



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Fall Nummer: D2003-0914

Entscheidung vom 23. Dezember 2003

1. The Parties

The Complainant is Buongiorno ... Italy.

The Respondent is O.G., Nassau, Bahamas.

2. The Domain Name and Registrar

The domain name at issue, <wwwbuongiorno.com>, is registered with OnlineNic, Inc. d/b/a China-Channel.com.

3. Procedural History

The WIPO Arbitration and Mediation Center (the "Center") received the Complaint on November 17, 2003, (electronic version) and on November 20, 2003, (hard copy). On November 18, 2003, the Center transmitted by email to OnlineNic, Inc. d/b/a China-Channel.com a request for registrar verification in connection with the domain name at issue. On November 20, 2003, OnlineNic, Inc. d/b/a China-Channel.com transmitted by email to the Center its verification response and confirmed that it was the Registrar for the domain name at issue and the Respondent is listed as the registrant of the domain name at issue. Further, the Registrar provided contact details for the administrative, billing, and technical contact and confirmed that the Uniform Domain Name Dispute Resolution Policy (the "Policy") applied to the domain name at issue.

In response to a notification of November 21, 2003, by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on November 21, 2003, (electronic version) and on November 24, 2003, (hard copy). The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Policy, 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"). The Complainant made the required payment to the Center.

In accordance with paragraphs 2(a) and 4(a) of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 25, 2003. In accordance with paragraph 5(a) of the Rules, the due date for Response was December 15, 2003. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 16, 2003.

The Center appointed Markus S. Hellgren as the Sole Panelist in this matter on December 19, 2003. 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 paragraph 7 of the Rules. The Panel was required to forward its decision to the Center by January 2, 2004, in accordance with paragraph 15 of the Rules.

The language of the proceeding is English.

4. Factual Background

The Complainant is the result of the merger by incorporation of Buongiorno

The Complainant is the owner of the following trademark application and trademark registration:

Italian Trademark Application No. 2000C0005479 BUONGIORNO, filed on May 11, 2000, in International Classes 35 (advertising, business management, business administration, office functions, e-business services, dissemination of advertising matter, buying and selling of goods via the Internet) and 38 (telecommunications, communication by computer terminals).

Community Trademark Registration No. 1705078 BUONGIORNO, filed on June 9, 2000, registered on October 4, 2002, in International Classes 35 (advertising, business management, business administration, office functions, dissemination of advertising matter, buying and selling of goods via the Internet) and 38 (telecommunications, communication by computer terminals).

The domain name at issue was registered on January 13, 2002.

5. Parties' Contentions

A. Complainant

Identical or Confusingly similar

The Complainant contends that the domain name at issue is confusingly similar to the trademark BUONGIORNO in which the Complainant has rights.

The Complainant states that it should be noted that several WIPO Panels have found that a risk of confusion exists when a domain name is composed by the letters "www," added to a Complainant's trademark in the context of a domain name, without the period between the letters "www" and the Complainant's trademark.

In this regard, the Complainant refers to *Reuters Limited v. Global Net 2000, Inc.*, WIPO Case No. D2000-0441, concerning the domain name <www.reuters.com> and *World Wrestling Federation Entertainment, Inc. v. Matthew Bessette*, WIPO Case No. D2000-0256, concerning the domain names <www.wwf.com> and <www.stonecold.com>.

Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the domain name at issue.

The Complainant is a very well-known company, listed in the Italian stock exchange. It also directly controls a group of companies which are based in Spain, the UK, France, Germany and Austria. The Complainant's core businesses are digital marketing services and value-added consumer services for wired and wireless telephony.

As such, the company name and trademark BUONGIORNO makes part of a brand recognized in the market. The Complainant's most important media and business tool is the website "www.buongiorno.com" registered under the Complainant's former company name Buongiorno.it S.p.A. on March 6, 2000.

The Respondent is unknown to the market players and to the customers. The activities carried out through the website distinguished by the domain name at issue, distribution of adult content through dialers, have no connection whatsoever with the brand and name BUONGIORNO or corporate connection with the Complainant's group.

The domain name at issue was registered on January 13, 2002, *i.e.* when the Complainant had already acquired goodwill and reputation in the market.

According to the above, there is no evidence, before any notice to the Respondent of this dispute, of the Respondent's 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.

Further to the above, there is no evidence that the Respondent, either as an individual person or as a business, has been commonly known by the domain name at issue.

Eventually, also in consideration of the fact that (i) the Respondent uses the domain name at issue for commercial purposes and that (ii) the Respondent obviously aims at exploiting a common typing error of the Internet users (who digit "wwwbuongiorno.com" instead of "www.buongiorno.com"), there is no evidence that the Respondent is making a legitimate non-commercial use or fair use of the domain name at issue. On the contrary, the above mentioned facts demonstrate that the Respondent is using the domain name at issue for misleading Internet users who intend to reach the Complainant's website www.buongiorno.com.

Registration and Use in Bad Faith

The Complainant contends that the domain name at issue was registered and is being used in bad faith.

The Complainant business and brand are targeted by the Respondent in order to illicitly exploit the Complainant's goodwill, brand and commercial reputation.

The Complainant contends that several WIPO Panels have found that the so called "typosquatting" activities amount to an activity in bad faith. In this respect, the Complainant refers to the previously cited WIPO Cases and also to *AT&T Corp. v. John Zuccarini d/b/a Music Wave and RaveClub Berlin*, WIPO Case No. D2002-0440, *Dell Computer Corporation v. RaveClub Berlin*, WIPO Case No. D2002-0601, *Collections Etc., Inc. v. RaveClub Berlin*, WIPO Case No. D2002-0698 and *The Princeton Review v. RaveClub Berlin*, WIPO Case No. D2003-0205.

The *ratio* of the above cited WIPO Cases applies to the present case. In fact, if the Respondent had intended to carry out its business in a genuine way, it could have used any other domain name to promote and carry out its own activities. The use of the domain name at issue - whose only purpose is to take advantage from Internet traffic searching for Complainant's brand and to divert this traffic to the Respondent's website - is a clear proof of the attempt, made by the Respondent, to attract for commercial gain Internet users to the Respondent's website, and to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and services on the Respondent's website or location.

B. Respondent

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

6. Discussion and Findings

The Panel is satisfied that the Center took all steps reasonably necessary to notify the Respondent of the filing of the Complaint and commencement of this administrative proceeding, and that the Respondent's failure to submit a Response is not due to any omission by the Center.

In view of the Respondent's failure to submit a Response, the Panel shall decide the dispute based upon the Complaint according to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it

considers appropriate according to paragraph 14(b) of the Rules.

According to paragraph 4(a) of the Policy, the Complainant must assert and prove each of the following:

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

A. Identical or Confusingly Similar

The Complainant refers to an Italian Trademark Application and a Community Trademark Registration in order to show that it has rights in the service mark BUONGIORNO. The Panel deems that a trademark application does not give the Applicant any trademark rights before a trademark registration is granted. However, the Complainant is the owner of a Community Trademark Registration for the service mark BUONGIORNO and has thereby shown that it has rights in the service mark in question.

The only differences between the Complainant's service mark BUONGIORNO and the domain name at issue are the addition of "www" and the gTLD ".com." The addition "www" is the well known acronym for "World Wide Web" and has no distinguishing capacity in the context of domain names. Further, the gTLD ".com" is of no significance when determining whether or not a domain name is identical or confusingly similar to a trademark or service mark.

A number of WIPO Panels have considered domain names that consist of the prefix "www" in front of a trademark and have concluded that such domain names are confusingly similar to the relevant trademark. See e.g. *World Wrestling Federation Entertainment, Inc. v. Matthew Bessette*, WIPO Case No. D2000-025 and *Microsoft Corporation and MSNBC Cable LLC v. Seventh Summit Ventures*, WIPO Case No. D2002-0567.

Accordingly, the Panel finds that the domain name at issue is confusingly similar to the service mark BUONGIORNO in which the Complainant has rights.

B. Rights or Legitimate Interests

According to paragraph 4(c) of the Policy, a Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Respondent of the dispute, the Respondent's 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) the Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is 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.

There is no evidence before the Panel that any of the situations in paragraph 4(c) of the Policy apply in the case of the Respondent.

The Complainant has shown that the Respondent uses the domain name at issue in connection with a commercial pornographic website. The website has no connection with the Complainant's service mark

BUONGIORNO or connection with the Complainant's group. The purposeful addition of "www" in front of the Complainant's service mark BUONGIORNO is a clear indication that the Respondent is using the domain name at issue in order to mislead Internet users who intend to reach the Complainant's website "www.buongiorno.com."

The Panel therefore finds that the Respondent has no rights or legitimate interests in the domain name at issue.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of a domain name:

(i) circumstances indicating that the respondent has registered or the respondent 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 on-line 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.

In addition to these criteria, other factors alone or in combination can support a finding of bad faith.

This is a typical case of "typosquatting" where the domain name consists of a third party trademark with the addition of "www" in front of the trademark. It is obvious that the Respondent wishes to take advantage of the Complainant's service mark since Internet users who neglect to include the period between the "www" and the Complainant's service mark BUONGIORNO are diverted to the Respondent's website instead of the Complainant's website. In this respect, the Panel agrees with the Panel in *AltaVista Company v. Saeid Yomtobian*, WIPO Case No. D2000-0937, that "The use of misspellings alone is sufficient to prove bad faith under paragraph 4(b)(iv) of the Policy because Respondent has used these names intentionally to attract, for commercial gain, Internet users to his website by making a likelihood of confusion with the Complainant's mark."

Further, the Respondent is using the domain name at issue in order to divert Internet users, who neglect to include the period between the "www" and the Complainant's service mark BUONGIORNO, to a pornographic website. Such use is considered to be evidence that the domain name has been registered and used in bad faith according to paragraph 4(a)(iii) of the Policy. See e.g. *Club Monaco Corporation v. Charles Gindi*, WIPO Case No. D2000-0936, *Caledonia Motor Group Limited v. Amizon*, WIPO Case No. D2001-0860 and *Six Continents Hotels, Inc. v. Seweryn Nowak*, WIPO Case No. D2003-0022. The Panel stated in *Six Continents Hotels, Inc. v. Seweryn Nowak*, WIPO Case No. D2003-0022: "Preliminary, it is commonly understood, under WIPO case law, that, whatever the motivation of Respondent, the diversion of the domain names to a pornographic site is itself certainly consistent with the finding that the domain name was registered and is being used in bad faith."

Accordingly, the Panel finds that the domain name at issue was registered and is being used in bad faith.

7. Decision

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