

ADMINISTRATIVE PANEL DECISION

ZAMBON S.p.A. v. Alberto Carrascosa
Case No. D2022-4033

1. The Parties

The Complainant is ZAMBON S.p.A., Italy, represented by Studio Barbero, Italy.

The Respondent is Alberto Carrascosa, Colombia.

2. The Domain Name and Registrar

The disputed domain name <zambongroup-es.com> is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 28, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 29, 2022.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on December 2, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a pharmaceutical company and owns a number of registrations for the trademark ZAMBON such as International Trademark Registration No. 509634 registered on January 26, 1987. The trademark ZAMBON was first used in 1906.

The disputed domain name was registered on June 10, 2022 and resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark ZAMBON. The disputed domain name contains the Complainant's trademark ZAMBON in its entirety. The addition of the elements "group", "es" and a hyphen does not eliminate confusing similarity. In fact, combining the Complainant's trademark with the term "group" increases confusion. The generic Top-Level Domain ("gTLD") ".com" is a standard registration requirement.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not authorized by the Complainant to use its trademark nor is it licensed by the Complainant. The Complainant submits that the Respondent is not known by the disputed domain name. There can be no legitimate reason for choosing the Complainant's trademark as it is the family name of the founder. There is no evidence of use of or demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or service. There is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name. The disputed domain name resolved first to a static page and currently resolves to an inactive webpage. This constitutes passive holding. The high risk of implied affiliation cannot constitute fair use under the circumstances. There is an intention to mislead Internet users by creating the impression that the disputed domain name is the Complainant's website for Spain. The Respondent failed to reply to the cease and desist letter.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant's trademark was registered several years before the disputed domain name was registered. The Complainant's trademark is well-known as determined by UDRP panels and is widely used and publicized. The Respondent must have been aware of it. Passive holding as is the case here may indicate bad faith under the circumstances. Additionally, The Respondent failed to reply to the cease and desist letter.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for the trademark ZAMBON. The Panel is satisfied that the Complainant has established its ownership of the trademark ZAMBON. The disputed domain name comprises the Complainant's trademark ZAMBON in its entirety. The term "group" does not prevent the fact that the disputed domain name is confusingly similar to the Complainant's trademark nor do the letters "es".

The gTLD, ".com" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

A complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not authorized by the Complainant to use its trademark. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests.

The absence of a substantive response by the Respondent allows the Panel to draw inferences, and under the circumstances, the absence of a response leaves the Complainant's *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name unrebutted.

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name.

Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered or Used in Bad Faith

The Respondent must have been aware of the Complainant's trademark as the Complainant's trademark is well-known and had been registered for 35 years when the disputed domain name was created. It has been found by prior UDRP panels that the mere registration of a domain name that is identical or confusingly similar to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The disputed domain name resolves to an inactive website. Prior UDRP panels have found that passive holding does not prevent a finding of confusing similarity if the totality of circumstances supports an inference of bad faith. See section 3.3 of the [WIPO Overview 3.0](#). Noting the Respondent's failure to provide any good-faith explanation for his registration and use of the disputed domain name, the well-known nature of the Respondent's trademark, it being the family name of the founder, and the absence of a plausible use of the disputed domain name that would be legitimate (*Johnson & Johnson v. Daniel Wistbacka*, WIPO Case No. [D2017-0709](#)), the Panel finds that the current passive holding of the disputed domain name does not prevent the Panel's bad faith finding.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <zambongroup-es.com> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: December 16, 2022