

ADMINISTRATIVE PANEL DECISION

Zambon S.p.A. v. Efrain Juarez

Case No. D2022-2611

1. The Parties

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

The Respondent is Efrain Juarez, United States of America.

2. The Domain Name and Registrar

The disputed domain name <zambongroup.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2022. On July 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 21, 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 July 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 17, 2022.

The Center appointed Knud Wallberg as the sole panelist in this matter on August 30, 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 multinational pharmaceutical company established in 1906 with its headquarter in Italy. The Complainant is the registered owner of numerous registered trademarks worldwide consisting of the name ZAMBON, including International Trademark Registration No. 509634 for ZAMBON (word mark), registered on January 26, 1987, for goods in in class 5 and International Trademark Registration No. 620243 for ZAMBON (word mark), registered on June 20, 1994, for goods in classes 1, 3, 5, 10, 16, 31, and 34. The Complainant also owns various domain names which integrates the ZAMBON trademark and variations of it such as: <zambongroup.com>, <zambonpharma.com>, and <zambon.com>.

The Respondent registered the disputed domain name on July 22, 2021. It does not resolve to an active website.

The Complainant's representative sent a cease-and-desist letter to the Respondent by email, on August 20, 2021, requesting the immediate cease of any use of, and the transfer of the disputed domain name to the Complainant. In absence of a reply, additional reminders were sent by email to the Respondent also via the concerned Registrar, but no reply was received. The Complainant's representative also sent a copy of the letter by registered mail to the Respondent's postal address, but the letter was returned to the sender with a delivery failure notice

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is confusingly similar to the trademark ZAMBON in which the Complainant has rights. The disputed domain name incorporates the whole of the Complainant's ZAMBON trademark and the fact that the disputed domain name differs from the Complainant's trademark by the addition of the non-distinctive elements "r" and "group" does not affect the confusing similarity.

The Complainant further states contends that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use ZAMBON trademark and that that the Complainant is not in possession of, nor aware of, the existence of any evidence demonstrating that the Respondent might be commonly known by a name corresponding to the disputed domain name as an individual, business, or other organization. In addition, there is no any evidence of use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services before or after any notice of the dispute herein, nor is there any evidence that the Respondent has used the disputed domain name in connection with a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

The Complainant finally states that the disputed domain name was registered and is being used in bad faith. In light of the prior registration and extensive use of the Complainant's trademark ZAMBON in connection with the Complainant's products, it is thus inconceivable that the Respondent was unaware of the existence of the Complainant's registered and well-known trademark at the time of registration of the disputed domain name. With respect to bad faith use, the fact that the disputed domain name does not resolve to an active website, is still bad faith use since the concept of "bad faith use" includes not only positive action but also passive holding. As an additional circumstance evidencing bad faith, the Respondent has not replied to the Complainant's cease-and-desist letters, which prior UDRP panels have held can be evidence of bad faith. Finally, before the disputed domain name was suspended by the concerned Registrar, the Respondent had set up MX records for the disputed domain name, meaning that it might be used for email communication which also amounts to bad faith use.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following:

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

Paragraph 4(a) of the Policy states that the burden of proving that all these elements are present lies with the Complainant. At the same time, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules, or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name <zambongroup.com> is confusingly similar (in the sense of the Policy) to the Complainant's registered trademark ZAMBON. The disputed domain name incorporates this mark in its entirety with the addition of the letter "r" and the common word "group". The generic Top-Level Domain ("gTLD") ".com" is a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the conditions in paragraph 4(a)(i) of the Policy are therefore fulfilled in relation to the disputed domain name.

B. Rights or Legitimate Interests

It is clear from the facts of the case that the Complainant has not licensed or otherwise permitted the Respondent to use its trademark and given the circumstances of this case, the Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent has not produced, and there is no evidence of the types of circumstances set out in paragraph 4(c) of the Policy that might give rise to rights or legitimate interests in the disputed domain name on the part of the Respondent in these proceedings.

Consequently, the Panel finds that the condition in paragraph 4(a)(ii) of the Policy is also fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the Complainant to prove both registration and use of the disputed domain name in bad faith. Paragraph 4(b) of the Policy provides examples of circumstances which shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has 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 the respondent's documented out-of-pocket costs

directly related to the domain name; or

- (ii) the 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

Accordingly, for the Complainant to succeed, the Panel must be satisfied that the disputed domain name has been registered and is being used in bad faith.

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant's trademark ZAMBON and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark.

The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name does not currently resolve to an active website. In this case the Complainant has however evidenced that the Respondent had initially set up active MX records connected to the disputed domain name, which enabled the Respondent to send emails using an email address that contains the disputed domain name.

Albeit that there are no concrete examples of such use, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an email address. The Panel notes in this connection that passive holding of a domain name does not prevent a finding of bad faith use under paragraph 4(a)(iii) of the Policy. See section 3.3 of [WIPO Overview 3.0](#) and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Noting that the disputed domain name incorporates the Complainant's distinctive and reputed trademark ZAMBON and the gTLD ".com", that no Response has been filed and that there appears to be no conceivable good faith use that could be made by the Respondent of the disputed domain name, and considering all the facts and evidence of the case, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy are also fulfilled in this case.

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.com> be transferred to the Complainant.

/Knud Wallberg/

Knud Wallberg

Sole Panelist

Date: September 20, 2022