

ADMINISTRATIVE PANEL DECISION

Zambon S.p.A. v. Mandysen

Case No. D2022-4671

1. The Parties

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

Respondent is Mandysen, Singapore.

2. The Domain Name and Registrar

The disputed domain name <zambons.com> is registered with Realtime Register B.V. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2022. On December 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 7, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on December 15, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on December 19, 2022.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on December 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 9, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on January 10, 2023.

The Center appointed Phillip V. Marano as the sole panelist in this matter on January 19, 2023. 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

Complainant is a multinational pharmaceutical and fine chemical company based in Italy that is present in over eighty-seven countries with nearly three thousand employees throughout the world. Complainant promotes its pharmaceuticals and chemicals through its official <zambonpharma.com> and <zambon.com> domain names and websites. Complainant owns valid and subsisting registrations for the ZAMBON trademark in numerous countries, including the trademark for ZAMBON (European Union Trade Mark No. 010374585, registered March 27, 2012), as well as ZAMBON (Italian Reg. No. 362016000012122, registered March 27, 2017), with earliest priority anywhere dating back to August 1, 1986.

Respondent registered the disputed domain name on June 23, 2022. Prior to this Complaint being filed, the disputed domain name redirected to websites featuring pornographic content. At the time this Complaint was filed, the disputed domain name no longer resolved to any website content.

5. Parties' Contentions

A. Complainant

Complainant asserts ownership of the ZAMBON trademark and has adduced evidence of trademark registrations in numerous countries and regions around the world including in the European Union, with earliest priority dating back to August 1, 1986. The disputed domain name is confusingly similar to Complainant's ZAMBON trademark, according to Complainant, because it incorporates the whole of Complainant's ZAMBON trademark and differs only by the addition of the non-distinctive letter "s" element and the necessarily disregarded ".com" generic Top-Level Domain ("gTLD").

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the lack of any license, permission, or authorization between Complainant and Respondent; the lack of any evidence that Respondent is known by the term "zambons"; the lack of any meaning of the term ZAMBON other than a surname and Complainant's well-known trademark; Respondent's initial use of the disputed domain name to forward to pornographic content; Respondent's subsequent passive holding of the disputed domain name; the fame of the ZAMBON trademark and the risk of implied affiliation; and Respondent's failure to respond to Complainant's cease and desist correspondence.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: Respondent's misappropriation of Complainant's well-known ZAMBON trademark; Respondent's initial use of the disputed domain name to forward to pornographic content; Respondent's subsequent passive holding of the disputed domain name, which wholly incorporates Complainant's well-known ZAMBON trademark; Respondent's failure to respond to Complainant's cease and desist correspondence; and Respondent's pattern of serial cybersquatting as demonstrated by prior decisions against Respondent under the Policy.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. the disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;

- ii. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. the disputed domain name has been registered and is being used in bad faith.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, *e.g.* where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the ZAMBON trademark has been registered in numerous regions and countries around the world with priority dating back to August 1, 1986. Thus, the Panel finds that Complainant's rights in the ZAMBON trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's ZAMBON trademark.

In this Complaint, the disputed domain name is confusingly similar to Complainant's ZAMBON trademark because, disregarding the ".com" gTLD, the entirety of the trademark is contained within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name [...] [I]n 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 confusingly similar [...]"). In regards to gTLDs, such as ".com" in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The combination with the letter "s" does not prevent a finding of confusing similarity between Complainant's ZAMBON and the disputed domain name. [WIPO Overview 3.0](#), section 1.8 (Additional terms "whether descriptive, geographic, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity under the first element); see also *Vorwerk International AG v. Super Privacy Service LTD c/o Dynadot / Roux*, WIPO Case No. [D2021-3874](#) ("The disputed domain name comprises the Complainant's THERMOMIX trade mark in its entirety, preceded by the letter 'o'.") Indeed, the Panel concurs with Complainant that the additional letter "s" does not prevent a finding of confusing similarity between Complainant's ZAMBON trademark and the disputed domain name.

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this case, Respondent fails to

come forward with any relevant evidence rebutting Complainant's *prima facie* case, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1.

It is evident that Respondent, identified by Whois data for the disputed domain name as Mandysen, is not commonly known by the disputed domain name or Complainant's ZAMBON trademark.

Under Section 4(c)(iii) of the Policy, neither legitimate noncommercial use or fair use of the disputed domain name can coexist with "intent for commercial gain to misleadingly divert consumers or to tarnish the complainant's trademark". [WIPO Overview 3.0](#), Section 2.4. No rights or legitimate interests derive from tarnishment of another's trademark by using it to divert Internet users to pornographic websites. See, e.g., *Andrey Ternovskiy dba Chatroulette v. Protection of Private Person / Aleksandr Katkov*, WIPO Case No. [D2017-0381](#) (finding the respondent's use of the domain name <chatroulletelolz.com> to redirect Internet users to pornographic websites "should and could not be considered a *bona fide* offering of goods or services"); *L'Oréal v. Robert Caceres, Dollarviews*, WIPO Case No. [D2015-1200](#) (finding that use of a domain name for a website displaying pornographic videos "does not constitute an example of rights and legitimate interests as per paragraph 4(c) of the Policy"); *Neste Oil Oyj v. Nesin Dmitry / Privacy Protection Service INC*, WIPO Case No. [D2014-0883](#) (noting that "pornographic content of the Respondent's website ought to be regarded as a proof of lacking right or legitimate interest"); *Bayerische Motoren Werke AG v. shilin Li*, WIPO Case No. [D2021-1573](#) (Finding *no bona fide* offering of goods or services or legitimate noncommercial or fair use where "[r]espondent is currently using the disputed domain name on a webpage featuring pornographic and gambling content"). In this Complaint, Complainant has attached screengrab evidence demonstrating that the disputed domain name was configured by Respondent to redirect to websites dedicated to pornographic content.

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent's documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The use of a domain name to tarnish a complainant's trademark, including for commercial purposes in connection with pornographic content, may constitute evidence of a respondent's bad faith. [WIPO Overview 3.0](#), Section 3.12. See *Red Bull GmbH v. Whois Agent, Domain Protection Services, Inc. / esco escortlar, escort sitesi*, WIPO Case No. [D2017-1639](#) (finding the respondent's use of the domain for a pornographic website constituted "a strong indication of bad faith registration and use", because it showed respondent's

main purpose was “to create a likelihood of confusion among customers and/or to tarnish the Complainant’s RED BULL trademark for commercial gain or any other illegitimate benefit”); *Bank of Jerusalem Ltd. v. Shek Cheung Chung*, WIPO Case No. [D2017-1153](#) (finding bad faith where the domain resolved to a website “at which adult content and links to websites at which pornographic content [was] being offered, tarnishing Complainant and its trademark, and for which Respondent [was] likely receiving commercial gain”). Here, it is clear to the Panel that Respondent has misappropriated Complainant’s ZAMBON trademark and configured the disputed domain name to redirect to various websites dedicated to pornographic content.

The Panel further concludes that failure by Respondent to answer Complainant’s cease and desist letter “suggests that Respondent was aware that it has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith”. See *America Online, Inc. v. Antonio R. Diaz*, WIPO Case No. [D2000-1460](#) (internal citations omitted). See also *Spyros Michopoulos S.A. v. John Toliás, ToJo Enterprises*, WIPO Case No. [D2008-1003](#). Furthermore, the failure of Respondent to answer this Complaint or take any part in the present proceedings, in the view of the Panel, is another indication of bad faith on the part of Respondent. See *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#).

Finally, this Complaint presents a quintessential example where Respondent has engaged in a pattern of bad faith registration and use within paragraph 4(b)(ii) of the Policy. [WIPO Overview 3.0](#), section 3.1.2. (“This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner.”) Complainant has cited at least two other cases where Respondent was found to have registered and used domain names in bad faith, all of which resulted in decisions against Respondent. These cases demonstrate that Respondent has repeatedly targeted in bad faith trademarks that have been considered well-known under the Policy, including SODEXO and RED BULL. *Sodexo v. Redacted for Privacy / Mandysen*, WIPO Case No. [D2022-3937](#); *Red Bull GmbH v. Mandysen*, WIPO Case No. [D2022-3517](#). These adverse UDRP decisions against Respondent show that Respondents’ *modus operandi* is to: hide its true identity through anonymous domain name registration services; register domain names incorporating well-known trademarks of others; trade-off the goodwill of those marks for commercial gain by redirecting Internet traffic; and refuse to participate when the rightful trademark owners file complaints under the Policy.

In view of the foregoing, the Panel concludes that Complainant has established the third element 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 <zambons.com> be transferred to Complainant.

/Phillip V. Marano/

Phillip V. Marano

Sole Panelist

Date: February 3, 2023