

Decision for dispute CAC-UDRP-107024

Case number	CAC-UDRP-107024
Time of filing	2024-11-06 09:35:11
Domain names	lamborghini-latinoamerica.com

Case administrator

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

Complainant

Organization	Automobili Lamborghini S.p.A.
--------------	-------------------------------

Complainant representative

Organization	Nctm Studio Legale
--------------	--------------------

Respondent

Name	Vasilij
------	---------

OTHER LEGAL PROCEEDINGS

Regarding other legal proceedings between the parties, the Complainant claims that the Respondent's real identity is Automóviles Lamborghini Latinoamerica S.A. de C.V and/or its legal representative Mr. Jorge Antonio Fernández García. The Complainant shows to have a vast contentious history with Automóviles Lamborghini Latinoamerica S.A.

The Complainant states inter alia that "Automóviles has, from time to time, attempted to obtain trademark registrations for the sign "Lamborghini"; such trademark applications for registration have been promptly and successfully opposed by the Complainant.

IDENTIFICATION OF RIGHTS

The Complainant is the holder of several trademarks including:

- European Union word mark LAMBORGHINI registered under No. 001098383 on June 21, 2000, in classes 7, 9, 12, 14, 16, 18, 25, 27, 28, 36, 37 and 41;
- European Union word mark AUTOMOBILI LAMBORGHINI registered under No. 001100221 on July 11, 2000, in classes 3, 7, 9, 12, 14, 16, 18, 20, 21, 25, 27, 28, 34, 36, 37 and 41;
- International word mark "LAMBORGHINI" registered under No. 444261 on March 15, 1979, in classes 3, 9, 14, 16, 18 and 25;
- Mexican word mark LAMBORGHINI registered under No. 1069751 on October 30, 2008, in class 28.

FACTUAL BACKGROUND

The Complainant, Automobili Lamborghini S.p.A., is an Italian manufacturer of high-performance sports cars, founded in 1963.

The Complainant is the owner of several LAMBORGHINI trademarks, including the international word mark LAMBORGHINI registered under No. 444261 registered on March 15, 1979 in classes 3, 9, 14, 16, 18, 25.

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

The disputed domain name has been registered on October 10, 2022. The disputed domain name currently resolves to a website displaying the LAMBORGHINI trademark, sport cars, merchandising, and text about cars, casino, artificial intelligence and blockchain.

PARTIES CONTENTIONS

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

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

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
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.

The Panel has therefore dealt with each of these requirements in turn.

1. Identity of confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant shows to be the holder of several registered LAMBORGHINI trademarks, it is established that there is a trademark in which the Complainant has rights.

The disputed domain name incorporates the Complainant's LAMBORGHINI trademark in its entirety, merely adding a hyphen and the term "latinoamerica". In the Panel's view, this addition does not prevent the Complainant's trademark from being recognizable within the disputed domain name (see section 1.8 WIPO Overview 3.0; *IM PRODUCTION v. Xue Han*, CAC Case No. 104877 <isabel-marantus.com>).

Additionally, it is well established that the Top-Level Domains ("TLDs") such as ".com" may be disregarded when considering whether the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (see section 1.11 WIPO Overview 3.0).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of production to the Respondent (although the burden of proof always remains on the Complainant) (see section 2.1 WIPO Overview 3.0 and *Champion Innovations, Ltd. V. Udo Dussling* (45FHH), WIPO case No. D2005-1094; *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO case No. D2003-0455; *Belupo d.d. v. WACHEM d.o.o.*, WIPO case No. 2004-0110).

The Panel notes that the Respondent has not shown to be commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is known as "Vasilij".

The Complainant's claims that the Respondent's real identity is Automóviles Lamborghini Latinoamerica S.A. As the disputed domain name resolves to a website promoting Automóviles Lamborghini Latinoamerica S.A., the Panel finds it very likely that the Respondent is at least related to this entity.

The Respondent states on its website that "Our rights were acquired from Automobili Lamborghini S.p.A. Italy in 1995, through international contracts, express authorizations and powers of attorney issued in favour of our company, to operate and exploit them for 99 years. We are authorised to carry out our research and development work autonomously and independently, generating our own designs, models and prototypes with our own technology. We also carry out the manufacture, assembly, distribution, import and export of our vehicles worldwide, including the export of our designs and technology and the sale of this through 'TURNKEY' plants"^[1]. However, the Complainant claims that this statement is false and that there never was any contractual authorization from the Complainant in favour of the company Automóviles Lamborghini Latinoamerica S.A. The Complainant has submitted court documents from proceedings between the parties, which refer to the unlawfulness of the Respondent's actions. Therefore, the Panel, in the overall view of the circumstances of the case and the fact that the Respondent has not contested the Complainant's argument, considers it more likely than not that there never was any contractual authorization from the Complainant in favour of the Respondent to register and/or use the disputed domain name.

Fundamentally, a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner. The correlation between a domain name and the complainant's mark is often central to this inquiry. Generally speaking, UDRP panels have found that where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 WIPO Overview 3.0). The disputed domain name incorporates the Complainant's LAMBORGHINI trademark in its entirety, merely adding the term "latinoamerica". In the Panel's view, this combination may even increase the risk of confusion with the Complainant as it can easily be considered as referring to the South American branch of the Complainant's group. Therefore, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant and cannot constitute fair use.

Beyond looking at the domain name and the nature of any additional terms appended to it, panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the WIPO Overview 3.0).

The Panel observes that the disputed domain name resolves to a website displaying the LAMBORGHINI trademark, sport cars, merchandising and text about cars, casino, artificial intelligence and blockchain. The Panel finds that this does not amount to a bona fide offering of goods or services, or a legitimate noncommercial or fair use of the disputed domain name.

The Panel is aware that the Respondent's prosecution of its various trademark applications for marks corresponding to the disputed domain name is or may be continuing. However, the Panel's position would not necessarily have been any different had the Respondent's marks proceeded to grant, noting that the existence of a respondent trademark does not automatically confer rights or legitimate interests on such respondent. For example, panels have generally declined to find respondent rights or legitimate interests in a domain name on the basis of a corresponding trademark registration where the overall circumstances demonstrate that such trademark was obtained primarily to circumvent the application of the UDRP or otherwise prevent the complainant's

exercise of its rights (see section 2.12.2., WIPO Overview 3.0). Here, the Respondent's acquisition of the disputed domain name and application to register corresponding trademarks is intimately bound up with the Complainant's rights in the LAMBORGHINI trademark, as demonstrated by the direct references to the Complainant on the website associated with the disputed domain name.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name. In light of the above, the Complainant succeeds on the second element of the Policy.

3. Bad faith

The Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (see section 4.2 WIPO Overview 3.0 and e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

As established above, the disputed domain name resolves to a website displaying the LAMBORGHINI trademark, sport cars, and merchandising incorporating the LAMBORGHINI figurative trademarks. In the Panel's view, the circumstances of this case indicate that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark (see section 3.2.4. WIPO Overview 3.0).

Moreover, the Panel finds that the probable link between the Respondent and Automóviles Lamborghini Latinoamerica S.A. indicates a pattern of bad faith conduct of targeting the Complainant's LAMBORGHINI mark. In a similar case involving the Complainant and Automóviles Lamborghini Latinoamerica S.A., the panel found that the latter registered and used 30 domain names incorporating the Complainant's LAMBORGHINI mark in bad faith (see CAC Case No. 105048).

According to the Panel, a respondent's awareness of a complainant and/or a complainant's trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070).

In the instant case, it is undisputable that the Respondent had knowledge of the Complainant's rights in the LAMBORGHINI trademark when it registered the disputed domain name, as:

- the disputed domain name incorporates the Complainant's distinctive and well-known LAMBORGHINI trademark in its entirety and only adds a term that can be related to the Complainant's business;
- some of the Complainant's LAMBORGHINI marks have been registered more than 40 years before the disputed domain name;
- the Respondent appears to have a vast contentious history with the Complainant.

Finally, the Respondent did not formally take part in the administrative proceedings and appears to have provided a false name. According to the Panel, this serves as additional indications of the Respondent's bad faith.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered and is being used in bad faith.

[1] Free translation from the website linked to the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **lamborghini-latinoamerica.com**: Transferred

PANELLISTS

Name	Flip Petillion
------	----------------

DATE OF PANEL DECISION 2024-12-16

Publish the Decision
