

Decision for dispute CAC-UDRP-104580

Case number	CAC-UDRP-104580
Time of filing	2022-05-16 09:25:32
Domain names	BRICOFERPRO.ONLINE, BRICOFERPRO.WEBSITE

Case administrator

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

Organization	Bricofer Group S.p.A.
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Complainant representative

Organization	Perani Pozzi Associati
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Respondent

Name	Pedro Tempera
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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, among others, of the following registrations for the trademark “BRICOFER”:

- International trademark registration n. 1346018 “BRICOFER”, granted on July 21, 2016, in classes 1, 2, 4, 5, 6, 7, 8, 11, 19, 20, 21, 22, 27, 28 and 35;
- EU trademark registration n. 015667744 “BRICOFER”, applied on July 20, 2016, and granted on January 2, 2017, in classes 1, 2, 4, 5, 6, 7, 8, 11, 19, 20, 21, 22, 27, 28 and 35;
- Italian trademark registration n. 302016000075591 “BRICOFER”, filed on July 19, 2016 and granted on December 12, 2017, in connection with classes 1, 2, 4, 5, 6, 7, 8, 11, 19, 20, 21, 22, 27, 28 and 35.

Moreover, the Complainant is also the owner, among the others, of the following domain names bearing the sign “BRICOFER”:

BRICOFER.CLOUD, BRICOFER.COM, BRICOFER.GA, BRICOFER.INFO, BRICOFER.IT, BRICOFER.NET, BRICOFERAPP.IT, BRICOFERBUYDAY.COM, BRICOFERBUYDAY.IT, BRICOFERBUYDAY.NET, BRICOFERLEGNO.IT, BRICOFERONLINE.COM, BRICOFERONLINE.EU, BRICOFERONLINE.IT, BRICOFERONLINE.NET, BRICOFERONLINE.ORG, BRICOFERPORTALE.COM, BRICOFERPORTALE.EU, BRICOFERPORTALE.IT, BRICOFERPORTALE.ORG, BRICOFERPROFESSIONAL.IT, BRICOFERPROMO.IT, BRICOFERSHOP.COM, BRICOFERSHOP.EU, BRICOFERSHOP.IT, BRICOFERSHOP.NET, BRICOFERSHOP.ORG, BRICOFERTUBE.COM, BRICOFERTUBE.EU, BRICOFERTUBE.IT, BRICOFERTV.COM, BRICOFERTV.EU, BRICOFERTV.IT, BRICOFER.SHOP, BRICOFER.STORE, BRICOFER110.IT, BRICOFERFAIDATE.IT, BRICOFERGROUPSPA.COM, BRICOFERGROUPSPA.EU, BRICOFERGROUPSPA.INFO, BRICOFERGROUPSPA.IT, BRICOFERGRUPPO.COM, BRICOFERGRUPPO.IT, BRICOFERS.COM, BRICOFERSERV.COM, BRICOFERSERVIZI.COM and BRICOFERSERVIZI.IT.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is a company specialized in the sale of products and services related to various fields, in particular hardware, tools, carpentry, wood, electricity, lighting, accident prevention, plumbing, faucets, construction, DIY, gardening, garden furniture, air conditioning, heating, housewares, detergents, pet, pet food, paints, colours, curtains, decorating, handles, office and home furnishings, metal shelving, setup, appliances and personal care detergents.

The history of the Complainant began in 1979, with the opening of a small hardware store in Rome and led to the creation of its own distribution network, comprising both directly operated and franchised outlets.

The Complainant has established itself throughout the country (today it boasts 120 stores throughout Italy) and works with leading suppliers in the Italian and international market.

On March 24, 2022 the Respondent registered the domain names <BRICOFERPRO.ONLINE> and <BRICOFERPRO.WEBSITE>.

It is more than obvious that the domain names at issue are identical, or – at least – confusingly similar, to the Complainant's trademark "BRICOFER". The disputed domain names incorporate the BRICOFER trademark adding the descriptive term "pro" (which is a common abbreviation for "professional" and is often used in the Complainant's business sector) which does not avoid the direct perception of the trademark being reproduced in the disputed domain names (see, in this regard, Canva Pty Ltd v. Wu Yu, WIPO Case No. DCO2022-0005 and Government Employees Insurance Company ("GEICO") v. Registration Private, Domains By Proxy, LLC / Nathan Rausch, WIPO Case No. D2021-2550). The Complainant considers that the BRICOFER trademark is recognizable in the disputed domain names, and the ccTLDs ".online" and ".website" are only technical requirement, totally disregarded for the purpose of the analysis of the confusing similarity. It is to be noted that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered identical or confusingly similar to that mark for purposes of the Policy. Furthermore, the applicable TLD in a domain name is considered a standard technical registration requirement and, as such, is generally disregarded under the first element confusing similarity test. See sections 1.7 and 1.11, WIPO Overview 3.0. Accordingly, the Complainant believes that the disputed domain names are confusingly similar to the Complainant's trademark, and that the first element of the Policy under paragraph 4(a)(i) has been fully proved.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

The Respondent has no rights on the disputed domain names, and any use of the trademark "BRICOFER" has to be authorized by the Complainant. Nobody has been authorized or licensed by the Complainant to use the domain names at issue.

The domain names at stake do not correspond to the name of the Respondent and, to the best of our knowledge, the Respondent is not commonly known as “BRICOFERPRO”.

Lastly, the Complainant does not find any fair or non-commercial uses of the domain names at stake.

Therefore, in the Complainant’s view the second element of the Policy under paragraph 4(a)(ii) has been proved.

THE DOMAIN NAMES WERE REGISTERED AND ARE USED IN BAD FAITH

The disputed domain names <BRICOFERPRO.ONLINE> and <BRICOFERPRO.WEBSITE> were registered and are used in bad faith.

The Complainant’s trademark “BRICOFER” is distinctive and well known all around the world. The fact that the Respondent has registered two domain names that are confusingly similar to it indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain names. In addition, if the Respondent had carried out even a basic Google search in respect of the wording “BRICOFER”, the same would have yielded obvious references to the Complainant. The Complainant submits an extract of a Google search in support of its allegation. This raises a clear inference of knowledge of the Complainant’s trademark on the part of the Respondent. Therefore, it is more than likely that the disputed domain names at issue would not have been registered if it were not for Complainant’s trademark. This is a clear evidence of registration of the domain names in bad faith.

In addition, the contested domain names are not used for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the domain names, the Respondent has registered or acquired the domain names primarily for the purpose of selling, renting, or otherwise transferring the domain names registration to the Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain names (par. 4(b)(i) of the Policy).

The disputed domain names are not used for any bone fide offerings, even if they are not connected to any web site, by now. In fact, countless UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party’s trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, and also the panels’ consensus view on this point, as reflected in the “WIPO Overview of WIPO Views on Selected UDRP Questions” at paragraph 3.2.).

In particular, the consensus view of WIPO UDRP panellists is that passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. However, panels have tended to make such findings in circumstances in which, for example, a complainant’s mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the complainant’s trade mark rights.

As regards to the first aspect, the Complainant has already extensively proved the reputation of its trademark. For what concerns the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with 2 domain names which do exactly correspond to the Complainant’s trademark and that result so similar to the Complainant’s domain names currently used by the latter to provide its product and services.

In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain names has to be considered a use in bad faith: «The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant’s legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent’s bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant’s goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent’s bad faith. On the

contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests» (Decision No. D2004-0615, Comerica Inc. v. Horoshiy, Inc.,).

Even excluding other illicit use of the domain names in the present case, anyway the Complainant could find no other possible legitimate use of BRICOFERPRO.ONLINE and BRICOFERPRO.WEBSITE. The sole further aim of the owner of the domain names under consideration might be to resell them to the Complainant, which represents, in any case, an evidence of the registration and use in bad faith, according to par. 4(b)(i) («circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name»).

In the light of the above, the third and final element necessary for finding that the Respondent has engaged in abusive domain names registration and use has been established.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

This is a case of adding a generic term "pro" to a well-established trademark and in respect of the practice that the specific top level of a domain name such as ".online" and "website" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar, the overall conclusion of the Panel is that the disputed domain names in its entirety are confusingly similar to Complainant's trademark BRICOFER.

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).

The Complainant has no business relationship with the Respondent, who does not enjoy any license, partnership or authorization from the Complainant. Furthermore, the actual use of the disputed domain names, which redirect towards a generic landing page, does not demonstrate any use that would indicate a bona fide offering of goods or service attached to the disputed domain names.

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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant's trademark BRICOFER and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain names without prior knowledge of the Complainant and the Complainant's mark. The Panel, therefore, finds that the disputed domain names were registered in bad faith.

The disputed domain names redirect towards a parking page. Whether such use is seen as "active" or "passive" holding, in the context of a well-established trademark such as BRICOFER, doesn't influence on the conclusion of the Panel that the disputed domain names are being used in bad faith.

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 three essential issues under the paragraph 4(a) of the Policy are whether:

- i. the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- ii. the Respondent has no rights or legitimate interests with respect to the disputed domain names; and
- iii. the disputed domain names have been registered and are being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited websites and public information concerning the disputed domain names, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel, therefore, came to the following conclusions:

a) The Complainant states and proves that the disputed domain names are confusingly similar to its trademarks and its domain names. Indeed, the trademark is fully incorporated in the disputed domain names.

The disputed domain names are therefore deemed identical or confusingly similar.

b) The Respondent is not generally known by the disputed domain names and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain names.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain names.

c) It is clear that the Complainant's trademarks and website were used by the Complainant long before the disputed domain names were registered which must have been known by the Respondent. There is no present bona fide use of the disputed domain names.

The Panel therefore finds that the disputed domain names have been registered and are being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied 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. **BRICOFERPRO.ONLINE**: Transferred
 - 2. **BRICOFERPRO.WEBSITE**: Transferred
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PANELLISTS

Name	Lars Karnoe
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DATE OF PANEL DECISION	2022-06-21
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Publish the Decision	
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