Decision for dispute CAC-UDRP-106581

Case number	CAC-UDRP-106581
Time of filing	2024-06-24 11:07:38
Domain names	amarogiuliani.com

Case administrator

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

Complainant

Organization	Giuliani S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Name	Giammario Villa

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks “AMARO GIULIANI”:

European Union Registration n. 018211571, registered on July 30, 2020;

European Union Registration n. 9905373, registered on September 23, 2011;

International Registration n. 219120, registered on April 17, 1959 and duly renewed.

FACTUAL BACKGROUND

The Complainant is an Italian pharmaceutical company that has been developing products in various pharmaceutical fields for over 130 years.

In 1937 the company became a real pharmaceutical company, with the name “Stabilimento Farmaceutico Chimico-biologico Dott. A&M Giuliani”: the manufacturing of Giliani’s products moves from Milan’s Lazzaretto Area to via Pelagio Palagi, still the company headquarters today.

The Complainant's company is now in its fourth generation.

Nowadays, the Complainant has almost 101 employees and a turnover of approximately 181 million euros in 2021.

The Complainant's products are distributed by most Italian pharmacies, but also online and in other international markets. In addition, the Complainant sells its products in all countries of the world also through other marketplaces such as Amazon or Ebay.

Moreover, the Complainant is owner of several top-level and country code top-level domain names, constituted by the verbal elements "Giuliani", among which we cite: <giulianipharma.com>, registered since 1999 and used as main web site of the Complainant and also of the domain names <amaro-giuliani.com>, <amaro-giuliani.it>, <amarogiuliani.it>, <gastrogiuliani.it> and <gastrogiuliani.com>, those last two dedicated specifically to Amaro Giuliani.

The disputed domain name <amarogiuliani.com> has been registered on April 26, 2011 by Mr. Giammario Villa, an Italian individual based in the United States: not only Giammario Villa is an Italian name, but it's also possible confirm the identity of Mr Villa from a research on social networks, it's evident that G. Villa is Italian and lives in Los Angeles where he works as a Master Taster, Wine & Food Educator, Public Speaker and Author.

The disputed domain name is currently not redirected to an active page; moreover, it is set up with active MX records, indicating that it is used to send and receive e-mails.

PARTIES CONTENTIONS

COMPLAINANT:

A) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

Under the first UDRP element, the direct comparison between the disputed domain name and the textual components of the cited trademarks makes it clear that the "AMARO GIULIANI" trademark is recognizable within the disputed domain name. The disputed domain name is in fact identical to the trademarks over which the Complainant has rights, since it incorporates the entire trademark without any difference.

While each case is judged on its own merits, in UDRP cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark under the first element of the Policy.

Comparing the disputed domain name with the "AMARO GIULIANI" trademark, it is clear that they are identical as there is no difference, nor have any changes or additions been made to the Complainant's trademarks.

There is a risk of confusion for those searching for "amarogiuliani" on the web but also for the possible creation of an email box by the Complainant who intends to use his own trademark.

Hence, the first requirement under para. 4 (a)(i) of the Policy and of para. 3(b), (viii), (b)(ix)(1) of the Rules is satisfied.

B) The Respondent has no rights or legitimate interests in respect of the disputed domain name

According to paragraph 4(a) of the Policy, the burden of proving the absence of the Respondent's rights or legitimate interests in respect of the disputed domain name lies with the Complainant.

It is nevertheless a well-settled principle that satisfying this burden is unduly onerous, since proving a negative fact is logically less feasible than establishing a positive. Accordingly, it is sufficient for complainant to produce a prima facie evidence in order to shift the burden of production to respondent.

The Respondent is Mr. Giammario Villa probably an Italian individual (as evident from the name) based in the United States.

The Complainant denies that the Respondent could have any right or legitimate interest in registering the disputed domain name. In particular, the Complainant's internal policies exclude that any commercial partner is authorized to register and use "AMARO GIULIANI" as domain name.

Moreover, as indicated in that factual part, Giammario Villa is active in the alcohol and beverage sector: it's therefore clear that Giammario Villa could not ignore the existence of the well-known bitter and trademark "AMARO GIULIANI".

Furthermore, it is very improbable that the Respondent could be commonly known as "AMARO GIULIANI", considering that "AMARO GIULIANI" is a trademark known only in relation to the Giuliani company which has been producing the aforementioned amaro for over 130 years.

In light of those considerations, the Complainant excludes that the Respondent is commonly known by the disputed domain name under Art. 4(c)(ii) of the Policy.

Further, the disputed domain name is currently inactive; the disputed domain name is not used in connection with a bona fide

offering of goods, and services nor the Respondent is using it in a legitimate non-commercial or fair manner.

The disputed domain name is not redirected to an active website and it is set up to send email, therefore indicating a high risk that it is registered to be involved in phishing activities. Such use of a domain name is clearly not a bona fide, legitimate or fair use under the UDRP Policy.

The fact that “AMARO GIULIANI” is a fanciful combination of words, strengthens the circumstance that the disputed domain name was registered for the sole scope of misleading potential consumers, to tarnish the Complainant’s trademark and to prevent the Complainant from reflecting its trademark in a corresponding domain name.

All above considered, the Complainant deems to have sufficiently proved the absence of rights or legitimate interests in the disputed domain name.

C) The disputed domain name was registered and used in bad faith

As far as registration in bad faith is concerned, the Respondent registered domain name contains a known third party’s trademark without authorization.

As mentioned before, G. Villa is active in the alcoholic and beverage sector, so it is certainly not possible that he was not aware of the well-known “Amaro Giuliani” trademark.

The Respondent could not ignore the existence of the “AMARO GIULIANI” trademark (referring to that specific bitter) at the time of the registration of the disputed domain name.

Moreover, as mentioned, “AMARO GIULIANI” is a well-known trademark (particularly in Italy) and “AMARO GIULIANI” is also a fanciful combination of words, therefore it is not conceivable a use of the disputed domain name not related to the Complainant’s activities and above all unauthorized.

This assumption is further proved by the fact that there are not differences between the disputed domain name and “AMARO GIULIANI”.

The fact that the disputed domain name contains entirely the Complainant's trademark must be considered an indication of registration in bad faith.

Furthermore, the disputed domain name has been registered long after the filing/registration of the Complainant’s trademarks.

As far as use in bad faith is concerned, the Complainant notes that the Respondent passively holds the disputed domain name. Previous panelists recognized that passive holding of a domain name can, in certain circumstances, constitute use in bad faith.

Moreover, the Panel noted that the question as to which circumstances of “passive holding” may constitute use in bad faith could not be answered in the abstract. This question may only be determined because of the particular facts of each case. One should give close attention to all the circumstances of the Respondent's behavior and a remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith. With this approach in mind, the Complainant points out the following circumstances as material to determine the Respondent’s bad faith in the use of the disputed domain name:

(i) the Complainant's mark is highly distinctive and widely known;

(ii) “AMARO GIULIANI” is an imaginative combination of words, closely related to the Complainant's activity (i.e. it is the name of the well-known medicinal amaro). Consequently, it is difficult to conceive of a use of the disputed domain name that does not infringe the Complainant's rights;

(iii) the disputed domain name is not used and, to the best of the Complainant's knowledge, has never been used;

(iv) the contact details of the Respondent are obscured. Previous panels considered this circumstance as an indication of bad faith in combination with other elements.

v) the disputed domain name is not redirected to an active website and it is set up to send e-mail, therefore indicating a high risk that it is registered to be involved in phishing activities.

The Complainant requests that the disputed domain name be transferred to the Complainant.

RESPONDENT

No administratively compliant Response was filed.

RIGHTS

RIGHTS

To the satisfaction of the Panel, the Complainant has shown that the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has 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

To the satisfaction of the Panel, the Complainant has 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 have been met, and there is no other reason why it would be unsuitable for providing the Decision.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or Confusingly Similar

First, the Panel is satisfied that the Complainant has shown it owns rights in the "AMARO GIULIANI" trademarks, with registration and evidence provided dating the trademark registration back to 1959.

Turning to analyze if there is a confusing similarity between the disputed domain name and the trademark. The disputed domain name reproduces the trademark in its entirety, namely "AMARO GIULIANI", with the only difference being that there is no space between the two elements of the trademark. This slight difference, which can be attributed to the technical nature of domain names, is immaterial and, therefore, insufficient to dispel the confusing similarity between the trademark and the disputed domain name.

Consequently, the Panel determines that the Complaint has satisfied the Policy's first element set under paragraph 4(a)(i).

2. Rights or Legitimate Interests

Based on the evidence on record and acknowledging that the Respondent failed to produce any allegations or evidence necessary to demonstrate its rights or legitimate interests in the disputed domain name, the Panel must turn to the uncontested facts.

The uncontested facts indicate that a) the Respondent is not commonly known by the disputed domain name; b) the Respondent is not related to the Complainant; c) the Respondent is not authorized to carry out any business activity for the Complainant; d) the Respondent has no license or authorization to use the trademarks; e) the disputed domain name is inactive; and f) the disputed domain name appears to have active MX records for e-mail capabilities.

Based on the above, the record at hand, and on the balance of probability, and considering that the Respondent has failed to respond to the Complainant's contentions, the Respondent has consequently not rebutted the prima facie case, as described in paragraph 2.1 of WIPO 3.0 Overview.

The above fact pattern on the balance of probabilities, indicates, if nothing else, a likely intention of confusing Internet users with a likely implied association with the Complainant through appearing to be a formal channel of the Complainant, as it reproduces the entirety of the Complainant’s trademark.

The evidence on record leads the Panel to conclude that the Respondent did not have rights or legitimate interests in the disputed domain name.

Consequently, the Panel determines that the Respondent has no rights or legitimate interests in the disputed domain name. Subsequently, the Complainant has fulfilled the second requirement set under paragraph 4(a)(ii) of the Policy.

3. Registered and Used in Bad Faith

Per the record and evidence, the Panel finds that the Respondent was likely aware of the Complainant and had the Complainant's trademark in mind when registering the disputed domain name. This is further reinforced by the fact that the "AMARO GIULIANI" trademark predates the registration of the disputed domain name as well as the global reputation of the "AMARO GIULIANI" mark indicates that the Respondent knew or should have known about the Complainant's rights when registering the disputed domain name. The Panel also notes that this is conclusion is not affected by the disputed domain name having been registered since 2011.

Additionally, this conclusion is supported by the fact that the Respondent seems to have active MX records with the capability to use e-mail service associated to the disputed domain name, which could indicate the potential for phishing appearing as a formal channel of the Complainant, especially bearing in mind that the disputed domain name reproduces the disputed domain name in its entirety. Without any visible explanation in disputed domain name regarding its association to the Complainant, and taking into account that the disputed domain is inactive, notwithstanding it has been registered since 2011, as well as considering that the Respondent appears to be active on social media, the Panel is left with no other option than to consider the conclusion that the Respondent, appears to misrepresent a link between the disputed domain name and the Complainant. In the case at hand, as the record supports, the Respondent appears to have targeted the Complainant on the balance of probabilities.

All the preceding analysis leaves the Panel no other option than to conclude that the most likely intention of the Respondent was to intentionally attempt to attract, for commercial gain, Internet users to its website/disputed domain name by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and/or disputed domain name, as per illustrated under paragraph 3.1 of WIPO 3.0 Overview.

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

4. Decision

For the preceding reasons and in concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **amarogiuliani.com**: Transferred

PANELLISTS

Name	**Rodolfo Rivas Rea**

DATE OF PANEL DECISION 2024-07-24

Publish the Decision