

ADMINISTRATIVE PANEL DECISION

Bacchetta Foundation v. 1&1 Internet Inc. / Michael Parks
Case No. D2022-0653

1. The Parties

Complainant is Bacchetta Foundation, United States of America (“U.S.”), represented by Hahn Loeser & Parks LLP, U.S.

Respondent is 1&1 Internet Inc., U.S. / Michael Parks, U.S.

2. The Domain Name and Registrar

The disputed domain name <bacchettafoundation.org> (the “Domain Name”) is registered with IONOS SE (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2022. On February 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint.

The Center sent an email to Complainant on March 10, 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 also on March 10, 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 March 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 31, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 1, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on April 4, 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

According to Complainant:

“Complainant is well known throughout the United States as Complainant is engaged in various philanthropic, charitable, and/or grantmaking initiatives and services with a number of charities throughout the United States. Complainant was first formed on June 14, 2011, and, since that time, Complainant has made grants to charities throughout the United States. Complainant is the owner of the “BACCHETTA FOUNDATION” Mark (the “Complainant’s Mark”), and Complainant has made extensive use of Complainant’s Mark since at least as early as June 14, 2011 in connection with, among other things, philanthropic, charitable, and/or grantmaking initiatives and services.

Although Complainant does not own a U.S. federal trademark registration for Complainant’s Mark, Complainant respectfully asserts that Complainant’s Mark has become a distinctive identifier which the relevant public associates with Complainant’s various philanthropic, charitable, and/or grantmaking initiatives and services throughout the United States. Indeed, the duration and nature of use of Complainant’s Mark is extensive. As previously stated, Complainant has used Complainant’s Mark for over ten (10) years throughout the United States. During this time, Complainant has made significant grants and/or donations to approximately one dozen public non-profit organizations totaling approximately \$27.5 million.”

The Domain Name was registered on December 22, 2021. The Domain Name currently does not resolve to a website. As of February 11, 2022, however, the Domain name resolved to a website that purported to be operated by Complainant. The site made extensive use of the BACCHETTA FOUNDATION mark, described the site’s business as providing charitable services, and asked the visitor to make a donation via hyperlink. The site also lists as its street address the physical address of Complainant until December 2021.

According to Complainant, Respondent has not been authorized to register the Domain Name or establish a website on Complainant’s behalf. It appears that Respondent’s website was set up to impersonate Complainant and solicit donations from Internet users who mistakenly believe that they are donating to Complainant’s charitable foundation.

Complainant alleges that Respondent appears to have set up fraudulent websites which impersonate two other charitable foundations, and that these sites have the exact same graphic layout (and even photos) as the site to which the Domain Name resolves.

Respondent has not denied any of the foregoing allegations, and has not questioned any of the evidence presented by Complainant.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has proven all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the unregistered trademark BACCHETTA FOUNDATION through use demonstrated in the record. The fact that Respondent is shown to have been targeting Complainant's mark supports Complainant's assertion that its mark has achieved significance as a source identifier. The Panel also concludes that the Domain Name is identical to that mark.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name. Respondent has not come forward in this proceeding to articulate or prove any legitimate reason for registering the Domain Name, which is identical to Complainant's mark. The undisputed record here shows that Respondent registered the Domain Name with the goal of impersonating Complainant's charitable business and, by means of consumer confusion. Such conduct is manifestly illegitimate.

The Panel concludes that Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the 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 Panel concludes that Respondent has registered and used the Domain Name in bad faith. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section. The Panel concludes that Respondent clearly targeted Complainant when registering the Domain Name, and did so to impersonate Complainant, in violation of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Name <bacchettafoundation.org> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: April 14, 2022