

## Procedure of Reassignment of the domain name “dupont.it”, subject to opposition proceedings

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**Decision of the Single-Member Panel in accordance with art. 3.12 and 4.15 of the “Regulation for dispute resolution in the ccTLD “.it” – Version 1.0 and of art. 4.18 of the “Guidelines for dispute resolution in the ccTLD “.it” –Version 1.0.**

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**Appellant:** Du Pont de Nemours Italiana S.r.l. (hereinafter referred to, for ease of reference, as “Appellant” or “Dupont”);

**Respondent:** Mr. Giovanni Caporaso (hereinafter referred to, for ease of reference, as “Respondent”);

**Domain name subject to previous opposition:** dupont.it.

**Single-member Panel:** Mr. Cristiano Bertazzoni, lawyer

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### THE COURSE OF THE PROCEEDINGS

1. On 6 May 2008 the Dispute Resolution Services Provider (DRSP), law firm Tonucci & partners, received from the Appellant – both electronically and by express courier – the introductory appeal of the reassignment procedure on the domain name which was the subject of the previous opposition, “dupont.it”.

2. On the same day, the DRSP informed the Registrar, in accordance with art. 4.3 par. 3 of the *Regulation for dispute resolution in ccTLD “it” – Version 1.0* of the reception of the introductory appeal of the reassignment procedure on the domain name which was the subject of the previous opposition, “dupont.it”

3. The four days provided by art. 4.3 having elapsed without any notices from the Registrar having been received, on 12 May 2008 the DRSP:

- a) having checked the regularity of the appeal and the enclosures;
- b) having checked the Appellant’s regular performance of the previous opposition to the registration of the subject domain name (doc. 4, Appellant’s file);
- c) having checked that the proceedings expenses have been paid;

it searched in the database of assigned names (DBAN) and found that the domain name “dupont.it” was assigned to Mr. Giovanni Caporaso. The status of the aforesaid domain name was “ACTIVE – CHALLENGED”.

4. On the same date, 12 May 2008, the DRSP acknowledged, pursuant to art. 4.4 of the Regulation for dispute resolution in ccTLD “it” – Version 1.0, receipt of the appeal (enclosing an electronic version thereof without attachments) and acknowledged to the

Respondent (at its email address [domains@commercecivity.com](mailto:domains@commercecivity.com) as retrieved from the Appellant's file, on the basis of a prior request for access to data forwarded to Dupont, in the absence of contact details in the DBAN) receipt of the introductory appeal of the reassignment procedure on the domain name which was the subject of the previous opposition proceedings, "dupont.it". In the aforesaid electronic notice, the DRSP also notified the forwarding of the appeal with all the relative enclosures by registered mail addressed to Mr. Caporaso, as can be seen from the deeds of the proceedings. Furthermore, in the above mentioned electronic notice, the DRSP reminded the Respondent that the reassignment procedure is considered started when the owner of the domain name in question has been totally notified of the appeal and its enclosures and that within the subsequent 25 days the Respondent may send its reply and documents to the DRSP. The Respondent was also invited to read the instructions for its defence at the DRSP's website, the link of which was provided. DRSP later checked the correct address of the notice and enclosed appeal which were forwarded to the email address [domains@commercecivity.com](mailto:domains@commercecivity.com) obtaining the report of successful transmission and delivery to the email server.

**5.** On 19 May 2008 DRSP notified by mail the parties to the proceedings – in accordance with art. 4.6 of the Regulation for dispute resolution in ccTLD ".it" – Version 1.0 – of the official date of start of the same. In particular – also according to art. 4.4 last paragraph of the regulation for dispute resolution in ccTLD ".it" – Version 1.0 – the DRSP stated as follows:

a) it forwarded by registered mail with return receipt the appeal with all the attachments thereto to Respondent Mr. Giovanni Caporaso, at the geographical address indicated by the deeds of the proceedings as acquired by Dupont following a request for access to data forwarded to the Registrar (doc. 3 Appellant's file);

b) on 14 May 2008, as attested by postal stamp affixed on the enclosed return receipt, the Post Office tried to deliver the parcel to the addressee, who appeared "no longer at that address";

c) considering that in accordance with art. 4.4 par. 2 letter (c) of the Regulation for dispute resolution in ccTLD ".it" – Version 1.0 of 18.01.2007, should the addressee be absent at the address indicated in the Registrar's database of assigned names, the appeal is considered notified to the owner of the aforementioned domain name upon the Post Office's attempt to deliver the registered letter;

d) considering that the date of 14 May 2008 should have been deemed the date on which the owner of the opposed domain name examined the appeal and attachments thereto;

e) considering that according to art. 4.4 of the Regulation for dispute resolution in ccTLD ".it" – Version 1.0 of 18.01.2007, the appeal was sent to the Respondent by email on 12 May 2007, and the email message appeared to have been correctly sent to the Respondent's email address;

consequently the DRSP informed that the official starting date of the reassignment procedure was formally indicated on 14 May 2008.

**6.** In the same message to the parties, the DRSP informed that the 25 day term for the Respondent to possibly send a brief of reply started from 14 May 2008 and that once the aforesaid term has lapsed, the DRSP would proceed with appointing the single-member panel in accordance with art. 4.7 of the Regulation.

7. On 9 June 2008, after the expiry of the fixed term for the Respondent without the latter having submitted any brief of reply, the DRSP proceeded with checking if Mr. Cristiano Bertazzoni – the expert indicated in the list published online on the DRSP’s website – was willing to be appointed within the single-member panel (requested by the Appellant in the appeal), charged with issuing the decision of the reassignment procedure. The expert ascertained the absence of causes hindering the acceptance of the appointment, notified the DRSP of its own written acceptance and communicated the date within which he would issue the decision.

8. On 10 June 2008 the DRSP notified the parties, in accordance with art. 4.7 of the Regulation for dispute resolution in ccTLD “.it” – Version 1.0 – of the completed formation of the single-member panel for the decision of the reassignment procedure on the domain name which was the subject of the previous opposition, “dupont.it”, and forwarded to the nominated expert all the deeds of the procedure for the purpose of the decision.

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### **INTRODUCTORY APPEAL OF DUPONT DE NEMOURS ITALIANA S.R.L.**

In the introductory appeal of these proceedings, Dupont stated it enjoyed rights to the DUPONT trade mark, the latter being the subject of several national and foreign registrations, mentioning i.a. the Italian registration of trade mark DUPONT No. 0001052075 with effect in Italy since 1921 (doc. 5 Appellant’s file) as well as Community registration No. 001427574 for the same trade mark of 16.12.1999 (doc. 6).

The examination of the trade mark documents highlighted registrations owned by Holding E.I. Dupont De Nemours and Company – USA. However, also in accordance with art. 4.1, paragraph 2, letters (a) and (b) of the Regulation for dispute resolution in ccTLD “.it” – Version 1.0 – this panel deems Dupont de Nemours Italiana S.r.l. to be legitimately entitled in the proceedings for the following reasons: firstly, the Appellant filed (doc. 8) the express statement of the U.S. parent company showing that all the trade marks are owned by E.I. Dupont De Nemours and Company – USA and its affiliated companies.

Secondly, this panel believes that the legal approach whereby all companies belonging to the same entrepreneurial group have the legitimate right to the protection of the so-called “group trade mark” is important, in that they must consider themselves at least implicit licensees, if not co-owners (see, in this respect, Court of Rome, 5 June 1986, in Foro Padano, 1987, I, 264).

In the case of groups of enterprises, the entrepreneurial singularity of the group should be considered, regardless of the (merely legal) splitting into different subjects, as recognised by case law (consistently, Court of Milan, 18/04/1983, in Riv. Ind., 1983, II, 329 and Court of Catania, 25 January 1977, in Giur. Ann. Dir. Ind., 1977, 221) and also in doctrine (inter alia, Vanzetti, section “Marchio” in Enciclopedia Giuridica Treccani, Di Cataldo, “*Distinctive signs*”, 1985, Sena, “Overcoming the so-called scheme of legal personality in the rules on competition and trade marks”, in Quaderni di giurisprudenza commerciale, 1987 and Pettiti “Il marchio di gruppo” , 1996).

On the other hand, legislative decree 10/2005 (Industrial Property Code) sets forth that a trade mark registration can be obtained by whoever uses it and intends to use it not only in the operation of its business, but also in “businesses controlled by it or using the trade

mark with its (the owner's) consent"; in this way, the Legislator has acknowledged that the registered trade mark can be used, and that not only the formal owner, but also the related subjects, by virtue of the intergroup relations, may benefit from the related protection.

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The Appellant based its appeal on rights documentally proved in connection with the DUPONT trade mark – created in 1802 – very famous worldwide (also in accordance with art. 6-bis of the Paris Convention), confusingly similar – being identical – to the domain name dupont.it and registered with rights prior to the subject domain.

With reference to the conditions set forth by art. 3.6(a) of the Regulation for dispute resolution in ccTLD “.it” – Version 1.0, the Appellant stated that, first of all, the domain dupont.it was identical and, in any case, apt to mislead the public with respect to the trade mark to which the Appellant enjoys legitimate prior rights. Dupont also stated that Mr. Giovanni Caporaso had proceeded with registering the domain dupont.it being fully aware he was infringing the Appellant's rights. This is evidenced by the fact that on the same website constructed below the domain in question, the Respondent publishes a series of links by categories containing both Dupont's trade mark and the trade marks corresponding to some of its most famous products like TEFLON E CORIAN (doc. 9).

As regards the requirement set forth by art. 3.6(b) of the regulation for dispute resolution in ccTLD “.it” – Version 1.0, the Appellant stated that without prejudice to the onus of proof on the Respondent, no exempting condition indicated by art. 3.6, 3<sup>rd</sup> par. of the Regulation existed, Mr Caporaso's conduct appearing to be contrary to the rules, especially to the provisions of law decree 30/2005 including the Industrial Property Code (hereinafter referred to, for ease of reference, as “i.p.c.”).

With regard to the requirement of art. 36(c) of the regulation for dispute resolution in ccTLD “.it” – Version 1.0, the Appellant stated as follows.

- The Respondent registered the domain dupont.it “only to usurp other party's distinctive signs and to take undue advantage of the appeal and popularity enjoyed by the “DUPONT” trade mark, registered by Dupont;
- The Respondent knowingly registered a domain name identical to an internationally famous trade mark; moreover, it even proceeded to exploit its potential appeal, if it is true – as ascertained – that the website, accessible through the domain dupont.it, is a parking page containing third parties' advertisements hosted on the site, presumably on payment according to the *pay per click* procedure;
- The Respondent demonstrated its bad faith also by providing – upon registering the domain – incorrect information and contact details, as if it intended to exclude, from the start, its availability.

For the foregoing, the Appellant requested the reassignment of the domain dupont.it in its favour.

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### **MR. GIOVANNI CAPORASO'S POSITION**

In spite of the regular notice of the introductory appeal, the Respondent did not join the present reassignment proceedings not did it file any brief of reply.

## **THE MEASURE REQUESTED BY THE APPELLANT**

In accordance with art. 3.6 of the Regulation for dispute resolution in ccTLD “.it” – Version 1.0, domain names are subject to the Reassignment Procedure where the appellant states that:

a) the contested domain name is identical or such as to create confusion with respect to a trade mark or another corporate distinctive sign to which it enjoys rights, or to its own name and surname;

b) the current assignee has no right or title in respect to the domain name in question;

c) finally, the domain name was assigned and is used in bad faith.

If the Appellant shows there are the conditions under lett. (a) and (c) mentioned above, and the Respondent, in turn, does not prove it has right or title in relation to the above domain name, the latter is transferred to the Appellant.

The appeal appears to be grounded and shall be accepted for the reasons set forth below.

### **ON THE REQUIREMENTS OF LETTER (A) OF ARTICLE 3.6 OF THE REGULATION FOR DISPUTE RESOLUTION IN ccTLD “.IT”**

The domain name “dupont.it” is clearly confusingly similar, both verbally and phonetically, to the worldwide known registered trade mark “DUPONT”, to which the Appellant enjoys legitimate rights as a company belonging to Holding Dupont.

In this respect, it should be agreed with the Appellant’s statements that the trade mark DUPONT should be considered famous and, therefore, worthy of protection as indicated by art. 22 2<sup>nd</sup> par. i.p.c., which prohibits the adoption as domain name of a mark similar to a registered trade mark renown also for non similar goods, regardless of whether they have been claimed for the specific services rendered via the website.

Although this circumstance is not necessary for the requirement *de quo*, the mere likelihood of confusion and identity between domain name and trade mark being sufficient regardless of its fame or the classes of goods and services for which it is registered, the trade mark’s renown is certainly of importance in demonstrating the bad faith and therefore the requirement ex art. 3.6(c) of the Regulation.

In light of the above, the condition for the requirement lett. A) art. 3.6 of the Rules should be deemed to have been met.

### **ON THE REQUIREMENTS OF LETTER (C) OF ARTICLE 3.6 OF THE REGULATION FOR DISPUTE RESOLUTION IN ccTLD “.IT”**

As provided by art. 3.6(c) of the Regulation, in order for the domain name to be reassigned, the Appellant should also prove that the domain name in question has been registered and is used in bad faith by the current assignee.

To check the existence of this requirement, art. 3.7 identifies the circumstances which, if demonstrated, prove the bad faith of the domain registration and use, namely:

- a) circumstances leading to the belief that the domain name has been registered with the main goal of assigning, licensing for use or transferring in another way the domain name to the Appellant, owner of a name which is the object of a right, recognised or established by international or Community law, or to a competitor for consideration, whether monetary or otherwise, which is of greater value than the costs reasonably borne by the Respondent for the registration and maintenance of the domain name;
- b) the circumstance that the domain name has been registered by the Respondent to prevent the holder of the right to a name, trademark, geographical name or other distinctive sign, recognised by national or Community law, from using such name, geographical name, trade mark or distinctive sign in a corresponding domain name and it being used for activities competing with that of the Appellant or, for public entities, magistrates or other state bodies, in such a way as to mislead citizens searching for information on institutional activities;
- c) the circumstance that the domain name has been registered by the Respondent with the main purpose of damaging the business of a competitor or usurping the Appellant's name and surname;
- d) the circumstance that, in using the domain name, the latter has been intentionally used to attract, for the sake of making a profit, Internet users, causing the likelihood of confusion with a name which is the subject of a right recognised or established by the national and/or Community law or with the name of a public entity;
- e) the registered domain name is a specific name, namely, the name of a public or private entity for which there is no provable link between the registrant of the domain name and the registered domain name.

The list provided at art. 3.7 of the Regulation is not exhaustive and the panel may find elements proving the bad faith in the registration and use of the domain names even from different circumstances.

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According to the panel, in the present case the Respondent's bad faith exists both in relation to the registration and to the use thereof which the Appellant proved through the documentation provided with the notice.

With respect to the registration, also in the light of the foregoing observations, it is believed that the Respondent, on requesting the assignment of the domain in question, could not ignore DUPONT's rights to the DUPONT trade mark, considering the worldwide fame of the latter for more than two hundred years.

Moreover, as Dupont revealed, it is believed that the Respondent was aware of its fame and intended, by registering the domain dupont.it, to illegally prevent the Appellant from using one of its distinctive signs on the web.

In the panel's view, such conduct represents the subjective element of the bad faith in compliance with art. 3.7 letters (b) and (c) of the Regulation. Furthermore, the use, presumably for profit-making, of the domain dupont.it (below which is another advertising site and third parties' commercial advertisements are published), also represents the subjective element of bad faith of art. 3.7 letter (d) of the Regulation.

**ON THE REQUIREMENTS OF LETTER (B) OF ARTICLE 3.6 OF THE REGULATION FOR DISPUTE RESOLUTION IN ccTLD ".IT"**

In order for the domain name in question to be reassigned, the Appellant shall prove, as it effectively did, the circumstances indicated at lett. A) and C) of art. 3.6 of the Regulation.

However, this rule provides that should the Respondent prove to have a right or title in relation to the domain name in question, the Appellant's request for reassignment shall be rejected. Therefore, it is the Respondent's task to prove the right or title which would legitimate it to the registration and use of the domain name.

Conversely, the Respondent did not present any defence in the proceedings *de quo*, thus failing to perform what was one of its precise tasks.

### **FOR THESE REASONS**

the Panel, having read and examined all the documents attached by the Appellant

### **ACCEPTS,**

in accordance with art. 4.15 of the Rules and 4.18 of the Guidelines for dispute resolution in ccTLD ".it", the appeal submitted by Du Pont de Nemours Italiana S.r.l. and the application for reassignment in favour of the domain name "dupont.it".

### **AND ORDERS**

that the DRSP proceed with the notices of this decision in accordance with and at the conditions provided by art. 4.16 of the Regulation, so that the Registrar adopt the measures indicated by art. 3.12 and 4.16 of the Regulation and 4.18 and 4.19 of the guidelines for dispute resolution in ccTLD ".it".

that the decision be published in accordance with article 3.11 of the Regulation on the webpage <http://www.tonucci.it/maps/decisio.htm> of the DRSP's site.

At today's date this decision is forwarded to the DRSP for subsequent uses.

Rome, 17 June 2008

Mr. Cristiano Bertazzoni  
(signature)