

## **ADMINISTRATIVE PANEL DECISION**

Columbia Insurance Company v. Rosario Bellantoni  
Case No. D2023-4871

### **1. The Parties**

The Complainant is Columbia Insurance Company, United States of America (the “United States”), represented by Baker & McKenzie LLP, United States.

The Respondent is Rosario Bellantoni, Italy, represented by Achilles Gioldasis - Attorney at Law, Greece.

### **2. The Domain Name and Registrar**

The disputed domain name <berkshirehathawaycapital.com> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 22, 2023. On November 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 23, 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 (Tucows Domains Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 23, 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 November 27, 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 November 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2023. The Response was filed with the Center on December 4, 2023. The Center sent an email to the Parties regarding possible settlement on December 5, 2023. The Complainant informed the Center on the same day that it would not request for suspension of proceeding.

The Center appointed Nicholas Smith as the sole panelist in this matter on January 4, 2024. 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 wholly owned indirect subsidiary of Berkshire Hathaway Inc. (“Berkshire Hathaway”). Berkshire Hathaway is one of the largest public companies in the world and one of the largest companies by revenue. Berkshire Hathaway is a conglomerate that has a wide variety of holdings in the field of real estate, insurance, energy, and utilities and manufacturing. Berkshire Hathaway, the Complainant, and various entities in the Berkshire Hathaway group offer a variety of services, including financial and investment services under the trademark BERKSHIRE HATHAWAY (the “BERKSHIRE HATHAWAY Mark”) and various BERKSHIRE HATHAWAY-formative marks.

The Complainant has held a trademark registration for the BERKSHIRE HATHAWAY Mark in various jurisdictions including a European Union Trade Mark registration for the BERKSHIRE HATHAWAY Mark (Registration number 005770946, registered March 6, 2008 for various financial services in class 36).

The Domain Name was registered on May 27, 2021. The Domain Name resolves to a website (the “Respondent’s Website”) that purports to offer competing financial services under the BERKSHIRE HATHAWAY Mark from an entity purportedly based in the United States.

#### **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 Domain Name.

Notably, the Complainant contends that:

- a) It is the owner of the BERKSHIRE HATHAWAY Mark, having registered the BERKSHIRE HATHAWAY Mark in various jurisdictions. The Domain Name is confusingly similar to the BERKSHIRE HATHAWAY Mark as it reproduces the BERKSHIRE HATHAWAY Mark in its entirety and adds the term “capital”.
- b) There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Complainant has not granted any license or authorization for the Respondent to use the BERKSHIRE HATHAWAY Mark. The Respondent is not commonly known by the BERKSHIRE HATHAWAY Mark, nor does it use the Domain Name for a *bona fide* purpose or legitimate noncommercial purpose. Rather the Respondent is using the Domain Name to pass off as Berkshire Hathaway or a licensee of Berkshire Hathaway for commercial gain by purporting to offer financial services in direct competition with Berkshire Hathaway and under the Berkshire Hathaway name. Such use is not a legitimate use of the Domain Name.
- c) The Domain Name was registered and is being used in bad faith. The Respondent is using the Domain Name to divert Internet users searching for Berkshire Hathaway to the Respondent’s Website to disrupt Berkshire Hathaway’s business and for commercial gain. Such conduct amounts to registration and use of the Domain Name in bad faith.

##### **B. Respondent**

The Respondent acknowledges the Complainant’s rights in BERKSHIRE HATHAWAY Mark, but contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the

Domain Name because the Respondent does not use the Domain Name to falsely associate itself with the Complainant or otherwise mislead clients into thinking that the Respondent's Website is an official Berkshire Hathaway website. This is because the Respondent purchased the Domain Name legally from the site provider. Furthermore, the Respondent has used the Domain Name in good faith because his application for the registration of a company was accepted by the State of Delaware, United States, and he was not informed of any conflict of interest or infringement of trade mark rights.

The Respondent notes that there are other domain names available for registration containing the BERKSHIRE HATHAWAY Mark.

## **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 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 entirety of the mark is reproduced within the Domain Name. Accordingly, the Domain Name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other elements, here "capital", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the respondent may demonstrate rights or legitimate interests in a disputed domain name.

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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made 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. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.
- the Respondent (as an individual, business, or other organization) has not been commonly known by the Domain Name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- the Respondent is not 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. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.
- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the Domain Name.

The composition of the Domain Name carries a risk of implied affiliation with the Complainant (see [WIPO Overview 3.0](#), section 2.5.1). The Respondent's use of the Domain Name to resolve to a webpage reproducing the Complainant's well-known BERKSHIRE HATHAWAY Mark and offering financial services in direct competition with Berkshire Hathaway does not amount to use for a *bona fide* offering of goods and services. Rather, it appears that the purpose behind the Respondent's Website is to encourage visitors to conduct business with the Respondent, under the impression that they are dealing with Berkshire Hathaway or a licensee of Berkshire Hathaway, such conduct not being *bona fide*. There is no explanation provided by the Respondent about its use of the Domain Name including why it chose to register a Domain Name wholly incorporating the BERKSHIRE HATHAWAY Mark for the purpose of offering competing financial services.

The Respondent submits that he uses the Domain Name in good faith, having registered a (presumably corresponding) company name with the State of Delaware, United States, but provides no documentary evidence to support this assertion. It is unclear what the Respondent means when it asserted that it purchased the Domain Name legally from the site provider however the mere fact that the Domain Name was available to be registered from a registrar does not by itself provide a party with rights or legitimate interests. The Respondent has failed to provide any relevant evidence demonstrating rights or legitimate interests in the Domain Name.

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

### **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 Panel finds that the Respondent must have been aware of the Complainant and its reputation in the BERKSHIRE HATHAWAY Mark at the time the Respondent registered the Domain Name. The Respondent has provided no explanation, and neither it is immediately obvious, why an entity would register a domain name incorporating the coined BERKSHIRE HATHAWAY Mark (with the addition of the descriptive term "capital") and redirect it to a website purportedly offering financial services in competition with Berkshire Hathaway and under the BERKSHIRE HATHAWAY Mark unless there was an awareness of and an intention to create a likelihood of confusion with the Complainant and its BERKSHIRE HATHAWAY Mark.

The Respondent's Website purports to offer financial services in direct competition with Berkshire Hathaway in a manner that creates the impression that it is or is associated with Berkshire Hathaway. Noting the coined nature of the BERKSHIRE HATHAWAY Mark and the absence of any explanation for the registration, the Panel considers that the most likely explanation is that the Respondent is using the Domain Name to

intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the BERKSHIRE HATHAWAY Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

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

## **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 Domain Name <berkshirehathawaycapital.com> be transferred to the Complainant.

*/Nicholas Smith/*

**Nicholas Smith**

Sole Panelist

Date: January 9, 2024