

Decision for dispute CAC-UDRP-105918

Case number	CAC-UDRP-105918
Time of filing	2023-10-30 09:49:59
Domain names	betlamborghini.com, casinolamborghini.com, casinoslamborghini.com, lamborghinicasino.com

Case administrator

Name	Olga Dvořáková (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

Name	JORGE ANTONIO FERNANDEZ GARCIA
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OTHER LEGAL PROCEEDINGS

With respect to other legal proceedings between the Parties, the Complainant has submitted the following:

"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:

1. Interim proceedings brought by the Complainant against the Respondent (Mr. Jorge Antonio Fernández García, together with Automóviles Lamborghini Latinoamerica 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 Latinoamerica 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 Latinoamerica SA de CV and featuring the Lamborghini Mark or any similar sign.
2. 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.

3. 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.
4. 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 Marks.
5. **UDRP proceeding no. 105048 before CAC**: on 26 January 2023 UDRP panellist (..) 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.
6. 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."

However, with respect to the disputed domain names in this proceeding, i.e <betlamborghini.com>, <casinolamborghini.com> <casinoslamborghini.com> and <lamborghinicasino.com> the Panel interferes from the Amended Complaint that there are no other legal proceedings which are pending or decided relating to the disputed domain names mentioned.

IDENTIFICATION OF RIGHTS

The Complainant registered the Lamborghini trademark first in Italy in 1974, and subsequently in several other countries in the world. The Complainant is the owner of numerous Lamborghini trademarks, *inter alia* of

- the Italian trademark registration "**Lamborghini**" (device) no. 1606272 filed on July 3, 1974;
- the Italian trademark "**Lamborghini**" no. 326126 filed on October 21, 1980;
- the US trademark registration "**Lamborghini**" no. 1622382 filed on January 16, 1990;
- the Argentinian trademark registration "**Automobili Lamborghini**" (device) no. 3513029 filed on June 9, 2016; and
- the EU trademark registration "**Lambo**" no. 006113451 filed on July 19, 2007.

All trademark registrations hereinafter referred to as the "Trademark".

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. Lamborghini vehicles are without a doubt amongst the world's most famous luxury sports cars. After 60 years, the Complainant's business continues to grow and in 2022 reached its best-ever performance in terms of turnover and profitability with a turnover of EUR 2.38 billion and more than 9,000 cars sold worldwide.

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

The disputed domain names have all been registered on April 24, 2023 and are all used in connection with a placeholder website

generated by the Registrar.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain names are all "almost identical" or "highly similar" to the Trademark, as they fully incorporate the Trademark, combining it with certain words, which have a descriptive connotation.

With respect to the second element of the UDRP, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names. More specifically, i) Complainant never authorized the Respondent to use the Trademark as a domain name or company name, a finding backed from various judicial decisions, ii) the Complainant never granted any right nor executed any agreement authorizing or licensing the use of the Trademark or of any similar sign to the Respondent, iii) as the disputed domain names are currently passively held, there is no information on the websites that could even remotely conceive a basis for a finding of rights or legitimate interests, iv) the lack of any license or authorization to commercially exploit the Trademark, is incompatible with all circumstances that may prove rights or legitimate interests, under Art. 4 (c) of the Policy and v) the Respondent has engaged in a pattern of conduct that ultimately generates a serious risk towards the Trademark and the Complainant.

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 and that the registration of the disputed domain names, which infringe the exclusive rights of the Complainant, is *per se* indicative of bad faith on part of the Respondent.

Furthermore, the Respondent's bad faith is further proven by his extended counterfeiting and competitively unfair conducts and by the fact that the Respondent perseveres to use and register domain names, although it has already been judicially restrained to do so, and that the Respondent's non-use of the disputed domain names equals to bad faith use and that these attempts of the Respondent are made with the purpose of disrupting the business of a competitor and with the intention to attract, for commercial gain, Internet users to the websites, by creating a likelihood of confusion with the Complainant's Trademark 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

With respect to the procedural factors of these proceedings, the Complainant has requested that the language of the proceedings is English, instead of Spanish which is the language of the registration agreement.

Even though the Respondent chose Spanish as language of the registration agreement, the Complainant requests that the proceedings are conducted in English given that the Respondent has extensively demonstrated to have knowledge of such language. Evidence of this is given, inter alia, by the fact that:

- i) the Respondent has previously registered other domain names hosting websites whose content is entirely in English, and;
- ii) the language of the registration agreement chosen for the registration of the 30 domain names in the name of the company Automóviles Lamborghini Latinoamérica SA de CV which is owned or at least controlled by the Respondent (to the best of the Panel's knowledge) - (registrant's e-mail was joanferci@gmail.com, the same used for the disputed domain names), reassigned to the Complainant on January 26, 2023 through the CAC UDRP proceeding no. 105048, was English.

The Panel is satisfied that the above prove Complainant's point and that choosing English as the language of the proceedings would be fair to both parties and would be a perfect balance of convenience. On the contrary conducting the proceeding in Spanish would burden the Complainant of additional expenses and delay which are not reasonable considering the demonstrated knowledge of English by the Respondent.

Having said that, the Panel is satisfied that all procedural requirements under the 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 a top-level domain names are 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.

Second, all disputed domain names are a combination of the Trademark and generic or descriptive terms that do not take away the distinctiveness of the famous Lamborghini trademark.

Therefore, the Panel agrees that all the disputed domain names are confusingly similar to the Trademark.

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 and that the burden of proof has been shifted to the Respondent. The Respondent did not deny any of the Complainant's 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. Even if the disputed domain names are not used actively by the Respondent, they do not give any further indication of the Respondent's own rights or legitimate interests.

3. Finally, the Panel is also satisfied that the Respondent registered the disputed domain names with full knowledge of the Complainant and its rights in the well-established Trademark as the Respondent has a vast procedural history with the Complainant, it even has a company that is apparently competing by using the Trademark in its company name and there have been multiple claims by the Complainant against the Respondent and its company for introducing counterfeit goods to the market in association with the Trademark, and the Respondent has undoubtedly engaged in a pattern of conduct, where he registers domain names involving the Trademark again and again in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name.

As to bad faith use, even if the disputed domain names are not actively used but passively held (by showing a placeholder website generated by the Registrar) according to the Telstra doctrine, passive holding 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. It is the Panel's view, that the circumstances in this case clearly justify the equation of passive holding and active use, because:

- i) the Trademark is highly distinctive and well-known;
- ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use;
- iii) the disputed domain names clearly target the Trademark;
- iv) the Respondent has registered many other domain names and has used/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;

v) from all of the circumstances, it cannot be interfered that there is 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 have been registered and are being 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. **betlamborghini.com**: Transferred
2. **casinolamborghini.com**: Transferred
3. **casinoslamborghini.com**: Transferred
4. **lamborghinicasino.com**: Transferred

PANELLISTS

Name **Stefanie Efstathiou LL.M. mult.**

DATE OF PANEL DECISION 2023-12-19

Publish the Decision