

ADMINISTRATIVE PANEL DECISION

Carel Industries S.p.A v. Frezza Giorgio
Case No. D2023-3605

1. The Parties

The Complainant is Carel Industries S.p.A, Italy, represented by Società Italiana Brevetti S.p.A., Italy.

The Respondent is Frezza Giorgio, Italy.

2. The Domain Name and Registrar

The disputed domain name <carel-group.com> is registered with Infomaniak Network SA (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 28, 2023. On August 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 29, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 30, 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 amendment to the Complaint on August 31, 2023.

The Center verified that the Complaint together with the amendment to 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 September 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 26, 2023.

The Center appointed Anna Carabelli as the sole panelist in this matter on October 18, 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 an Italian company established in 1973, which manufactures and markets control solutions for air conditioning, refrigeration and heating, and systems for humidification and evaporative cooling. The Complainant operates both directly and through subsidiaries in about eighty countries.

The Complainant is the owner of numerous trademark registrations for CAREL in several jurisdictions, including the following:

Countries / Jurisdictions	Trademark	Application No.	Classes	Application date	Registration date
ITALY	CAREL (figurative)	VR1997C00039 4 last renewal No. 362017000106 632	9	October 1, 1997	March 16, 2000
EUROPEAN UNION	CAREL (word)	493767	9,11	March 20, 1997	October 14,1999
EUROPEAN UNION	CAREL (word)	18378909	6,7,9,11,17, 35,37,4 1,42	January 20, 2021	August 03, 2021
INTERNATIONAL REGISTRATION designating: Belarus, Bosnia and Herzegovina, China, Croatia, Republic of Korea , Macedonia, Montenegro, Morocco, Norway, Russian Federation, Serbia, Singapore, Switzerland, Türkiye , Ukraine	CAREL (word)	676173	9,11,16	June 24, 1997	June 24, 1997

The Complainant is also the owner of the domain name <carel.com>, which resolves to the Complainant's official website, as well as other domain names including <carel.it>, <carelgroup.org> and <carel.store>.

The disputed domain name was registered on June 21, 2023 and resolves to an inactive page which states the following in Italian "Impossibile raggiungere il sito" ("Unable to reach the site").

5. Parties' Contentions

A. Complainant

The Complainant submits and contends that:

The disputed domain name is confusingly similar to the Complainant's registered and well-known CAREL mark.

Indeed, the disputed domain name reproduces entirely the Complainant's trademark with the addition of the term "group", followed by the generic Top-Level (gTLD) ".com".

The Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed, authorized or permitted the Respondent to register the disputed domain name. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name nor is he using it in connection with a *bona fide* offering of goods or services, so as to confer a right or legitimate interest in it in accordance with paragraph 4(c)(i) of the Policy. Indeed, the disputed domain name resolves to an inactive website. The Complainant submits that the disputed domain name is configured with MX records and is therefore capable of email communication for phishing activity.

The disputed domain name was registered and is being used in bad faith.

The Respondent knew or should have known about the existence of the earlier and well-established Complainant's mark. Passive holding, which is the case here, demonstrates bad faith. The Respondent's concealment of its identity by using a privacy service and the fact that the disputed domain name is configured with MX records, which could potentially be used for phishing purposes, are also indicative of bad faith.

Based on the above, the Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

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

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the CAREL mark based on the evidence submitted in the Complaint.

The disputed domain name consists of the Complainant's CAREL mark, with the addition of the term "group" preceded by a hyphen, and followed by the gTLD ".com".

As highlighted in section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), the addition of a gTLD such as “.com” is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test.

Therefore, the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name (see section 1.7 of the [WIPO Overview 3.0](#)).

The disputed domain name entirely incorporates the Complainant’s CAREL mark and this is a sufficient element to establish the first element, as held by previous UDRP panels (e.g., *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element.

Accordingly, the Panel finds that disputed domain name is confusingly similar to the CAREL mark in which Complainant has rights. Therefore, the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice to it of the dispute, its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name, even if it has acquired no trademark or service mark rights;
- (iii) it 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.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following: (a) the Complainant holds prior rights in the globally registered and well-known CAREL mark, (b) the Respondent has not been authorized to use the Complainant’s trademark in any way, and (c) the disputed domain name does not resolve to an active website.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Here the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy. There is no indication before the Panel of any activity in relation to the disputed domain name that would give rise to rights or legitimate interests to the Respondent. Moreover, the

disputed domain name is confusingly similar to the Complainant's CAREL trademark and carries a risk of implied affiliation with the Complainant. Such risk for implied affiliation cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

Therefore, the Panel finds that the Complainant has established paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant.

Given the reputation of the Complainant's trademark, registration and use of which precede by far the registration of the disputed domain name, it is not conceivable that the Respondent did not have in mind the Complainant's trademark when registering the disputed domain name. Such fact suggests that the disputed domain name was registered in bad faith (see [WIPO Overview 3.0](#), section 3.2.2). Prior panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith ([WIPO Overview 3.0](#), section 3.1.4).

As to bad faith use, the evidence submitted with the Complaint shows that the disputed domain name does not point to an active website. The current inactive status of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. As stressed by many previous UDRP decisions, "While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding 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, and (iii) the implausibility of any good faith use to which the domain name may be put." (See section 3.3 of the [WIPO Overview 3.0](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Each of these considerations points to the Respondent's passive holding of the disputed domain name being in bad faith. Specifically: (i) the Complainant's trademark is distinctive and well established; (ii) the Respondent has failed to submit any claims or evidence of good-faith use; (iii) the absence of any relationship between the Respondent and the Complainant; and, (iv) given the confusing similarity to the Complainant's trademark, there is no conceivable good faith use to which the disputed domain name could be put by the Respondent, that would not result in creating a misleading impression of association with the Complainant.

Furthermore, the fact that the disputed domain name is configured with MX records which could potentially be used for phishing purposes, corroborate the finding of bad faith.

For all the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith by the Respondent.

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, <carel-group.com>, be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: October 24, 2023