

Decision for dispute CAC-UDRP-105919

Case number	CAC-UDRP-105919
Time of filing	2023-10-30 09:49:51
Domain names	lamborghiniinabox.com, lamborhNILat.com, lamborhNILatam.com, novalamborghini.com, lamborhNIBet.com

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **Automobili Lamborghini S.p.A.**

Complainant representative

Organization **Paolo Lazzarino (Nctm Studio Legale)**

Respondent

Name **JORGE ANTONIO FERNANDEZ GARCIA**

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 below defined) with consequent recognition of lack of Respondent's right to use them, in particular:

Interim proceedings brought by the Complainant against the Respondent (Mr. Jorge Antonio Fernández García together with Automóviles Lamborghini Latinoamérica SA de CV, where he acts as a CEO) before the Court of Genoa, Italy (R.G. 6821/2019): with an ex parte injunction 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 and Automóviles Lamborghini Latinoamérica SA de CV 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 Automóviles Lamborghini Latinoamérica SA de CV and featuring the Lamborghini Mark or any similar sign.

Proceedings brought by the Complainant against the Respondent 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 defendant 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 i) the non-existence of any right of the Respondent to use the Lamborghini Marks and ii) that the license agreements used by the Respondent were 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, questioned the authenticity of the purported license agreements filed by the Respondent and by Automóviles Lamborghini Latinoamerica SA de CV and the Respondent's (and the company's) right to use the Lamborghini Mark or to be authorized licensees of the Complainant. Since then, the Respondent has tried to challenge, on various grounds, the judgement. However, its attempts always proved unsuccessful.

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

UDRP proceeding n. 105048 before CAC: on 26 January 2023 UDRP panellist Peter Muller ruled for the reassignment of 30 domain names illegitimately registered in the name of the company Automóviles Lamborghini Latinoamerica SA de CV by the Respondent (registrant's e-mail was joanferci@gmail.com, the same used for the Disputed Domain Names) on the following grounds: (i) all the disputed domain names included the Complainant's trademark "Lamborghini", in some cases alone and in others combined with certain non-distinctive words but always clearly recognizable within the disputed domain names; (ii) Automóviles Lamborghini Latinoamerica SA de CV did not have any rights or legitimate interests in the disputed domain names as it was evident from the facts that (a) the renowned "Lamborghini" mark was never contractually granted to Automóviles Lamborghini Latinoamerica SA de CV and (b) the Complainant had already judicially challenged such unlawful use by Automóviles Lamborghini Latinoamerica SA de CV; (iii) there does not appear to be any possible or conceivable good-faith use of the disputed domain names that would not be illegitimate for passively held domain names while active domain names clearly diverted traffic for Automóviles Lamborghini Latinoamerica SA de CV's commercial gain.

The Complainant started proceedings in Uruguay against the company Automóviles Lamborghini Uruguay, also part of the Respondent's group of companies, which is deputed to illegally collect royalty payments from the illegitimate and unauthorized exploitation of the Lamborghini Mark in Uruguay. The Complainant requested the cancellation of the tradename of the company and sought a court order preventing the company from exploiting the Lamborghini Marks in that country. The first hearing is expected to take place by the end of 2023."

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks consisting either of the word element "LAMBORGHINI" alone or where "LAMBORGHINI" represents the main distinctive feature.

Some of the most relevant trademarks are as follows:

- Italian trademark registration "Lamborghini" (device) no. 1606272 filed on 3 July 1974;
- the Italian trademark "Lamborghini" no. 326126 filed on 21 October 1980;
- the EU trademark registration "Automobili Lamborghini" no. 001100221 filed on 8 March 1999;
- the EU trademark registration "Automobili Lamborghini" (device) no. 013500384 filed on 27 November 2014;
- the Mexican trademark registration "Lamborghini" no. 1069750 filed on 3 March 2008;
- the Mexican trademark registration "Lamborghini" (device) no. 1069752 filed on 3 March 2008;
- the US trademark registration "Lamborghini" no. 1622382 filed on 16 January 1990;
- the Brazilian trademark registration "Automobili Lamborghini" (device) no. 911158642 filed on 9 June 2016;
- the Argentinian trademark registration "Automobili Lamborghini" (device) no. 3513029 filed on 9 June 2016; and
- the EU trademark registration "Lambo" no. 006113451 filed on 19 July 2007.

Moreover, the Complainant owns, among other domain names, a domain name lamborghini.com, registered on 15 September 1996 which hosts its official website, with an interactive webpage, including detailed graphics of its cars, photos and footage, but also showing its merchandise products and customer-oriented services.

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. In 2021, the Complainant's business reached a turnover of EUR 1.95 billion (an increase of 19% compared to 2020) and 8,405 cars sold worldwide.

The Respondent is a physical person named Jorge Antonio Fernandez García, resident of the Mexico City in Mexico, who registered the

following disputed domain names:

- on 24 April 2023: lamborhinet.com, and
- on 27 March 2023: lamborhinetinabox.com, lamborhinetlat.com, lamborhinetlatam.com, and novalamborhinet.com

The Complainant states that the disputed domain name <lamborhinet.lat> is used by the Respondent to offer for sale unauthorized products/services under the trademark “Lamborghini”. The other disputed domain names are not actively used.

PARTIES CONTENTIONS

COMPLAINANT' CONTENTIONS:

Identical or confusingly similar

The Complainant argues that the disputed domain names and the Complainant's registered trademarks “LAMBORGHINI” are confusingly similar.

The Complainant argues that its trademarks are fully contained within the disputed domain name and points out that the elements in which the signs vary do not alter the overall confusion between the signs.

No rights or legitimate interests

The Complainant argues that there is no evidence at all that the Respondent is commonly known by the disputed any of the domain names or a name corresponding to the disputed domain names, nor that the Respondent is making a bona fide offering of goods or services. Moreover, the Complainant states that the Respondent is being using the Complainant's trademarks without any authorization which demonstrates, conclusively and not only prima facie, the absence of any genuine rights or legitimate interests of the Respondent with reference to the disputed domain names and represents a clear intent of unlawful association with the Complainant.

Registered and used in bad faith

As far as bad faith registration is concerned, the Complainant states that since the Respondent does not have rights or legitimate interests in the Complainant's trademarks', which according to the Complainant infringes exclusive rights of the Complainant, its registration is per se indicative of bad faith on part of the Respondent.

Moreover, the Complainant states that the disputed domain names have been registered on 27 March 2023 and 1 on 24 April 2023, so after the judicial rulings to which it refers and three months after previous decision of the Czech Arbitration Court (“CAC”) issued on 26 January 2023 in the case No. 105048, which clearly shows bad faith of the Respondent at the time of the disputed domain name acquisition.

As far the use of the disputed domain names concerns, the Complainant point out that the domain name <lamborhinetlat.com> redirects to what appears to be the official website of the company Automóviles Lamborghini Latinoamerica SA de CV, where the Respondent acts as a CEO, the remaining disputed domain names do not appear to be in use.

The Complainant underlines that, although most of the domain names are not actively used by the Respondent, passive holding may amount to bad faith use under certain circumstances, as in this case, were the Respondent not only acts without any authorization as the Complainant's representative, uses without any permission the Complainant's trademarks but also abuses the ICANN's system: the

Complainant indicates to be compelled to file multiple complaints before this CAC to request reassignment of domain names apparently registered by different entities/persons, domiciled in different countries, or through proxies, but actually used by the Respondent for its counterfeiting activities.

RESPONDENT'S CONTENTIONS:

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are confusingly similar to trademarks 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 used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The first issue in this case concerns the language in which the UDRP proceeding can be conducted.

The Respondent chose Spanish as a language of the registration agreement. However, the Complainant argues that the Respondent has a good knowledge English and that conducting the proceeding in Spanish would burden the Complainant of additional expenses and delay which are not reasonable. More specifically, the Complainant points out on the following circumstances:

The content of the website of the disputed domain name <lamborghinilat.com> is entirely in English;

The language of the registration agreement chosen for the registration of the 30 domain names in the name of the company Automóviles Lamborghini Latinoamerica SA de CV by the Respondent reassigned to the Complainant on 26 January 2023 through the UDRP proceeding n. 105048 before CAC, was English;

Choosing English as language of the proceeding would be fair to both parties the Complainant is an Italian company and neither English nor Spanish are native languages for it or for its authorized representative.

The Rules for the Uniform Domain Name Dispute Resolution Policy (UDRP) dictate in the article 11 that the language for a dispute proceeding:

(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

(b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.

In deciding the appropriate language of the proceeding, the Panel considers that the Respondents understands English mainly because the website <lamborghinilat.com> of the company Automóviles Lamborghini Latinoamerica SA de CV in which the Respondent acts as a CEO has its official website only in English (there is not even an alternative to switch to Spanish or other language and even the Privacy policy documentation placed on such website is only in English language).

Therefore, the Panel finds that the Respondent understands English and bearing in mind all the above-mentioned factors in their

conjunction considers unreasonable and undefective to conduct the proceeding in Spanish.

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 shall decide 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 shall draw such inferences therefrom as appropriate.

In the present case, the Respondent has not submitted any Response and therefore any arguments and documents in support of them and consequently has not contested any of the contentions made by the Complainant (unlike in UDRP proceeding n. 105901 before CAC).

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

The Complainant is owner of a considerable number of trademarks whose common distinctive element is a particle "LAMBORGHINI". Besides the Italian and EU protection, the trademark "LAMBORGHINI" have been registered by the Complainant in various non-EU countries, including the Respondent's country of origin, Mexico.

The disputed domain names are as follows:

<lamborghiniinabox.com>

<lamborhNILat.com>

<lamborhNILatam.com>

<novalamborghini.com>

<lamborhINIBet.com>

All the disputed domain names comprise of the distinctive element "LAMBORGHINI" which does not have any particular meaning apart from being a surname of the Complainant's founder Ferruccio Lamborghini. The other word elements "bet", "in a box", "lat", "latam" and "nova" comprised in the disputed domain names has a known meaning and are all suggestive of the product/location of condition. All five disputed domain names comprise of the Top-Level domain ".com".

Panel finds that the disputed domain names coincide in the majority of the verbal and visual elements with the Complainant's trademark and produced likelihood of association in a sense that the disputed domain names produce an idea in the internet users of being somehow related to the Complainant or, as the case may be, from economically-linked subject, which is not true.

The Panel accordingly concludes that paragraph 4(a)(i) of the Policy is satisfied.

3. The Complainant demonstrated that the Respondent is not in any way related to its business but rather conducts parasitism on the Complainant name and goodwill by way of unauthorize use of the Complainant's trademark in its business activities

despite of not being authorized in any way.

Moreover, the Respondent as such has never been known under the name “LAMBORGHINI”, or any combination of this trademark, apart from the knowledge the public has of the Respondent due to his illicit activities in the market consisting of pretending relationship with the Complainant.

Consequently, and in the absence of a Response, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain names, so that the requirements of paragraph 4(a)(ii) of the Policy are met.

4. As to the bad faith at the time of the registration, the Panel finds that, in light of the distinctiveness of the Complainant’s trademark that are fully comprised within the disputed domain names, and of the worldwide presence of the Complainant’s products (namely cars), the Respondent must have been aware of the Complainant’s trademark at the time of the registration of the disputed domain names.

The fact that the Complainant has undertaken legal steps, including court and alternative disputes proceeding even before registration date of the disputed domain names, makes prior assumption about the Respondent knowledge of the Complainant’s business and trademarks even more reliable.

Bearing in mind these circumstances, the Respondent can be deemed to have registered the domain names for the purpose of parasitism.

As to the use of the disputed domain names in bad faith, the Panel consider the fact that the disputed domain name lamborghinilat.com resolves to a webpage belonging to the Respondent on which the Complainant trademarks are used in relation to different products (cars and merchandise) without any authorization granted by the Complainant as a clear sign of a Respondent’s bad faith.

In view of the Panel the fact that the Respondent falsely claimed to be the representative and exclusive licensee of the Complainant in Latin America, and in some cases even the owner of trademark registrations for the Complainant’s trademarks, constitutes another clear evidence of the Respondent’ bad faith in connection with the use of the disputed domain names, namely with the domain name <lamborghini.lat>.

With regard to the remaining disputed domain names, those do 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 a 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 Complainant’s business name and trademark “LAMBORGHINI” has a strong reputation and is widely known, as evidenced by several prizes granted to “Lamborghini cars” in different EU and non-EU countries;
- the disputed domain names include (as the only element which is different form the Complainant’s trademark), the word elements “bet”, “in a box”, “lat”, “latam” and “nova”, which can be perceived as allusive to the products offered by the Complainant illegally;
- the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain names.

Under such circumstances, the Panel considers the Complainant’s argument and evidence submitted as sufficient to show that the

Respondent uses the disputed domain names in bad faith.

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. **lamborghiniinabox.com**: Transferred
2. **lamborhNILat.com**: Transferred
3. **lamborhNILatam.com**: Transferred
4. **novalamborghini.com**: Transferred
5. **lamborhNIBet.com**: Transferred

PANELLISTS

Name	Hana Císlerová
------	-----------------------

DATE OF PANEL DECISION 2023-12-05

Publish the Decision
