

Decision for dispute CAC-UDRP-105285

Case number CAC-UDRP-105285

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Domain names palumboyachts.com

Case administrator

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

Complainant

Organization Palumbo Group S.P.A.

Complainant representative

Organization Convey srl

Respondent

Organization Victoria Dom S.A.

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the domain name <palumboyachts.com> ('the disputed domain name').

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade mark, amongst others:

- EU trade mark registration no. 017883294, registered on 20 August 2018 for the figurative mark PALUMBO, in classes 12, 37 and 42 of the Nice Classification.

(Hereinafter, 'the Complainant's trade mark'; 'the Complainant's trade mark PALUMBO'; or 'the trade mark PALUMBO' interchangeably).

At present, the disputed domain name resolves to an active website, the details of which are discussed further below ('the Respondent's website').

FACTUAL BACKGROUND

A. Complainant's Factual Allegations

The Complainant's statements of fact can be summarised as follows:

The Complainant has been operating in the shipbuilding industry for 51 years, during which time it has undertaken construction of complex vessels, such as cruise ships, ferries, mega-yachts, and offshore units. It has refitted 1.937 ships and 341 superyachts in the past 5 years. The Complainant's group personnel comprise over 900 employees, resources and exclusive subcontractors, and 100+ naval architects and engineers.

The Complainant has begun its activities as a fairly modest carpentry and metalwork yard to support the local Italian ship repair industry. Currently, the Complainant represents the largest refit/repair network in the Mediterranean, has grown to become a major player in the shipbuilding industry, and is building up its reputation in the luxury yacht world.

The Complainant launched its first 54 meter superyacht in 2011 and, at present, operates the following world renowned trade marks: Isa Yachts, Columbus Yachts, Mondomarine, Extra Yachts and Palumbo SY Refit.

In addition to the trade mark mentioned in the section 'Identification of Rights', and many others, the Complainant holds since 2016 the domain name <palumbogroup.it>, which resolves to the Complainant's official website.

B. Respondent's Factual Allegations

The Respondent has failed to serve a Response in this UDRP administrative proceeding, the result of which being that the Complainant's factual allegations are uncontested.

PARTIES CONTENTIONS

A. Complainant's Submissions

The Complainant's submissions can be summarised as follows:

I. The disputed domain name is confusingly similar to a trade mark in which the Complainant has rights

The Complainant avers that the disputed domain name is confusingly similar to the Complainant's trade mark PALUMBO, in so far as it incorporates the Complainant's trade mark in its entirety. The addition of the word 'yachts' is insufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trade mark PALUMBO. On the contrary, the generic term 'yachts' worsens the likelihood of confusion as it directly refers to the Complainant's business activity. Furthermore, the generic Top-Level Domain (gTLD) suffix (<.com>) is typically disregarded in the assessment of identity or confusing similarity under paragraph 4(a) of the UDRP Policy.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant is not in possession of, nor aware of the existence of, any evidence demonstrating (i) that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name as an individual, business, or other organisation; (ii) that the Respondent holds any registered trade mark rights with respect to the disputed domain name; (iii) the Respondent's use, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods and services before any notice of this UDRP administrative proceeding; and (iv) that the Respondent has been using the disputed domain name for a legitimate non-commercial purpose.

The Respondent registered the disputed domain name in order to redirect it to a website related to PALUMBO products/services, which does not represent a bona fide offering as the Respondent's website capitalises on the reputation and goodwill of the Complainant's trade mark and misleads Internet users who could wrongly assume that the disputed domain name is a Complainant's authorised reseller.

III. The Respondent registered and is using the disputed domain name in bad faith

Registration

The trade mark PALUMBO has been used extensively and exclusively by the Complainant since 1967, and through long established and widespread use in several countries worldwide.

The trade mark PALUMBO enjoys worldwide reputation in the industry sectors of shipbuilding and refitting.

The disputed domain name was registered in January 2023, years after the Complainant had obtained registered trade mark rights for PALUMBO, including in Poland, where the Respondent is prima facie located.

Use

The Complainant avers that the Respondent has intentionally used the disputed domain name to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (paragraph 4(b)(iv) of the UDRP Policy).

The Complainant further avers that the Respondent's website displays a picture of a yacht owned by the Complainant as well as the statement 'Palumbo Yacht Ship Yard. You decide buy or not', which the Complaint claims would suggest to Internet users the possibility of buying PALUMBO yachts through the Respondent's website.

The Respondent's website was previously linked to an Instagram account held by the Respondent exploiting the PALUMBO trade mark. The Complainant sought the suspension of the account in view of the trade mark infringement, which the Complainant succeeded on 27 February 2023.

The Complainant also contends that, whilst the Respondent's website remains under construction, the following cumulative circumstances sway in favour of the Complainant: (i) the Respondent's lack of response to the Complainant's cease and desist letter prior to this UDRP administrative proceeding; (ii) the Respondent's concealment of its identity; and (iii) the implausibility of any good faith use of the disputed domain name.

The Complainant therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent's Submissions

The Respondent has failed to serve a Response in this UDRP administrative proceeding, the result of which being that the Complainant's submissions are uncontested.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has failed to make a prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name (within the meaning of paragraph 4(a)(ii) of the UDRP Policy).

BAD FAITH

The Panel makes no ruling on this UDRP Policy ground for the reasons set forth in section 'Principal Reasons for the Decision' further below.

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

A. General

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy sets out the following threshold for the Complainant to meet for the granting of the relief sought (transfer of the disputed domain name):

- i. The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- 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.

It is incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three UDRP Policy grounds in turn.

B. Identical or Confusingly Similar

The Panel is satisfied that the Complainant owns trade mark rights in 'PALUMBO' since 2018.

The disputed domain name <palumboyachts.com> was registered on 30 January 2023, and it is composed of the joint terms 'palumbo' and 'yachts'.

The Complainant's trade mark PALUMBO is wholly incorporated into the disputed domain name. The contiguous generic term 'yachts' in the disputed domain name string effectively evokes the industry sector in which the Complainant operates, thereby heightening the risk of association with the PALUMBO trade mark. Furthermore, and as rightly asserted by the Complainant, the gTLD <.com> is typically disregarded by UDRP panels under this Policy ground given that the gTLD is part of the domain name's anatomy.

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

C. Rights or Legitimate Interests

The second UDRP Policy ground provides that the Respondent shall demonstrate that it has rights or legitimate interests in the disputed domain name. It therefore falls on the Complainant the burden to refute any such showing.

Paragraph 4(c) of the UDRP Policy sets out a non-exhaustive list of examples by which the Respondent can demonstrate its rights or legitimate interests in the disputed domain name, as follows:

- (i) before any notice of this UDRP administrative proceeding, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain name, even if the Respondent has acquired no trade mark or service mark rights; or
- (iii) the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The evidentiary standard under the UDRP proceedings is such that, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to provide evidence to the contrary.

The Respondent has defaulted in this UDRP administrative proceeding. Nevertheless, the Panel is empowered to draw adverse inferences from the Respondent's silence (Rule 14 (b) of the UDRP Rules).

Having reviewed the case file, the Panel notes that the Complainant does not carry out any activity for, or has any business or relationship with, the Respondent. The Complainant does not appear to have authorised the Respondent to make any use of the Complainant's trade mark PALUMBO nor to register the disputed domain name, and there is no evidence on the record to suggest that the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain name.

It is moreover rather clear that the registration of the disputed domain name postdates the registration of PALUMBO trade mark.

The circumstances of the present case falling outside the scope of the above paragraphs 4(c)(i) and (ii) of the UDRP Policy, the Panel's attention has therefore been drawn to the provisions of paragraph 4(c)(iii). In order to further determine this Policy ground, the Panel has performed independent, albeit discreet, factual research on certain aspects of this case, and has also taken stock of paragraph 2.5.2 of the WIPO Panel Views on Selected UDRP Questions, Third Edition ('WIPO Jurisprudential Overview 3.0'), which contains various facts and circumstances illustrative to assessing the fair use of a domain name.

Paragraph 2.5.2 of the WIPO Overview 3.0 lists the following eight (8) determinative factors for a finding of fair use of a domain name, which the Panel will address in turn:

(i) whether the disputed domain name was registered and is being used for legitimate purposes and not as a pretext for commercial gain

The Respondent's website, albeit still under construction, appears to be aimed at reviewing and possibly critiquing the Complainant's offering of yachts, and not as a pretext for commercial gain. This becomes apparent when visiting the Respondent's website on which the following sentence is displayed: 'Real customers opinions on Palumbo Ship Yard. You decide buy or not'.

(ii) whether the Respondent reasonably believes its use (whether referential, or for praise or criticism) to be truthful and well-founded

The content of the Respondent's website suggests that it is intended to be used to genuinely provide reviews on the Complainant's yachts.

In addition, the Panel notes that the Instagram account, which the Complainant claims to be held by the Respondent, used to display the following sentence on the account holder's page: 'Real customers opinions on Palumbo Ship Yard. You decide for yourself whether it is worth or not to buy Palumbo yacht'. The Instagram account holder is identified as 'palumbo_yachts' and the Instagram post adduced as evidence by the Complainant is headed 'palumboyachtreview'.

On balance, the Panel considers that the Respondent reasonably believes the use of the disputed domain name to be truthful and well-founded.

(iii) whether it is clear to Internet users visiting the Respondent's website that it is not operated by the Complainant

The Panel takes the view that any reasonably informed Internet user will immediately notice that the Respondent's website is aimed at airing customers' reviews about the Complainant's yachts, and that the Respondent's website is not affiliated with the Complainant in any way. In addition, the Respondent's website differs significantly from the Complainant's official website at <palumbogroup.it>. The Panel also notes that the Respondent's website is also dissimilar to the website at the domain name <palumbosuperyachts.com> which appears to have been registered by the Complainant in 2018.

(iv) whether the Respondent has refrained from engaging in a pattern of registering domain names corresponding to marks held by the Complainant or third parties

There is no evidence on the record suggesting that the Respondent has registered a range of domain names to reflect the trade mark of the Complainant or of any other third party, nor has the Complainant made any claim or suggestion to that effect. In fact, the piece of information about the Instagram account, which was brought into the record by the Complainant, corroborates the indicium that the Respondent appears to have registered the disputed domain name for genuine criticism purposes and not to obtain a financial gain.

Moreover, the Panel has undertaken independent research and found out that the Respondent, Victoria Dom S.A., appears to operate in a different industry area from the Complainant's, namely the real estate industry in Poland and vicinities focussing on residential homes.

(v) where appropriate, whether a prominent link (including with explanatory text) is provided to the relevant trademark owner's website

There is no evidence of such link being provided on the Respondent's website. Nonetheless, in view of the above indicia swaying in favour of the Respondent's case, the Panel considers that absence of a link to the Complainant's website would be immaterial to the case outcome in the circumstances.

(vi) whether senders of e-mail intended for the Complainant but (because of user confusion) directed to the Respondent are alerted that their message has been misdirected

There is no indication that the Respondent has engaged in such conduct.

(vii) whether there is an actual connection between the Complainant's trade mark in the disputed domain name and the corresponding website content, and not to a competitor, or an entire industry, group, or individual

The Respondent's website is directed at the Complainant's offering of goods and services only and not the Complainant's competitor(s) or the yacht industry.

(viii) whether the disputed domain name registration and use by the Respondent is consistent with a pattern of bona fide activity (whether online or offline).

The Panel's findings on the above factors endorse the view that the Respondent's website is aimed to be used to provide customer reviews on the Complainant's offering of goods and services.

On balance, given the above considerations, the Panel is of the view that the disputed domain name is intended to be used for genuine critique and not for ulterior commercial purposes.

For the foregoing reasons, the Panel finds that the Complainant has failed to make a prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the UDRP Policy.

D. Registered and Used in Bad Faith

In light of the Panel's finding under section C above, the Panel shall not consider this UDRP Policy ground as any such finding would consequently be immaterial to the outcome of this UDRP administrative proceeding.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **palumboyachts.com**: Remaining with the Respondent

PANELLISTS

Name **Gustavo Moser**

DATE OF PANEL DECISION **2023-04-26**

Publish the Decision
