Decision for dispute CAC-UDRP-107015

Case number	CAC-UDRP-107015
Time of filing	2024-11-04 15:07:42
Domain names	southdadelamborghini.com

Case administrator

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

Complainant

Organization	Automobili Lamborghini S.p.A.

Complainant representative

Organization	HK2 Rechtsanwälte

Respondent

Name	Thomas Roman

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 <southdadelamborghini.com>.

IDENTIFICATION OF RIGHTS

The Complainant owns several national trademarks and international registrations for “Lamborghini” in numerous territories around the world, well identified in the Complaint.

The Complainant enjoys a high degree of renown worldwide. The Complainant’s group promotes Lamborghini cars in different languages worldwide on the internet, inter alia at www.lamborghini.com. Authorized dealers of the Complainant promote Lamborghini cars worldwide also via authorized additional websites with accordingly licensed trademark uses targeting specific local markets, e.g. under https://www.lamborghinisouthdade.com.

FACTUAL BACKGROUND

The Complainant – commonly referred to as Lamborghini – is an Italian manufacturer of high- performance sports cars based in Sant'Agata Bolognese, Italy. The company was founded in 1963 by Ferruccio Lamborghini as Automobili Ferruccio Lamborghini. The vehicles of the Complainant belong to the world’s most famous luxury sports cars.

The disputed domain name <southdadelamborghini.com> was registered on February 27, 2024.

PARTIES CONTENTIONS

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

COMPLAINANT:

• The disputed domain name is identical or confusingly similar to the protected mark

According to the Complainant, the disputed domain name <southdadelamborghini.com> is confusingly similar to Complainant´s Lamborghini trademarks.

The disputed domain name consists of two elements i) the geographical prefix “southdade”, referring to a region in the southern Miami-Dade County in Florida; and ii) the Complainant’s well-known trademark Lamborghini.

The disputed domain name incorporates the entirety of the Lamborghini trademark. According to the Complainant, it has long been established under numerous UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms (whether geographical, descriptive, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element of the Policy (see WIPO Overview 3.0, Question 1.8).

The prefix “southdade” does not distinguish the disputed domain name from the Complainant’s trademarks. To the contrary, Internet users would expect goods and services related to Lamborghini cars of Lamborghini itself in the South Date region of Miami-Dade county. Internet users therefore will expect a website that is either operated or at least consented to by the Complainant, like the website lamborghinisouthdade.com run by an authorized dealer of the Complainant.

Also, the addition of the generic Top-Level Domains (gTLD) ".com" does not add any distinctiveness to the disputed domain name.

Therefore, the Complainant argues that the disputed domain name is confusingly similar to the Complainant's Lamborghini trademark within the meaning of Paragraph 4(a)(i) of the Policy.

• Respondent does not have any rights or legitimate interest in the disputed domain name

According to the Complainant, the disputed domain name is not being used in connection with a bona fide offering of goods or services. The disputed domain name resolves to a website which displays a generic racing car, the title “South Dade Lamborghini” and a Subscribe option. According to its footer, this website is run by “South Dade Lamborghini”. Nowhere on the parking page-similar website does the Respondent accurately and prominently discloses the registrant’s (non-existing) relationship with the Complainant.

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has any interest in the disputed domain name.

The Complainant also concludes that it has not found any evidence that the Respondent has made any known legitimate, non-commercial use of the disputed domain name.

Therefore, the Complainant contends that the Respondent has no right nor legitimate interest in respect of the disputed domain name, within the meaning of the Paragraphs 4(a)(ii) and (4)(c) of the Policy.

• The disputed domain name has been registered and is being used in bad faith

The Complainant argues that by using the disputed domain name the Respondent intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website.

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the trademark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith pursuant to paragraph 4(b)(iv) (section 3.1.4, WIPO Overview 3.0).

According to the Complainant, the disputed domain name further endorses an assumption of affiliation between the Complainant and the disputed domain name. The disputed domain name is designed to imply that there is an affiliation between Complainant and the business “Lamborghini South Dade” even though no such affiliation exists. Consequently, the disputed domain name is likely to confuse consumers to believe that it is connected to the Complainant.

The Complainant has also contacted the Respondent for an asking price via the anonymizing broker service of domain provider GoDaddy. The Respondent offered an asking price of USD 15,000 for the disputed domain name, by far exceeding its out of pocket-costs for the registration. The Complainant concludes that this conduct shows that the Respondent registered the disputed domain name with the intent of selling it for profit by exploiting the Complainant’s goodwill in his trademarks.

In addition, the Complainant’s use of its trademarks and business activities as a world-famous car manufacturer predates the registration of the disputed domain name by decades. According to the Complainant, the Respondent had actual knowledge of the Complainant´s trademarks when acquiring the disputed domain name, taking into account that the Respondent offered the disputed

domain name for sale directly to Complainant.

Finally, the Complainant provides that the disputed domain name does not resolve to an active website – the non- use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding (section 3.3 WIPO Jurisprudential Overview 3.0). In this case passive holding infers bad faith registration and use since the Complainant´s trademarks are (i) very distinctive and of strong reputation, and (ii) the disputed domain name cannot be used in good faith.

Therefore, the Complainant contends that the Respondent has registered and used the disputed domain name in bad faith and its conduct falls within the meaning of Paragraph 4(a)(iii) of the Policy.

In conclusion, the Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that 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) The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights

The Panel is satisfied that the Complainant is the owner of trademark registrations for Lamborghini that predate the registration of the disputed domain name.

The disputed domain name is comprised of the Complainant’s well-known trademark Lamborghini with the addition of the prefix "southdade". Essentially, the Respondent has appropriated the trademark Lamborghini by adding a geographical prefix "southdade" to presumably lead consumers to believe that it is affiliated with the Complainant and its business activities. Previous UDRP panels have found that the fact that a domain name wholly incorporates a complainant’s registered mark is sufficient to establish identity

or confusing similarity for the purposes of the Policy (see, e.g., Oki Data Americas Inc. v ASD, Inc., WIPO Case No. D2001-0903).

The disputed domain name consists of two elements i) the geographical prefix “southdade”, referring to a region in the southern Miami-Dade County in Florida; and ii) the Complainant’s well-known trademark Lamborghini. In Panel's view, the Respondent must have been aware of the Complainant’s marks prior to the acquisition of the disputed domain name since the Complainant operates via authorized dealers promoting the Lamborghini mark in the local markets. When entering the terms Lamborgini plus “southdade” in the Google search engine, the returned results point to the Complainant and its authorized dealers, as in this case under https://www.lamborghinisouthdade.com.

Further, the disputed domain name not only fully incorporates the Lamborghini trademark but also includes a purely generic top-level domain (“gTLD”) “com”. Previous UDRP panels have also held that the gTLD “.com” is not to be taken into account when assessing whether a domain name is identical or confusingly similar to a trademark. See e.g., Wiluna Holdings, LLC v. Edna Sherman, FA 1652781 (Forum 22 January 2016).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark Lamborghini.

2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the term Lamborgini as part of the disputed domain name. The Respondent is not in any way affiliated with the Complainant nor is it authorized to register the disputed domain name. The Panel believes that the Respondent is not commonly known by the disputed domain name or that it has legitimate interest over the disputed domain name. When entering the terms Lamborgini plus “southdade” in the Google search engine, the returned results point to the Complainant and its authorized dealers.

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In particular, the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant’s trademark for its commercial activities.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith

The Panel agrees with the Complainant that its trademark enjoys a high degree of renown worldwide. The Complainant’s well-known trademark Lamborgini significantly predates the registration of the disputed domain name. The Panel finds that there appears no reason why the Respondent would register the Complainant's trademark as part of the disputed domain name, other than to create the impression that it is connected to the Complainant's business activities. Given the distinctiveness of the Complainant's trademark worldwide and its strong online presence, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's well-known trademark Lamborgini. The Complainant’s use and registration of the trademark Lamborgini significantly precede the registration date of the disputed domain name. The fact that the Respondent has registered a domain name that includes the term Lamborgini with the addition of the geographical prefix "southdade", and despite the addition of the gTLD “.COM”, clearly indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name. It is reasonable to conclude that this is evidence of registration of the domain name in bad faith.

In fact, the use of the prefix “southdade”, referring to a region in the southern Miami-Dade County in Florida in connection with the Lamborgini trademark rather strengthens the impression that the disputed domain name is in some way connected to the Complainant or its authorized dealers, and at least the Respondent may be seen to free ride on the reputation of the Complainant and its name and trademark Lamborgini.

In addition, the Panel notes that the Respondent's attempt to resell the disputed domain name for a sum of USD 15,000 exceeding by far its out of pocket-costs for the registration of the disputed domain name likely indicates evidence of the Respondent's bad faith and unlikely constitutes good faith of use of the disputed domain name.

Further, the disputed domain name redirects to an inactive look-alike page. According to the Panel, a passive holding of the disputed domain name may amount to bad faith when it is difficult to imagine any plausible future active use of the disputed domain name by the Respondent that would be legitimate and not infringing the Complainant’s well-known mark or unfair competition and consumer protection legislation (See Inter-IKEA v Polanski, WIPO Case No. D2000 1614; Inter-IKEA Systems B.V. v. Hoon Huh, WIPO Case No. D2000 0438; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). Countless UDRP decisions also confirmed that the passive holding of a domain name with the knowledge that the domain name infringes another party’s trademark rights is evidence of bad faith registration and use (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

In summary, taking into account circumstances of this case, specifically i) the distinctiveness of the Lamborghini mark, ii) the Respondent's likely knowledge of the Complainant's rights, iii) the fact that the disputed domain name is passively held and redirects to an inactive look-alike page with no legitimate use, especially if the Respondent had knowledge of the Complainant's trademark rights and iv) the high asking price exceeding by far the Respondent's out of pocket-costs for the registration of the disputed domain name in Panel's view indicates registration and use of the disputed domain name in bad faith.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy, which is that the Respondent's registration and use of the disputed domain name is in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **southdadelamborghini.com**: Transferred

PANELLISTS

Name	**Barbora Donathová**

DATE OF PANEL DECISION 2024-12-04

Publish the Decision