Decision for dispute CAC-UDRP-106172

Case number	CAC-UDRP-106172
Time of filing	2024-01-23 08:05:11
Domain names	franke-ricambi.cloud, ricambi-franke.cloud, ricambifranke.com, frankericambi.com, franke-ricambi-it.com, ricambi-franke-it.com

Case administrator

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

Complainant

Organization	Franke Technology and Trademark Ltd

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Raffaele Cicino

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 owner of several KLARNA trademarks:

- International figurative trademark registration no. 387826 “FRANKE” registered on 17.02.1972
- International figurative trademark registration no. 581340 “FRANKE” registered on 24.10.1991
- International word trademark registration no. 975860 “FRANKE” registered on 14.06.2007
- International figurative trademark registration no. 0872557 “FRANKE” registered on 28.02.2005

The disputed domain names were registered:

- <franke-ricambi.cloud> on 22.11.2023;
- <ricambi-franke.cloud> on 22.11.2023;
- <ricambifranke.com> on 23.11.2023;
- <frankericambi.com> on 23.11.2023;
- <franke-ricambi-it.com> on 24.11.2023;
- <ricambi-franke-it.com> on 24.11.2023.

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is part of the Franke Group, a global group of companies based in Switzerland, originally founded in 1911. The Franke Group provides innovative devices and systems for kitchens, bathrooms, professional foodservices and coffee preparation. The Franke group employs over 8,000 persons in 37 countries and has an active business presence in Italy.

The Complainant owns of numerous trademark registrations for the mark FRANKE. The vast majority of these trademark registrations predate the registration of the disputed domain names. The Complainant also owns numerous domain names containing the trademark FRANKE, among them: <franke.com>, <franke.cn> and <frankeparts.com>.

At the time of the filing of the Complaint, the disputed domain names resolved to websites which have aimed at inferring a direct association to the Complainant and its FRANKE trademark. The FRANKE trademark was prominently and repeatedly quoted on the websites associated to the disputed domain names. At the time of the filing of the Amended Complaint, the disputed domain names do not resolve to active websites anymore, as on January 23, 2024, the Complainant filed a request before the Hosting provider Aruba S.p.a. to take down the content of the websites associated with the disputed domain names. Thus, on January 26, 2024, the disputed domain names do not resolve to active websites anymore.

(i) The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

All the disputed domain names, in their second-level portion, incorporate in its entirety the Complainant's trademark FRANKE. Moreover, the addition of the following descriptive terms "ricambi" and "IT" would not prevent a finding of confusing similarity to the trademark. The presence of the generic Top-Level Domain (gTLD) ".com" or ".cloud" in the first level portion of the disputed domain names is a standard registration requirement and may be disregarded when assessing whether the disputed domain names are confusingly similar to the trademark in which the Complainant has rights. The disputed domain names are therefore confusingly similar to the Complainant's trademark FRANKE.

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain names; (Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

The disputed domain names were registered between November 22 to 24, 2023, many years after the first registrations of the Complainant's FRANKE trademarks. The Complainant has not licensed or authorized the Respondent to register or use the disputed domain names, nor is the Respondent affiliated to the Complainant in any form. There is no evidence that the Respondent is known by the dispute domain names or owns any corresponding registered trademarks.

When conducting searches on online trademark databases regarding the terms corresponding to full text of the disputed domain names with and without the top-level domain name (.cloud and .com), no information is found in relation with trademarks corresponding to the aforementioned terms.

The Respondent has not been using, or preparing to use, the disputed domain names in connection with a bona fide offering of goods and services, nor making a legitimate noncommercial or fair use of the disputed domain names.

The Complainant submits, that the disputed domain names incorporating in its second level portion the FRANKE trademark and the terms "ricambi", as well as "IT" regarding <franke-ricambi-it.com> and <ricambi-franke-it.com>, reflects the Respondent's intention to create an association, and a subsequent likelihood of confusion, with the Complainant, its FRANKE trademark, and its business conducted under the same, in Internet users' mind.

Furthermore, the FRANKE trademark was prominently and repeatedly quoted on the websites associated to the disputed domain names. Moreover, the color tones displayed therein, were similar to the ones on the Franke group's website at "franke.com". Furthermore, no name as to the person operating the websites, associated to the disputed domain names, were given therein. The websites associated with the disputed domain names did not accurately and prominently disclose the absence of relationship between the Complainant and the Respondent. Instead, the mentions, merely including the Complainant's trademark and descriptive terms, were displayed at the bottom of the website. Such display infers affiliation with the Complainant and the FRANKE trademark in Internet users' mind and make them believe that the disputed domain names and the corresponding website are directly connected to the Complainant and the Franke group.

(iii) The disputed domain names were registered and are being used in bad faith. (Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

The Respondent registered the disputed domain names many years after the first registrations of the Complainant's widely known FRANKE trademark. Moreover, the Franke group has a strong presence online via its official website and on social medias. By conducting a simple search online on popular search engines regarding the term "FRANKE", the Respondent would have inevitably learnt about the Complainant, its trademark and business.

Furthermore, the registration of the disputed domain names aims at creating a direct association with the Franke group, the Complainant's FRANKE trademark as well as its domain name <franke.com>. The structure of the disputed domain names shows that the Respondent registered it having the Complainant and its FRANKE trademark in mind. It reflects the Respondent's clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant's trademark in Internet users'

mind. By reading the disputed domain names, the Internet users may believe that they are directly connected to or authorized by the Complainant. The Respondent registered the disputed domain names to take advantage of the Complainant's widely known trademark.

Furthermore, the disputed domain names resolved to websites repeatedly quoting the Complainant's FRANKE trademark. It further shows that, at the time of the registration of the disputed domain names, the Respondent acquired them very likely with the intent to later use them in connection to the FRANKE trademark.

Use of the disputed domain names creates a likelihood of confusion in Internet users' mind and may lead them to attempt contacting the person operating the websites to purchase services. Thus, the use of the disputed domain names might have generated revenues for the Respondent. Such gain would be unfairly obtained: the Respondent may sell services or products, unrelated to FRANKE products and services, by capitalizing on the fame of the Complainant and its FRANKE trademark. It shows that the Respondent registered and uses the disputed domain names primarily with the intention of attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of such website.

Therefore, the Complainant requests the disputed domain names to be cancelled.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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

The Complainant requested the consolidation of the multiple domain name disputes on the following grounds:

- The disputed domain names were successively registered at close dates between November 22 to 24, 2023.
- The disputed domain names show similarity in their structure and spelling.
- The disputed domain names have the same IP address and have been registered before the same Registrar and have the same Hosting provider.
- The Respondent has regarding each disputed domain names actively concealed its identity in the WhoIs records by using a privacy shield.
- The Respondent has used the disputed domain names in a highly similar fashion.

According to the paragraph 10(e) of the Rules of UDRP Policy "a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules". According to Paragraph 3(c) of the UDRP Rules states that: "The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder".

According to Registrar, the registrant of all disputed domain names is the same person and the consolidation of all disputed domain names into one consolidated dispute is therefore allowed.

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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
2. The respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

1) Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the numerous FRANKE trademark registrations, first of them registered since 1972. The disputed domain names were registered between November 22 and November 24, 2023, i.e. more than 50 years after the first of the FRANKE trademark registration.

All the disputed domain names contain the term “FRANKE” which is the only word or word element of the Complainant’s trademarks. All the disputed domain names furthermore contain the word “RICAMBI” which is the generic term with the meaning “SPARE PARTS” in English and this term is thus connected to the Complainant’s business. Two of the disputed domain names contain the term “IT” which could be understand as the abbreviation for Italy, the country of residence of the Respondent and the country where the Complainant provides his goods and services.

The addition of the generic term (RICAMBI) or geographic term (IT) does not change the overall impression of the designation as being connected to the Complainant and its trademarks and use of this generic and descriptive terms more likely strengthens the likelihood of confusion between the disputed domain names and Complainant’s trademark. Furthermore, the addition of the generic top-level domain (.COM or .CLOUD) does not change the overall impression of the designation as being connected to Complainant’s trademarks.

Therefore, the Complainant has, to the satisfaction of the Panel, shown the disputed domain names are confusingly similar to the Complainant’s trademarks “FRANKE” in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

2) Rights or Legitimate Interests

As stated in the WIPO Jurisprudential Overview 3.0 at Section 2.1, while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain names.

There is no available evidence that the Respondent is engaged in, or have engaged in any activity or work, i.e. legitimate or fair use of the disputed domain names, that demonstrates a legitimate interest in the disputed domain names. Moreover, the disputed domain names resolve to an inactive website and at the time of the filling of the complaint, the disputed domain names resolved to a website similar to the official Complainant’s website presentation.

There is further no evidence, that the Respondent is known by the disputed domain names or that it has a legitimate interest over the disputed domain names. It has not been proved by the Respondent that he has rights or legitimate interests in the disputed domain names or the Respondent is related with the Complainant. Neither license nor authorization has been proven to be granted to the Respondent to make any use of the Complainant’s trademark or apply for registration of the disputed domain names.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain names within the meaning of paragraph 4(a)(ii) of the Policy.

3) Registered and Used in Bad Faith

The Respondent has registered the disputed domain names which consist of the entire Complainant’s trademark “FRANKE” and generic or geographical terms “RICAMBI” and “IT”. It is inconceivable that the Respondent would have come up with a domain name consisting of the terms “FRANKE RICAMBI” without having prior knowledge of the Complainant, its trademarks, products and services. On the balance of probabilities, it is evident that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence and scope of the Complainant's trademark at the time of registration and use of the disputed domain names.

Therefore, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site by creating a likelihood of confusion with the Complainant’s (Paragraph 4(b)(iv) of the Policy).

The Complainant has established the fact, that the disputed domain names create direct association to the Complainant and is therefore capable of creating a likelihood of confusion of the internet users. The registration and usage of the disputed domain names could therefore potentially harm Complainant’s business.

Moreover, the Respondent have engaged in registering the domain names confusingly similar to the Complainant's trademark already, as follows from the decision CAC-UDRP-105842 (Franke Technology and Trademark Ltd v. Raffaele Cicino) related to domain names <spare-parts-franke.com>, <franke-spare-parts.com>, <franke.cloud>, <franke-ricambi.com>, <ricambifranke.com>, <frankericambi.cloud>, <ricambifranke.cloud>, <ricambi-franke-cappe.cloud>, <ricambifranke-forni.cloud>, <ricambi-franke-frigoriferi.cloud>, <ricambi-franke-lavastoviglie.cloud>, <ricambifranke-lavelli.cloud>, <ricambi-franke-miscelatori.cloud> and <ricambi-franke-pianidicottura.cloud>.

Considering the confusing similarity between the Complainant's trademarks and the disputed domain names, long time between the registration of the Complainant's trademarks and the disputed domain names, resolving of the disputed domain names to an inactive (or non-functional) webpage (or previously to a webpage clearly copying or mimicking the Complainant's own webpage), distinctiveness of the Complainant's trademarks and theirs worldwide reputation and failure to submit a response in the UDRP proceedings and to provide any evidence of good faith use, the Panel finds that 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.

The Panel finally considers that the Complainant has shown that the disputed domain names <franke-<ricambi.cloud>, <ricambi-franke.cloud>, <ricambifranke.com>, <frankericambi.com>, <franke-ricambi-it.com> and <ricambi-franke-it.com> are confusingly similar to the trademarks in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain names and the disputed domain names have been registered and are being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **franke-ricambi.cloud**: Cancelled
2. **ricambi-franke.cloud**: Cancelled
3. **ricambifranke.com**: Cancelled
4. **frankericambi.com**: Cancelled
5. **franke-ricambi-it.com**: Cancelled
6. **ricambi-franke-it.com**: Cancelled

PANELLISTS

Name	**Petr Hostaš**

DATE OF PANEL DECISION 2024-02-29

Publish the Decision