

ADMINISTRATIVE PANEL DECISION

Coordinadora Integral Optica de Servicios Agrupados, S.L v. Michael Mickens, Confluence International
Case No. D2023-4236

1. The Parties

The Complainant is Coordinadora Integral Optica de Servicios Agrupados, S.L, Spain, represented by Elzaburu, Spain.

The Respondent is Michael Mickens, Confluence International, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <cione.com> is registered with Network Solutions, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 11, 2023. On October 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 14, 2023, 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 (Perfect Privacy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 16, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 20, 2023.

The Center verified that the Complaint together with the amended 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 October 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 14, 2023.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on November 28, 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

The Complainant is a cooperative of independent opticians founded in 1973. It does business under the CIONE mark. It has approximately 1,000 members and 1,200 opticians in Spain and Portugal. The Complainant celebrated the fiftieth anniversary of its brand in 2023 with a themed event. According to a media profile dated November 8, 2021, the Complainant distributes more than 800,000 orders per year and provides next-day delivery throughout Spain and Portugal.

The Complainant owns a variety of registered trademarks for the term CIONE on its own and with other terms (referred hereafter as “the CIONE mark”). The Complainant’s earliest such mark appears to be Spanish Registered Trademark No. M1927649 for the combination word and figurative mark C CIONE, registered on December 5, 1995, in Class 5. The Complainant also owns a variety of word marks including Spanish Registered Trademark No. M2552956 for the word mark CIONE 01, registered on January 28, 2004, in Class 5. The portfolio of registered trademarks put forward by the Complainant appears predominantly to cover Spain, with three further marks registered in the European Union between 2022 and 2023.

The disputed domain name was registered on November 26, 1999. Little is known of the Respondent, which has not participated in the administrative proceeding, other than that it lists an organization name of Confluence International with a post office box address of Pennington, New Jersey, United States. There is no website associated with the disputed domain name, although it appears prima facie from the Whois entry that it is used for email, based on the registrant and administrative contact email address. The format of the email address concerned suggests that it is probably used by the Respondent, Michael Mickens, who is also named in the Whois record as the technical contact for the disputed domain name.

On May 12, 2023, the Complainant’s representative issued a cease-and-desist notice to the email address which was associated with the disputed domain name at that time. No reply was received to this message.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the Complainant’s CIONE mark is reproduced in its entirety in the disputed domain name, that the Complainant has been unable to identify any trademark registrations owned by the Respondent that would support the disputed domain name, and that the mere passive holding of a domain name may demonstrate bad faith under the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name, due to the fact that the majority of and most distinctive part of the mark is reproduced therein, being CIONE, absent only the "C" in the first trademark cited or the digits "01" in the second. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Insofar as the first trademark cited is a combination mark, the wording may be severed from the design elements. [WIPO Overview 3.0](#), section 1.10.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

The requirements of paragraph 4(a) of the Policy are conjunctive. A consequence of this is that failure on the part of a complainant to demonstrate one element of the Policy will result in failure of the complaint in its entirety. Accordingly, in light of the Panel's finding in connection with registration and use in bad faith, discussed below, it is unnecessary for the Panel to address the issue of the Respondent's rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The Complainant's submissions do not identify any of these circumstances as present in this case.

On this topic, the Complainant primarily focuses on its submission that the mark CIONE is a relevant and prestigious distinctive sign on the Spanish and Portuguese markets, and that the Complainant has been marketing its products since 1978. The Complainant states that this makes it possible to establish "beyond doubt" that the Respondent acted in bad faith in registering the disputed domain name because it was aware that it was appropriating a name that identifies the Complainant. The Complainant adds that the disputed domain name is not associated with any website and argues that the operation of the doctrine of passive holding indicates a finding of registration and use in bad faith.

The Panel notes that the disputed domain name has been registered since 1999, appears to be used for email, and is not overtly targeting the Complainant in any way. Generally speaking, in order to prove registration in bad faith, the Complainant must show that the Respondent registered the disputed domain name with the Complainant's rights in mind and with intent to target these unfairly. This can be a challenge for a complainant where a longstanding domain name is concerned, as in this case, if it is necessary to adduce evidence of the position as at the date of registration, which may be in the distant past.

In the present case, there is no suggestion that the Respondent acquired the disputed domain name more recently than as at the original registration date, meaning that the Complainant must look back some 24 years to the position in 1999. In that respect, its evidence falls short of establishing registration in bad faith.

Other than the Complainant's assertion of its own presence in the Spanish and Portuguese market since 1978, it is notable that it has provided neither submissions nor evidence supporting the notion of how the Respondent, an entity appearing to be in New Jersey, United States, might have become aware of the Complainant before it registered the disputed domain name on November 26, 1999. No evidence is available on the record regarding the extent or reach of the Complainant's mark at that time, whereby it might be reasonable for the Panel to infer that the disputed domain name was registered in the knowledge of the Complainant's rights. Indeed, there is nothing on the record indicating that the Complainant's mark has been used to any extent beyond the countries of Spain and Portugal, other than the fact that the Complainant's registration of European Union trademarks in 2022 and 2023 may suggest a wider European dimension to its recent operations.

That said, as the panel noted in *Fakir Elektrikli EV Aletleri Diş Ticaret Anonim Şirketi v. Development Services, Telepathy, Inc.*, WIPO Case No. [D2016-0535](#), "the fact that a respondent is in a different jurisdiction than a complainant is something that some people can consider to be of greater significance than it actually is, particularly if the complainant has a significant online presence". The Panel must therefore also ask itself whether the Complainant has provided evidence of any such online presence in 1999 or indeed of any other way in which, on the balance of probabilities, the Respondent registered the disputed domain name with the Complainant or its rights in mind. There is no evidence on the present record that the Complainant maintained an online presence of substance in 1999, or indeed any online presence, which could have come to the Respondent's attention. There is also no evidence of any other way in which the Respondent might or should have known of the Complainant's rights bearing in mind the Parties' geographic separation.

Turning to the use of the disputed domain name, and the Complainant's submission regarding the operation of the passive holding doctrine under the Policy, the Panel refers to section 3.3 of the [WIPO Overview 3.0](#) which notes that while panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying this doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

With regard to factor (i), the Panel notes that the Complainant's mark is distinctive, and the evidence on the record suggests that it is likely to be widely known in Spain and Portugal. However, there is no evidence before the Panel indicating that the Complainant's reputation, and/or its trademark rights, extended to the United States in 1999. With regard to factor (ii), the Respondent has failed to submit a response and has not provided evidence of actual or contemplated good-faith use. Nevertheless, it has not escaped the Panel's notice that the composition of the disputed domain name may be read as representing the initials of the Respondent's entity name, coupled with the word "one". This suggests a possible contemplated good-faith use of the disputed domain name, as does the potential use of the disputed domain name for a corresponding corporate email address, albeit that there is no evidence of any actual use before the Panel. With regard to factor (iii), there is no evidence before the Panel indicating that the Respondent has concealed its identity or provided false contact details. Finally, with regard to factor (iv), in light of the possible composition of the disputed domain name to represent the Respondent's entity name, it cannot be said that the potential good faith use of the disputed domain name would be implausible.

The evidence in the case file as presented does not indicate that the Respondent's aim in registering the disputed domain name was to profit from or exploit the Complainant's trademark.

The Panel finds that the Complainant has not proved on the balance of probabilities that the disputed domain name was registered in the knowledge of the Complainant's rights and/or with intent to target these unfairly. While that might be regarded as the end of the matter, in the totality of the circumstances of the present case, the Panel adds that it does not find bad faith on the basis of the passive holding doctrine as contended by the Complainant.

Based on the available record, the Panel finds the third element of the Policy has not been established.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: December 12, 2023