disputed domain name to a website offering training school for graduates, professionals and companies like the ones offered by the Complainant clearly shows that the Respondent was indeed well aware of the Complainant's trademark and registered the disputed domain name with such trademark in mind.

The Panel notes that the Respondent's use of the disputed domain name in connection with a website promoting educational services similar to those offered by the Complainant, amounts to bad faith under paragraph 4(b)(iv) of the Policy, since the Respondent intentionally attempted to attract Internet users to its website, in all likelihood for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website and the services promoted therein.

With reference to the current redirection of the disputed domain name to a blank page, which is tantamount to an inactive website, the Panel notes that, as established in a number of prior cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding.

In view of the above, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOCCONIBUSINESSSCHOOL.COM**: Transferred

PANELLISTS

Name	Luca Barbero
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DATE OF PANEL DECISION 2022-10-25

Publish the Decision
