Decision for dispute CAC-UDRP-106030

Case number	CAC-UDRP-106030
Time of filing	2023-12-14 10:31:57
Domain names	dreambocconi.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Università Commerciale Luigi Bocconi

Complainant representative

Organization	Buzzi, Notaro e Antonielli d'Oulx

Respondent

Organization	Catal Academy SA

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 name.

IDENTIFICATION OF RIGHTS

The Complainant has demonstrated ownership of registered trademark rights for BOCCONI for the purposes of standing to file a UDRP complaint.

The Complainant is the owner of several trademark registrations for BOCCONI, including the following:

- European Union trademark registration No. 007487978 for BOCCONI (word mark), filed on December 22, 2008, and registered on June 9, 2009, in classes 9, 16, 25, 35, 36, 41, 42, 43 and 45;

European Union trademark registration No. 007488018 for BOCCONI (figurative mark), filed on December 22, 2008, and registered on December 11, 2009, in international classes 9, 16, 25, 35, 36, 41, 42, 43 and 45.

FACTUAL BACKGROUND

The Complainant was founded by Ferdinando Bocconi in 1902 in memory of his son Luigi Bocconi who died in the Battle of Adua in 1896.

The Complainant is a private Italian University specializing in teaching economic and social sciences, management, law and politics.

The aim is to train students in the name of innovation, developing and integrating individual talent with business skills, favoring an educational model that gives equal importance to theoretical and practical knowledge. According to rankings drawn up by specialized agencies, the Complainant is one of the best universities in the world, ranking respectively 4th and 14th among the universities located in the European Union and abroad.

The Complainant is the owner, amongst others, of the domain name <unibocconi.it> registered on June 12 2002, and used by the Complainant to promote its educational services under the trademark BOCCONI.

The disputed domain name <dreambocconi.com> was registered on July 20, 2023, and resolves to a website offering assistance and lessons in preparation of admission tests to the University of the Complainant.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name <dreambocconi.com> is confusingly similar to the trademark BOCCONI in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the descriptive word “dream” and the generic Top Level Domain (“gTLD”) “.com”.

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name since: i) the Respondent does not use, and has not used, the disputed domain name in connection with a bona fide offering of goods or services, as the disputed domain name is being used in connection with an active website offering assistance, lessons and admission tests to the University of the Complainant; ii) the Respondent has no rights in the disputed domain name despite its false claim that “Dream Bocconi is a trademark of Catal Academy”, since no trademark registrations were found for DREAM BOCCONI; iii) the Respondent is not a licensee of the Complainant and has in no way been authorized or allowed by the Complainant to use the BOCCONI mark in any way; and iv) the Respondent is using the disputed domain name to intentionally attempt to attract, confuse and profit from Internet users seeking the Complainant and its services, thus taking unfair advantage of the Complainant’s goodwill in the BOCCONI mark.

The Complainant claims that the Respondent registered the disputed domain name in bad faith because: i) the Respondent had actual knowledge of the Complainant, its trademark and its educational services at the time of registration, considering the composition of the disputed domain name and the content of the correspondent website, referring to the Complainant’s educational services and displaying a photograph of the Bocconi University’s campus; ii) the Respondent registered the disputed domain name in order to intentionally attempt to attract users searching for the Complainant’s educational services for commercial gain, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the website.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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 name (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 name has been registered and is 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

1. The Complainant has provided evidence of ownership of valid trademark registrations for BOCCONI.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark BOCCONI as it reproduces the trademark in its entirety with the mere addition of the generic term "dream", which is not sufficient to prevent a finding of confusing similarity.

As to the gTLD".com", as established in a number of prior UDRP cases, it is viewed as a standard registration requirement and as such can be disregarded for the purpose of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has made a prima facie case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain name could be inferred.

The Panel notes that, based on the records, the Complainant has not authorized the Respondent to register and use its trademark BOCCONI. Moreover, there is no evidence that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name.

As highlighted above, the disputed domain name, confusingly similar to the Complainant's trademark, is currently pointing to an active website offering assistance, lessons and admission tests to the University of the Complainant and publishing images of the University itself, without displaying any disclaimer of non-affiliation with Complainant. The Panel finds that the Respondent's use does not amount to a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name without intention to misleadingly divert the consumers or to tarnish the Complainant's trademark.

Moreover, the disputed domain name, combining the Complainant's trademark with the generic term "dream" (clearly associable to the idea that many candidates would strongly aspire to attend such University), is inherently misleading and suggests an affiliation with the Complainant that, according to the records, does not exist.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the prior use of BOCCONI as name, trademark and domain name by the Complainant, the activity of which has been promoted online via the Complainant's website www.unibocconi.it since 2002, the Respondent must have been aware of the Complainant's trademark when it registered the disputed domain name in July 2023. The fact that the Respondent has made reference to the Complainant and its educational services on the website at the disputed domain name, reproducing also an image of the Complainant's university building, demonstrates that the Respondent was indeed well aware of, and intended to target, the Complainant and its trademark.

The Panel also notes that, in view of the use of the disputed domain name to divert users to the website described above, offering assistance and lessons in preparation of admission tests to the University of the Complainant and publishing an image of the Complainant's premises, the Respondent intentionally attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website and the services provided therein, according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **dreambocconi.com**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2024-01-25

Publish the Decision