

Decision for dispute CAC-UDRP-105048

Case number	CAC-UDRP-105048
Time of filing	2022-12-08 09:03:44
Domain names	lamborghini.lat, lamborghini.black, lamborghini.fashion, lamborghini.green, e-lamborghini.app, lamborghini-coin.com, lamborghini-eyewear.com, lamborghini-financial-group.com, lamborghini-financial.group, lamborghini-financial.investments, lamborghini-financial.management, lamborghini-gate.com, lamborghini-latam.com, lamborghini-loc.com, lamborghini-lvx.com, lamborghini-lvx.net, lamborghini-marketing-group.com, lamborghini-official-licensee.com, lamborghini-official-marketing.com, lamborghini-royal-dynasty.com, lamborghini-watches.com, lamborhinishdigitalbank.app, lamborhinishdigitalbank.com, lamborhinishgate.com, lamborhinishmultiverse.com, lamborhinishroyaldynasty.com, multiverselamborghini.com, store-lamborghini.com, the-lamborghini-lifestyle.com, lamborgate.com

Case administrator

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

Organization	Automobili Lamborghini S.p.A.
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Complainant representative

Organization	Nctm Studio Legale
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Respondent

Organization	AUTOMOVILES LAMBORGHINI LATINOAMERICA SA
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OTHER LEGAL PROCEEDINGS

Regarding other legal proceedings between the parties, the Complainant made the following statement:

“The Complainant and the Respondent have been involved in other legal proceedings, ended with judgements, mainly addressing the non-authenticity of certain license agreements purportedly granting to the Respondent’s license rights on the Lamborghini Marks (as hereinafter defined) with consequent recognition of lack of Respondent’s right to use them, in particular:

Interim proceedings brought by the Complainant against the Respondent (Automoviles Lamborghini Latinoamerica SA together with its CEO, Mr. Jorge Antonio Fernández García) before the Court of Genoa, Italy, (R.G. 6821/2019): with an ex parte order dated 20 July 2019 and confirmed on 31 December 2019 (not appealed), the Italian Court has ascertained and declared that there was no valid and effective agreement between the parties legitimizing the Respondent to use the Lamborghini Marks, and consequently prohibited the defendants to use in any way in the territory of all EU countries the Lamborghini Mark or any trade mark, company name, domain name and in general any distinctive sign containing words and/or figures identical or similar to those claimed by the Lamborghini Mark or in any case containing the name “Lamborghini”, alone or in association with others and ordered the transfer to the Complainant of all domain names registered by the Respondent and featuring the Lamborghini Mark or any similar sign (an order that Marcaria refused to

implement).

Proceedings brought by the Complainant against the Respondent (as well as its CEO and others involved in the infringement) before the Eastern District of Virginia Court, USA (case I:18-cv-00062-TSE-TCB): with decision dated 16 June 2020, now res judicata, the US Court issued a permanent injunction against the defendants from advertising, marketing or selling unlicensed and unauthorised counterfeit goods that infringe the Complainant's federally registered trademarks in the United States and from using the Complainant's federally registered trademarks in the United States. The Court acknowledged the absence of right of the Respondent to use the Lamborghini Mark and the license agreements filed for recordal by the Respondent to be fictitiously created and, thus, invalid, unenforceable and fraudulent.

The interim proceedings before the Argentina National Commercial Court of Buenos Aires, n° 6 - Registry n° 12 (case no. 30101/2019): with decision dated 11 November 2020, the Argentinian Court, by reversing a previous interim decision, acknowledged the non-authenticity of the purported license agreements filed by the Respondent and that the Respondent has no right to use the Lamborghini Mark or to pretend to be an authorized licensee of the Complainant.

The High Court of 2nd degree of Santa Catarina in Brazil, by deciding in interim proceedings also involving the Respondent, ruled out the license rights alleged by the Respondent on the Lamborghini Mark."

IDENTIFICATION OF RIGHTS

The Lamborghini Mark has been registered by the Complainant first in Italy, since 1974, and subsequently in several countries worldwide. The Complainant is inter alia registered owner of US trademark registration no. 1622382 "Lamborghini", filed on January 16, 1990, Mexican trademark registration no. 1069750 "Lamborghini", filed on March 3, 2008, and EU trademark registration no. 006113451 "Lambo", filed on July 19, 2007.

FACTUAL BACKGROUND

The Complainant is a well-known Italian sports car manufacturing company, founded in 1963 by Ferruccio Lamborghini. Since 1998, the Complainant is a wholly-owned subsidiary of Audi AG. After almost 60 years, the Complainant's business continues to grow and in 2021 reached its best-ever performance in terms of turnover and profitability with a turnover of EUR 1.95 billion (an increase of 19% compared to 2020) and 8,405 cars sold worldwide.

The Complainant owns, among others, the domain name <lamborghini.com>, which hosts its official website.

The disputed domain names have been registered between August 5, 2014, and June 22, 2022. The disputed domain names <lamborghini.lat> and <lamborghini-coin.com> redirect to websites active in the supply of marketing and financial services, and the domain name <lamborgate.com> redirects to a website providing information about the Complainant and the relationship between the parties. The other domain names are not actively used.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain names are all identical or confusingly similar to the Complainant's trademarks.

With regard to the domain names <lamborghini.lat>, <lamborghini.black>, <lamborghini.fashion>, and <lamborghini.green>, the Complainant argues that they are identical to the trademark "Lamborghini" as they fully incorporate such trademark without any further addition. The Complainant further states that the disputed domain names <e-lamborghini.app>, <lamborghini-coin.com>, <lamborghini-eyewear.com>, <lamborghini-financial-group.com>, <lamborghini-financial.group>, <lamborghini-financial.investments>, <lamborghini-financial.management>, <lamborghini-gate.com>, <lamborghini-latam.com>, <lamborghini-loc.com>, <lamborghini-lvx.com>, <lamborghini-lvx.net>, <lamborghini-marketing-group.com>, <lamborghini-official-licensee.com>, <lamborghini-official-marketing.com>, <lamborghini-royal-dynasty.com>, <lamborghini-watches.com>, <lamborhinedigitalbank.app>, <lamborhinedigitalbank.com>, <lamborhinegate.com>, <lamborhinimultiverse.com>, <lamborhinaryaldynasty.com>, <multiverselamborghini.com>, <store-lamborghini.com>, and <the-lamborghini-lifestyle.com> are confusingly highly similar to the trademark "Lamborghini" as they fully incorporate such trademark, combining it with generic words. Finally, with regard to the disputed domain name <lamborgate.com>, the Complainant argues that this domain name is confusingly similar to the Complainant's trademark "Lambo".

Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names.

It states that it never authorized the Respondent to use the Complainant's trademarks as a domain name or company name. The Complainant further contends that the Respondent falsely claims on its website at <lamborghini.lat> to be the representative of the Complainant in Latin America, owner of trademark registrations for the trademark "Lamborghini" in several countries of Latin America, and the exclusive licensee of the trademark "Lamborghini". The Complainant further states that the Respondent concocted fictitious and fraudulent documents (i.e., license agreements) forging the Complainant's seal and its legal representative signature, falsely pretended

to be the Complainant's authorized representative, filed for recordal of such fictitious license agreements before the European Union and other countries' Intellectual Property offices, and blatantly marketed counterfeit products. In support of its allegations, the Complainant broadly refers to the above-mentioned decisions in court proceedings between the parties.

With regard to the Respondent's use of the domain name <lamborgate.com>, the Complainant states that the Respondent is using this domain name to redirect Internet users to a website aimed at spreading false information about the Complainant and the relationship between the parties. It further argues that the Respondent cannot refer to a legitimate non-commercial or fair use of this domain name in the name of "free speech" because the Respondent could well have chosen to use a domain name that was not confusingly similar to the Complainant's trademark for any (non-existing) informative purpose, but intentionally did not so in order to attract the public and divert the Complainant's business.

As to the domain names <lamborghini.lat> and <lamborghini-coin.com>, the Complainant states that these domain names are used to supply of unauthorized products/services under the trademark "Lamborghini" and blatantly constitute a trademark infringement which is per se proof of lack of rights or legitimate interests.

Finally, the Complainant also contends that the Respondent's company name and its trademark applications (all opposed by the Complainant) do not lead to own rights or legitimate interests because the Respondent was not authorized by the Complainant to use the Complainant's trademarks as a company name or to file for trademarks and as the Respondent cannot claim to be rightfully known as "Lamborghini".

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith.

The Complainant argues that the Respondent does not have rights or legitimate interests in the disputed domain names but, at the time of registration, willfully and unrightfully associates with the Complainant and its trademark "Lamborghini" and that the registration of the disputed domain names, which infringe the exclusive rights of Complainant, is per se indicative of bad faith on part of the Respondent.

The Complainant further contends that the Respondent's bad faith is also proven by its extended counterfeiting and competitively unfair conduct and by the fact that the Respondent perseveres to use and register domain names although it has already been judicially restrained to do so by several courts. It also argues that evidence of bad faith is also given by the facts that the Respondent is using the Complainant's well-known logo on its website and that the disputed domain names are identical to a well-known trademark and registered by an unaffiliated entity which intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademarks.

The Complainant also argues that the Respondent's non-use of some of the disputed domain names equals to bad faith use.

Finally, the Complainant contends that the use of the disputed domain names is made with the purpose of disrupting the business of a competitor and with the intention to attract, for commercial gain, Internet users to the website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its products and services.

RESPONDENT:

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (i) the disputed domain names are identical or confusingly similar to the Complainant's trademark; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

1.

The Panel accepts that the disputed domain names are identical or confusingly similar to the Complainant's trademarks.

First, it is well established that the specific top-level domain name is generally not an element of distinctiveness that can be taken into consideration when evaluating the identity or confusing similarity between the complainant's trademark and the disputed domain name.

The second levels of the disputed domain names <lamborghini.lat>, <lamborghini.black>, <lamborghini.fashion>, and <lamborghini.green> all include the Complainant's trademark "Lamborghini" without further elements and are identical to such trademark.

The disputed domain names <e-lamborghini.app>, <lamborghini-coin.com>, <lamborghini-eyewear.com>, <lamborghini-financial-group.com>, <lamborghini-financial.group>, <lamborghini-financial.investments>, <lamborghini-financial.management>, <lamborghini-gate.com>, <lamborghini-latam.com>, <lamborghini-loc.com>, <lamborghini-lvx.com>, <lamborghini-lvx.net>, <lamborghini-marketing-group.com>, <lamborghini-official-licensee.com>, <lamborghini-official-marketing.com>, <lamborghini-royal-dynasty.com>, <lamborghini-watches.com>, <lamborhinishdigitalbank.app>, <lamborhinishdigitalbank.com>, <lamborhinishgate.com>, <lamborhinishmultiverse.com>, <lamborhinishroyaldynasty.com>, <multiverselamborghini.com>, <store-lamborghini.com>, and <the-lamborghini-lifestyle.com> all include the Complainant's trademark "Lamborghini" and additional elements like "e", "coin", "eyewear", "financial", "group", "gate", "latam", "loc", "lvx", or "marketing". However, the Complainant's trademark "Lamborghini" is still clearly recognizable within the disputed domain names, which is sufficient to find for confusing similarity under the Policy, even if some of the additional elements like "loc" or "lvx" are not clearly generic at first sight.

Finally, the disputed domain name <lamborgate.com> fully includes the Complainant's trademark "Lambo" and, according to the principles shown above, is confusingly similar to this trademark as well.

2.

The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain names. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent did not deny these assertions in any way and therefore failed to prove any rights or legitimate interests in the disputed domain names.

Based on the evidence before the Panel, the Panel cannot find any rights or legitimate interests of the Respondent either.

The domain names not used by the Respondent do not give any further indication of the Respondent's own rights or legitimate interests.

<lamborghini.lat> and <lamborghini-coin.com>

It is obvious that the Respondent used the Complainant's trademarks in commerce before notice of the present dispute. The key question, however, is whether the Respondent can invoke rights or legitimate interests under the Policy in these proceedings. This would require that the Respondent's business acts were a bona fide use under the Policy. In general, a respondent will only be able to demonstrate a good faith offering where its goods or services are in a different class than those for which the complainant's mark is protected. This is a logical interpretation since overlap between the respondent's and the complainant's products could suggest an intent to exploit the Complainant's trademark for commercial gain.

The Complainant provided evidence that it is the registered owner of the "Lamborghini" trademark in Mexico, where the Respondent is located, since 2008 and therefore years before the Respondent started registering the disputed domain names. Furthermore, the Panel is aware that the Complainant produced well-known cars, such as the Countach, since the 70s. There is hardly an exotic sports car that has a higher degree of recognition than the Lamborghini Countach, which was the star of many Hollywood movies.

The Respondent has not contested the Complainant's arguments and has not submitted any evidence that it had started using the sign "Lamborghini" at a time when the Complainant's trademark was not yet known worldwide. Moreover, the Respondent uses the word "Lamborghini" on its web pages in the lettering used by the Complainant and, in addition, the Complainant's logo, which is also well-known. Furthermore, the Respondent states on its website that it has "designed, developed and built car models with our own technology" and that, as the "only licensee worldwide", it can "offer the brand exclusively in Latin America and non-exclusively worldwide for a wide range of products". These acts of use are in clear contradiction with the Complainant's allegations. In addition, the Complainant has submitted court documents from proceedings between the parties, which clearly refer to the unlawfulness of the Respondent's actions. Even though the Complainant has not provided any judicial decisions concerning the Respondent's use of the mark "Lamborghini" in Mexico containing a finding that such use is unlawful, the Panel, in the overall view of the circumstances, considers it far more likely than not that the Respondent's actions are infringing and thus not bona fide within the meaning of the Policy.

In particular, the following circumstances are relevant to the overall assessment:

- It is more than unusual for the owner of a well-known trademark to allow a third party to manufacture its own products in direct competition with the trademark owner's core product. Therefore, the allegation on the Respondent's website that it itself "designed, developed and built car models" is, in the Panel's view, a strong indication that this is precisely not a licensing relationship between the parties and that the Respondent's acts of use have no contractual basis.
- The court decisions submitted by the Complainant contain findings that there is no valid and effective agreement between the parties and that the "license agreements submitted by the Respondent in these proceedings are fictitiously created and, thus, invalid, unenforceable and fraudulent". In fact, these remarks do not relate to Mexico. However, the overall circumstances only allow the Panel to conclude that the Respondent cannot base its use of the Complainant's trademarks on any contractual basis. Otherwise, the judicial decisions would have at least included some findings in favor of the Respondent.

<lamborgate.com>

The Respondent cannot rely on own rights or legitimate interests with regard to the use of the disputed domain name <lamborgate.com> in connection with a website providing information about the Complainant and the relationship. In particular, the Panel finds that the Respondent's use of this domain name is no legitimate or fair use under the Policy, as the Respondent's website, in the Panel's view, is clearly used in connection with the Respondent's commercial activities. On its website, the Respondent informs Internet users of the parties' various disputes but also provides information on the Respondent's CEO and its business activities. Thus, the Panel assumes that the website (also) serves to promote the commercial interests of the Respondent. In addition, the website dominantly uses the Complainant's well-known bull logo on the very top and therefore may give the first impression to Internet users that the website is somehow related to the Complainant. Finally, the website at <lamborgate.com> is not the Respondent's only website but part of the Respondent's pattern of registering domain names corresponding to the Complainant's trademarks. In the view of the Panel, the disputed domain name <lamborgate.com> cannot be considered independently of the facts of the case as a whole. In the Panel's view, the Respondent's unauthorized use of other domain names also has an impact on the assessment of possibly permissible use of the domain name <lamborgate.com>. As a final remark, the Panel is well aware of the UDRP decisions related to domain names containing trademarks and pejorative or derogatory terms, such as "gate". Even if there is no majority view established on this point, some panels found that such terms may be suitable to avoid a direct attribution of the domain name to the trademark owner for the public, because no trademark owner would use such a domain name in connection with his business operations. However, even in these cases every legitimacy of a respondent's use of a domain name including a third-party trademark equally depends on the question of whether the domain name is used in commerce or not. Given that the Panel holds that the disputed domain name (also) serves the Respondent to promote its commercial interests, a permissible use cannot be affirmed from any point of view.

Accordingly, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

3.

The Panel is satisfied that the Respondent registered the disputed domain names with full knowledge of the Complainant and its rights in the well-established trademarks as the Respondent is using the Complainant's logo on its website and alleges to produce sports cars, which is the Complainant's core product since decades.

As to bad faith use, by using the disputed domain names <lamborghini.lat> and <lamborghini-coin.com> in connection with a website offering the Respondent's products and services, the Respondent was, in all likelihood, trying to divert traffic intended for the Complainant's website to its own for commercial gain as set out under paragraph 4(b)(iv) of the Policy.

The Respondent's use of the disputed domain name <lamborgate.com> in connection with a website providing information about the Complainant and the relationship between the parties is bad faith use under the Policy as well, as the Respondent's use is not non-commercial or fair (See findings on the rights or legitimate interests of the Respondent). Rather the Respondent was, in the Panels view, likewise trying to divert traffic intended for the Complainant's website to its own for commercial gain as set out under paragraph 4(b)(iv) of the Policy.

Finally, the fact that the Respondent is not actively using but merely passively holding some of the disputed domain names does not obstruct a finding of bad faith use under the Policy with regard to these domain names as, in the present case, such passive holding of the disputed domain names is equal to active use. There is a consensus view among panels that the element of use in bad faith is satisfied not only if a domain name is actively being used on the Internet, but also if in the light of the overall circumstances of the domain registration, the passive holding of a domain name equates with an active use of a domain name. In the Panels view, the circumstances in this case clearly justify the equation of passive holding and active use, because:

- The Complainant's trademarks are highly distinctive and well-known;
- The Respondent had provided no evidence whatsoever of any actual or contemplated good faith use;
- The disputed domain names clearly target the Complainant's trademarks;
- The Respondent registered many domain names and uses some of them in an improper manner, which makes the unused domain names an abusive threat hanging over the head of the Complainant, and
- From all of the circumstances, there does not appear to be any possible or conceivable good-faith use of the disputed domain names that would not be illegitimate.

As a result, the Panel finds that all of the disputed domain names are used in bad faith 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. **lamborghini.lat**: Transferred
2. **lamborghini.black**: Transferred
3. **lamborghini.fashion**: Transferred
4. **lamborghini.green**: Transferred
5. **e-lamborghini.app**: Transferred
6. **lamborghini-coin.com**: Transferred
7. **lamborghini-eyewear.com**: Transferred
8. **lamborghini-financial-group.com**: Transferred
9. **lamborghini-financial.group**: Transferred
10. **lamborghini-financial.investments**: Transferred
11. **lamborghini-financial.management**: Transferred
12. **lamborghini-gate.com**: Transferred
13. **lamborghini-latam.com**: Transferred
14. **lamborghini-loc.com**: Transferred
15. **lamborghini-lvx.com**: Transferred
16. **lamborghini-lvx.net**: Transferred
17. **lamborghini-marketing-group.com**: Transferred
18. **lamborghini-official-licensee.com**: Transferred
19. **lamborghini-official-marketing.com**: Transferred
20. **lamborghini-royal-dynasty.com**: Transferred
21. **lamborghini-watches.com**: Transferred
22. **lamborhinishdigitalbank.app**: Transferred
23. **lamborhinishdigitalbank.com**: Transferred
24. **lamborhinishgate.com**: Transferred
25. **lamborhinishmultiverse.com**: Transferred
26. **lamborhinishroyaldynasty.com**: Transferred
27. **multiverselamborghini.com**: Transferred
28. **store-lamborghini.com**: Transferred
29. **the-lamborghini-lifestyle.com**: Transferred
30. **lamborgate.com**: Transferred

PANELLISTS

Name	Peter Müller
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DATE OF PANEL DECISION	2023-01-26
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Publish the Decision	
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