



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE

ADMINISTRATIVE PANEL

DECISION

CIIDRC case number:	16880-CDRP	Decision date: March 28, 2022
Domain Name:	lamborghini.ca	
Panel:	Douglas M. Isenberg, Esq.	
Complainant:	Automobili Lamborghini S.p.A.	
Complainant's representative:	Philip Koch of HK2 Rechtsanwälte	
Registrant:	Mike Morgan	

1. PROCEDURAL HISTORY

The procedural history of this case was set out in a letter from the Canadian International Internet Dispute Resolution Centre to the Panel:

- a. On February 11, 2022, Mr. Phil Koch of HK2 Rechtsanwälte, filed a Complaint pursuant to the CDRP and the Resolution Rules. The identity of the Registrant is not published in the public WHOIS database; therefore, the Registrant's name was not included in the Complaint.
- b. CIRA was notified of this proceeding on February 11, 2022, and on the same date, CIRA transmitted by email to CIIDRC its verification response informing who is the Registrant of the disputed domain name. CIRA also confirmed that the < lamborghini.ca > domain name was placed on a Registrar LOCK.
- c. On February 11, 2022, CIIDRC, confirmed compliance of the Complaint and commencement of the dispute resolution process.
- d. On February 15, 2022, counsel for the Complainant filed further submission with respect to the issue of the Registrant's legitimate interest (or lack thereof) in the disputed domain name, as permitted by section 11.1 of the CIRA Domain Name Dispute Resolution Rules Version 1.5.

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- e. Pursuant to Resolution Rule 4.4, CIIDRC notified the Registrant of this administrative proceeding and forwarded a Notice of commencement of the administrative proceeding along with the Complaint to the Registrant on February 11, 2022. The Complainant's additional submission was sent to the Respondent on February 15, 2022.
- f. Attempts to deliver the Complaint to the Registrant have been unsuccessful. (Documentation of delivery attempts by courier and email enclosed).
- g. The Registrant failed to file its response by the due date of March 7, 2022.
- h. The Complainant in this administrative proceeding has elected for a Panel consisting of a single-member.
- i. CIIDRC appointed Douglas M. Isenberg, Esq., as a single-member Panel in the above-referenced matter on March 14, 2022.

The domain name <lamborghini.ca> (the "Disputed Domain Name") was registered on February 15, 2017.

This matter is conducted pursuant to the Canadian Dispute Resolution Policy (the CDRP) and the Canadian Dispute Resolution Rules (the Resolution Rules) of the Canadian Internet Registry Authority.

2. FACTS ALLEGED BY THE PARTIES

Complainant states that it "was founded in 1963 by Ferruccio Lamborghini as Automobili Ferruccio Lamborghini," that it is "part of the Lamborghini Group," that it is "an Italian manufacturer of high-performance sports cars based on Sant'Agata Bolognese, Italy," and that its "vehicles... belong to the world's most famous luxury sports cars."

Complainant further states, and provides evidence in support thereof, that it is the owner of "a large number of... national and international trademarks for the term LAMBORGHINI (the "LAMBORGHINI Trademark"), including Intl' Reg. No. 460,178 (registered March 28, 1981), as well as the following registrations in Canada: CIPO Reg. Nos. TMA744080 (registered July 27, 2009) and TMA248397 (registered July 25, 1980).

Complainant further states, and provides evidence in support thereof, that the Disputed Domain Name resolves to a pay-per-click ("PPC") website that also includes the text, "Buy this name \$28,000 USD."

The Registrant did not submit a response.

3. CONTENTIONS OF THE PARTIES

- **Complainant**

The Complainant submits that the Disputed Domain Name is confusingly similar to the LAMBORGHINI Trademark because it "is identical to Complainant's wordmarks 'Lamborghini' and confusingly similar to the design marks" and "'Lamborghini' is the only component of the domain name."

The Complainant further submits that the Registrant has no legitimate interest in the Disputed Domain Name because the Registrant does not satisfy any of the criteria set forth in paragraph 3.4 of the CDRP, including that the PPC website associated with the Disputed Domain Name “is not a bona fide offering because PPC links compete with or capitalize on the reputation and goodwill of the Complainant’s trademark, or otherwise mislead internet users” and the Disputed Domain Name “generates a high risk of implied false affiliation with the Complainant and its activities.”

The Complainant further submits that the Registrant has registered the Disputed Domain Name in bad faith because, *inter alia*, by offering to sell the Disputed Domain Name for US \$28,000, “there can be no doubt that the Domain Name was solely registered for the purpose of selling the Domain Name to the Complainant, or the Complainant’s licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant’s actual costs and thereby unfairly capitalize[s] on Complainant’s goodwill in its trademarks”; “[r]esolving a Domain Name to a pay-per-click page, such as in the present instance, with a view to reaping a commercial advantage by capitalizing on consumer confusion constitutes a prima facie evidence of bad faith”; the “Registrant has offered a means by which internet users may access links to business that compete with the Complainant, but in any case is competing for Internet traffic by trying to capitalize on consumer confusion and Complainant’s goodwill in its trademarks”; and the Registrant “has also already been Respondent in two administrative proceedings under CDRP, namely Cases No. CRDP-2180 – skyscanner.ca et al. and 16133-CRDRP – walmartrewards.ca),” both of which resulted in the transfer of the disputed domain names.

- **Registrant**

As stated above, the Registrant did not submit a response.

- **Remedy Sought**

The Complainant requests the Domain Name be transferred to it.

4. DISCUSSION AND FINDINGS

4.1 Eligibility

The Complainant is an eligible complainant under paragraph 1.4 of the CDRP, which states: “The person initiating a Proceeding (the ‘Complainant’) must, at the time of submitting a complaint (the ‘Complaint’), satisfy the Canadian Presence Requirements for Registrants (the ‘CPR’) in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (‘CIPO’) and the Complainant is the owner of the trade-mark.” As stated above, Complainant is the owner of multiple CIPO registrations for the LAMBORGHINI Trademark.

4.2 Requirements

In accordance with Paragraph 4.1 of the CDRP, the Complainant must prove, on a balance of probabilities, that:

- the Registrant's dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and
- the Registrant has registered the domain name in bad faith.

Further, in accordance with Paragraph 4.1 of the CDRP, the Complainant must provide some evidence that:

- the Registrant has no legitimate interest in the domain name

The Panel will consider each of these requirements in turn.

4.3 Analysis

4.3.1 That the Registrant's dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights

With respect to paragraph 3.1(a) of the CDRP, the Panel concludes that Complainant had rights in the LAMBORGHINI Trademark prior to the date of registration of the Disputed Domain Name, as a result of the registrations described above.

Paragraph 3.3 of the CDRP states: "In determining whether a domain name is 'Confusingly Similar' to a Mark, the Panel shall only consider whether the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark." It is apparent that the Disputed Domain Name contains the LAMBORGHINI trademark (and only the LAMBORGHINI Trademark) in its entirety.

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(a) of the CDRP.

4.3.2 That the Registrant has no legitimate interest in the domain name

With respect to paragraph 3.1(b) of the CDRP, regarding a lack of legitimate interests, the Registrant has not made any attempt to rebut Complainant's allegations or argue that it has a legitimate interest in the Disputed Domain Name under any of the six elements described in paragraph 3.4 of the CDRP, nor is there any evidence that demonstrates Registrant has a legitimate interest in the Disputed Domain Name. See, e.g., *General Motors LLC v. Tony Wilson*, CIRA Case No. 00182 ("the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name and this evidence has not been rebutted by the Registrant").

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(b) of the CDRP.

4.3.3 That the Registrant has registered the domain name in bad faith

The Panel evaluates whether the Complainant has established that Registrant has registered the Disputed Domain Name in bad faith, as defined by the CDRP. Pursuant to paragraph 3.5 of the CDRP, the following “shall be evidence that a Registrant has registered a domain name in bad faith”:

- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant’s licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant’s actual costs in registering the domain name, or acquiring the Registration;
- (b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant’s licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;
- (c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant’s licensor or licensee of the Mark, who is a competitor of the Registrant; or
- (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s 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 Registrant’s website or location or of a product or service on the Registrant’s website or location.

The Panel is persuaded that bad faith exists pursuant to paragraph 3.5(a), *given that the Registrant has advertised the Disputed Domain Name for sale for US \$28,000. See, e.g., KINDRED IP LIMITED v. Patrick Lanier*, CIIDRC Case No. 16135-CDRP: A “landing page” offering to sell a disputed domain name for US \$2,000 “is obviously an amount far in excess of the Registrant’s actual registration costs” and “is only one step away from the classic cybersquatting archetype in which a registrant actively solicits the complainant or a competitor to purchase the Domain Name for a disproportionate sum.”

The Panel is persuaded that bad faith exists pursuant to paragraph 3.5(b), given that the Registrant has lost at two previous decisions under the CDRP. See, e.g., *Inter-Continental Hotels Corporation v. James Alex, Design Factory*, WIPO Case No. D2010-0974 (finding bad faith under the analogous Uniform Domain Name Dispute Resolution

Policy (UDRP) where complainant alleged that “two domain names...indicate[] a ‘pattern’ of conduct by Respondent”).

The Panel is persuaded that bad faith exists pursuant to paragraph 3.5(c), given that the Registrant is using the Disputed Domain Name in connection with a PPC website. See, e.g., *Omer DeSerres Inc. v. Erik Maddeaux*, CIRA Case No. DCA-1005-CIRA: Using a disputed domain name in connection with “a pay-per-click website displaying various sponsored (or advertised) links that resolve to websites that compete with the Complainant... with a view to reaping a commercial advantage by attempting to capitalize on consumer confusion constitutes *prima facie* evidence of bad faith.”

In light of the above, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(c) of the CDRP.

5 DECISION and ORDER

For the above reasons, in accordance with Paragraph 4 of the CDRP, Paragraph 12 of the Resolution Rules, the Panel orders that the Disputed Domain Name be transferred to the Complainant.

Made as of March 28, 2022

SIGNATURE OF PANEL

