

Decision for dispute CAC-UDRP-105842

Case number	CAC-UDRP-105842
Time of filing	2023-10-03 09:46:38
Domain names	spare-parts-franke.com , franke-spare-parts.com , franke.cloud , franke-ricambi.com , ricambi-franke.com , frankericambi.cloud , ricambifranke.cloud , ricambi-franke-cappe.cloud , ricambi-franke-forni.cloud , ricambi-franke-frigoriferi.cloud , ricambi-franke-lavastoviglie.cloud , ricambi-franke-lavelli.cloud , ricambi-franke-miscelatori.cloud , ricambi-franke-pianidicottura.cloud

Case administrator

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

Organization	Franke Technology and Trademark Ltd
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Complainant representative

Organization	BRANDIT GmbH
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Respondent

Name	Raffaele Cicino
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of several trademark registrations consisting of or containing the word 'FRANKE', in particular:

- international figurative mark No 581340 'FRANKE' in stylised letters, internationally registered on 24 October 1991;
- international figurative mark No 387826 'FRANKE' in stylised letters, internationally registered on 17 February 1972;
- international word mark No. 975860 "FRANKE", internationally registered on 14 June 2007, all designating several countries; and
- international figurative mark No. 872557 "FRANKE" in stylised letters, internationally registered on 28 February 2005, designating the European Union (note: not an EU trademark as incorrectly claimed by the Complainant).

(collectively referred to as "FRANKE trademarks").

FACTUAL BACKGROUND

The Complainant is part of the Franke Group, a global group of companies established in Switzerland in 1911. The Franke Group is active, inter alia, in the production of equipment and systems for kitchens, bathrooms, professional food service and coffee preparation.

The Franke Group is active in 36 countries and generated net sales of CHF 2.56 billion in 2021. The Franke Group's products are marketed in many countries around the world, including Italy.

The Complainant owns the domain name <franke.com>, which is linked to the websites in several languages.

The disputed domain names were registered successively between 31 January and 29 June 2023.

PARTIES CONTENTIONS

1. Complainant

The Complainant argues that all the disputed domain names, namely <spare-parts-franke.com>, <franke-spare-parts.com>, <franke.cloud>, <franke-ricambi.com>, <ricambi-franke.com>, <frankeriacambi.cloud>, <ricambifranke.cloud>, <ricambi-franke-cappe.cloud>, <ricambi-franke-forni.cloud>, <ricambi-franke-frigoriferi.cloud>, <ricambi-franke-lavastoviglie.cloud>, <ricambi-franke-lavelli.cloud>, <ricambi-franke-miscelatori.cloud> and <ricambi-franke-pianidicottura.cloud> are all confusingly similar to the Complainant's FRANKE trademarks, which they incorporate in their entirety. The Complainant contends that the addition of descriptive terms such as "spare - parts", "ricambi", "cappe", "forni", "frigoriferi", "lavastoviglie", "lavelli", "miscelatori" or "pianidicottura" is not sufficient to escape the finding that the domain names are confusingly similar to the FRANKE trademarks.

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

In particular, the Complainant has not licensed or authorised the Respondent to register or use the disputed domain names, nor is the Respondent affiliated with the Complainant in any way.

Furthermore, there is no evidence that the Respondent is known by the disputed domain names or owns any corresponding registered trademarks.

The Complainant alleges that the Respondent is not using or preparing to use the disputed domain names in connection with a bona fide offer of goods and services, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain name. In particular, the Complainant submits that the structure of the disputed domain names, which include in their second level part the trade mark FRANKE and the terms "spare", "parts", "ricambi", "cappe", "forni", "frigoriferi", "lavastoviglie", "lavelli", "miscelatori" or "pianidicottura" - reflect the Respondent's intention to create, in the minds of internet users, an association and a consequent likelihood of confusion with the Complainant, its trade mark FRANKE and its business conducted under that trade mark. By reading the disputed domain names, which contain the FRANKE trademark and terms relating to the Complainant's field of activity, Internet users may be misled into believing that the disputed domain names are directly associated with the Complainant and will resolve to the Complainant's official website, which is not the case, as the disputed domain names resolve to the websites of a third party not affiliated with the Franke Group. In this regard, the Complainant alleges that the content of the websites associated with the disputed domain names is intended to suggest a direct association with the Complainant and its FRANKE trademark. This is due, inter alia, to the fact that the FRANKE trademark is prominently mentioned on the websites associated with the disputed domain names and that the websites do not identify the person operating them.

Although it appears that the Respondent allegedly offers the products or services at issue on the website associated with the disputed domain names, they do not disclose the relationship between the Complainant and the Respondent and thus do not meet the cumulative requirements of the Oki data test.

The Complainant alleges that the disputed domain names were registered in bad faith, in particular (i) that the Respondent registered the disputed domain names many years after the Complainant's FRANKE Trademarks were registered, (ii) that the registration of the disputed domain names - which include the FRANKE Trademark and descriptive terms related to the Franke Group's business - is intended to create a direct association with the Franke Group, the Complainant's FRANKE Trademarks and its domain name <franke.com>.

Finally, the Complainant alleges that all of the disputed domain names are being used in bad faith, claiming that the disputed domain names contain the FRANKE trademark and, with the exception of <franke.cloud>, terms relating to the Franke Group's business. They refer to a website on which the FRANKE trademark is repeated and which aims to imitate the Complainant's official website www.franke.com. This reference to the FRANKE trademark is intended to attract the attention of Internet users and to lead them to believe that the website is affiliated with the Complainant, which is not the case. Such use of the disputed domain names creates a likelihood of confusion in the minds of internet users and may lead them to attempt to contact the person operating the website in order to purchase services.

2. Respondent

No administratively compliant response has been submitted by the Respondent.

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).

The Complainant has successfully demonstrated that it is the rightful owner of the FRANKE trademarks. The word FRANKE, which is the only word or word element of the Complainant's FRANKE trademarks, is clearly recognisable in the disputed domain names. The addition of descriptive English and Italian terms, mostly related to the Complainant's line of business, in particular "spare-parts", "ricambi" (in English 'spare-parts'), "cappe" (in English hoods), "forni" (in English ovens), "frigoriferi" (in English 'fridges'), "lavastoviglie" (in English 'dishwashers'), "lavelli" (in English 'sinks'), "miscelatori" (in English 'mixers') or "pianidicottura" (in English 'hobs') is not sufficient to avoid confusion on the part of internet users. The confusing similarity is also not prevented by the graphic representation of some of the Complainant's marks, given that figurative, stylised or design elements in a mark generally cannot be represented in a domain name (see "Article 1.10 of the WIPO Jurisprudence Overview 3.0").

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).

A complainant is required to establish a prima facie case that the respondent lacks rights or legitimate interests. Once such a case is made, the burden of proof shifts to the respondent to demonstrate their rights or legitimate interests in the domain name. Failure to do so results in the complainant satisfying paragraph 4(a)(ii) of the Policy (as per Article 2.1 of WIPO Jurisprudential Overview 3.0).

Based on the contentions of the Complainant, the panel finds that the Complaint has successfully established a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

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).

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see Article 3.1. of WIPO Jurisprudential Overview 3.0).

Registration in bad faith

The Panel considered the following factors in determining bad faith registration of the disputed domain names:

(a) the long history and reputation of the Complainant's FRANKE trademarks, which were registered long before the registered domain names; and

(b) The Respondent's registration of the domain names in a short period of time using the same pattern, in particular the combination of the well-established FRANKE trademark with the descriptive terms, both in English and Italian, relating to the Complainant's industry.

Based on the foregoing, the Panel concludes that the Respondent must have been aware of the Complainant and its trademarks when it registered the disputed domain names.

In light of the foregoing, the Panel finds that the Respondent has registered the disputed domain names in bad faith.

Bad faith use

The disputed domain names are associated with third party websites that give the impression of being the official website of the Complainant, in particular through the use of the complainant's stylised FRANKE trademark in the same style and red colour as that used by the Complainant, inter alia, on its official website www.franke.com. The third-party websites do not contain any information as to the identity of the person operating them or as to the relationship between those websites and the Complainant. Based on the appearance and design of the websites, the internet user may mistakenly believe that the websites are either directly operated by the Complainant or the Franke Group or that the Complainant has authorised, licensed and/or endorsed such websites.

The Panel finds that such use is not for bona fide offerings, but rather an attempt to attract internet users to the website for commercial gain by creating a likelihood of confusion with the Complainant's trademark as to source, sponsorship, affiliation or endorsement.

Therefore, the Panel finds that the disputed domain names are being used in bad faith.

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.

Paragraph 3(c) of the UDRP Rules provides that a complaint may involve more than one domain name, provided that the domain names are registered by the same domain name holder. In this case, all of the disputed domain names are registered by the same domain name holder and there are no multiple respondents as alleged by the Complainant.

PRINCIPAL REASONS FOR THE DECISION

The Panel has determined that the disputed domain names are confusingly similar to the Complainant's trademarks.

Based on the contentions presented by the Complainant, the Panel has found that the Complainant has satisfactorily made a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

The Panel finds that, based on the Complainant's contentions and evidence, it can be concluded that the Respondent must have been aware of the Complainant's trademarks when it registered the disputed domain names, and as such, the Respondent has registered the disputed domain names in bad faith.

Lastly, the Panel has concluded that the Complainant has successfully proven that the disputed domain names 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. **spare-parts-franke.com** : Cancelled
2. **franke-spare-parts.com** : Cancelled
3. **franke.cloud** : Transferred
4. **franke-ricambi.com** : Cancelled
5. **ricambi-franke.com** : Cancelled
6. **frankericambi.cloud** : Cancelled
7. **ricambifranke.cloud** : Cancelled
8. **ricambi-franke-cappe.cloud** : Cancelled
9. **ricambi-franke-forni.cloud** : Cancelled
10. **ricambi-franke-frigoriferi.cloud** : Cancelled
11. **ricambi-franke-lavastoviglie.cloud** : Cancelled
12. **ricambi-franke-lavelli.cloud** : Cancelled
13. **ricambi-franke-miscelatori.cloud** : Cancelled
14. **ricambi-franke-pianidicottura.cloud** : Cancelled

PANELLISTS

Name	Karel Šindelka
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DATE OF PANEL DECISION 2023-11-21

Publish the Decision
